



Reports of Cases

Case T-214/08

Paul Alfons Rehbein (GmbH & Co.) KG

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)

(Community trade mark — Opposition proceedings — Application for registration of the Community figurative mark OUTBURST — Earlier national word mark OUTBURST — Genuine use of the earlier trade mark — Article 43(2) and (3) of Regulation (EC) No 40/94 (now Article 42(2) and (3) of Regulation (EC) No 207/2009) — Production of evidence for the first time before the Board of Appeal — Article 74(2) of Regulation No 40/94 (now Article 76(2) of Regulation No 207/2009) — Rule 22(2) of Regulation (EC) No 2868/95)

Summary of the Judgment

1. *Community trade mark — Observations of third parties and opposition — Examination of the opposition — Proof of use of the earlier mark — Genuine use — Meaning — Criteria for assessment*

(Council Regulation No 40/94, Art. 43(2); Commission Regulation No 2868/95, Art. 1, Rule 22(2))

2. *Community trade mark — Observations of third parties and opposition — Examination of the opposition — Proof of use of the earlier mark — Genuine use — Meaning — Criteria for assessment — Requirement of solid and objective evidence*

(Council Regulation No 40/94, Art. 43(2))

3. *Community trade mark — Observations of third parties and opposition — Examination of the opposition — Proof of use of the earlier mark — Time-limit set by the Office — Submission of additional evidence after the end of the time-limit where there are new factors — Lawfulness*

(Commission Regulation No 2868/95, Art. 1, Rule 22(1))

1. In interpreting the notion of genuine use, for the purposes of Article 43(2) of Regulation No 40/94 on the Community trade mark, it must be remembered that the *ratio legis* of the provision requiring that the earlier mark must have been put to genuine use in order to be capable of being used in opposition to a trade mark application is to restrict the number of conflicts between two marks, where there is no good commercial justification resulting from a function actually performed by the mark on the market.

However, the purpose of Article 43(2) of Regulation No 40/94 and Rule 22(3) of Regulation No 2868/95, implementing Regulation No 40/94, is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade mark protection to the case where large-scale commercial use has been made of the marks.

There is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. Furthermore, 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.

When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly the usages regarded as warranted in the economic sector concerned as a means of maintaining or creating 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.

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.

(see paras 21-24)

2. An overall assessment, taking into account all the relevant factors of the case, must be carried out to examine in any particular case whether an earlier trade mark, for the purposes of Article 43(2) of Regulation No 40/94 on the Community trade mark, has been put to genuine use. Moreover, the genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned.

(see para. 25)

3. According to Rule 22(2), second sentence of Regulation No 2868/95 implementing Regulation No 40/94 on the Community trade mark, where the opposing party has to furnish proof of use or show that there are proper reasons for non-use, the Office for Harmonisation in the Internal Market (Trade Marks and Designs) shall invite him to provide the proof required within such period as it shall specify. If the opposing party does not provide such proof before the time limit expires, the Office shall reject the opposition.

However, that rule cannot be interpreted as precluding additional evidence from being taken into consideration where new factors exist, even if such evidence is adduced after the expiry of that time-limit.

That rule must be understood as not precluding the admission of additional evidence which merely supplements other evidence submitted within the time-limit laid down from being taken into account, where the initial evidence was not irrelevant, but was held to be insufficient. Such reasoning, which in no way renders the above rule superfluous, is all the more appropriate because the opponent did not abuse the time-limits by knowingly employing delaying tactics or by demonstrating manifest negligence, and because the additional evidence which it submitted merely corroborates the evidence resulting from the affirmations which were submitted within the time-limits.

(see paras 46, 53)