

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY
CANCELLATION DECISION
N° 300032
of 15 June 2020**

Claimant: **Westlake Chemical Corporation (Delaware)**
2801 Post Oak Blvd., Suite 600
77056 Houston, Texas
United States of America

Representative: **Novagraaf Nederland BV**
Hoogoorddreef 5
1101 BA Amsterdam
The Netherlands

against

Defendant: **ZHONGCE RUBBER GROUP COMPANY LIMITED**
No.2 10th Avenue
Hangzhou Economic and Technological Development Zone
Hangzhou
Zhejiang
China

Representative: **Chiever B.V.**
Barbara Strozzilaan 201
1083 HN Amsterdam
The Netherlands

Contested trademark: International registration 790769

WEST LAKE

I. FACTS AND PROCEEDINGS

A. Facts

1. On 27 July 2018 the claimant filed an application for cancellation following Article 2.30bis (1)(a) in conjunction with Article 2.30quater (1) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP")¹ based on the grounds for revocation set out in Article 2.27 (2) BCIP namely that no genuine use has been made of the contested trademark in accordance with Article 2.23bis BCIP.

2. The cancellation application is directed against the international registration 790769, designating amongst others the Benelux, which was filed by the defendant on 16 September 2002 and was registered on 26 December 2002 for goods in class 12 for the following semi-figurative trademark:



3. The cancellation application is directed against all goods of the contested trademark, namely:

Class 12: Inner tubes and tyre covers for various kinds of vehicles; inner tubes and tyre covers for bicycles.

4. The language of the proceedings is English.

B. Course of the proceedings

5. The application for revocation is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter 'the Office') to the parties on 31 July 2018. During the administrative phase of the proceedings both parties filed arguments. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter: "IR"). As the application relates exclusively to a declaration of revocation for non-use, pursuant to Rule 1.31(2) of the UR, the defendant was first given the opportunity to react in writing by submitting proof of use or substantiating that there are proper reasons for not using the contested trademark, at which time the claimant and, finally, the defendant were asked to react.

6. Upon examination of the file the Office suspended the proceedings ex officio due to a lack of clarity about the classification of the contested trademark. The defendant was first given the opportunity to react. Afterwards the claimant could reply to the defendant's arguments. The administrative phase was completed on 15 January 2020.

II. ARGUMENTS

A. Defendant's arguments

7. The defendant explains that he is headquartered in China and has four subsidiaries (ZC Europe, ZC America, ZC Brazil and ZC Thailand). He is the only tyre company in mainland China that is ranked in

¹ This decision shall always refer to the laws and regulations applicable on the date of the decision, except in the case of provisions which have undergone a material change during the proceedings and which are relevant to the decision.

the top 10 of the global ranking of Top 75 Global Tyre Manufactures. The contested trademark is used mainly for the international market. According to the defendant, the products are specially designed for demand from local markets and provide a wide variety of products. The defendant refers to its European website <http://www.westlaketyre.com/eu/index.php>.

8. As proof of use the defendant produces invoices, packing lists and bills of Lading (*sic*) from 2015 to 2018. He explains that in the past five years he has continuously sold WESTLAKE tyres to the Benelux distributors Van Aalderen Twen-Tyre B.V. and Deldo Autobanden NV through UAE based company Zenises DMCC. Furthermore, the defendant also produces print screens from various Dutch and Belgian web shops offering defendant's WESTLAKE tyres for sale.

9. Based on the foregoing, the defendant concludes that the contested trademark was used uninterruptedly in the Benelux for the past five years for all goods claimed. He therefore requests that the Office dismisses this application for revocation and orders the defendant to bear the costs.

B. Claimant's arguments

10. The claimant argues that the evidence produced by the defendant only shows use of the trademark in respect to radial tyres for powered land vehicles, whereas the goods listed in the specification of the contested trademark concern *inner tubes and tyre covers for various kinds of vehicles; inner tubes and tyre covers for bicycles*. For clarification purposes the claimant provides pictures of tyre covers and inner tubes for various kinds of vehicles and pictures of tyre covers for bicycles and inner tubes for bicycles. The defendant did not provide proof of use regarding the goods listed in the contested trademark, according to the claimant.

11. For these reasons, the claimant requests that the proof of use is deemed irrelevant, that the cancellation is granted and that the costs shall be borne by the unsuccessful party.

C. Defendant's last arguments

12. The defendant disagrees with claimant's conclusion that the contested trademark is not genuinely used for the goods listed in the classification of said trademark. He refers to the basic Chinese registration of the contested trademark. According to an English translation provided by a professional Chinese translator the Chinese registration is registered for 'inner tubes and tyres for various kinds of vehicles; inner tubes and tyres for bicycles'.

13. The defendant is of the opinion that WIPO apparently used an alternative translation of the Chinese basic registration. Nevertheless, it should be clear that WIPO meant to cover 'tyres' with the alternative translation, even if this word is not mentioned literally in the alternative translation used. Given the specific order of the words in the alternative translation 'inner tubes and tyre covers' it does not make any sense to explain 'tyre covers' literally as goods intended to cover tyres, since the sequence of the words makes it obvious that they see to the combination of a tyre consisting of an inner and outer part, according to the defendant.

14. The defendant argues that he has submitted substantial proof of use for 'tyres' and that 'tyres' are covered by the contested trademark, if not literally then by the alternative translation 'inner tubes and tyre covers' by WIPO.

15. Therefore, the contested trademark was used in the Benelux for the past five years for all goods claimed. The defendant thus requests that the application for cancellation is dismissed and that a decision is taken on the costs in favour of the defendant.

D. Defendant's reaction to the request for clarification regarding the classification of the contested trademark

16. The defendant invoked the following arguments to clarify the scope of protection of the classification of the contested trademark. First of all, he refers to a copy of the Chinese registration certificate together with an English translation which should prove that 'tyres' are the correct/intended translation of the claimed goods.

17. However, in the event the Office feels it is bound by the translation 'tyre cover' the defendant points out that 'tyre covers' also refers to 'tyres' themselves and not only to the covers of tyres. He refers to a Google Image Search to confirm his statement. Furthermore, he observes that the corresponding french translation for tyre covers, 'enveloppes pneumatiques' denotes the outer and external rubber part of a tyre. He submits an extract from the Office of the French language of Quebec, as well as an extract from an online dictionary and an extract from a patent document to attest this. Based on the foregoing he reiterates that the contested trademark was used in the Benelux during the relevant period for tyre covers, which is the equivalent of tyres.

18. Finally, after the prescribed time limit to file a reaction had lapsed, the defendant also sent the Office a copy of a decision of the Portuguese Trademark Office in a similar case which he considers relevant here.

E. Claimant's response following the defendant's reaction

19. The claimant points out that the original specification of the international registration is the English language. Since this specification does not read 'tyre' it does not cover 'tyres'.

20. Further, claimant refers to several decisions before other national and European authorities revoking the contested trademark due to lack of genuine use for the goods in class 12 or establishing lack of genuine use of the contested trademark for the goods covered.

21. Thus claimant requests the Office to deem the earlier filed evidence irrelevant, reject the defence filed by the defendant, grant the cancellation action filed as well as grant claimant an award on the costs.

III. GROUNDS FOR THE DECISION

A.1 Legal framework

22. Pursuant to Article 2.30bis (1)(a) in conjunction with Article 2.30quater (1) BCIP an application for revocation may be filed with the Office based on the grounds set out in Article 2.27 (2) BCIP. It is in

that case up to the defendant to provide proof that genuine use has been made of the contested trademark in accordance with Article 2.23bis BCIP in a period of five years prior to the date of the application claim for revocation in the Benelux territory or that there are proper reasons for non-use.

23. The application for revocation was submitted on the 27 July 2018. Therefore, the defendant is required to show use of the contested trademark, during the period from 27 July 2013 to 27 July 2018 ("the relevant period").

24. Following rule 1.41 io. 1.25 IR the proof of use should contain evidence of the place, duration, extent and manner of use of the contested trademark for the goods for which it is registered and against which the application for revocation is directed.

25. In accordance with the decision of the Court of Justice of the European Union (hereinafter referred to as "CJUE") of 11 March 2003 (CJUE, Ansul, C-40/01, ECLI:EU:C:2003:145) there is genuine use of a trademark 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. This is done 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. In that regard, the condition relating to genuine use of the trademark requires that the mark, as protected in the relevant territory, be used publicly and outwardly (see also General Court of the European Union (hereinafter referred to as "EGC"), Silk Cocoon, T-174/01, 12 March 2003, ECLI:EU:T:2003:68; EGC, Vitafruit, T-203/02, 8 July 2004, ECLI:EU:T:2004:225; EGC, Charlott, T-169/06, 8 November 2007, ECLI:EU:T:2007:337).

26. The EGC held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine (EGC, Hipoviton, T-334/01, 8 July 2004, ECLI:EU:T:2004:223; EGC, Sonia-Sonia Rykiel, T-131/06, 30 April 2008, ECLI:EU:T:2008:135). The purpose of the notion of genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trademark protection to the cases where large-scale commercial use has been made of the mark (EGC, Vitafruit, already referred to above).

27. In addition the EGC held that genuine use of a trademark 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 trademark in the market concerned (see EGC, Hiwatt, T-39/01, 12 December 2002, ECLI:EU:T:2002:316; EGC, Vitakraft, T-356/02, 6 October 2004, ECLI:EU:T:2004:292 and EGC, Sonia-Sonia Rykiel, already referred to above).

B. Analysis of the proof of use

28. The defendant submitted the following exhibits in order to demonstrate genuine use of the contested trademark:

1. Invoices, packing lists and bills of lading from 2015 to 2018 demonstrating the sale of tyres under the contested trademark in the Benelux;
2. Print screens from several Benelux web shops (www.banden-pneus-online.nl; www.autoenanders.nl; www.oponeo.nl; www.bandenconcurrent.nl and www.bandenleader.be) regarding the offering of West Lake tyres.

29. After an examination of the proof of use submitted, the Office finds that the exhibits only show use of the contested trademark in relation to tyres. There is no other evidence presented in relation to any other goods.

30. The Office establishes that the contested trademark is registered in class 12 for "inner tubes and tyre covers for various kinds of vehicles; inner tubes and tyre covers for bicycles". The goods for which the contested mark is used - tyres - are not covered by any of the categories for which the contested trademark is registered. An inner tyre refers to an inner rubber tube containing air which is inside a car tyre or bicycle tyre, whereas a tyre refers to a thick piece of rubber which is fitted onto the wheels of vehicles such as cars and bicycles².

31. The defendant argues that the term "tyre covers" in the classification also refers to "tyres". He explains that a Chinese registration served as the basis for the contested international trademark application, which was done in English, and that it is clear from a translation of this Chinese registration that it intended to claim "tyres" in class 12. Furthermore, the defendant observes that the corresponding French translation for tyre covers also covers "tyres" (see point 17). The Office establishes that the language of the contested international trademark application is English. It is not possible for the Office to check whether this English wording of the application corresponds with the wording of the classification in the Chinese basic registration. It should however be assumed to be the same as the English text and thus have exactly the same scope. It is the responsibility of the defendant to ensure that the language of the basic registration corresponds with the language of the international application and to take the necessary actions to remedy this should this not be the case. The French translation of the contested trademark application provided by WIPO is assumed to have the same meaning as the English text. In these proceedings the text of the classification of the goods in class 12 of the contested trademark is leading for the Office to judge whether the defendant has demonstrated use of said trademark.

Conclusion

32. As the defendant only demonstrated use of the contested trademark for tyres and these goods are not covered by the classification of the goods in class 12, as it appears from the language of the international application, the defendant did not demonstrate that the contested trademark has been used in the Benelux within the relevant period.

B. Other factors

33. The parties refer to decisions of other national and European authorities in order to support their arguments in this case (see points 18 and 20). The Office points out that it is not bound by other and/or its previous decisions. Each case has to be dealt with separately and with regard to its particularities. Besides, as for the defendant's reference to a Portuguese decision (see point 18), this information was submitted outside of the given time limit. The Office emphasizes that arguments should be submitted within the time limits as specified in rule 1.31 IR. In addition, the Office establishes that the defendant only provided the original Portuguese decision, without submitting a translation.

² See www.collinsdictionary.com.

C. Conclusion

34. Based on the foregoing the Office is of the opinion that the defendant did not provide proof that the contested trademark has been used in the Benelux within the relevant period.

IV. Decision

35. The cancellation application with number 3000032 is justified.

36. International registration 790769, with regard to the Benelux, will be revoked.

37. The defendant shall pay the claimant 1,420 euros in accordance with Article 2.30ter (5) BCIP in conjunction with rule 1.44 (2) IR, as the cancellation application is awarded in its entirety. This decision constitutes an enforceable order pursuant to Article 2.30ter (5) BCIP.

The Hague, 15 June 2020



Tineke Van Hoey
(*rapporteur*)

Camille Janssen

Diter Wuytens

Administrative officer: Diter Wuytens