

**DECISION
of the First Board of Appeal
of 28 June 2021**

In case R 1547/2019-1

Rochem Group AG

Bahnhofstrasse 32

6300 Zug

Switzerland

IR Holder / Appellant

represented by BALDER IP LAW, S.L., Paseo de la Castellana 93, 28046 Madrid, Spain

v

ROCHEM MARINE S.r.l.

Via degli Artigiani, 51

16162 Genova

Italy

Cancellation applicant / Defendant

represented by PGA S.P.A., Via Mascheroni, 31, 20145 Milano, Italy

APPEAL relating to Cancellation Proceedings No 14 543 C (International Registration No 1 151 485, designating the European Union)

THE FIRST BOARD OF APPEAL

composed of G. Humphreys (Chairperson), M. Bra (Rapporteur) and A. Kralik (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 Rochem Group AG is the proprietor ('the IR holder') International registration No 1 151 485 designating amongst others the EU ('the IR'), for the figurative mark

ROCHEM

based on Swiss trade mark No 636 779 with a priority claim of 6 November 2012 and registered on 15 January 2013, for various goods and services in Classes 1, 2, 3, 11, 37, 40 and 42.

The goods and services at issue in this appeal in respect of which the IR was declared invalid by the Cancellation Division are the following:

Class 11 - Apparatus and installations for separation and filtration of gaseous and liquid materials; separation and filtration elements for liquid and gaseous media, parts and accessories for the aforesaid goods, included in this class;

Class 40 - Removal of contaminated waters, waste waters and other contaminated gaseous or liquid materials by means of separation and filtration installations, of separation and filtration devices; finishing and treatment of liquid and gaseous materials by means of separation and filtration installations and by means of installations with separation and/or filtration elements.

- 2 The IR was republished on 18 March 2013 in accordance with Article 152(2) of Council Regulation (EC) No 207/1009 of 26 February 2009 and was granted effects in the European Union on 27 August 2014.
- 3 On 24 February 2017, the ROCHEM MARINE S.r.l. ('the invalidity applicant') filed a request for a declaration of invalidity of the EU designation of the IR in its entirety on grounds of the likelihood of confusion pursuant to Article 53(1)(a) of Council Regulation (EC) No 207/1009, as amended by Regulation 2015/2424 (hereinafter 'the CTMR, as amended by Regulation 2015/2424', now Article 60(1)(a) EUTMR). The application for a declaration of invalidity was based on Italian trade mark registration No 933 481 of the figurative mark



filed on 11 October 2000, registered on 12 July 2004 and duly renewed on 7 October 2010 for the following goods:

Class 11 – Desalination plants; grey water and black water treatment plants.

- 4 On 12 June 2017, the IR holder requested proof of use of the earlier mark pursuant to Article 57(2) and (3) CTMR, as amended by Regulation 2015/2424.

- 5 On 20 November 2017, the cancellation applicant submitted proof of use consisting of the following:
- Exhibit 1: Extract from the website www.rochem.de on its history and core business of designing, developing and installing (since 1994) complete waste water/drinking water treatment systems for cruise ships and large ferries; naval surface ships, submarines; landfill leachates and offshore;
 - Exhibit 2: Five invoices and one delivery note;
 - Exhibit 3: Documentation on trade fairs and exhibitions attended: Ecomondo Rimini 2007, 2008, 2009, 2010; Navdex Abu Dhabi 2011; Sea Trade Genova 2002 and 2004;
 - Exhibit 4: Advertising material;
 - Exhibit 5: Article on the ERSAI 400 project from the publication ‘Tecnologie e trasporti Mare’ – May/June 2008;
 - Exhibit 6: Technical sheets and a 2015 installation manual on the Bio-Filt Rochem product for the Italian Navy;
 - Exhibit 7: 2008, 2010 and 2012 technical product drawings.
- 6 On 23 February 2018, the IR holder replied arguing that the evidence was insufficient to demonstrate use of the earlier mark because:
- The information from the website is undated and not in Italian;
 - The five invoices did not show use of the earlier mark for the goods and all except for one were rendered to the same undertaking;
 - The delivery note was an internal document;
 - The pictures of attendance at trade fairs, the article from the publication ‘Tecnologie e trasporti Mare’ the technical documentation did not demonstrate use of the earlier mark;
 - The advertisements were undated and mostly in English;
 - The technical drawings were in German;
 - The evidence referred to use of the company name Rochem Marine Srl.
- 7 By decision of 20 May 2019 (‘the contested decision’), the Cancellation Division partially declared the IR invalid, namely for the goods and services in Classes 11 and 40 cited at paragraph 1 on grounds of the likelihood of confusion. The IR was maintained on the register for the remainder of the goods and services, which were found dissimilar. Genuine use was found for all the goods protected by the earlier mark. The parties were ordered to bear their own costs. The contested decision in material part is summarised as follows:

Proof of use

- Place of use: The invoices have been issued to clients in Italy. The advertising material, instruction manual and technical sheets are in English and Italian and bear an address in Italy. Therefore, there are sufficient indications in relation to use in Italy.
- Time of use: The invoices are dated within the relevant period. The earliest is from December 2010 and the most recent from January 2016. Exhibit 7 contains an installation manual dated in 2015 in which the earlier mark appears and the extract of ERS AI 400 Technologie & Transporti Mare is dated 2008. The technical drawings are dated between 2008 and 2016. There are sufficient indications concerning time of use.
- Nature of use: Most of the evidence shows the sign as registered.
- Extent of use: The total value of the invoices provided is approximately EUR 1.5 million. This is a considerable sum of money, even spread out over a period of several years from 2010 until 2016. The items manufactured and sold by the cancellation applicant are expensive industrial goods and therefore even a small number of invoices (five and one delivery note) covering large sums are capable of demonstrating significant commercial operations. Therefore, there are sufficient indications in relation to the extent of use.
- Although the invoices have not been translated from Italian into English, it is clear from the cancellation applicant's submissions and the short description of goods on the registration certificate of the earlier mark, that the invoices refer to desalination plants, and grey water and black water treatment plants. The invoices, taken together with the other evidence of business activity, particularly the instruction manual, technical sheets and advertising material, are sufficient to show that the earlier mark has been put to actual and genuine use in relation to the registered goods, namely: desalination plants, grey water, and black water treatment plants.
- The evidence is sufficient to establish genuine use of the earlier mark in Italy for the goods in question during the relevant period.

Likelihood of confusion

- The relevant consumers are likely to display a relatively high degree of attention.
- The contested goods in Class 11 and contested services in Class 40 cover the goods and services involved in the process of water treatment and therefore they are at least similar to the earlier grey water and black water treatment plants for which the earlier mark enjoys protection. These contested goods and services are also closely connected to the earlier desalination plants and are similar to a low degree.

- The marks in question are visually and aurally similar, because the most inherently distinctive part of the contested mark replicates the most distinctive element of the earlier mark in the same fanciful typeface, without material alteration.
 - There is a likelihood of confusion within the meaning of Article 60(1)(a) EUTMR in connection with Article 8(1)(b) EUTMR for the goods and services of the IR that are similar.
- 8 On 18 July 2019, the IR holder filed an appeal against the contested decision. The statement of grounds of the appeal was received on 17 September 2019.
- 9 The cancellation applicant replied with observations on 22 November 2019.

Submissions and arguments of the parties

- 10 The IR holder disputes the finding in the contested decision that the earlier mark has been genuinely used for ‘desalination plants; grey and black water treatment plants’ in Class 11 arguing as follows:
- The website extract is undated and is not in Italian. It does not show the trade mark but the sign  .
 - Only four of the trade fairs took place in Italy. At most the documentation on trade fairs demonstrates the existence of the company Rochem Marine Srl or ROCHEM MARINE but not use of the earlier mark as a trade mark.
 - The contested decision erred in stating that ‘it is clear from the cancellation applicant’s submissions and the short description of the goods on the registration certificate of the earlier mark, that the invoices refer to desalination plants and grey water and black water treatment plants’. The documents provided to show genuine use have to validate the information showed on the registration certificate, and not vice versa.
 - The invoices show at most use of a company name. Four out of the five invoices have been issued to one specific undertaking. This should be sufficient to disregard the invoices as means of showing use of the Italian mark for the goods in Class 11.
 - The delivery note is an internal document and does not depict the trade mark.
 - The use of ROCHEM MARINE on the letterhead of the invoices shows use of a corporate name. ROCHEM MARINE does not appear on Invoice No 000421 and should be disregarded. The sale of four items in ten years in the other invoices is not sufficient.
 - None of the documents shows the earlier mark affixed to the goods.

- Some of the advertising material has to be disregarded as it depicts signs that differ substantially from the earlier mark; by showing signs not depicted in blue or excluding the word ‘Marine’ or the drop device.
- The goods referred to in the leaflets are designated by another name: COSTA, FORTUNA, BECRUX, ELETTRA or TODARO.
- It is more likely that documents in English were not addressed to the Italian consumer.
- ERSAI 400 ‘Tecnologie e trasporti Mare’ – May/June 2008 publication does not show the trade mark affixed to the goods.
- The goods represented in the instruction manual are called Bio-Filt ®. The manual shows use of a company name and not a trade mark.
- The technical sheets do not show the place of use or the use of the earlier mark on the goods.
- The technical drawings, being in German, cannot be addressed to an Italian consumer.
- The technical drawings do not depict the earlier mark.

11 The cancellation applicant contends as follows:

- The appeal only concerns the proof of use and not the assessment under Article 8(1)(b) EUTMR.
- The Cancellation Division evaluated and took into account all the exhibits.
- Exhibit 1 (printout from the cancellation applicant’s website www.rochem.de/en/) gives an overview of the history and core business of the cancellation applicant.
- Material submitted without any indication of date of use may, in the context of an overall assessment, still be relevant and taken into consideration in conjunction with other pieces of evidence that are dated (17/02/2011, T-324/09, Friboi, EU:T:2011:47, § 33).
- The Office did not require a translation of the invoices, which the IR holder complains are in Italian.
- The IR holder contests whether the invoices show that the item sold are ‘desalination plants and grey water and black treatment plants’; all invoices submitted clearly mention the product description ‘Imp. Compl. Trattamento Liquami acque nere/grige’ which translated into English is ‘Sewage treatment plant black/grey water’.
- The invoices cannot be disregarded because four of the five invoices were issued to one undertaking.

- The Cancellation Division compared the short description of the goods on the registration certificate of the earlier mark, with the description in the invoices and stated that taken together with the other evidence of business activity, particularly the instruction manual, technical sheets and advertising material, they were sufficient to show that the earlier mark had been put to actual and genuine use in relation to the registered goods.
- Additional evidence by way of a further 22 invoices dated within the reference periods issued to customers in Italy and showing the use of the mark ‘ROCHEM MARINE’ for desalination plants, grey water and black water treatment plants are submitted on appeal.
- Although pieces of evidence individually may be insufficient by themselves to prove the use of an earlier trade mark, they may contribute to proving use in combination with other documentation and information. The Cancellation Division rightly evaluated the proof of use in its entirety.
- As supplementary evidence of the use of the trade mark on the products, a picture of an exhibit space at the trade fair ‘SEAFUTURE’ held in La Spezia in 2016 is enclosed, from which it is clearly possible to note that the mark is also affixed to the products. For the sake of clarity regarding the cancellation applicant’s participation in this event, a copy of the invoice for the cost of renting the exhibition space (Exhibit B – Item 1-2) is attached.
- The signs used in the advertising material do not alter the distinctive character of the earlier mark. The word element ‘ROCHEM’ is the most distinctive part of the earlier mark and it is reproduced in all the signs.

Reasons

- 12 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 13 Given the date on which the application for the declaration of invalidity was filed, namely 24 February 2017, which is decisive for the purpose of identifying the applicable substantive law, the facts of the case are governed by the substantive provisions of Regulation No 207/2009, in the Community trademark, as amended by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs), hereinafter ‘the CTMR, as amended by Regulation 2015/2424’.
- 14 Consequently, in the present cases, so far as concerns the substantive rules, the references in the contested decision to Articles 8(1)(b), 64(2) and (3), and 47(2) EUTMR must be understood as referring to Article 8(1)(b), 57(2) and (3), and 42(2) of Regulation No 207/2009, as amended by Regulation 2015/2424 the

wording of which is identical. Accordingly, the same applies to the references made hereinafter by the Board to Articles 8(1)(b), 64(2) and (3), and 47(2) EUTMR. The applicable provisions are indicated into parenthesis.

- 15 Furthermore, according to settled case-law, procedural rules are generally held to apply on the date on which they enter into force, the cases are governed by the procedural provisions of Regulation No 2017/1001 (12/05/2021, T 70/20, MUSEUM OF ILLUSIONS (fig.) / MUSEUM OF ILLUSIONS (fig.), EU:T:2021:253, § 17 and the case-law cited).
- 16 Pursuant to Article 80 EUTMDR, the implementing provisions of Commission Regulation No 2868/95 of 13/12/1995 (CTMIR) continue to apply to ongoing proceedings until such proceeding are concluded, unless otherwise provided in Article 82 EUTMDR. Since the adversarial part of the proceedings started before, and the request for proof of use of the earlier mark was made, before 1 October 2017, the CTMIR provisions regarding Revocation and Invalidity (Rules 37 to 40) and on proof of use (Rule 22) continue to be applicable to the invalidity proceedings that are the subject of this appeal, pursuant to Article 82(2)(f), (g) and (i) EUTMDR.
- 17 Since the appeal was filed after 1 October 2017, Chapter VII of EUTMR and Title V, ‘Appeals’ of EUTMDR, shall apply to it pursuant to Article 82(2)(j) EUTMDR.
- 18 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

Evidence of use filed on appeal

- 19 In its submission in response to the grounds of appeal, the cancellation applicant filed additional evidence relating to use of the earlier mark. The evidence consists of 22 invoices, a picture of the exhibit space the cancellation applicant occupied at the Seafuture trade fair in La Spezia, Italy 2016, and an invoice issued to the cancellation applicant for the cost of renting that space dated 14 April 2016.
- 20 Pursuant to Article 95(2) EUTMR, which is applicable in the present appeal proceedings, the Office may disregard facts or evidence which are not submitted in due time by the parties concerned. That provision grants the Board discretion to decide, while giving reasons for its decision, whether or not to take into account facts and evidence submitted out of time (13/03/2007, C-29/05 P, Arcol, EU:C:2007:162, § 43).
- 21 In accordance with settled case-law (13/03/2007, C-29/05 P, ARCOL / CAPOL, EU:C:2007:162, § 44; 11/12/2014, T-235/12, Grass in bottle (other), EU:T:2014:1058, § 62 and the case-law cited), which is now enshrined in Article 27(4) EUTMDR, the Board of Appeal may accept facts or evidence submitted for the first time before it only where (a) those facts or evidence are on the face of it, likely to be relevant for the outcome of the case and (b) they have not been produced in due time for valid reasons, in particular where they are merely supplementing relevant facts and evidence which had already been submitted in

due time, or are filed to contest findings made or examined by the first instance of its own motion in the decision subject to appeal.

- 22 In the present case, the evidence has been provided in response to the EUTM proprietor's arguments on appeal raising the insufficiency of the five invoices submitted before the Cancellation Division, and on the lack of evidence that goods bearing the earlier mark were exhibited at trade fairs. The evidence filed on appeal is relevant and supplements the evidence submitted previously before the Cancellation Division. The additional evidence filed on appeal is admitted by the Board exercising its discretionary power.

Proof of use

- 23 According to Articles 64(2) and (3) EUTMR (Articles 57(2) and (3), of Regulation No 207/2009, as amended by Regulation 2015/2424), if the proprietor of the EU trade mark so requests, the proprietor of an earlier trade mark, being a party to the invalidity proceedings, is to furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier trade mark has been put to genuine use in the Member State in question in connection with the goods or services in respect of which it is registered and which the proprietor of that earlier trade mark cites as justification for its application for a declaration of invalidity, or that there are proper reasons for non-use, provided that the earlier trade mark has at that date been registered for not less than five years. If at the date on which the EU trade mark application was filed or at the priority date of the EU trade mark application, the earlier trade mark had been registered for not less than five years, the proprietor of the earlier trade mark is to furnish, in addition, proof that the conditions set out in Article 47(2) EUTMR (Article 42(2) CTMR, as amended by Regulation 2015/2424) were satisfied at that date.

- 24 Rule 22 CTMIR (which was worded in a similar way as Article 10 EUTMDR), provided:

‘(3) The indications and evidence for the furnishing of proof of use shall consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based, and evidence in support of these indications in accordance with paragraph 4.

(4) The evidence ... shall, in principle, be confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 76(1)(f) [CTMR]’ (now Article 97(1)(f) EUTMR).

- 25 There is genuine use of a trade mark where the mark is used in accordance with its essential function as a trade mark, which is to guarantee the identity of the origin of goods or services for which it is registered, in order to create or preserve an outlet for those goods and services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 43). Moreover, the condition relating to genuine use of the trade mark requires that the mark, as protected on the relevant

territory, be used publicly and outwardly (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 37; 30/04/2008, T-131/06, Sonia Rykiel, EU:T:2008:135, § 38; 18/01/2011, T-382/08, Vogue, EU:T:2011:9, § 27).

- 26 In interpreting the notion of genuine use, account must be taken of the fact that the *ratio* for the requirement that the earlier mark must have been put to genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor to restrict trade mark protection to the case where large-scale commercial use has been made of the marks (26/09/2013, C-609/11 P, Centrotherm, EU:C:2013:1449, § 72, 74; 29/11/2018, C-340/17P, ALCOLOCK, EU:C:2018:965, § 90; 02/02/2016, T-171/13, MOTOBİ B PESARO, EU:T:2016:54, § 49).
- 27 When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establish whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 43).
- 28 As to the extent of the use to which the earlier trade mark has been put, account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use (02/02/2016, T-171/13, MOTOBİ B PESARO, EU:T:2016:54, § 71 and the case-law cited).
- 29 In order to examine, in a particular case, whether a mark (the earlier Italian mark in this case) has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case. That assessment implies certain interdependence between the factors taken into account. Thus, a low volume of goods marketed under the trade mark may be compensated for by a high intensity or a certain consistency over time of the use of that trade mark or vice versa. In addition, the turnover and the volume of sales of goods marketed under the earlier mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the mark and the characteristics of the products or services on the relevant market. As a result, the Court has stated that use of the mark at issue need not always be quantitatively significant in order to be deemed genuine. Even minimal use can therefore be sufficient to be deemed genuine, provided that it is viewed as warranted in the economic sector concerned in order to maintain or create a market share for the goods or services protected by the mark (02/02/2016, T-171/13, MOTOBİ B PESARO, EU:T:2016:54, § 72 and the case-law cited).
- 30 The Court of Justice also added (11/05/2006, C-416/04 P, Vitafruit, EU:C:2006:310) that it is not possible to determine a priori and in the abstract a quantitative threshold for the purposes of determining whether use is genuine or not and, therefore, a *de minimis* rule, which would not allow EUIPO or, on appeal, the General Court, to appraise all the circumstances of the dispute before

it, cannot be laid down. Thus, when it serves a real commercial purpose, even minimal use of the trade mark can be sufficient to establish genuine use (02/02/2016, T-171/13, MOTOBI B PESARO, EU:T:2016:54, § 73 and the case-law cited).

Five-year reference periods

- 31 The application for a declaration of invalidity against the contested IR was filed on 24 February 2017 and based on the earlier Italian trade mark No 933 481 registered on 12 July 2004. The contested IR was registered on 15 January 2013 with a priority claim of 6 November 2012. The earlier mark had, therefore, been registered for more than five years both at the date of the application for the declaration of invalidity and at the date of priority of the contested IR. Therefore, the relevant five-year periods to be taken into consideration as regards the proof of use of the earlier Italian mark are:
- 6 November 2007 to 5 November 2012 inclusive ('first period'); and
 - 24 February 2012 to 23 February 2017 ('second period').

Evaluation of the evidence

- 32 The IR holder in essence considers that the provisions governing evidence must be interpreted cumulatively, so that information which did not relate to the place, time, extent and nature of the use which had been made of the earlier mark should not be taken into account and that the Cancellation Division erred in validating the exhibits with shortcomings (undated, in English or German) from other exhibits meeting some of the criteria.
- 33 In this respect, it suffices to recall that, although Rule 22 CTMIR (similar to Article 10 EUTMDR) refers to indications concerning the place, time, extent and nature of use, and gives examples of acceptable evidence, such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements and statements in writing, that rule does not state that each piece of evidence must necessarily give information about all four elements to which proof of genuine use must relate, namely the place, time, nature and extent of use (16/11/2011, T-308/06, Buffalo Milke, EU:T:2011:675, § 61; 17/04/2008, C-108/07 P, Ferro, EU:C:2008:234, § 33).
- 34 Moreover, it is settled case-law that it cannot be ruled out that an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (17/04/2008, C-108/07 P, Ferro, EU:C:2008:234, § 36; 17/04/2008, C-108/07 P, Ferro, EU:C:2008:234, § 34).
- 35 Although each item of evidence considered individually must not necessarily include all the information required to establish genuine use of a contested mark, by contrast, it must be possible for the place, time, nature and extent of the use claimed by means of each item of evidence to be corroborated by other items of evidence submitted by the proprietor of a contested mark. It is therefore only the

consideration of all the evidence submitted to the Cancellation Division that must make it possible to establish proof of that use and each piece of evidence, therefore, does not necessarily have to relate at the same time to the time, place, duration, nature and extent of use.

- 36 In the present case, the Board considers that the evidence considered as a whole provides indications of the place, time, nature and extent of use of the earlier mark for the goods registered for the reasons given below.

Time of use

- 37 The invoices bear dates throughout each of the two reference periods. In relation to the first period, the cancellation applicant has also provided specifically an article on the ERS AI 400 project in the publication ‘Tecnologie e trasporti Mare’ – May/June 2008, and technical drawings. In relation to the second period, the cancellation applicant has provided a 2015 installation manual, evidence that it rented and exhibited products bearing the sign ROCHEM MARINE at the Seafuture trade fair in La Spezia, Italy in 2016, and technical drawings. There is sufficient evidence on the time of use, namely, over the two reference periods.

Place of use

- 38 The place of use is Italy and this is corroborated by the invoices all bearing dates in the two reference periods issued principally to Italian undertakings. The IR holder considers that the documents that are not in Italian cannot be deemed to have been directed to Italian customers. As the contested decision rightly stated and which is not disputed, the relevant public of the goods of the earlier mark are highly specialised and attentive undertakings seeking water treatment solutions for cruise ships, large ferries, naval surface ships and submarines (see extract from the website www.rochem.de in Exhibit 1 and advertising material in Exhibit 4, and the article in the publication ‘Tecnologie e trasporti Mare’ – May/June 2008, on the installation of the cancellation applicant’s reverse osmosis and water treatment system on a floating hotel/accommodation barge on the Caspian Sea.), which is dated within the first period and provides relevant information on the specialised nature of the goods. The attentive and well-informed public will understand the material provided in English. In any case, the cancellation applicant has provided sufficient material in Italian such as the invoices rendered principally to clients in Italy, the advertising material, commentary on the ERS AI 400 project in the publication ‘Tecnologie e trasporti Mare’ – May/June 2008, the technical drawings and the 2015 installation manual, and evidence of participation in trade fairs, in Italy, such as the invoice for participation in the trade fair ‘SEAFUTURE’ held in La Spezia in 2016.

Extent of use

- 39 In the IR holder’s view, five invoices submitted before the Cancellation Division four of which have been issued to the same undertaking are insufficient.
- 40 Bearing in mind the highly specialised and sophisticated nature of the product, its relatively high unit cost, the fact that the number of cruise liners, ships and

submarines manufactured and refurbished annually will not be high, the five invoices that were submitted before the Cancellation Division (four for EUR 275 000 and the fifth for in excess of EUR 387 000) constitute use which, objectively, is such so as to create or preserve an outlet for the goods in question and entails a volume of sales which, in relation to the period and frequency of use, is not so low that it may be concluded that the use is merely token, minimal or notional for the sole purpose of preserving the rights conferred by the mark.

- 41 In that context, it should be added that, in so far as the EUTM proprietor emphasises the fact that the sales volumes in question were very low, the requirement of genuine use does not seek to assess commercial success or to review the economic strategy of an undertaking; nor is it intended to restrict trade mark protection to cases where large-scale commercial use has been made of the marks (26/09/2013, C-609/11 P, Centrotherm, EU:C:2013:1449, § 72, 74; 29/11/2018, C-340/17P, ALCOLOCK, EU:C:2018:965, § 90).
- 42 In any case, those invoices have been supplemented on appeal by new invoices extending over the two reference periods, each for amounts that are very high, rendered principally to undertakings in Italy (see for example in relation to the first period, Invoice No 000283 of 30/06/2010 issued to Fincantieri SpA for the total value of EUR 895 000, Invoice No 000016 dated 22/01/2010 issued to another Italian client for the supply of a water desalination system for in excess of EUR 118 000; in relation to the second period Invoice Nos 000106, 000107, and 000108 all dated 18/04/2014, for the total value of approximately EUR 513 000 for the supply of sewage treatment issued to Fincantieri SpA)
- 43 As regards the delivery note, the IR holder's argument that it is an internal document lacking probative value cannot be followed. To the contrary, the relevant delivery note number is mentioned in Invoice No 000421 dated 21 November 2013, and concerns the delivery of the ROCHEM BioFilt, type 03/09-5m sold to the Italian shipbuilding company Fincantieri and therefore corroborates the public and outward delivery to an independent undertaking.

Nature of use

- 44 The cancellation applicant does not dispute the use of the sign  in the top right hand corner of the majority of the invoices and in the photos of the stands at trade fairs, in the technical sheets and in the instruction manual.
- 45 Nor does the IR holder dispute that the cancellation applicant marketed both water desalination by reverse osmosis and sewage water treatment plants in the reference periods (see for example, Invoice No 000283, of 30/06/2010, for the provision of a grey and black water treatment plant, to Fincantieri Spa, for a total amount of EUR 805 500, in the first period; Invoice No 000424 dated 07/10/2010 for the supply of reverse osmosis units to an Italian client for EUR 380 000 (first period); Invoice No 000273 dated 27/07/2012 for the supply of two reverse osmosis system (dissalatori) to another Italian client (Arsenale MM), in the first and second period); Invoice No 000454 dated 22/10/2010 for the supply of the BIO FILT water treatment plant to another Italian client in the first period; and

Invoices Nos 000106, 000107 and 000108 all dated 18/04/2014, falling in the second period, for the total value of approximately EUR 513 000, for the supply of sewage treatment plants).

- 46 However, according to the IR holder, this sign refers to the cancellation applicant's name and does not constitute use of a trade mark for the goods protected.
- 47 In that regard, it must be borne in mind that, when a mark contains a word that is, as in the present case, also a company name, it is possible for the company name to be used as a trade mark (see, to that effect, 15/07/2015, T-24/13, CACTUS OF PEACE CACTUS DE LA PAZ (fig.) / CACTUS, EU:T:2015:494, § 62 and the case-law cited). However, it is apparent from the case-law that the purpose of a company name is to identify a company and not, in itself, to distinguish goods or services. Accordingly, there is use in relation to goods or services where a third party affixes the sign constituting its company name to the goods which it markets, or where, even if the sign is not affixed, the third party uses that sign in such a way that a link is established between the sign which constitutes the company name and the goods marketed or the services provided by the third party (11/09/2007, C-17/06, Céline, EU:C:2007:497, § 21-23).
- 48 Where that condition is satisfied, the fact that a word element is used as the company's trade name does not preclude its use as a mark to designate goods or services (30/11/2009, T-353/07, Coloris, EU:T:2009:475, § 38 and the case-law cited; 18/07/2017, T-110/16, SAVANT, EU:T:2017:521, § 26).
- 49 In this case, the evidence as a whole establishes a link between the sign which constitutes the company name and the goods marketed. Indeed, the use of the earlier mark is as a house mark. While the cancellation applicant's name and address is indicated in the top left hand corner, the sign  appears independently and separately of the company name and address in the top right hand corner in most of the invoices.
- 50 The link between the sign and the term 'ROCHEM' which is the most distinctive element of the earlier mark is evident from the delivery note rendered in connection with the items covered by Invoice No 000421 identifying the supply of the 'ROCHEM BioFilt type 03/09-5', from the photo of the cancellation applicant's stand at the Seafuture trade fair submitted on appeal showing products with the sign 'ROCHEM MARINE', as well as from the main particulars of the ERSAI 400 accommodation barge in the publication 'Tecnologie e trasporti Mare' – May/June 2008, specifying as the 'fresh water makers' the 'Rochem Reverse Osmosis'.
- 51 The earlier mark, also appears at the top of the technical sheets on water desalination and on waste water treatment and in the 2015 installation manual on the Bio-Filt Rochem product for the Italian Navy, where it is used not as a company name but as the house mark for the range of water treatment solutions provided by the cancellation applicant: the ROCHEM reverse osmosis system ('ROCHEM RO system') and on the BIOFILT (which is described in the evidence as a 'ROCHEM bio reactor').

- 52 The technical sheets provided clearly explain the water treatment solutions offered under the sign , namely, the water desalination by ROCHEM RO systems and the conversion of grey and black water to blue water by the use of the ROCHEM BIOFILT plant.
- 53 The article on the ERSAI 400 project in the publication ‘Tecnologie e trasporti Mare’ – May/June 2008 further shows that the SAIPEM ERSAI 400 accommodation barge was equipped with ROCHEM technology: the reverse osmosis system for desalination and sewage water treatment plant.
- 54 In the light of the foregoing, there is sufficient evidence of the genuine use of the earlier mark for the goods protected by that mark in the reference periods.

On whether the signs used differ substantially from the earlier mark as registered

- 55 The IR holder refers in particular to the use of the following signs in some of the advertising material and argues that this material should be disregarded as it shows signs that differ significantly from the form of the earlier mark as registered within the meaning of Article 15(1)(a) CTMR as amended by Regulation 2015/2424 (now Article 18(1)(a) EUTMR):



- 56 As the Cancellation Division correctly found, the evidence as a whole shows use of the earlier mark in the form registered, namely, . The present case therefore does not concern a situation where the cancellation applicant has made use only of the signs illustrated above at paragraph 55.
- 57 Furthermore, the Board does not agree that these signs differ significantly from the form in which the earlier mark is registered.
- 58 The purpose of Article 18(1)(a) EUTMR (Article 15(1)(a) CTMR, as amended by Regulation 2015/2424) is to avoid imposing strict conformity between the used form of the trade mark and the form in which the mark was registered and to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned. In such situations, where the sign used in trade differs from the form in which it was registered only in negligible elements, so that the two signs can be regarded as broadly equivalent, the abovementioned provision envisages that the obligation to use the trade mark registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade (23/02/2006, T-194/03, Bainbridge, EU:T:2006:65, § 50).

- 59 A finding of an alteration of the distinctive character of the mark as registered requires an assessment of the distinctive and dominant character of the added elements based on the intrinsic qualities of each of those elements and the relative position of the different elements within the arrangement of the trade mark (12/03/2014, T-381/12, *Palma Mulata*, EU:T:2014:119, § 30; see also 10/06/2010, T-482/08, *Atlas Transport*, EU:T:2010:229, § 31 and case-law cited).
- 60 The earlier mark derives its distinctiveness from the verbal element ‘ROCHEM’ and that is reproduced in the above signs. Some of these signs also feature the word ‘MARINE’ present in the earlier mark as registered. The use of these signs does not alter the distinctive character of the earlier mark in the form registered. There is little that is striking about the colour blue for water treatment solutions; the drop device is of ancillary importance and occupies a secondary position in the overall impression produced by the mark and will be perceived by the relevant public as purely decorative. Insofar as the cover page of the publication in which the sign  has a blue background colour, quite naturally, for contrast, the colour green was adopted for the sign, which in other respects is practically identical to the earlier mark. As to the additional words, such as ‘WATER TREATMENT’, ‘REVERSE OSMOSIS SYSTEMS’ and ‘GREY AND BLACK WATER TREATMENT’, being descriptive and furthermore depicted in a much smaller size, they cannot be considered to alter the distinctive character of the earlier mark as registered. The wavy form was adopted for specific promotional material depicting ocean life with wavy lettering and used the wording ‘ROCHEM MARINE’ and other text in a wavy style to convey the notion of movement at sea.
- 61 The IR holder also refers to the use of names such as COSTA, FORTUNA, BECRUX, ELETTRA or TODARO in the product information. In that regard, reference is made to the fact that there is no precept in the EUTM system that obliges the proprietor of a mark to prove the use of it on its own, independently of any other mark. The case could arise where two or more trade marks are used jointly and autonomously, as for example a house mark in conjunction with a specific product / model identifier.

Translation of the proof of use

- 62 The IR holder also complains about the lack of translation of some of the documentation. In particular, the EUTM proprietor criticises the Cancellation Division for having assessed the invoices from the description of the goods in the registration certificate and its translation.
- 63 Rule 22(6) CTMIR, applicable in this case (which is similar to Article 10(6) EUTMDR), provided that where the evidence supplied by the opposing party is not in the language of the opposition proceedings, the Office *may* require the opposing party to submit a translation of that evidence in that language.
- 64 In the present circumstances in the light of the fact that parts of the evidence were already in English, and that evidence could be cross referenced to the parts in Italian, the Cancellation Division quite rightly did not request a translation of the evidence in Italian.

- 65 As to the invoices, whilst the wording of the goods in Italian in the registration certificate of ‘Impianti di dissalazione. Impianti di trattamento acque grigie ed acque nere’ translated as ‘desalination plants; grey water and black water treatment plants’, would explain the description in Italian of the goods in the invoices, the Board notes that the nature of the goods covered by the invoices was, in any case, adequately explained by the advertising material and the technical sheets in both English and Italian. Moreover, on appeal, the cancellation applicant has presented invoices, which include in the description of the goods, the following wording in English ‘water treatment plant’.

Conclusion

- 66 In the light of the above considerations, the Board confirms the finding of genuine use of the earlier mark for all the goods registered, namely, ‘desalination plants ; grey water and black water treatment plants’.

Likelihood of confusion

- 67 The IR holder has presented no arguments on the assessment in the contested decision under Article 8(1)(b) EUTMR.
- 68 For the reasons given in the contested decision, the Board endorses the finding that the goods and services of the mark applied for in Classes 11 and 40 are similar to the goods of the earlier mark.
- 69 The marks are also visually and aurally similar as found in the contested decision because they coincide in the distinctive word element ‘ROCHEM’, which has no specific meaning in relation to the goods and services at issue and differ only in elements that are weak or are decorative.
- 70 In the light of the above considerations, the contested decision correctly found a likelihood of confusion in Italy.

Costs

- 71 As the IR holder is the losing party in the appeal proceedings within the meaning of Article 109(1) EUTMR, it shall be ordered to bear the costs incurred by the cancellation applicant in the appeal proceedings.
- 72 As to the appeal proceedings, these consist of the cancellation applicant’s costs of professional representation of EUR 550.
- 73 As for the invalidity proceedings, the Cancellation Division ordered the parties to bear their own costs. This decision remains unaffected.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal ;**
- 2. Orders the IR holder to bear the cancellation applicant's costs in the appeal proceedings, which are fixed at EUR 550.**

Signed

G. Humphreys

Signed

M. Bra

Signed

A. Kralik

Registrar:

Signed

H.Dijkema

