

BENELUX OFFICE FOR INTELLECTUAL PROPERTY

CANCELLATION DECISION

N° 3000343

29 September 2023

Claimant: **KSR Solution GmbH**
In Wirtschaftspark 15
3494 Gedersdorf
Austria

Representative: **AKD N.V.**
Wilhelminakade 1
3072 AP Rotterdam
Netherlands

against

Defendant: **Perry Ellis International Europe Limited**
Olympic House, Pleasants Street
Dublin 8
Ireland

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

Contested trademark: **Benelux registration 465034**




I. FACTS AND PROCEEDINGS

A. Facts

1. On 31 August 2021, 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 Benelux registration 465034 of the combined word-

 /figurative mark, which was filed and registered by the defendant on 12 June 1989 for goods in Classes 9, 14, 16, 18 and 24.

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

Class 9: Spectacles, protective goggles, anti-glare spectacles and sunglasses and parts and accessories thereof (not included in other classes); suits, hoods, jackets, trousers and footwear for diving.

Class 14: Watches and fashion jewellery.

Class 16: Stationery (not included in other classes) and printed matter including decals and bumper stickers.

Class 18: Leather and imitation leather and goods made from them not included in other classes; animal skins; suitcases and travel bags; wallets, purses and key holders; umbrellas, parasols and walking sticks; whips and saddlery goods.

Class 24: Woven fabrics and textile products not included in other classes; blankets and tablecloths; towels.¹

4. The language of the proceedings is English.

B. Course of the proceedings

5. The cancellation action is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 8 September 2021. 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

¹ Free translation of the Dutch list of goods:

"Kl 9 Brillen, beschermbrillen, antiverblindingsbrillen en zonnebrillen alsmede onderdelen en toebehoren daarvoor (voor zover niet begrepen in andere klassen); pakken, kappen, jakken, broeken en voetbekleding om te duiken.

Kl 14 Horloges en modesieraden.

Kl 16 Papierwaren (voor zover niet begrepen in andere klassen) en drukwerk waaronder plakplaatjes en bumperstickers.

Kl 18 Leder en kunstleder en hieruit vervaardigde producten voor zover niet begrepen in andere klassen; dierehuiden; koffers en reistassen; portefeuilles, beurzen en sleutelhouders; paraplu's, parasols en wandelstokken; zweepen en zadelmakerswaren.

Kl 24 Weefsels en textielproducten voor zover niet begrepen in andere klassen; dekens en tafellakens; handdoeken."

a declaration of revocation for non-use, pursuant to Rule 1.31(2) of the IR, 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, after which the claimant and, finally, the defendant were asked to react. The administrative phase was completed on 6 May 2022.

II. ARGUMENTS

A. Defendant's arguments

6. Before going through the proof of use submitted, the defendant states that the claimant filed the request for revocation in reaction to an earlier opposition filed by the defendant against the claimant. The defendant claims that he is put to maximum trouble and expenses to prove the use in this procedure, while there is plenty of opportunity for the claimant to request proof of use in the opposition procedure.

7. The relevant period during which use of the contested trademark should be demonstrated is between 31 August 2016 and 31 August 2021, according to the defendant.

8. The defendant explains that the GOTCHA brand is being used in the fashion industry. He produces several screenshots via web.archive.org of GOTCHA clothing being sold via a website in 2017. Currently, the GOTCHA brand is also sold on various websites. To substantiate this, the defendant produces a screenshot dated 2021. He claims that the GOTCHA website has been actively used for many years. Products on the GOTCHA website are being shipped to the UK and the European Union. Consumers in the Benelux can also access the GOTCHA website to purchase various GOTCHA products. This is common since GOTCHA is a very well-known brand in many countries, according to the defendant. Furthermore, the sale of GOTCHA products has also been promoted annually on social media. The defendant produces some examples thereof.

9. As a result, it has to be concluded that the contested trademark has been genuinely used for all of the goods concerned during the relevant period. Therefore, the defendant requests BOIP to reject the application for revocation and orders that the costs of these proceedings shall be borne by the claimant.

B. Claimant's arguments

10. The claimant argues that the defendant did not genuinely use the contested trademark in the Benelux within the relevant period (31 August 2016 until 31 August 2021).

11. After assessing the evidence and referring to the legal framework regarding the requirements for proof of genuine use, the claimant establishes that the provided evidence completely lacks indications of place, extent and nature of the use for the relevant goods. The evidence exclusively consists of screenshots of three different websites and some social media posts. The websites are either not directed at the Benelux public, and/or it is unclear whether the websites were visited by Benelux consumers. No evidence is provided as to whether any sales were made in the Benelux.

12. Moreover, the evidence does not relate to the goods in classes 9, 14, 16, 18 and 24 for which the contested trademark has been registered. It only relates to particular clothing items. Hence, according to the claimant, there is not even a beginning of proof that the contested trademark has been put to genuine

use. Given that it is so evident that the provided evidence cannot contribute to prove genuine use of the contested trademark, the claimant refrains from detailing all (further) shortcomings of the provided evidence piece by piece.

13. Furthermore, there has been no use of the contested trademark, but only of signs which alter its distinctive character. According to the claimant, the distinctive and dominant elements in the contested trademark are the shark figure holding a flag and the letters under the shark figure which are for the majority displayed in an irregular fashion. These letters are hard to decipher (the second element under the shark figure will not be recognized as the letter O, but rather as a figurative element; certain letters, the O – if recognized – and the A, are rotated 90 degrees; the element connected to the foot of the shark figure could be perceived as part of the figure or as a letter, possibly an I or a T). Signs that leave out the shark figure or the irregular configuration of the letters alter the distinctive character of the trademark as registered and cannot serve to proof genuine use of said trademark. The claimant concludes that all signs in the evidence alter the distinctive character of the contested trademark and cannot prove genuine use.

14. The claimant also states that there are deceitful claims on the Gotcha website. It is claimed on the website that a visitor can also ship to the Benelux which follows from a reference announcing, "Now shipping to the UK & EU". However, to the claimant it is self-evident from this announcement that the defendant did not ship to the EU previously. This announcement was only made very recently. A screenshot made via the WayBackMachine on the 27th of April 2021 shows that the website did not refer to shipments to the UK and EU at that time. It appears that the defendant amended its website in light of these proceedings. There are various opposition and cancellation procedures between the parties. Prior to the opposition action by the defendant and the cancellation actions there was no indication on the website that it shipped to the EU, let alone the Benelux territory. The claimant finds the defendant's claim, that the items can be purchased from the Benelux, deceitful. Contrary to the indication on the website it is in practice not possible to order from the Benelux/any other country, other than the US.

15. For these reasons, the claimant concludes that the defendant has not genuinely used the contested trademark. Therefore, he requests that the Office revokes the contested trademark and orders that the costs are borne by the defendant.

C. Defendant's last arguments

16. First of all, the defendant states that claimant is aware of the use of the GOTCHA brand by the defendant as the claimant filed the application for revocation after receiving the opposition from the defendant against the application GOTCHA (1586233). A simple search on the internet shows the intensive use of the contested trademark by the defendant. This revocation action is merely a reaction to the opposition.

17. The defendant argues that the screenshots provided are solid and objective evidence of effective and sufficient use of the contested trademark on the market concerned.

18. As to the extent of the use, the defendant points out that evidence was provided from the websites www.mandmdirect.nl and www.etsy.com/nl. These websites only sell clothing and other products in large quantities and cannot be 'used' for 'token sales' merely to meet the use requirements of a trademark registration as claimant seems to imply, according to the defendant.

19. Furthermore, claimant's statement that no evidence of use has been provided for all the goods of the contested trademark, is not correct. Evidence of use has for example been provided regarding towels. The defendant revisits some examples of evidence again that he already filed earlier but also puts forward new pictures of two key rings.

20. Claimant also states that the proof of use submitted relates to use of signs which are different from the trademark as registered. However, the defendant claims, with reference to a detailed photo of a bonnet, that the shark figure is in fact on the bonnet. The exact trademark also appears on all products that are shown in the evidence provided before.

21. In reaction to claimant's statement that the Gotcha website is not aimed at the Benelux public since the website is in English, the defendant replies that this is not correct since English is a generally spoken and understood language within the Benelux. Nowadays, many clothing websites are even only available in the English language. The fact that the Gotcha website is in English will not discourage people in the Benelux from ordering goods on the website. The same reaction applies to the social media posts for which it is not necessary that they are in Dutch to demonstrate proof of use in the Benelux. Besides that, the evidence as provided clearly also mentions Dutch websites such as www.mandmdirect.nl and www.etsy.com/nl. Both websites are shown in the Dutch language and thus aiming at the Dutch (speaking) public specifically. Lastly, the evidence of use clearly dates from the relevant period, according to the defendant.

22. It follows that the defendant has provided proof of use for each specifically listed subcategory within the relevant period, and thus that the contested trademark has been used publicly and outwardly for said goods in the relevant territory in the relevant period. Nature of use requires, inter alia, that the contested Benelux trademark is used as a trademark, that is, for identifying origin, thus making it possible for the relevant public to distinguish goods of different providers. In the present case, the evidence filed undoubtedly shows a link between the goods in question and the use in accordance with its essential function, which is to guarantee the identity of the origin of goods for which it is registered.

23. As a result, the proof submitted demonstrates genuine use of the contested trademark for all the goods concerned within the relevant period. The defendant requests the Office to reject the revocation action and order the claimant to bear all costs.

III. DECISION

A.1 Legal framework

24. 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.

25. The application for revocation was submitted on 31 August 2021. Therefore, the defendant is required to show genuine use of the contested trademark, during the period from 31 August 2016 to 31 August 2021 ("the relevant period").

A.2 Proof of use

In general

26. In accordance with the case-law of the European Court of Justice ("CJEU") there is genuine use of a trademark if the mark, 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, is used in order to create or preserve an outlet for those goods or services, not including token use for the sole purpose of preserving the rights conferred by the mark.² When assessing whether use of the trademark is genuine, must be taken into account all the facts and circumstances relevant to establishing whether the commercial use of the mark is real, particularly the practices regarded as warranted in the relevant economic sector as a means of maintaining or creating market shares 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.³ 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.⁴

27. The General Court held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine.⁵ In interpreting the concept of genuine use, account should be taken of the fact that the *ratio legis* of the requirement that the mark must have been put to genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trademark protection to the case where large-scale commercial use has been made of the marks.⁶

28. 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.⁷

29. 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 concerned.

Analysis of the proof of use

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

1. Screenshots of the website www.mandmdirect.nl dated 9 July 2017 and 22 November 2017, made via TheWayBackMachine, showing different kinds of sweaters, jackets, T-shirts and shirts being offered for sale under the sign "Gotcha"
2. Screenshot of the website www.etsy.com/nl made on 10 December 2021 showing one sweater being offered for sale "Gotcha Surf Merk Kleding Hoodie Pullover Sweatshirt"

² CJEU 3 July 2019, C-668/17, ECLI:EU:C:2019:557, point 38 (Viridis) and CJEU 11 March 2003, C-40/01, ECLI:EU:C:2003:145, point 43 (Ansul).

³ CJEU 31 January 2019, C-194/17, ECLI:EU:C:2019:80, point 83 (Pandalis) and CJEU 11 March 2003, C-40/01, ECLI:EU:C:2003:145, point 43 (Ansul).

⁴ EGC 4 April 2019, T-910/16 and T-911/16, ECLI:EU:T:2019:221, point 29 and the case-law mentioned there (Testa Rossa).

⁵ EGC 8 July 2004, T-334/01, ECLI:EU:T:2004:223, point 36 (Hipoviton) and EGC 30 April 2008, T-131/06, ECLI:EU:T:2008:135, point 41 (Sonia Rykiel).

⁶ EGC 4 April 2019, T-910/16 and T-911/16, ECLI:EU:T:2019:221, point 28 and the case-law mentioned there (Testa Rossa).

⁷ EGC 8 July 2020, T-686/19, ECLI:EU:T:2020:320, point 35 (GNC LIVE WELL).

3. Screenshot of the website www.gotcha.com dated 10 December 2017, made via



TheWayBackMachine, showing only the following element

4. Screenshots of the website www.gotcha.com (not dated) mentioning "Now shipping to UK & EU" and showing use of different Gotcha signs, either on the website itself, or on various items of clothing (bonnets, pants, T-shirts, hats, socks) or accessories (skate deck, beach towel,



volleyball and label pins):



5. Screenshots from posts on the Instagram page "@gotchabrand", one is dated "25 November", the other two "May 28" and "April 24" together with the hashtag "#GOTCHA2021". These posts show photos of a person wearing either a sweater or a T-shirt with the Gotcha sign being



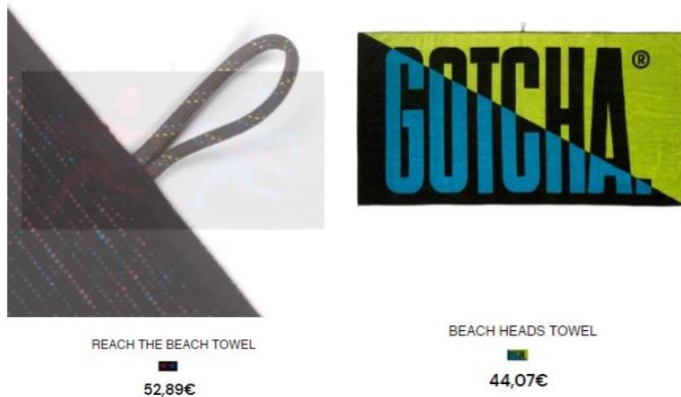
represented as follows

6. With his final arguments the defendant also refers to photos of two key rings (no date or place



is mentioned)

31. The Office establishes that the defendant has failed to prove genuine use of the contested trademark. All exhibits only concern a few screenshots showing items of clothing and some accessories. There are only two photos of products that relate to goods concerned by the contested trademark, namely



towels . These photos of merely two towels (exhibit 4) carry no indication of date, place, and even of the contested trademark in one case. None of the other evidence actually relates to the goods concerned of the contested trademark in classes 9, 14, 16, 18 and 24. The photos of two key rings, that were introduced by the defendant together with his final arguments (and that also carry no indication of date, nor place) (exhibit 6) cannot change this conclusion and merely confirm the lack of proof of use of the contested trademark. For this reason alone, the evidence submitted is already largely insufficient.

32. Besides, none of the evidence refers to the contested trademark as registered. The use of a trademark in a form which differs from the form in which it was registered is regarded as genuine use provided that the distinctive character of the trademark in the form in which it was registered is not altered.⁸ The Office establishes that either the different styling for the word GOTCHA and/or leaving out the shark figure affects the distinctive character of the contested trademark. As the exhibits only refer to these altered forms of the contested trademark, the evidence can also not serve to demonstrate genuine use of the contested mark.

33. Based on the very limited evidence filed no conclusions can be drawn in relation to the nature, extent, place, duration and manner of use of the contested trademark in the Benelux.

B. Other factors

34. The defendant claims that he is put to maximum trouble and expenses to prove the use in this procedure by the claimant, while there is plenty of opportunity for the claimant to request proof of use in the earlier opposition proceedings pending between the parties (see point 6). Such a claim can however not have any bearing on the outcome of the case at hand, as the only question that needs to be answered is the question as to whether the contested trademark was genuinely used in the Benelux during the relevant period. It is not for the Office to decide on any other issues, such as the relationship between parties.

C. Conclusion

35. Based on the foregoing the Office concludes that the defendant did not provide proof that the contested trademark has been used in the Benelux within the relevant period, nor that there are proper reasons for non-use.

⁸ CJEU 11 October 2017, C501/15 P, ECLI:EU:C:2017:750, point 65 and case law cited there (Cactus).

IV. DECISION

36. The cancellation application with number 3000343 is justified.

37. Benelux registration 465034 will be revoked.

38. 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, 29 September 2023



Tineke Van Hoey
(*rapporteur*)

Marjolein Bronneman

Camille Janssen

Administrative officer: Rémy Kohlsaet