



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

OPERATIONS DEPARTMENT  
Cancellation Division

C490

**DECISION  
of the Cancellation Division  
of 11/01/2012**

**IN THE PROCEEDINGS FOR A DECLARATION OF INVALIDITY**

OHIM reference number: 5018 C

Community trademark: 6 769 161  
INNOVADEX

Language of the proceedings: English

**APPLICANT** **Innova Market Insights B.V.**  
Marketing 22  
6921 Duiven  
The Netherlands

**REPRESENTATIVE** **Simmons & Simmons**  
Claude Debussylaan 247  
1082 MC Amsterdam  
The Netherlands

against

**COMMUNITY TRADE MARK PROPRIETOR** **Innovadex LLVC**  
7932 Santa Fe Drive  
Overland Park KS 66204  
United States of America

**REPRESENTATIVE** **Van Diepen Van Der Kroef Advocaten**  
Dijsselhofplantsoen 16-18  
1077 BL Amsterdam  
The Netherlands

### THE CANCELLATION DIVISION

composed of: José Antonio Garrido Otaola, Thomas Hvammen Nicholson and Tuomas Mattila has taken the following decision on 11/01/2012:

- 1) **The request for a declaration of invalidity is rejected.**
- 2) **The invalidity applicant shall bear the costs of the Community trade mark proprietor: The amount of costs to be paid by the applicant to the Community trade mark proprietor shall be 450 EUR, corresponding to representation costs.**

### FACTS AND ARGUMENTS

- (1) The Community trade mark No 6 769 161 INNOVADEX (word mark) ('the contested CTM') was filed on 20/03/2008 and registered on 16/01/2009 with priority from 04/01/2008 for the following services:

**Class 42:** *Technical information, namely, providing information via a website on global computer networks in the form of an on-line database featuring technical data relating to raw material chemicals, food and beverage industries, pharmaceuticals, biotechnology, chemicals for medicinal purposes, industrial machinery, heavy construction, fabricated metal products, lumber and wood products, electronic and electric equipment, stone, clay and glass products, instruments, transportation equipment, primary metal industries, textile mill products, paper and allied products, non-metallic minerals and petroleum and coal products; except in connection with such technical information and media services provided via a website on global computer networks, none of the foregoing services in the fields of pharmaceuticals, veterinary, pharmacogenomic, biotechnical, dental or medical products or devices include clinical research and testing services for others, manufacturers! and independent sales representative services for others, consulting or business marketing consulting services for others, marketing or market research or analysis services for others, healthcare policy research and development services, developing and implementing disease management and treatment protocols or patient outcome analysis services.*

- (2) On 10/12/2010 Innova Market Insights B.V. (the 'invalidity applicant') filed a request for a declaration of invalidity under Article 53(1)(c) CTMR in conjunction with Article 8(4) CTMR against this Community trade mark in English based on the earlier trade name INNOVA used in the course of trade in the Netherlands in relation to an online database for the food industry.
- (3) The invalidity applicant files its request for a declaration of invalidity in respect of all the services covered by the contested CTM.
- (4) The invalidity applicant submits evidence to support that it has used various INNOVA trade names in the course of trade of more than local significance in

the Netherlands and that the invalidity applicant has established a right under Article 5 of the Dutch Trade Name Act ('Handelsnaamwet') to prohibit the use of the contested CTM since the signs in comparison are confusingly similar. In this respect, the invalidity applicant states that it is settled case law in the Netherlands that use of a trade name on the internet is considered nationwide use of that trade name.

- (5) On 11/02/2011, the CTM proprietor was notified of the application for invalidity against the above-mentioned CTM, and following an extension, was on 20/05/2011 given a two month period to reply.
- (6) The CTM proprietor replied on 20/07/2011 arguing that the claimed trade name does not give the invalidity applicant right to prohibit use under Dutch law. The CTM proprietor furthermore states that the invalidity applicant is not the proprietor of the trade name INNOVA since the evidence also refers to the company CNS Media B.V.
- (7) Furthermore, the CTM proprietor argues that parts of the evidence show use of INNOVA as a trade mark, not as a trade name.
- (8) Regarding use of an earlier right, the CTM proprietor argues that the evidence at best only shows use of the invoked trade name of merely local significance in the Netherlands, in particular due to the absence of a real presence on the Dutch market.
- (9) Assuming that the invalidity applicant has a right to which it can prohibit use of a later trade mark under Dutch law, the CTM proprietor argues that there will not be confusion as the scope of protection of the claimed trade names are at best limited, the signs are not sufficiently similar and the services and markets clearly distinct.
- (10) According to the CTM proprietor, the scope of protection of trade names goes hand in hand with its notoriety, and the invalidity applicant's trade names are not sufficiently known by the relevant public in the Netherlands for there to be confusion with the contested CTM. The CTM proprietor disputes that the invalidity applicant is a market leader, stating that no evidence regarding this has been submitted. As a result, the CTM proprietor argues that the invalidity applicant's trade name INNOVA Market Insights B.V. is so far removed from the contested CTM to exclude confusion.
- (11) Regarding Innovadatabase, according to the CTM proprietor, use of Innovadatabase was first initiated in 2006, only 1 ½ years before the priority date of the contested CTM, and internet hits submitted as evidence yield few hits, thereby contradicting the claims of the invalidity applicant regarding its use. Also, part of this evidence pertains to trade mark use and it also transpires that ownership lies with CNS Media, not the invalidity applicant.
- (12) Regarding the use of INNOVA – Food and Beverage Innovation in respect of periodicals, the CTM proprietor states that this apparently is published by CNS Media, not the invalidity applicant and that since this is the title of the publication, it does not constitute use of a trade name. Furthermore, this full name differs quite a lot from the contested CTM INNOVADEX.

- (13) The invalidity applicant did not reply to the observations of the CTM proprietor.
- (14) On 09/11/2011, the Office notified the parties that the adversarial part of the proceedings was closed. No further submissions were to be allowed and a decision would be taken in due course.

## GROUNDS OF THE DECISION

### *On the admissibility of the request*

- (15) The invalidity request complies with the formal requirements prescribed in the CTMR and the Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing CTMR ("CTMIR"), in particular as laid down in Article 56 CTMR and Rule 37 CTMIR. It is admissible.

### *On the substance*

- (16) The request is not well founded as the Cancellation Division does not find that the contested CTM has been registered in breach of Article 53(1)(c) in conjunction with Article 8(4) CTMR.

#### a) Use in the course of trade of more than local significance

- (17) The rationale and criteria for assessing whether use in the course of trade is of more than local significance has been assessed in paragraphs 36 and 37 of the decision of the General Court of 24/03/2009, T-318/06 to T-321/06, 'General Optica', whereupon it stated the following:
- (18) 'As regards the interpretation of the condition relating to the significance of the sign in question, according to which that significance must be more than merely local, it must be pointed out first that the rationale of that provision is to restrict the number of conflicts between signs, by preventing an earlier sign, which is not sufficiently important or significant, from making it possible to challenge either the registration or the validity of a Community trade mark (para 36).'
- (19) 'Furthermore, the significance of a sign used to identify specific business activities must be established in relation to the identifying function of that sign. That consideration means that account must be taken, first, of the geographical dimension of the sign's significance, that is to say of the territory in which it is used to identify its proprietor's economic activity, as is apparent from a textual interpretation of Article 8(4) of Regulation No 40/94. Account must be taken, secondly, of the economic dimension of the sign's significance, which is assessed in the light of the length of time for which it has fulfilled its function in the course of trade and the degree to which it has been used, of the group of addressees among which the sign in question has become known as a distinctive element, namely consumers, competitors or even suppliers, or even of the exposure given to the sign, for example, through advertising or on the internet (para 37).'

- (20) In the judgment of 29/03/2011, C-96/09 P, 'Bud', paragraphs 159 and 160, The European Court of Justice elaborated on the criteria concerning use in the course of trade of more than local significance stating that 'It follows that, in order to be capable of preventing registration of a new sign, the sign relied on in opposition must actually be used in a sufficiently significant manner in the course of trade and its geographical extent must not be merely local, which implies, where the territory in which that sign is protected may be regarded as other than local, that the sign must be used in a substantial part of that territory' and 'In order to ascertain whether that is the case, account must be taken of the duration and intensity of the use of that sign as a distinctive element vis-à-vis its addressees, namely purchasers and consumers as well as suppliers and competitors. In that regard, the use made of the sign in advertising and commercial correspondence is of particular relevance'.
- (21) Furthermore, as stated in paragraph 162 'It is in fact only in the territory in which the sign is protected, whether the whole or only part of it is concerned, that the applicable law confers on the sign exclusive rights which may enter into conflict with a Community trade mark'.
- (22) According to Article 53(1)(c) CTMR in conjunction with Article 8(4) CTMR, a non-registered sign may be invoked in cancellation proceedings if the rights to that sign were acquired prior to the date of application for registration of a Community trade mark or the date of priority claimed in the application for registration.
- (23) Furthermore, under Article 53(1)(c) CTMR, the criterion "*used in the course of trade*" contained in Article 8(4) CTMR has to be interpreted as a specific requirement that actual use must be present under European law, and has as its consequence that the Office requires proof of actual use of the invoked sign, in the absence of which the request for cancellation has to be rejected.
- (24) Article 53(1)(c) CTMR states that a Community trade mark shall be declared 'where there is an earlier right as referred to in Article 8(4) (...)', thereby referring to the condition that the earlier right must exist at the time of filing the application for invalidity.
- (25) Therefore, use must be present at the *date on* which the cancellation request was filed as well as on the date of filing or priority of the challenged CTM.
- (26) The contested CTM was filed on 20/03/2008, but with a priority date from 04/01/2008, while the cancellation application was filed on 10/12/2010. The invalidity applicant is therefore required to show that it had established rights to the trade names INNOVA by 04/01/2008 in the Netherlands and that such a right still existed at the time of filing the application of invalidity on 10/12/2010.
- (27) The invalidity applicant submitted the following evidence to prove this:
- Advertisements from the magazine The World of Food Ingredients, The Journal of the Practising Food Technologist from October/November 2002 and SN Sports Nutrition, The World of Food Ingredients from 2003. A

database described as 'The Worldwide Innovations Network Database' is advertised by INNOVA Market Insights B.V (sub 1 – 2).

- Undated excerpt from The World of Food Ingredients listing the contact details of The World of Food Ingredients, Food Ingredients First, SN and the invalidity applicant as the same and in the Netherlands (sub 3).
- 27 excerpts of the publication INNOVA – Food and Beverage Innovation from 2003 to 2010 containing news from the food industry (sub 4 – 8, 10 – 11, 21, 24 – 27, 29 – 30, 32, 34, 36, 38 – 39, 41 – 44, 46, 49 – 50, 52 ).
- Excerpt from the 2005 program and exhibit directory for the food expo IFT held in the US. It contains a presentation of an INNOVA new products database made by CNS Media Group/Innova Market Insights. When describing the database, reference is made to the INNOVA team and that INNOVA has designed posters (sub 9).
- Excerpt from the 2006 program for IFT where INNOVA had a "Taste the Trend" pavilion where it demonstrated innovations, driving ingredients, flavours, packaging and food technology as well as showcasing new product development trends in a number of categories (sub 12).
- Advertisement from The World of Ingredients from 2006 for the INNOVA database, an online database containing information about new food and beverage products, up to the minute news and research, trend analysis and statistical data, current information on markets. Also an advertisement for INNOVA – the total innovation publication (sub 13).
- Directory listing for Innova Market Insights from the catalogue of the international food products exhibition SIAL – The Global Food Marketplace held in France in 2006 (Sub 14).
- Media kit 2007 from The World of Ingredients about an INNOVA database stating that the publication The World of Ingredients is supported by INNOVA and also that the INNOVA database network has 500 associates in 60 countries (sub 15).
- Excerpt from the program for FoodSmarts IFT 2007 held in the US in 2007. It contains information about the INNOVA pavilion held by the INNOVA database team (sub 16).
- An advertisement for the INNOVA database from the World of Food Ingredients from 2007 (sub 17).
- Excerpt of a barter agreement signed 30/11/2007 where INNOVA Marketing Insights will be a media partner and provide services to the other party in relation to a Nutritional Bars Conference in Germany in 2008 (sub 18).
- A letter to CNS Media BV – INNOVA Market Insights of 02/01/2008 concerning a barter agreement between CNS Media and Soy Conference THV, a Belgian company (sub 19).
- The World of Food Ingredients media kit 2008 with an advertisement for the INNOVA database (sub 20).
- Barter agreement between CMP Information and CNS Media in relation to an exhibition in Poland in April 2008 and in China in June 2008. CMP Information undertakes *inter alia* to provide the complete company details of INNOVA and The World of Food Ingredients in the official show catalogues and exhibitor manuals (sub 22 and 23).
- Excerpt of the program and exhibit directory for the IFT food expo held in the US in 2008 containing a description of the INNOVA (Market Insights) 'Taste the Trend' pavilion (sub 28).
- Excerpt from the directory for the food exhibition SIAL held in France in 2008 containing the contact details of the invalidity applicant. It makes reference to INNOVA's Food & Beverage database (sub 31).

- Show catalogue for the exhibition HI Health Ingredients Europe held in France in 2008. It contains the contact details of the invalidity applicant, and makes reference to INNOVA's Food & Beverage database (sub 33).
  - Barter agreement between CMP Information and CNS Media in relation to the publication The World of Food Ingredients. In relation to this, CNS Media agrees to provide editorial coverage in INNOVA Foods & Beverage innovation newsletter and website (sub 35).
  - The World of Food Ingredients media kit 2009 produced by CNS Media and with an advertisement for the INNOVA database (sub 37).
  - The Event Guide for Vitafoods International expo held in Geneva, Switzerland in 2009 with the contact details of the invalidity applicant and a description of the INNOVA database (sub 40).
  - Excerpt of a barter agreement between the Dubai World Trade Centre and CNS Media BV in relation to an exhibition in 2010 whereupon INNOVA Market Insights is to be logo-linked to the web pages of the other party (sub 45).
  - Show catalogue 2009 for FI Europe, Food Ingredients Europe held in Germany in November 2009. INNOVA Market Insights are mentioned in the directory (sub 47).
  - Excerpt of the schedule for a Sports & Performance Nutrition Conference held in November 2009 in Germany where the Head of Research of the invalidity applicant was scheduled to hold a presentation (sub 48).
  - Excerpt of the schedule for Healthy Nutritional Bars Conference held in Germany in 2010 where the Head of Research of the invalidity applicant held a presentation (sub 51).
  - Email of 30/09/2010 concerning a question asked during training on site in New York whether INNOVADEX was part of INNOVA and thus having a partnership with Mintel (sub 53).
  - Excerpt from the program of the food expo SIAL 2010 held in France in October 2010 where INNOVA Market Insights are listed as one of the participants from the Netherlands (sub 54).
  - An excerpt from the publication Nutrition Insight from 2010 published by The World of Food Ingredients referring to INNOVA Market Insights at IFT10 and [www.innovadatabase.com](http://www.innovadatabase.com) (sub 55).
- (28) The CTM proprietor has in turn submitted the following evidence to contend the applicability of a Dutch trade name to prohibit the use of the contested CTM as well as the acquisition of any prior rights by the invalidity applicant:
- Excerpts from court decisions from the Netherlands (Annexes 1 and 2).
  - Screen print of the website [www.foodingredientsfirst.com](http://www.foodingredientsfirst.com) (Annex 3).
  - Search result for INNOVA database and INNOVA Market Insights (Annex 4).
  - Print of Google search for the word element INNOVA (Annex 5).
  - Print of registered Dutch Innova trade names (Annex 6).
  - Search results for INNOVADEX and INNOVA (Annex 7).
  - Screen print of INNOVADEX's present opening page (Annex 8).
  - Printouts from [www.foodingredientsfirst.com](http://www.foodingredientsfirst.com) and [innovadatabase.com](http://innovadatabase.com) (Annex 9).
  - Screen print of [www.foodingredientscentral.com](http://www.foodingredientscentral.com) (Annex 10).

*Assessment of the evidence*

*A sign used in the course of trade of more than local significance*



- (29) The invalidity applicant has claimed to have used the earlier trade names INNOVA, INNOVA Market Insights and INNOVA Database in the Netherlands in relation to a database for the food sector. The invalidity applicant also states that it has used these trade names in relation to various other business activities, in particular its own magazine.
- (30) The Cancellation Division will first assess whether the invalidity applicant has acquired the rights to the trade names INNOVA, INNOVA Market Insights and INNOVA Database in the Netherlands for a database in the food sector prior to the filing of the contested CTM.
- (31) In particular, the evidence needs to:
- show use of INNOVA as a trade name, not as e.g. a trade mark,
  - show use by the invalidity applicant of INNOVA as a trade name,
  - indicate use in the Netherlands,
  - and relate to a database for the food sector and not, e.g. be used as the name of a publication or be used in relation to presenting and demonstrating innovations and trends within the food and beverages industry.
- (32) Of the evidence submitted, the advertisements from The World of Food Ingredients from 2002 and 2003 (sub 1 and 2), the excerpt from the 2005 program and directory of the US food expo IFT (sub 9), the advertisements from the World of Ingredients from 2006 and 2007 (sub 13 and 17), the media kits from 2007, 2008 and 2009 from the World of Ingredients (sub 15, 20 and 37), the excerpt from the French food expo SIAL in 2008 (sub 31), the show catalogue for the French food expo HI Health Ingredients in 2008 (sub 33), the event guide for the Swiss Vitafoods International expo from 2009 (sub 40) and the excerpt from Nutrition Insight from 2010 (sub 55) contain references to the various cited INNOVA trade names in relation to databases for foods.
- (33) The other pieces of evidence either do not specify the activities concerned or they concern other kinds of activities. The many excerpts of the publication INNOVA – Food and Beverage Innovation from 2003 to 2010 indicate use of INNOVA as a trade mark for a food industry publication, some of the other listings from food expos indicate use of INNOVA in relation to demonstrating innovations, not directly in relation to a database and none of the barter agreements refer to a database.
- (34) As to use of the term INNOVA as a trade name, it must be noted that trade names are the names used by enterprises to identify the enterprise as such and its activities, whereas trade marks are used to identify the goods and services of an enterprise.
- (35) The evidence that pertains to the database does to a varying degree indicate use of the different variants containing INNOVA as a trade name. The advertisements from 2002 clearly indicate use of the trade name INNOVA Market Insights B.V. in relation to the database WIN. The excerpt from the 2005 program and exhibit directory of the food expo IFT does refer to 'INNOVA's new product database', thereby implying the name of the business behind the database. To the extent the various excerpts from the food expos relate to a database, trade name use is at least indicated since reference is made to INNOVA Market Insights B.V. as the enterprise behind the database.



- (36) However, evidence such as the media kits from the World of Food Ingredients seem to indicate more trade mark use than trade name use, seeing that they refer to a product called INNOVA database.
- (37) Consequently, some evidence indicates use of trade names containing INNOVA in respect of databases, others not.
- (38) In respect of showing the geographical and economic dimension of use in the Netherlands, the evidence submitted is quite problematic.
- (39) The invalidity applicant is situated in the Netherlands, and the evidence supports that this is the principal office of the invalidity applicant. This may indicate use **from** the Netherlands, but as such not **in** the Netherlands, in particular considering the apparently international flavour of the database. Furthermore, none of the evidence suggests any particular use of the trade name in the Netherlands. The URL of the database indicated in the evidence is the generic top-level domain .com and the database is in English, so it does not prove anything as such in respect of use in any specific country.
- (40) Even if use of a trade name on the internet is considered nationwide use under Dutch law, the invalidity applicant is nevertheless required under Article 8(4) CTMR to demonstrate the geographical and economic extent of use of the trade name in the geographical area for which it is claimed, in this case the Netherlands.
- (41) As to the economic dimension of use, the invalidity applicant in its observations states that at the time of filing the request for invalidity, the database had 6 800 subscriptions. It does not specify to which extent these subscribers were located in the Netherlands or even in the European Union, although it may be assumed that there were some at least. The invalidity applicant also states that its database is one of only four on the total industry market for food and beverages, however without submitting any specific evidence to actually substantiate this. The media kits also state that the INNOVA database network has many associates in many countries, e.g. in 2007 with 500 associates in 60 countries tracking new beverages and food products.
- (42) While these figures indirectly stipulate an economic dimension overall worldwide which seems to be of some significance, the invalidity applicant has not been able to link such an economic dimension to the place for which it claims that it has acquired a trade name, namely in the Netherlands.
- (43) Consequently, although there are some indications of use of trade names containing INNOVA from 2002 and onwards for a database provided by the invalidity applicant, the invalidity applicant has not submitted any evidence on the degree to which it has been used in the Netherlands and of the group of addressees or the exposure of the trade name INNOVA in relation to databases for the food and beverages industry in the Netherlands. A finding that use has been of more than local significance in the Netherlands, although not entirely unlikely, would be based on probabilities and presumptions based on the evidence submitted by the invalidity applicant in relation to the market sector involved. This is not sufficient, in particular considering the rationale behind Article 8(4) CTMR, namely to restrict the number of conflicts between signs when the earlier sign is not sufficiently important or significant.

- (44) Therefore, the invalidity applicant has failed to prove that it has acquired rights of more than local significance prior to the filing of the contested CTM under Article 8(4)(a) to the extent it has claimed this in respect of providing a database.
- (45) Furthermore, it is not entirely clear if the invalidity applicant has claimed the trade name INNOVA in relation to other business activities, most notably the publication named INNOVA – Food and Beverage Innovation.
- (46) Assuming it has, the Cancellation Division finds that the fact that it releases a publication labelled INNOVA – Food and Beverage Innovation in English from the Netherlands does not as such prove that it has acquired an earlier right as a trade name in the Netherlands under Article 8(4) CTMR. The invalidity applicant has not submitted anything in respect of geographical or economic dimension of use in the Netherlands, and seeing that the publication is in English and concerns a specialised industry, relatively little can be assumed about the use in the Netherlands.
- (47) Furthermore, the publication excerpts indicate use of INNOVA more as a trade mark than as a trade name in relation to this activity.
- (48) The invalidity applicant has also stated that it has used the INNOVA trade names in relation to other business activities, however with the exception of publishing its own magazine failing to specify these services. The invalidity applicant has therefore clearly not proven that it has acquired any rights to any trade names to any of the other business activities than the INNOVA database and the INNOVA publication already dealt with.

*The right to prohibit the use of a subsequent mark under national law*

- (49) For the sake of completeness, the Cancellation Division will deal with the issue of whether the claimed Dutch trade name in the present case may constitute an earlier right under Article 8(4) CTMR.
- (50) The invalidity applicant states that the OHIM guidelines specify that a Dutch trade name can be invoked as an earlier right under Article 8(4) CTMR. It also states that the requirements for obtaining injunctive relief under section 5 of the Dutch Trade Name Act ('Handelsnaamwet') have been met.
- (51) The CTM proprietor on the other hand argues that, excluding earlier registered trade marks, it is only possible to claim rights to prohibit use of a subsequent trade mark in the Netherlands under the general provision on wrongful acts under Article 6:162 of the Dutch Civil Code ('CC'). According to the CTM proprietor, confusion is not sufficient for this provision to be applicable since at least a wrongful act, such as e.g. bad faith, is also required.
- (52) Furthermore, the CTM proprietor argues that the right to prohibit the use of a later trade mark based on a trade name cannot be derived from either the Benelux Convention on Intellectual Property ('BCIP') or the Dutch Trade Name Act cited by the invalidity applicant.

- (53) As stated in paragraph 189 of 'Bud', in accordance with Article 76 CTMR, the burden of proving that the condition giving a proprietor the right to prohibit the use of a subsequent trade mark lies with the party claiming such a right before OHIM.
- (54) In this respect the invalidity applicant needs to furnish all the information necessary for the decision, including the identification the applicable law and provision of all the necessary data for its sound application. The evidence to be provided must allow the Cancellation Division to safely determine that a particular right is provided for under the law in question as well as the conditions for acquisition of such right. The evidence must furthermore clarify whether the holder of such right is entitled to prohibit the use of a subsequent as well as the conditions under which such right may prevail and be enforced vis-à-vis a subsequent trade mark.
- (55) One possible exception to the restriction of the OHIM in examining facts *ex officio* in *inter partes* proceedings under Article 76 CTMR may occur if the national law relied on can be considered a well-known fact (see the judgment of the General Court of 09/12/2010, T-303/08, 'Golden Elephant', paragraphs 65 and 67). According to the General Court, well-known facts are facts likely to be known by anyone or which may be learnt from generally accessible sources (see also the judgment of the General Court of 20/04/2005, T-318/03, 'Atomic Blitz', paragraph 35).
- (56) As to the cited national law in the present case, it is clear that the OHIM guidelines state that a right to a trade name may be used to prohibit the use of a subsequent trade mark. Reference is made to Article 2.19 BCIP, the Trade Name Act and Article 6:162 of the Dutch Civil Code. Although this suggests the possibility of using a trade name to prohibit the use of a trade mark under Dutch law, this has been contested by the CTM proprietor.
- (57) Furthermore, the invalidity applicant has cited Section 5 of the Dutch Trade Name Act, which states that 'It is illegal to use an identical trade name, which was already legitimately used, before the company was driven under that name, by another company or which so similar to that trade name, that this may cause confusion among the public because of the nature of the companies or their place of residence'.
- (58) This provision only makes reference to the use of trade names, not trade marks, and therefore does not according to its wording seem to be applicable to the case at hand.
- (59) Instead, the Cancellation Division notes the statements made in the decision of the Board of Appeal of 14/04/2008 in R-1232/2007-1, 'Gstor/G-STAR', at paragraphs 37 – 39:
- (37) Article 8(4) CTMR lays down the requirement, amongst others, that the proprietor of the sign must have the right under the terms of the national law governing this right to prohibit the use of the contested mark. In the Netherlands, trade names are protected pursuant to Article 1 *Handelsnaamwet* (Law on Trade Names) of 1921, aimed at preventing the public's confusion and deception through use of a trade name. This law defines a trade name as the name under which an undertaking is conducted, and rights in a trade name arise with legitimate use in trade. The name must

have a certain durability and reputation (see explanation on the website of the World Intellectual Property Organisation: <http://www.wipo.int/amc/en/processes/process2/rfc/rfc3/annexes/annex13.html>). Registration in the Trade Register at the Chamber of Commerce is no prerequisite to protection (see Bettinger, *Domain Name Law and Practice*, NL.06, 2005).

(38) Trade names are prohibited, according to Article 5 *Handelsnaamwet*, that are identical or confusingly similar to an existing trade name according to the circumstances, such as the activity, the location or similar circumstances. A trade name is confusingly similar when, with regard to the type of business and the place of the business, there is a risk or likelihood of confusion between the two companies on the part of the public (see website WIPO, cited above; Bettinger, cited above).

(39) There is no specific provision in Dutch law granting or extending the protection of trade names against identical or confusingly similar younger trade marks applied for or registered. The prohibition of use in the sense of Article 8(4)(b) CTMR would have to be based on general provisions of tortuous acts, where the conditions for that group of conflicts do not seem to be clearly defined in Dutch case-law and doctrine. Case-law is scarce, since the protection of registered trade marks normally has priority over unregistered trade marks or trade names. Opinions vary between granting protection to trade names against trade marks under the same conditions as against trade names (see previous paragraph) or to limit protection against applications filed in bad faith (see Constant J. J. C. van Nispen in: Schricker, Bastian, Knaak, *Gemeinschaftsmarke und Recht der EUMitgliedstaaten*, 2006, at paragraphs 43-45).

- (60) Given the fact that the issue of whether an earlier trade name may be applied to prohibit the use of a later trade mark and the conditions for prohibiting such use at best seems to be a bit unclear under Dutch law, it cannot be considered to be a well-known fact which the Cancellation Division should establish. Instead, the invalidity applicant should have submitted evidence proving that a Dutch trade name can be invoked to prohibit use of a later trade mark under Article 8(4) CTMR as well as the conditions for prohibiting use. In the absence of this, the Cancellation Division finds that the invalidity applicant failed to prove under Article 8(4) CTMR that Dutch law provides the proprietor of an earlier trade name the right to prohibit the use of a later trade mark.

#### *Conclusion*

- (61) In conclusion, the Cancellation Division finds that the invalidity applicant failed to prove the existence of an earlier right of more than local significance in the Netherlands under Article 8(4) CTMR. Furthermore, and for the sake of completeness, the Cancellation Division also finds that the invalidity applicant failed to prove that the claimed Dutch trade name can prohibit the use of a trade mark under Dutch law. As a result, the request for invalidity must be rejected.

#### **COSTS**

- (62) Pursuant to Article 85 (1) CTMR and Rule 94 CTMIR, the party losing cancellation proceedings shall bear the fees and costs of the other party. The invalidity applicant, as the party losing the cancellation proceedings shall bear the costs of the CTM proprietor.
- (63) According to Rule 94 CTMIR, the costs to be paid to the CTM proprietor are the costs of representation which are to be fixed on the basis of the maximum rate set therein.



### THE CANCELLATION DIVISION

<hr/> José Antonio Garrido Otaola	<hr/> Thomas Hvammen Nicholson	<hr/> Tuomas Mattila
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#### **Notice on the availability of an appeal:**

Under Article 59 of the Community Trade Mark Regulation any party adversely affected by this decision has a right to appeal against this decision. Under Article 60 of the Regulation notice of appeal must be filed in writing at the Office within two months from the date of notification of this decision and within four months from the same date a written statement of the grounds of appeal must be filed. The notice of appeal will be deemed to be filed only when the appeal fee of 800 euro has been paid.

#### **Notice on the review of the fixation of costs:**

The amount determined in the fixation of the costs may only be reviewed by a decision of the Cancellation Division on request. Under Rule 94(4) CTMIR 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 point 30 of the Fees Regulation) has been paid.

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

OPERATIONS DEPARTMENT  
Cancellation Division

C491B

**Invalidity proceedings: Notification of a decision to the CTM proprietor**

Alicante, 11/01/2012

VAN DIEPEN VAN DER KROEF  
ADVOCATEN  
Postbus 76729  
NL-1070 KA Amsterdam  
PAÍSES BAJOS

*Reference:* **20110222/03-005**  
*Fax number:* **00 31-205747475**  
*Community trade mark concerned:* **006769161**  
**INNOVADEX**  
*OHIM reference:* **000005018 C**  
*Language of the proceedings:* **English**

Please see attached the decision terminating the proceedings referred to above. It was delivered on 11/01/2012.

**Biruté Sataite Gonzalez**

Enclosures (excluding the cover letter): 13 pages