

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
CANCELLATION DECISION
N° 3000165
10 May 2021

Claimant: **Octo Asset Management B.V.**
Zuid-Hollandlaan7
2596 AL Den Haag
The Netherlands

Representative: **Marqu Brands & Trademarks B.V.**
Zuid-Hollandlaan 7
2596 AL Den Haag
The Netherlands

against

Defendant: **OCTO TECHNOLOGY**
50 Avenue des Champs Elysées
75008 Paris
France

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

Contested trademark: **International registration 1125164**



I. FACTS AND PROCEEDINGS

A. Facts

1. On 31 October 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 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 1125164, designating amongst others the Benelux, which was filed by the defendant on 5 July 2012 and was registered on 3 January 2013 for goods and services in 9 and 42 for the following semi-figurative trademark:



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

- Class 9: Apparatus for recording, inputting, storing, transmitting, distributing, reading out, reproducing and processing sounds, images and information; data processing apparatus and equipment; computers; software, computer programmes [programs], recorded; data processing software; magnetic and digital recording media, CD-ROMs, digital versatile discs known as DVDs; telecommunications apparatus and instruments; computer equipment and programs for transmitting and receiving data, sounds and images provided via a global telecommunications network; (downloadable) electronic publications.
- Class 42: Design and updating of computer programmes and software; computer programming; design, updating and creation of programs on compact discs, interactive CD-ROMs, digital video discs, digital versatile discs (DVDs), CD-ROMs linked to the Internet and other recording media; design of information systems in the field of computing; advice, consulting, information, technical appraisals, engineering services and engineering work in the field of computers and information systems.

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 27 November 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 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. The administrative phase was completed on 5 August 2020.

II. ARGUMENTS

A. Defendant's arguments

6. The defendant explains that the relevant period to prove genuine use is five years preceding the filing date of the cancellation action, being 31 October 2014 to 31 October 2019.

7. The defendant states that he has genuinely used the contested trademark within the relevant period. Some of the documents he submitted are confidential and have therefore been anonymized in part. The defendant submits several invoices to various clients in the Benelux, most of them bearing the contested trademark. The defendant explains that some of the invoices concern the PAYCONIQ project in which he took part and he cites a transition proposal that identifies the services provided in connection with the contested trademark in this project. He elaborates that he was one of the technological partners and has been developing the IT Back End and API part of PAYCONIQ. The invoices regarding traveling expenses must be seen as circumstantial evidence, in the sense that they are for meetings and events relating to designing and updating computer programs, computer programming and providing consultancy services relating thereto. From the defendant's perspective, the invoices show genuine use of the contested trademark during the relevant period.

8. The defendant also submits copies of web pages from the Wayback Machine. According to the defendant, these copies show that the defendant's website has been live and displaying the contested trademark during the relevant period. Furthermore, the copies also show that the contested trademark is used to offer the contested goods and services as it is stated on the website 'We carry out IT consulting assignments and we develop our strategic applications' and 'From start up to multinational, OCTO intervenes everywhere where IT plays a decisive role in the transformation of societies.'

9. Furthermore, the defendant submits three PowerPoint presentations dated 2014, 2015 and 2018. He explains that these presentations relate to Belgian and Dutch branches of Alphacredit BNP Paribas Group and show the nature of the goods and services, namely the development of software and consultancy services relating thereto, and IT services and strategic consultancy related thereto. The presentations also show that the defendant offers advice, consulting, information, technical appraisals, engineering services and engineering work in the field of computers and information systems.

10. In order to provide insights into the company, the defendant submits documents relating to the establishment of the Belgian subsidiary of OCTO and the dissolution and liquidation thereof dated from 2010-2018. It concerns circumstantial evidence establishing that the defendant had been active in the Belgian market during the relevant period. Octo Technologies Holding B.V. concerns a Dutch branch that was incorporated in December 2015, which shows in the defendant's opinion that he has been active and still is active in the relevant territory.

11. Finally, the defendant introduces several marketing materials from the website www.octo.com in both English and French. It concerns 'Quick Reference Card API' documents as well as brochures.

12. Based on the foregoing the defendant concludes that the evidence presented shows that the contested trademark has been genuinely used during the relevant period. He requests that the Office accepts the proof of use submitted and orders the claimant to bear the costs.

B. Claimant's arguments

13. The claimant first makes some preliminary remarks. As the defendant submitted more than 1000 pages to demonstrate genuine use, it is practically impossible to comment on each individual page of these submissions. Therefore, the claimant will first comment on the general legal principles listed by the defendant in so far as they are relevant and will afterwards comment on the materials themselves.

14. The claimant explains that he already asked the defendant to submit proof of use of the trademark OCTO for the goods and services registered. After several reminders and no response, the claimant was forced to start these cancellation proceedings. With regard to the defendant's remark on the confidentiality of possible evidence, it strikes the claimant as remarkable that just a few pages from the more than 1000 pages submitted have been marked confidential, however it is not clear at all why these documents had to be marked as confidential. The claimant thinks that from the beginning the defendant believed that no proof of use of the contested trademark could be presented. The defendant's intention with these 1000 pages is producing a smokescreen to make it difficult to conclude that there is no convincing proof of genuine use.

15. Genuine use means actual use of the contested trademark as registered, here a word and device mark in colour. Therefore, documents showing use of another sign, such as the words OCTO or OCTO Technology or another device mark, do not in principle show use of the marks as registered, according to the claimant. Most of the documents do not show use as a trademark.

16. Genuine use should be understood as use that is not merely token use. The claimant explains that the notion of 'use' relates to the notion of 'use as a trademark' which has not been shown in the exhibits submitted. Besides, genuine use must be consistent with the essential function of a trademark. The submitted material only illustrates use of the contested trademark as a company name, since its only purpose is to identify the company. The claimant argues that there is no evidence showing the contested trademark on any of the registered goods and/or services.

17. According to the claimant genuine use entails use of the contested trademark on the market for the goods and services concerned. The defendant only made attempts to make genuine use of the contested trademark, but the attempts never lead to anything and in the end the business was even disbanded. The claimant argues that there is no reason to decide that in such a case the owner of such a mark should still be protected against use of similar trademarks by third parties by stretching notions of genuine use so far that such activities may lead to conservation of the rights.

18. The submitted evidence shows that no goods or services have been marketed under the trademark. Although it may have been the intention of the defendant to actually market such goods and services, the claimant observes that such efforts have never been materialized and thus cannot lead to a

qualification as goods or services about to be marketed. In this regard the advertising material submitted is either not from the period concerned or does not show use as a trademark.

19. The claimant states that when assessing whether there has been genuine use, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the trademark is real. This observation is especially relevant in the light of the failed attempts by the defendant to create a market for its goods and services. The claimant feels that the defendant has also failed to list any of the specific nature of the goods and services, the characteristics of the market and the frequency of the alleged use, as a consequence such relevant circumstances do not exist.

20. Although use need not be quantitatively significant for it to be deemed genuine, the claimant feels that the evidence is not sufficient to prove genuine use of the trademark. None of the evidence meets all criteria. Neither does an overall assessment of the evidence give a sufficient impression of use.

21. The claimant contests each of the document's relevance and points out that some of the documents are not dated and the services/products mentioned in the evidence are not the services/products for which the contested trademark is registered and in any case there is no public and outward use of the contested trademark on the Benelux market. Furthermore, he alleges that use of the contested trademark does not constitute use of the trademark in the form in which it is registered.

22. Some proof of use documents are worthy of an individual discussion, according to the claimant. The invoices do not make any reference to use of the contested trademark as a trademark. On these invoices the trademark is used as the company name. There is also no indication that the invoices are related to any products or services as registered under the trademark. Insofar the use could be seen as use as a trademark, the claimant establishes that the use was not long-term, frequent and regular. The claimant also observes that the defendant only showed a few potential customers over the entire period of five years. Just one invoice for the amount of 90.000 euros should be considered as extremely low, especially in view of the market of the defendant where daily rates of 1000 euros are charged. It should be noted that the defendant did not provide any information as to potential customers, sales figures, advertisement measures or other measures in order to assess the extent of use.

23. According to the claimant, the background information on Payconiq as well as the Octo transition proposal do not constitute proof of genuine use of the contested trademark. With regard to the copies of the webpages www.octo.com/fr, the claimant states that they cannot serve as evidence of use since they do not show use of the contested trademark for the goods and services concerned. Besides, he points out that the website only states the place France. There is no information that this website is addressed to and visited by Benelux customers.

24. The PowerPoint presentations only show the contested trademark on their first two pages, which demonstrates use as a company name not as a trademark. The claimant feels these presentations only concern two isolated attempts to contact the companies they were made for.

25. The company information submitted by the defendant only proves the establishment of a Belgian subsidiary of the defendant and its liquidation. Moreover, the claimant observes that it shows the contested trademark merely as a company name, not as a trademark. The turnover of the Belgian subsidiary has been so limited that it has not served a real commercial purpose and has thus been dissolved and liquidated. As for the marketing materials, the claimant remarks that out of the hundreds of

pages of material the contested trademark has only been displayed on a few of those pages. This cannot be seen as genuine and consistent use of the trademark. Furthermore, all these materials do not contain evidence that they were made available to the Benelux public. It cannot be taken for granted that the marketing materials led to any business in the Benelux and that the services under the trademark were provided. The defendant failed to submit additional proof on this point.

26. The claimant also anticipates an argument from the defendant that use of the logo cannot constitute use of a company name, because a logo is not a name. However any conclusion that use of the logo might or might not constitute use as a trademark can only be reached on the basis of use presented as a trademark (which the defendant did not present) and not as a result of a linguistic quirk.

27. Based on the foregoing, the claimant concludes that there is no sufficient evidence of the extent of use of the goods and services under the contested trademark within the relevant territory during the relevant period. Therefore, the Benelux designation of the contested international trademark must be cancelled. Claimant requests that the Office invalidates the contested trademark and that the costs of these proceedings be borne by the defendant.

C. Defendant's last arguments

28. The defendant states that he explicitly contests all arguments and allegations made by the claimant and maintains the arguments and evidence submitted earlier. The claimant's allegation, that from the beginning the defendant would not have had proof of use of the contested trademark, is unfounded according to the defendant.

29. First, the defendant makes some general remarks regarding the legal framework. With regard to the claimant's argument that no use has been made of the contested trademark as registered, the defendant argues the evidence clearly shows use of the trademark as registered, and also shows use in an altered form (either as the word OCTO or with slightly different figurative elements). This altered use also constitutes genuine use as the distinctive and dominant element of the contested trademark is the word OCTO. Furthermore, the defendant also observes that the territorial scope of the use of a trademark is only one of several factors considered when determining whether use is genuine or not.

30. The materials that do not comply with all relevant factors must be considered in view of the entirety of the evidence submitted, and a separate assessment of the various factors is suitable. Even if some relevant factors are lacking in some items of evidence, the defendant argues that the combination of all the relevant factors in all the items of evidence may still indicate genuine use.

31. Furthermore, the defendant observes that the contested trademark is a word/device mark (logo), which does not constitute use of a company name as it is not a name. The contested trademark is clearly used as a trademark, namely, to identify the goods and services. The vague wording by the claimant that it would probably qualify as use of another identifying sign of the company is not further substantiated, and it is thus not clear what type of 'other identifying sign' this should be. Therefore, the defendant believes the claimant's argument should be set aside. Besides, the invoices clearly refer to the contested goods and services. Lastly, the defendant remarks that throughout the claimant's arguments reference is made to the 'mark'. With this wording the claimant implies that the evidence concerns use of a trademark, not a tradename, in the view of the defendant.

32. The defendant rebuts the claimant's argument that the evidence submitted is purely for internal use. He states that the invoices, the OCTO transitional proposal, the copies of web pages, the PowerPoint presentations and the marketing materials show that it concerns use aimed at potential customers of the goods and services, and therefore demonstrates external use.

33. The defendant explains that consultancy services are offered through giving presentations, meetings, and conferences. As a result, the PowerPoint presentations must be seen in relation to the specific nature of the services. Thus, the contested trademark is used for the goods and services.

34. The invoices show that sales have been made. The defendant has sent consultants to clients for IT-related projects (such as strategy assessments, Dev/Ops services). These services, as well as the travel expenses and other costs made to realize the projects, have been charged to the defendant's client. Therefore, there are sufficient indications as to the extent of the use, according to the defendant.

35. Secondly, the defendant refutes the claimant's arguments per type of evidence submitted. Regarding the invoices, the defendant points out that they clearly identify the contested consultancy services. On the invoices the contested trademark is visible as registered. Therefore, this concerns use as a trademark. The nature of the services must be seen in relation to the invoices. Holding meetings and giving presentations are essential activities to sell the defendant's services, especially regarding consulting. The defendant argues that the invoices show that he has sent its employees to potential clients within the relevant territory to present and sell IT-related projects. He emphasizes that the threshold is whether a trademark owner has tried to create a market share and has seriously tried to acquire a commercial position in the Benelux market. Actual commercial success is not relevant.

36. The defendant explains that the PAYCONIQ project is a joint project of six Dutch banks focused on the Benelux market which follows from the background information on the PAYCONIQ project. It follows from the invoices submitted that the defendant has offered services in relation to the PAYCONIQ project. He argues that travel expenses would not be charged if services are not being performed.

37. The defendant observes that the contested trademark is used in the Octo Transition proposal as it is clearly visible on several places in the proposal itself. The fact that the colour of the letters differs from the contested trademark as registered does not alter the distinctive character of the mark as a whole. Furthermore, the transition proposal, considered together with other evidence, shows that the contested trademark has been used in relation to the contested goods and services.

38. As for the copies of the web pages, they are provided in the French language. The defendant explains they are aimed at the 'French market' which also includes the Benelux public given that a larger part of Belgium including Brussels is French speaking, and French is one of the official (and spoken) languages of Luxembourg. Thus, even though these web pages are not all dated, they do contribute to the overall assessment that sufficient evidence of use of the contested trademark has been provided.

39. The PowerPoint presentations show the contested trademark as registered and are dated and focused on the relevant territory and show the nature of the goods and services. The defendant remarks that the OCTO trademark is used on the footer of each page which constitutes use of the contested trademark. Besides, these presentations show use of the contested trademark as a trademark. Lastly, the defendant points out that giving presentations and holding meetings are 'sales' of the services covered by the contested trademark. It is not required to demonstrate concluded contracts to show genuine use.

40. The company information should be considered circumstantial evidence that the defendant had been active on the Belgian market during the relevant period. The fact that a former branch is being dissolved is not evidence that no genuine use of the trademark has been made, according to the defendant. The defendant's statement that he has a Dutch branch was erroneously included in his previous argumentation. However, he explains that this does not adversely affect his legal position as the issue at hand is to prove genuine use of the contested trademark.

41. As to the marketing materials, the defendant refutes the claimant's statement that the contested trademark is only used on a few pages. The trademark is also visible (mostly in word but also in word/device form) throughout the brochures. The word/device mark is indeed sometimes used in a different form than registered. However, it concerns minor changes in the defendant's opinion. He recalls that use of a variation of the trademark as registered which does not alter the distinctive character of the trademark may establish genuine use. Finally, the defendant notes that it is not required nor common for brochures or advertising materials that trademarks are shown on every single page. What counts is that the OCTO trademark is used as a trademark and the documents show that the relevant goods and services are being offered under the trademark.

42. For these reasons, the defendant concludes that he has provided sufficient proof of use to establish that the contested trademark was genuinely used during the relevant period of use, 31 October 2014 to 31 October 2019 and in the Benelux and for the relevant goods and services in classes 9 and 42.

43. He requests the Office to reject this cancellation action and to maintain the contested trademark registration and to decide that the costs of these proceedings be borne by the claimant.

III. DECISION

A.1 Legal framework

44. 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 for revocation in the Benelux territory or that there are proper reasons for non-use.

45. The application for revocation was submitted on 31 October 2019. Therefore, the defendant is required to show use of the contested trademark, during the period from 31 October 2014 to 31 October 2019 ("the relevant period").

46. 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.

47. 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).

48. 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).

49. 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

50. The defendant submitted the following exhibits to demonstrate genuine use of the contested trademark:

1. 8 Invoices from either 2016 or 2018;
2. Background information Payconiq project:
 - a. Article 'Banks join forces for Dutch launch of Payconiq' dated 20 April 2017 and published on www.ing.com;
 - b. Article 'Payconiq helps Belgium go cashless' dated 9 February 2017 and published on www.ing.com;
 - c. Wikipedia page on 'Payconiq' ;
3. Octo transition proposal 'Back-end and API: Transition to OCTO TEAM 2' dated 12 August 2015;
4. Copies of web pages from the website www.octo.com/fr via the Wayback Machine dated 2014, 2015, 2016, 2017, 2018 and 2019;
5. Presentations:
 - a. Alpha Credit BNP Paribas Group dated 24 December 2014;
 - b. BAF OCTO – Workshop report, BNP Paribas Fortis, dated 25 January 2018;
 - c. Proposal for ... [confidential] project scoping & delivery – Oral defense, Alpha Credit BNP Paribas Group, dated 13 October 2015;
6. Company information, excerpts from the Belgian Official Journal regarding OCTO Technology SPRL as well as excerpts from the Dutch Chamber of Commerce regarding OCTO Technologies Holding BV;
7. Marketing materials from OCTO Technology, in English and in French.

51. When assessing whether certain use of the trademark is genuine, all the facts and circumstances relevant to establishing whether the commercial use of the mark is real in the course of trade must be taken into account. In particular it is of importance 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. Also of importance are the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (CJUE, *La Mer Technology*, C-259/02, 27 January 2004, ECLI:EU:C:2004:50). However, the smaller the commercial volume of the exploitation of the mark, the more necessary it is to produce additional evidence to dispel possible doubts as to the genuineness of the use (EGC, *Vogue*, T-382/08, 18 January 2011, ECLI:EU:T:2011:9).

52. In these proceedings the defendant has to demonstrate genuine use of the contested trademark in the Benelux within the relevant period. The Office establishes first of all, taking into account all exhibits submitted, that no evidence was provided for the goods in class 9. The exhibits only relate to part of the services for which the mark is registered in class 42: *Design and updating of computer programmes and software; computer programming; design of information systems in the field of computing; advice, consulting, information, technical appraisals, engineering services and engineering work in the field of computers and information systems.*

53. The defendant submitted more than 1000 pages of proof of use. Most of these documents concern brochures explaining the defendant's activities. It follows from these documents that the defendant is a French company that provides IT services as well as IT consultancy.

54. The fact that some of the proof of use falls outside of the relevant period or is not dated at all, does not necessarily mean that these exhibits cannot be taken into consideration here. 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 contested trademark in the relevant period (see CJUE, *La Mer Technology*, already cited; CJUE, *Alcon*, C-192/03 P, 5 October 2004, ECLI:EU:C:2004:587 and the case law referred to there and CJUE, *Aire Limpio*, T-168/04, 7 September 2006, ECLI:EU:C:2008:420). In that regard the company information as well as the marketing materials confirm the defendant's activity in the field of IT services and consultancy and can serve to support genuine use of the contested trademark in the Benelux.

55. The defendant submits eight invoices addressed to three customers in the Benelux (ING in the Netherlands and BNP Paribas and Alpha Credit Bank in Belgium). The contested trademark is represented in the heading of the invoices. They are dated 2016 or 2018 and fall within the relevant period. The invoices relate to IT services and consultancy which follows from the references mentioned: "Ref: API Strategy assessment dated January 12th 2018 between OCTO Technology and BNP Paribas Fortis SA/NV – [BAF]-API Fortis", "Payconiq back end Lot 2" and "Etude détaillée du plan de transformation IT"¹. The invoices cover the compensation of travel expenses and in one invoice they also cover 'Dev/Ops' or 'Senior Dev/TL'. Dev/Ops refers to a set of practices that combines software development (Dev) and information-technology operations (Ops). Following the nature of consultancy services, consultants will visit clients to assist them/pitch their services and will thus generate travel expenses. The amounts that are billed range from a couple of hundred euros, over a couple of thousand euros to one invoice for 95.000 euros. It follows from these invoices that the contested trademark has been used in the Benelux within the relevant period, however only for part of the services for which it is registered in class 42.

¹ Free translation: 'Detailed study of the IT transformation plan'.

56. The background information about the Payconiq project dated 2017 confirms the involvement of ING in this project. This information can thus serve to support the invoices.

57. The claimant argues that the contested trademark is merely used as a company name but not as trademark. Use of a company name can be regarded as use 'in relation to services', even though the sign is not affixed, if the sign is used in such a way that a link is established between the company name and the services at issue (EGC, Céline, C-17/06, 11 September 2007, ECLI:EU:C:2007:497). The representation of the contested trademark on top of the invoices can support genuine use of the registered trademark. The references mentioned in the invoices establish that there is a link between the contested trademark and part of the services for which the contested trademark is registered in class 42.

58. Moreover, the link between the contested trademark and part of the services in class 42 for which genuine use is demonstrated also follows from the OCTO transition proposal as well as the presentations. These presentations and the proposal contain the contested trademark as registered and date from within the relevant period. They illustrate the aforementioned link:

- It says in the OCTO transition proposal "*As one of the technological partners, OCTO has been developing the IT Back End and API part of Payconiq service for 9 months since September 2015*"
- In the presentation to Alpha Credit dated 13 October 2015 a proposal is made for a project. In a slide titled 'Eligible team profile for 360 scoping phase' reference is made to the OCTO Community "*18 years of experience in architecture scoping. OCTO Technology accompany BNPP PF group in its digital transformation, enabling new architecture paradigms and working methodology.*"

59. It follows from an overall analysis of all evidence that the contested trademark as registered is clearly used in the invoices, in the presentations and in the transition proposal in relation to part of the services in class 42 of the contested trademark. The fact that the contested trademark is also sometimes used in a different form cannot affect the finding of genuine use of the contested trademark.

Conclusion

60. The defendant demonstrated genuine use of the contested trademark within the Benelux during the relevant period, however only for part of the services in class 42 *Design and updating of computer programmes and software; computer programming; design of information systems in the field of computing; advice, consulting, information, technical appraisals, engineering services and engineering work in the field of computers and information systems*. There is no, or at least not enough evidence to demonstrate genuine use of the contested trademark for the services *design, updating and creation of programs on compact discs, interactive CD-ROMs, digital video discs, digital versatile discs (DVDs), CD-ROMs linked to the Internet and other recording media* in class 42 and the goods in class 9.

B. Conclusion

61. Based on the foregoing the Office is of the opinion that the defendant did only provide proof that the contested trademark has been used in the Benelux within the relevant period for part of the services in class 42. For the remaining services in class 42 as well as the goods in class 9 no proof of genuine use has been demonstrated.

IV. DECISION

62. The cancellation application with number 3000165 is partly justified.

63. International registration 1125164, with regard to the Benelux, will be revoked for the following goods and services for which no genuine use was demonstrated:

- Class 9: All goods.
- Class 42: Design, updating and creation of programs on compact discs, interactive CD-ROMs, digital video discs, digital versatile discs (DVDs), CD-ROMs linked to the Internet and other recording media.

64. International registration 1125164, with regard to the Benelux, will remain registered for the following services for which genuine use was demonstrated:

- Class 42: Design and updating of computer programmes and software; computer programming; design of information systems in the field of computing; advice, consulting, information, technical appraisals, engineering services and engineering work in the field of computers and information systems.

65. Neither of the parties shall pay the costs in accordance with article 2.30ter (5) BCIP in conjunction with rule 1.44 (2) IR, as the opposition is only partly justified..

The Hague, 10 May 2021



Tineke Van Hoey
(*rapporteur*)

Pieter Veeze

Diter Wuytens

Administrative officer: Diter Wuytens