

CANCELLATION No 17 366 C (INVALIDITY)

Nelson William Charles, Kalvaria ter 2., 1089 Budapest, Hungary (applicant), represented by **Oppenheim Ugyvedei Iroda**, Karolyi u. 12., 1053 Budapest, Hungary (professional representative)

a g a i n s t

Mandelay Mo. Kft., Gyártelep 12001/33 hrsz., 2310 Szigetszentmiklós, Hungary represented by **Danubia Szabadalmi És Jogi Iroda Kft.**, Bajcsy-Zsilinszky út 16., 1051 Budapest, Hungary (professional representative).

On 16/04/2019, the Cancellation Division takes the following

DECISION

1. The application for a declaration of invalidity is rejected in its entirety.
2. The applicant bears the costs, fixed at EUR 450.

REASONS

The applicant filed an application for a declaration of invalidity against all the goods and services of European Union trade mark No 12 250 593 'EDUCTOR', namely against all the goods and services in Classes 10, 35 and 44. The application is based on the non-registered trade mark 'EDUCTOR' protected in Hungary, Germany, Bulgaria, Belgium, Austria, Cyprus, Denmark, Greece, Spain, Finland, France, United-Kingdom, Italy, Netherlands, Portugal, Romania and Sweden in relation to the following goods and services: *medical and veterinary instruments and devices, medical instruments and diagnostic devices based on bioresonance; commercial services relating to medical instruments and devices; and to instruments and diagnostic devices operating based on bioresonance; therapeutic and diagnostic medical services based on bioresonance.*

The applicant invoked Article 60(1)(a) EUTMR in connection with Article 8(3) EUTMR.

SUMMARY OF THE PARTIES' ARGUMENTS

The applicant argued that he is using the name 'EDUCTOR' in the course of trade since 2002 and that it is protected as a non-registered trade mark and well-known trade mark within the meaning of Article 6bis of the Paris Convention in various European countries, namely Hungary, Germany, Bulgaria, Belgium, Austria, Cyprus, Denmark, Greece, Spain, Finland, France, United-Kingdom, Italy, Netherlands, Portugal, Romania and Sweden. He further argued that the EUTM proprietor was one of its agent due to their commercial relationship and that the contested mark was filed by the proprietor without his consent.

The EUTM proprietor filed observations and replied to all the arguments submitted by the applicant.

UNAUTHORISED FILING BY AN AGENT OR REPRESENTATIVE OF THE TRADE MARK OWNER — 60(1)(a) EUTMR IN CONNECTION WITH ARTICLE 8(3) EUTMR

Article 60 EUTMR enables proprietors of earlier rights to apply for a declaration of invalidity of an EUTM when a trade mark has been filed without authorisation by an agent or representative of its proprietor (Article 60(1)(b) EUTMR in conjunction with Article 8(3) EUTMR).

The substantive conditions for considering an earlier right referred to in Article 60(1) EUTMR in conjunction with Article 8 EUTMR as a relative ground for a declaration of invalidity are the same as in opposition proceedings.

According to Article 8(3) EUTMR, upon opposition by the **proprietor of the trade mark**, a trade mark will not be registered where an agent or a representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's consent, unless the agent or representative justifies his action.

It follows from the above that to succeed under Article 8(3), the cancellation applicant has to establish that he is proprietor of an earlier 'trade mark' within the meaning of Article 8(3) EUTMR.

Scope of application of Article 8(3): existence of an earlier trade mark

In the present case, the applicant invoked the earlier non-registered trade mark 'EDUCTOR' protected in Hungary, Germany, Bulgaria, Belgium, Austria, Cyprus, Denmark, Greece, Spain, Finland, France, United-Kingdom, Italy, Netherlands, Portugal, Romania and Sweden in relation to *medical and veterinary instruments and devices, medical instruments and diagnostic devices based on bioresonance; commercial services relating to medical instruments and devices; and to instruments and diagnostic devices operating based on bioresonance; therapeutic and diagnostic medical services based on bioresonance.*

Article 8(3) EUTMR applies to earlier 'trade marks' that have been applied without consent. Unregistered trade marks and well-known trade marks within the meaning of Article 6bis are covered by this provision to the extent that the law of the country of origin recognises such a mark.

Substantiation of the earlier non-registered mark

According to Article 95(1) EUTMR, the Office will examine the facts of its own motion in proceedings before it; however, in proceedings relating to relative grounds for refusal of registration, the Office will restrict this examination to the facts, evidence and arguments submitted by the parties and the relief sought.

According to Article 16(1)(b) EUTMDR, in connection with 7(2) EUTMDR, in the case of an application pursuant to Article 60(1) EUTMR, the cancellation application shall file evidence of the existence, validity and scope of protection of its earlier mark or right, as well as evidence proving its entitlement to file the application.

Therefore, the onus is on the cancellation applicant to submit evidence of the existence of the earlier mark, which in the case of an earlier non-registered mark necessarily includes identifying the applicable law protecting non-registered marks in the territory in

question and the conditions for their acquisition (see, by analogy, 05/07/2011, C-263/09 P, Elio Fiorucci, EU:C:2011:452, § 50).

As regards the provisions of the applicable law, and by analogy with what is foreseen in the case of non-registered marks invoked under Article 8(4) EUTMR, the cancellation applicant must provide a clear identification of the content of the national law relied upon by adducing publications of the relevant provisions or jurisprudence (Article 7(2)(d) EUTMDR). The cancellation applicant must provide the *reference* to the relevant legal provision (Article number and the number and title of the law) and the *content* (text) of the legal provision by adducing publications of the relevant provisions or jurisprudence (e.g. excerpts from an official journal, a legal commentary, legal encyclopaedias or court decisions). If the relevant provision refers to a further provision of law, this must also be provided to enable the other party and the Office to understand the full meaning of the provision invoked and to determine the possible relevance of this further provision. Where the evidence concerning the content of the relevant national law is accessible online from a source recognised by the Office, the cancellation applicant may provide such evidence by making a reference to that source (Article 7(3) EUTMDR).

In the present case, the cancellation applicant did not submit any information on the legal protection granted to the non-registered mark invoked, or the conditions to be fulfilled for its acquisition under the laws of any of the Member States mentioned in the cancellation notice.

Consequently, the cancellation applicant failed to establish the existence of an earlier trade mark within the meaning of Article 8(3) EUTMR, that is, the earlier non-registered trade mark 'EDUCTOR'.

Therefore, the Cancellation Division finds that the application is not well founded under Article 8(3) EUTMR.

COSTS

According to Article 109(1) EUTMR, the losing party in cancellation proceedings must bear the fees and costs incurred by the other party.

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

According to Article 109(7) EUTMR and Article 18(1)(c)(ii) EUTMIR, the costs to be paid to the EUTM proprietor are the representation costs, which are to be fixed on the basis of the maximum rate set therein.

**The Cancellation Division**

José Antonio GARRIDO
OTAOLA

Julie, Marie-Charlotte
HAMEL

Frédérique SULPICE

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. 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 720 has been paid.