

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**CANCELLATION DECISION**  
**N° 3000149**  
**of 12 October 2021**

**Claimant:** **MS TRADEMARKS Sp. z o.o.**  
Al. Gen. Wladyslawa Andersa 615  
43-300 Bielsko – Biala  
Poland

**Representative:** **BAP IP bvba - Brantsandpatents**  
Charles de Kerchovelaan 17  
9000 Gent  
Belgium

*against*

**Defendant:** **Friedrich Knapp**  
Hansestrasse 48  
38112 Braunschweig  
Germany

**Representative:** **V.O.**  
Carnegieplein 5  
2517 KJ Den Haag  
Netherlands

**Contested trademark: International registration 706285**



## **I. FACTS AND PROCEEDINGS**

### **A. Facts**

1. On 26 September 2019 the claimant filed an application for cancellation, in accordance with Article 2.30bis (1) (a) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP"), based on the ground for revocation stated under 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 International trademark registration 706285, designating the Benelux, which was filed by the defendant on 21 August 1998 and was registered for goods

in classes 9, 14, 16, 18 and 25, for the following combined word/figurative mark:



3. The cancellation application is directed against all goods in classes 18 and 25 of the contested trademark, which are:

Class 18 Leather, plastic and textile products, namely bags, particularly sports' bags and shopping bags and other leather products, namely cases not adapted to the goods to be contained, as well as small leather goods, particularly kits, coin holders and keyring cases.

Class 25 Men's and women's clothing, including knitwear, knitted goods, leather and imitation leather clothing, particularly blouses, shirts, tee-shirts, sweat shirts, jackets, pullovers, tops, bustiers, trousers, skirts, outfits, suits, coats, underwear, swimwear, headgear, scarves, headbands, tracksuits, gloves, belts for clothing, footwear.

4. The language of the proceedings is English.

### **B. Course of the proceedings**

5. The cancellation application is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 21 October 2019. 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 only concerns the revocation ground for non-use, the defendant, in accordance with Rule 1.31 (2) IR, was first given the opportunity to respond in writing by submitting proof of use or to substantiate that there are proper reasons for not using the trademark, after which the claimant and subsequently the defendant were requested to respond. The administrative phase was completed on 16 October 2020.

## **II. ARGUMENTS**

### **A. Defendant's arguments**

6. In order to prove that the contested trademark has been genuinely used, the defendant has submitted several types of documents, such as advertising material, invoices, delivery notes, style and order sheets, art work and sales figures.

7. According to the defendant, the contested trademark has been used under license by the NEW YORKER GROUP of which the defendant is the owner and managing director. The defendant also argues that the affiliates of the NEW YORKER GROUP in Belgium, Luxembourg and the Netherlands have sold and offered the goods concerned on which the contested trademark has been displayed on the packaging and labelling.

8. The contested trademark has also been used on marketing materials, such as flyers and coupons. The dates mentioned on these flyers and coupons fall within the relevant period. The flyers and coupons are in different languages (inter alia English, French and German), which, according to the defendant, shows that these materials are destined for a variety of European countries, including the Benelux. The defendant also refers to several photos that show that the contested trademark is used on labels and hangtags for clothing.

9. According to the defendant, it follows from the invoices that the defendant has offered and sold products during the relevant period in all three Benelux countries. Even though the invoices do not directly indicate or display the contested trademark, the delivery codes mentioned in the invoices can be linked to the delivery notes, which in turn show a description of the product, including the product code. The defendant further states that the style and order sheets, as well as the art work mention these product codes and show that the contested trademark has been displayed on the goods concerned. The defendant argues that the invoices and delivery notes should be seen in relation to the artwork and style and order sheets. The defendant also submits several combinations of these documents that are related to each other.

10. The defendant further refers to sales figures for Belgium, the Netherlands and Luxembourg. The defendant points out that the retail stores of New Yorker sell only to end consumers. Therefore, no invoices to third parties or end consumers are submitted as copies of sales receipts do not exist.

11. The defendant concludes that the contested trademark has been genuinely used and requests that the Office accepts the submitted proof of use and rules that the claimant bears the costs.

## **B. Claimant's arguments**

12. The claimant states that the evidence does not show that the contested trademark has been genuinely used in the Benelux in the past five years. According to the claimant, the evidence presents many inconsistencies and even some inaccuracies.

13. The claimant argues that several documents do not fall within the relevant period or are not dated at all. With regard to the advertising materials, the claimant states that it is unclear if these flyers and coupons are meant for the Benelux market, because none of these documents are in Dutch. According to the defendant, the English, German and French documents could also be destined for other European countries. Furthermore, the claimant points out that two photos of the products in clothing stores also show an instruction sign in German, Turkish and Polish in the background. This indicates that these photos are not taken in the Benelux. In addition, the claimant also states that it is not demonstrated that the advertising materials relate to the goods concerned.

14. With regard to the invoices and delivery notes, the claimant argues that these documents do not show the contested trademark. The claimant also states that the sales figures do not show any link with the contested trademark.

15. Furthermore, the claimant points out that one of the examples of matching documents shows an inconsistency, namely that the order sheet concerned is of a later date than the corresponding invoice and delivery note. According to the claimant, this would imply that this specific product was invoiced and delivered before it was even created.

16. The claimant concludes that the documents submitted by the defendant are insufficient to prove use for the goods concerned in the Benelux territory. For this reason, the claimant requests that the Office declares the contested trademark revoked for the goods in class 18 and 25.

### **C. Defendant's final arguments**

17. In reply to the arguments of the claimant, the defendant submits additional evidence including declarations of the Benelux manager of New Yorker, additional delivery notes that show the contested trademark, a declaration of an accountant, photos, art work and the cover of a magazine.

18. The defendant argues that all materials submitted must be assessed in conjunction with each other. Even if a piece of evidence is insufficient by itself to prove genuine use of the contested trademark, such a document could still contribute to the overall assessment of the proof of use in combination with other documents and information.

19. With regard to the claimant's argument that there is an incorrectness in one of the combinations of matching documents, the defendant explains that the product concerned was updated and that the art sheet mentions the date on which the document has been updated as 'date of creation'.

20. The defendant also refers to a declaration of an accountant, in order to substantiate the sales figures that are already submitted.

21. In the light of the above, the defendant states that he has provided sufficient evidence of use and requests that the Office rejects the request for cancellation and rules that the claimant bears the costs.

## **III. GROUNDS FOR THE DECISION**

### **A. Legal framework**

22. Pursuant to Article 2.30bis (1)(a) BCIP an application for revocation may be filed with the Office based on the grounds set out in, inter alia, Article 2.27 (2) BCIP. It is in that case for the defendant to prove that genuine use of the trademark has been made in the Benelux territory, in accordance with Article 2.23bis BCIP, in the five years previous to the filing of the application for revocation or that there are proper reasons for non-use.

23. The application for revocation was filed on 26 September 2019. Therefore the defendant was required to show use of the trademark during the period from 26 September 2014 to 26 September 2019 ('the relevant period').

24. Following Rule 1.41 IR in conjunction with Rule 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 and services against which the application for revocation is based.

25. In accordance with the decision of the European Court of Justice (hereinafter referred to as "ECJ") of 11 March 2003 (ECJ, 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 trademark 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 proven by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trademark on 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 in the Benelux:

- 1) Advertising materials, such as flyers and coupons in, inter alia, French, German and English;
- 2) Photos of products (in stores), hangtags and labels;
- 3) Invoices from New Yorker GmbH & Co KG in Germany to New Yorker Nederland B.V., New Yorker Luxembourg S.à.r.l. and New Yorker Belgium BVBA dated between July 2014 and June 2019;
- 4) Delivery notes, containing a delivery note number and descriptions of various clothing products, as well as product numbers, dated between July 2014 and August 2018;
- 5) Artwork and style and order sheets, containing product numbers and graphical images and photos of various products, indicating the position of the contested trademark on these products;

- 6) Several examples of combinations of matching invoices, delivery notes and style and order sheets;
- 7) Overview of sales figures for Belgium, the Netherlands and Luxembourg regarding clothing, shoes and bags.

*Additional evidence:*

- 8) Declaration of the manager of New Yorker in Belgium, the Netherlands and Luxembourg;
- 9) Delivery notes dated between September 2018 and July 2020;
- 10) Example of combination of matching documents;
- 11) Declaration of an accountant;
- 12) Photos of products;
- 13) Art work sheets concerning bags and sneakers;
- 14) Cover of a magazine, dated November 2001.

29. The Office finds that the invoices, delivery notes, art work, order and style sheets and combinations (nrs. 3, 4, 5, and 6) show that various clothing products have been sold to different New Yorker clothing stores in the Benelux within the relevant period. The order and style sheets show that the contested trademark is applied to different pieces of clothing, as several photos also indicate (nr. 2). It is correct that these photos are not dated. However, it should be noted that the possibility that some of the proof of use falls outside of the relevant period, does not necessarily mean that these exhibits cannot be taken into consideration. They can still serve to support other proof that was submitted or can contribute to a better analysis of the scope of the use of the trademark in the relevant period (see ECJ, La Mer Technology, C-259/02, 27 January 2004, ECLI:EU:C:2004:50; ECJ, Alcon, C-192/03 P, 5 October 2004, ECLI:EU:C:2004:587 and the case law referred to there and ECJ, Aire Limpio, T-168/04, 7 September 2006, ECLI:EU:T:2006:245).

30. The invoices submitted represent a monetary amount of around EUR 500.000,- and the delivery notes show that it (roughly estimated) concerns more than 5000 pieces of clothing, distributed to 9 different stores in the Benelux. The defendant also refers to sales figures (nr. 7) which indicate that during the relevant period around 60.000 pieces of clothing, containing the contested trademark, have been sold in the Benelux. It should be recalled that the fact that this document has not been drawn up by an independent party, but by the defendant himself, does not necessarily mean that it is ruled out as evidence. When assessing the probative value of a document, account should be taken inter alia with the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on its face, the document appears sound and reliable (see EGC, Salvita, T-303/03, 7 June 2005 and opposition decision BOIP, Y-TAG, 2000904, 23 October 2008). The Office is able to conclude from the order and style sheets that at least 235 items containing the contested trademark (representing 12 different types of garment) can be traced back to the delivery notes. The Office finds that in this case the sales figures are sufficiently substantiated by the other evidence submitted and the Office sees no further reason to consider that the content of these documents is incorrect. Therefore, the Office finds that the evidence, assessed as a whole, sufficiently demonstrates that the sales are substantial and that it exceeds mere token use.

31. With regard to the goods concerned in class 25, the evidence, considered in relation to each other, confirms the use of the contested trademark in the Benelux for various clothing products, namely blouses, shirts, tops, shorts, jeans, blazers, pullovers, jackets, coats and underwear. On the other hand, the Office

finds that the evidence does not clearly demonstrate the use of the other clothing products, mentioned in class 25. However, this does not affect the scope of the classification, because the words 'including' and 'particularly' only refer to specific examples of goods covered by the general term before it and therefore does not limit them. Furthermore, the Office considers that the evidence does not sufficiently show that the contested trademark is used for the goods mentioned in class 18 and the goods 'belts' and 'footwear' mentioned in class 25. The delivery notes (which contain a description of the products) do not show any description of the goods mentioned in class 18. With regard to belts and footwear, only the additional delivery notes, submitted with the last reply of the defendant, mention belts and one type of sneakers. However, there are no matching invoices to confirm that these products were sold to the stores in the Benelux, nor does the evidence contain art sheets that demonstrate the contested trademark applied to these types of belts and sneakers. Although the defendant has submitted photos of bags and sneakers with the contested trademark, which suggests that the trademark has also been used for these products, this cannot be clearly concluded from the evidence provided. In this regard, the Office points out that genuine use of a trade mark cannot be proven 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 (EGC, Vogue, T-382/08, 18 January 2011, ECLI:EU:T:2011:9).

32. The Office concludes that the overall assessment of the evidence sufficiently demonstrates that genuine use of the contested trademark has been sufficiently proven for the following goods:

*Class 25 Men's and women's clothing, particularly blouses, shirts, tee-shirts, sweat shirts, jackets, pullovers, tops, trousers, coats, underwear.*

33. However, for the remaining goods as indicated in paragraph 3, the Office concludes that the evidence considered as a whole does not sufficiently demonstrate the extent, duration and way in which the trademark has been used in the Benelux.

#### **C. Other factors**

34. The defendant submitted additional evidence in its last reply (see paragraph 17). The Office finds that the nature and content of these documents, taking account of the principle of the right to be heard, do not give rise to the provision of an additional round within the meaning of Rule 1.31(2)(f) IR, because those documents make no difference and do not impact the outcome of the decision.

#### **D. Conclusion**

35. The defendant has showed that the contested trademark has been genuinely used for part of the goods in class 25 in the five years previous to the filing of the application for revocation. For the remainder part of the goods in class 25, as well as the goods in class 18, the defendant fails to prove that the contested trademark has been genuinely used or that there is a proper reason for non-use for a part of the goods.

#### **IV. DECISION**

36. The cancellation application with number 3000149 is partially justified.

37. International Registration 706285 will be revoked for the Benelux for the following goods for which the genuine use has not been proven, namely:

- Class 18: (*all goods*)
- Class 25: Knitwear, knitted goods, leather and imitation leather clothing, bustiers, skirts, outfits, suits, swimwear, headgear, scarves, headbands, tracksuits, gloves, belts for clothing, footwear.

38. International registration 706285 will be upheld for the following goods for which the genuine use has been proven, as well as the goods against which the cancellation was not directed, namely:

- Class 9: (all goods)
- Class 14: (all goods)
- Class 16: (all goods)
- Class 25: Men's and women's clothing, particularly blouses, shirts, tee-shirts, sweat shirts, jackets, pullovers, tops, trousers, coats, underwear.

39. Neither of the parties shall pay the costs in accordance with Article 2.30ter, 5 BCIP.

The Hague, 12 October 2021



Eline Schiebroek  
(*rapporteur*)

Pieter Veeze

Tomas Westenbroek

Administrative officer: Raphaëlle Gérard