



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET  
(TRADE MARKS AND DESIGNS)

Opposition Division

OPPOSITION No B 1 866 824

Carlos [REDACTED] 10, 08038 Barcelona, Spain  
(opponent), represented by [REDACTED] 08029  
Barcelona, Spain (professional representative)

against

[REDACTED]  
[REDACTED] 79, Athens, Greece (applicant), represented by Theodoros  
Zacharopoulos, Pindarou 11, 10673 Athens, Greece (professional representative).

On 13/12/2012, the Opposition Division takes the following

DECISION:

1. Opposition No B 1 866 824 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300.

REASONS:

The opponent filed an opposition against some of the goods and services of  
Community trade mark application No [REDACTED], namely against some of the  
goods and services in Classes 1, 11 and 40. The opposition is based on Spanish trade  
mark registrations No [REDACTED] and No [REDACTED].  
[REDACTED] The opponent invoked Article 8(1)(b) CTMR.

SUBSTANTIATION

According to Article 76(1) CTMR, in proceedings before it the Office shall examine the  
facts of its own motion; however, in proceedings relating to relative grounds for refusal  
of registration, the Office shall be restricted in this examination to the facts, evidence  
and arguments provided by the parties and the relief sought.

It follows that the Office cannot take into account any alleged rights for which the  
opponent does not submit appropriate evidence.

According to Rule 19(1) CTMIR, the Office shall give the opposing party the opportunity  
to present the facts, evidence and arguments in support of his opposition or to  
complete any facts, evidence or arguments that have already been submitted pursuant  
to Rule 15(3) CTMIR, within a time limit specified by it and which shall be at least 2  
months starting on the date on which the opposition proceedings shall be deemed to  
commence in accordance with Rule 18(1) CTMIR.

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According to Rule 19(2) CTMIR, within the period referred to above, the opposing party shall also file proof of the existence, validity and scope of protection of his earlier mark or earlier right, as well as evidence proving his entitlement to file the opposition. In particular, if the opposition is based on a registered trade mark which is not a Community trade mark, the opposing party must provide a copy of the relevant registration certificate and, as the case may be, of the latest renewal certificate, showing that the term of protection of the trade mark extends beyond the time limit referred to in paragraph 1 and any extension thereof, or equivalent documents emanating from the administration by which the trade mark was registered - Rule 19(2)(a)(ii) CTMIR.

In the present case the notice of opposition was not accompanied by any evidence as regards the earlier Spanish trade marks on which the opposition is based.

On 25/08/2011 the opponent was given two months, commencing after the ending of the cooling-off period, to submit the above mentioned material. This time limit expired on 30/12/2011.

On 04/11/2011, in order to substantiate the earlier rights on which the opposition is based, the opponent submitted the following documents: (i) an extract from Sitadex (the database of the Spanish Patent and Trade Mark Office) with respect to earlier Spanish trade mark registration No [REDACTED] specifically four pages in Spanish, (ii) the translation into English of the aforementioned document, (iii) an extract from Sitadex (three pages in Spanish) with respect to earlier Spanish trade mark registration No [REDACTED] and (iv) the translation into English of the aforementioned document.

On 10/11/2011, the opponent filed arguments in support of its opposition, specifically four pages in English. Nevertheless, apart from the documents listed above, no further evidence with respect to the earlier rights on which the opposition is based was submitted by the opponent before the expiry of its time limit of 30/12/2011.

In the present case the evidence filed by the opponent with respect to earlier Spanish trade mark registration No [REDACTED] is not sufficient to substantiate the opponent's earlier trade mark, because there is no evidence of renewal of this earlier right.

The duration of Spanish trade mark registrations applied for since 12/05/1989 is ten years starting from the filing date. According to the extract from Sitadex, the earlier mark concerned was filed on 16/12/1991 and was renewed for a further period of ten years, being, therefore, in force until 16/12/2011 (as evidenced by the decision dated 18/03/2002 published on 16/04/2002).

However, as the period of protection of the earlier mark concerned was due to lapse before the expiry of the two months substantiation period (i.e. 30/12/2011), the opponent should have filed a renewal certificate in order to prove that the term of protection of its trade mark extends beyond the time limit given to it to substantiate the opposition. In this context, it should be noted that the relevant date is the date on which the registration would expire (i.e. 16/12/2011), and not the possibility of renewing the mark within the six months grace period under the Paris Convention.

According to Rule 20(1) CTMIR, if until expiry of the period referred to in Rule 19(1) CTMIR the opposing party has not proven the existence, validity and scope of protection of his earlier mark or earlier right, as well as his entitlement to file the opposition, the opposition shall be rejected as unfounded.

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The opposition must therefore be rejected as unfounded insofar as it is based on earlier Spanish trade mark registration No [REDACTED]

The examination of the opposition will continue on the basis of the other earlier right claimed as basis of the opposition, specifically Spanish trade mark registration No [REDACTED]

#### PROOF OF USE

According to Article 42(2) and (3) CTMR, if the applicant so requests, the opponent shall furnish proof that, during the period of five years preceding the date of publication of the contested trade mark, the earlier trade mark has been put to genuine use in the territories in which it is protected in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use.

According to the same provision, in the absence of such proof the opposition must be rejected.

The applicant requested that the opponent submit proof of use of the two trade marks on which the opposition is based. The request was filed in due time and it was admissible given that the earlier trade marks were registered more than five years prior to the publication of the contested application.

On 05/03/2012 the opponent was given two months to file the requested proof of use.

As a preliminary remark it is to be noted that the Office's communication as of 05/03/2012 by means of which the opponent was notified of the request for proof of use, referred expressly to both earlier marks on which the opposition was based.

However, since earlier Spanish trade mark registration No [REDACTED] [REDACTED] was not substantiated (as explained above), the Opposition Division will hereinafter consider only the remaining valid earlier right, namely Spanish trade mark registration No [REDACTED]

The contested application was published on 10/05/2011.

The opponent was therefore required to prove that the trade mark on which the opposition was based was put to genuine use in Spain during the period of 10/05/2011 to 09/05/2006 inclusive. Furthermore, the evidence must show use of the trade mark for the goods on which the opposition is based, namely:

Class 11: *Filters for swimming pools.*

According to Rule 22(3) CTMIR, the evidence of use shall consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based.

On 04/05/2012 the opponent submitted evidence as proof of use.

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The opponent expressly mentioned in its submissions that it did not submit any evidence concerning the use of the earlier Spanish trade mark No [REDACTED] ('No proof of use is being submitted in respect of opponent's trademark ES [REDACTED], but only in respect of ES [REDACTED]'). Furthermore, it did not argue that there were proper reasons for non-use of Spanish registration No [REDACTED] either.

According to Article 76(1) CTMR, in *inter partes* proceedings the Office is restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought.

According to Rule 22(2) CTMR, if the opposing party does not provide such proof before the time limit expires, the Office shall reject the opposition.

Therefore, considering that: (i) all the documents submitted as evidence of use relate to Spanish trade mark No [REDACTED] and that (ii) this mark cannot be taken into account as basis of the opposition, since the opponent failed to prove its validity, as detailed above in the 'Substantiation' section of the present decision, the opposition must be rejected pursuant to Article 42(2) and (3) CTMR.

For the sake of completeness, the Opposition Division points out that the outcome of the present decision would still be the same, even if it had examined the evidence of use filed by the opponent. According to Article 15 CTMR, the mark must be used for the goods or services for which it is registered in order to be enforceable. Furthermore, according to the first sentence of Article 42(2) CTMR, the earlier registered mark must have been put to genuine use in connection with the goods or services in respect of which it is registered and which the opponent cites as justification for its opposition. In the case at hand, the earlier right for which the opponent submitted evidence of use (and which was found to be not substantiated) covered goods in Class 9 (specifically *electric and electronic devices for swimming pools*), which are obviously not the same as the goods covered by the remaining earlier right in relation to which the examination of the opposition was continued (namely, *filters for swimming pools* in Class 11). Hence, in view of the principle of economy and good administration of proceedings and without prejudice to Article 76(1) CTMR, there is no need to analyse and assess the documents filed by the opponent in order to see whether they could support a finding of genuine use with respect to the remaining valid earlier right on which the opposition is based (i.e. Spanish trade mark registration No [REDACTED]), since they all relate to goods in Class 9 covered by Spanish trade mark registration No [REDACTED].

#### COSTS

According to Article 85(1) CTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the opponent is the losing party, it must bear the costs incurred by the applicant in the course of these proceedings.

According to Rule 94(3) and (7)(d)(ii) CTMR, the costs to be paid to the applicant are the costs of representation which are to be fixed on the basis of the maximum rate set therein.

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The Opposition Division

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According to Article 59 CTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 CTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. According to Rule 94(4) CTMR, such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Article 2(30) CTMR) has been paid.

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