

**DECISION
of the Fifth Board of Appeal
of 15 February 2023**

In case R 497/2022-5

Retail Royalty Company
101 Convention Center Drive
Las Vegas Nevada 89109
United States of America

EUTM Proprietor / Appellant

represented by D Young & CO LLP, Rosental 4, 80331 Munich, Germany

v

Isdera AG
Feldmannstraße 121
66119 Saarbrücken
Germany

Revocation Applicant / Defendant

represented by Friedrich Graf von Westphalen & Partner mbB, Kaiser-Joseph-Str. 284,
79098 Freiburg i. Br., Germany

APPEAL relating to Cancellation Proceedings No 36 205 C (European Union trade
mark registration No 11 553 203)

THE FIFTH BOARD OF APPEAL

composed of V. Melgar (Chairperson), Ph. von Kapff (Rapporteur) and S. Rizzo
(Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 7 February 2013, Retail Royalty Company ('the EUTM proprietor') sought to register the figurative mark



as a European Union trade mark ('EUTM') for the following list of goods:

Class 3: *Fragrance; toiletries namely body wash and deodorants.*

Class 18: *Athletic bags, all-purpose athletic bags, duffel bags, tote bags, all-purpose carrying bags, drawstring pouches.*

Class 21: *Water bottles sold empty.*

Class 24: *Towels.*

Class 25: *Clothing including tops, bottoms, socks, gloves, scarves, legwarmers, dresses, skirts, outerwear, bras and underwear, footwear and headwear.*

Class 26: *Shoe laces; Hair accessories, namely hair bands, barrettes and hair ties.*

Class 27: *Yoga mats.*

- 2 The application was published on 25 March 2013 and the mark was registered on 2 July 2013.
- 3 On 18 June 2019, Isdera AG ('the revocation applicant') filed a request for revocation of the registered mark for all the above goods.
- 4 The grounds of the request for revocation were those laid down in Article 58(1)(a) EUTMR.
- 5 On 7 November 2019, the EUTM proprietor submitted evidence as proof of use.

- Exhibit AW1: Printouts showing fragrances and beauty products (body sprays) available via www.ae.com between 2014-2017, taken from Wayback Machine web archive. Some of the products bear the signs AE, AEO or AERIE whilst few of them show, among others, the signs



and






. The extracts include the signs





. The prices of the products are shown in US dollars, euros and GBP for the UK.



- Exhibit AW2: Printouts showing various types of bags (tote bags, handbags) available via www.ae.com between 2014-2017, taken from

Wayback Machine web archive where the signs ,  and  are shown. The prices of the products are shown in US dollars.

- Exhibit AW3: Printouts showing water bottles sold empty, available online in June 2019, taken from Wayback Machine web archive and currently offered for sale via www.ae.com. Only six bottles refer to AEO and the prices are shown in US dollars.
- Exhibit AW4: Printouts showing towels available via www.ae.com in June 2019, taken from Wayback Machine web archive. Some of them include AEO and the prices are shown in US dollars.
- Exhibit AW5: Printouts showing various articles of clothing (PJ pants, bottoms, kimonos, tanks, t-shirts), footwear (shoes, sneakers flip flops, boots, casual shoes, sandals), headgear (hats, beanies, caps), available via www.ae.com between 2011-2017, taken from Wayback Machine web

archive. The prices are shown in US dollars. The signs  and  are shown.

- Exhibit AW6: Printouts showing hair accessories, namely hair bands and hair ties, available via www.ae.com in 2019, taken from Wayback Machine web archive. They include AE and the prices are shown in US dollars.
- Exhibit AW7: EU online sales figures from 2014 to 2017 including a breakdown of Units and sales in US dollars of the AEO products. The document does not include a date or the source although they refer to many countries of the European Union and a short description of the products.
- Exhibit AW8: Examples of packaging (non-dated) showing the Eagle mark applied to products themselves or to labels, tags and packaging for goods such as socks, gloves, underwear, legwarmers, tights, bifolds

featuring the sign  or caps, shoes and sneakers bearing the sign .

- Exhibit AW9: Several EU orders dated 2006, 2008, 2010, 2011, 2012, 2013 and 2015 and addressed to several EU countries showing the AEO, AE and AERIE products.
- The EUTM proprietor also refers to documents submitted in Opposition Division proceedings No B 3 001 974 on 11 June 2018 and 17 December 2018 in relation to which the revocation applicant had the chance to comment. They are shown as follows:

- First Witness Statement of Mr Alexander Walsh, Corporate Counsel of Intellectual Property and Brand Protection of American Eagle Outfitters, signed on 8 June 2018. It encloses the following attachments:

- **AW1:** Fashion United article, ‘American Eagle to launch in the UK with three stores’, dated 1 July 2014. The American retailer has more than 1,000 stores in the US, Canada, Mexico, China and Hong Kong, and through its e-commerce websites it ships to 81 countries worldwide. American Eagle Outfitters and Aerie merchandise is available at 82



licensed international franchise stores in 13 countries. The sign is displayed on a T-shirt.

- **AW2:** Guardian article, ‘‘Normcore’ goes mainstream as American Eagle lands in the UK’, dated 26 October 2014.
- **AW3:** Details of the opponent’s earlier figurative Eagle Marks together with a declaration of the Senior Graphic Design Director at American Eagle Outfitters and the copyrights.
- **AW4:** EUIPO Opposition Division decision 06/09/2017, B 2 752 965, (Eagle Mark), which states a reputation of the Eagle mark in the UK for at least pants, jeans, shorts, shirts, t-shirts.
- **AW5:** UKIPO decision, O-068-13 (LET IT ROCK) in which the Eagle mark was the opposed mark. It recognises substantial sales of the mark in the UK.
- **AW6:** Several decisions from different Intellectual Property Offices decided in the opponent’s favour.
- **AW7:** BrandZ 2007 Ranking report Top Most Powerful Brands by Millward Brown. It ranks American Eagle Outfitters in the 10th position among the apparel brands. A Fashion United article showing the statistics of the UK fashion industry in billion pounds. An extract from the Eurostat news release showing the figures of the EU population.
- **AW8:** WHOIS reports for ae.com and aeo.com.
- **AW9:** Several printouts showing AEO websites available in GBP and EUR. The contested mark is not shown.
- **AW10:** Several printouts showing www.ae.com shipping locations (inter alia, Finland, France, Austria, Germany), taken from Wayback Machine web archive dated 2011, 2012, 2013, 2014, 2015, 2016 and 2017. In some of the extracts the Eagle sign is shown.
- **AW11:** Several printouts showing use of the Eagle mark on various products (caps, body spray, flip flops) and product packaging available via www.ae.com between 2013 and 2015 taken from Wayback Machine web archive. Some of the products show the Eagle mark together with American Eagle Outfitters but others show ‘American Eagle’ or ‘AE’ and are shown in US dollars.

- **AW12:** Printouts showing fragrances and beauty products available via www.ae.com between 2013-2017, taken from Wayback Machine web archive.
- **AW13:** Printouts showing various types of bags available via www.ae.com between 2011-2017, taken from Wayback Machine web archive.
- **AW14:** Printouts showing clothing, footwear, headgear available via www.ae.com between 2011-2017, taken from Wayback Machine web archive.
- **AW15:** Examples of packaging (non-dated) for goods such as socks, gloves, underwear, legwarmers, tights, billfolds featuring the sign



- **AW16:** Pictures of products (non-dated) such as perfumery, make up, tote-bags, underwear, sleepwear, socks, hats, flipflops, sneakers,



footwear, caps and headbands showing the signs



applied to the products themselves or to labels, tags and packaging.

- **AW17:** Several news reports and articles published in, inter alia, The Telegraph (2017), Fashion United (2014), LDN Fashion (2014), Fashion Beans (2014), Retail Week (2014), Daily Mail, Standard (2014) relating to the opening of AEO's UK stores. The EUTM proprietor provides figures of the numbers of visits of the online editions.
- **AW18:** American Eagle Outfitters UK Limited, Directors' report and Audited Financial Statements 31 January 2015 to 30 January 2016 by Ernst & Young LLP.
- **AW19:** Details of Westfield Stratford City, Westfield London and Bluewater Shopping Centre.
- **AW20:** Extracts in Greek and in English dated 2015-2017 which correspond to several news reports and articles published in, inter alia, Vipnews, Kathimerini, The Sugar Plum Fairy, Mononews, Boxnews, Fayscontrol relating to the opening of AEO's Greece stores. The photo-



call and the products show the sign

- **AW21:** Printouts showing the Eagle mark on www.ae.com between 2009-2016, taken from Wayback Machine web archive.
- **AW22:** EU online sales figures from 2006 to 2011 including a breakdown of Units and sales in euros. The document does not include a date or the source.

- **AW23:** A document showing EU online sales details from 2012 to 2017 per country. They include a description of the products, the code number and the amounts in US dollars. Several extracts from the page www.ae.com are enclosed showing the information of the products. The code of the product is included which could be cross referenced with the list of sales. Only one item bears the contested mark.
- **AW24:** Printouts from www.ebay.co.uk showing results of the search American Eagle in the UK. Only some products (clothing) bear the Eagle mark.
- **AW25-27:** Extracts from several sources dated 2014, 2015 showing retail stores in the UK, Greece and Poland.
- **AW28:** Photographs showing swing tags/labels on clothing items bearing



the sign .

- **AW29:** Representative UK retail store sales details, 2014-2017.
- **AW30:** Examples of products (variety of clothing items, footwear and headgear as well as perfumes, bags, wallets and belts) bearing the Eagle



mark and .

- **AW31:** UK and EU sales figures from 2006 to 2014 including a breakdown of Units and sales in euros. The document does not include a date or the source. UK stores sales figures, 2014.
- **AW32:** Greece sales figures in 2016 breaking down total sales in euros and average units.
- **AW33:** Greece (from 2013-2018) and Poland (2012-2015) stores sales figures generated by IBM Cognos software.
- **AW34:** A spreadsheet. According to the EUTM proprietor, it shows details of EU customer orders placed via www.ae.com during 2015. It includes a description of the products and the amounts as well as the country. The contested mark is not mentioned.
- **AW35:** More than a hundred orders from 2006 to 2016 and addressed to several EU countries showing AEO products.
- **AW36:** Worldwide advertising spend from 2002-2014 in euros and in US dollars. The document does not include a date or the source. According to the EUTM proprietor, they advertise products sold under the Eagle mark.
- **AW37:** Examples of mail shots from 2012 sent to customers in the UK



and the EU showing the sign on clothing items.


- **AW38:** Examples of press materials and billboard campaigns dated 2012, 2013, 2014 of American Eagle Outfitters. Some of the clothing items show the Eagle mark.

- **AW39:** Text Marketer article, 'Top marketing campaigns from 2015', dated 12 January 2016.
- **AW40:** Wolf Brand Experience article, 'American Eagle Outfitters launches in the UK – The Eagle has landed', dated 12 December 2014.
- **AW41:** Photographs of banners, ticket gates on tube stations showing




. According to the EUTM proprietor, they correspond to AEO UK 'Underground Takeover' dated 22 September 2015.




- **AW42:** Photographs showing  in advertising materials in Greece. Sample of invoices which, according to the EUTM proprietor, refer to the placement of advertisements and photographer of store opening.
- **AW43:** A table which, according to the EUTM proprietor, shows consumer visits to www.ae.com between 2011 and 2015. It contains a breakdown per country and year and the total visits. The source is not included.
- **AW44:** Details of total website hits to www.ae.com between 2013 and 2018. It specifies the country, the page visits and the visits. The information has been compiled by Adobe Analytics.
- **AW45:** Details of internet web traffic statistics for www.aeo.com generated by Alexa showing the monthly unique visitor metrics, global ranking and site visitors.
- **AW46:** A sheet which, according to the EUTM proprietor, refers to details of calls to UK and EU Customer Services lines in 2015 and 2016 respectively. Screenshots of the www.aeo.com showing the telephone numbers for the customer service lines in the EU countries.
- **AW47:** Screenshots of the AEO smart phone app downloaded from the iTunes store and Google Play taken from the Wayback Machine in 2015.



The app shows the sign .

- **AW48:** A Euro-monitor article, 'Teen Fashion Coming of Age?' dated 30 March 2016 mentioning the success of American Eagle.
- **AW49:** Printouts from the AEO Facebook page and a table detailing the number of 'likes' per EU countries.
- **AW50:** Printouts from AEO Facebook page; printouts from third party and AEO Instagram accounts.
- **AW51:** Printouts from social networking sites (Instagram, Twitter,



Pinterest) showing the sign .

- **AW52:** Examples of celebrities in different publications (2011-2012) wearing the EUTM proprietor's clothing.
- **AW53:** Management Study Guide article, 'Retail Fashion Advertising for Youth' (2017).
- **AW54:** Articles (FashionUnited, RetailWeek) relating to the launch of a UK specific online store dated 2015. They show a photograph of stores in the UK.
- **AW55:** Articles published in UK fashion magazines such as Glamour,



InStyle, Mirror, Cosmopolitan, Look, 2014-2015 featuring in relation to clothing.

- **AW56:** Fashion blog posts 2014-2016 featuring in relation to clothing (denim).
- Second Witness Statement of Mr Alexander Walsh, Corporate Counsel of Intellectual Property and Brand Protection of American Eagle Outfitters, signed on 13 December 2018. It encloses the following attachments:
- **AXW1-3:** Online sales details in Croatia, Denmark and Hungary between 2012-2017.
 - **AXW4:** Highlighted representative EU online sales details, 2012-2017 per country. They include a description of the products, the code number and the amounts in US dollars.
 - **AXW5:** Screenshots of watches available on www.ae.com between 2016-2017, taken from Wayback Machine web archive, and printout from AEO Facebook page showing watch, dated 2016.
 - **AXW6:** Screenshots of jewellery items available on www.ae.com between 2016-2017, taken from Wayback Machine web archive.

- 6 By decision of 28 January 2022 ('the contested decision'), the Cancellation Division partially revoked the contested EUTM. The EUTM proprietor's rights in respect of European Union trade mark No 11 553 203 are revoked as from 18 June 2019 for some of the contested goods, namely:

Class 3: *Fragrance; toiletries namely body wash and deodorants.*

Class 18: *Athletic bags, all-purpose athletic bags, duffel bags, all-purpose carrying bags, except handbags and tote bags, drawstring pouches.*

Class 21: *Water bottles sold empty.*

Class 24: *Towels.*

Class 26: *Shoe laces; hair accessories, namely hair bands, barrettes and hair ties.*

Class 27: *Yoga mats.*

However, the EUTM remained registered for the following goods:

Class 18: *Hand bags and Tote bags.*

Class 25: *Clothing including tops, bottoms, socks, gloves, scarves, legwarmers, dresses, skirts, outerwear, bras and underwear, footwear and headwear.*

It gave, in particular, the following grounds for its decision:

Article 58(1)(a) EUTMR

- In revocation proceedings based on the grounds of non-use, the burden of proof lies with the EUTM proprietor as the revocation applicant cannot be expected to prove a negative fact, namely that the mark has not been used during a continuous period of five years. Therefore, it is the EUTM proprietor who must prove genuine use within the European Union or submit proper reasons for non-use.
- In the present case, the EUTM was registered on 2 July 2013. The revocation request was filed on 18 June 2019. Therefore, the EUTM had been registered for more than five years at the date of the filing of the request. The EUTM proprietor had to prove genuine use of the contested EUTM during the five-year period preceding the date of the revocation request, that is, from 18 June 2014 until 17 June 2019 inclusive, for the contested goods listed in paragraph 1.
- On 7 November 2019, the EUTM proprietor submitted evidence as proof of use. As the EUTM proprietor requested to keep certain commercial data contained in the evidence confidential vis-à-vis third parties, the Cancellation Division will describe the evidence only in the most general terms without divulging any such data. The evidence to be taken into account is listed in paragraph 5.

Preliminary remarks

On the evidence related to the United Kingdom

- The EUTM proprietor has submitted, inter alia, evidence relating to the United Kingdom (UK) with a view to demonstrating use of the contested mark. All that evidence relates to a period prior to 1 January 2021.
- On 1 February 2020, the UK withdrew from the EU subject to a transition period until 31 December 2020. During this transition period EU law remained applicable in the UK. Therefore, use in the UK prior to the end of the transition period constituted use ‘in the EU’. Consequently, the evidence relating to the UK and to a period prior to 1 January 2021 is relevant with a view to maintaining rights in the EU and will be taken into account.

On the well-known character of the contested mark

- The EUTM proprietor argues that the Eagle mark has become a very well-known mark in the relevant public. In support of it, it quotes earlier decisions of the Office which considered that the Eagle mark enjoys reputation.
- The Cancellation Division notes that the role of the Office is to assess the evidence put before it in the light of the parties’ submissions. Although the decisions submitted may indicate that the mark has a certain level of recognition in a certain market, it has to be noted that even proprietors of purportedly well-known marks must submit evidence to prove genuine use of their marks.

- In this case, all the pieces of evidence will be analysed, including the earlier decisions. Therefore, the case will be assessed on the evidence, in its entirety, submitted by the EUTM proprietor which will have to be sufficient to prove that the contested mark was genuinely used during the relevant period, in the relevant place and to a sufficient extent and as registered or in a form that does not alter the distinctive character of it and in relation to the goods for which it is registered.

Use by a third party

- The EUTM proprietor argues in the witness statements signed by the Corporate Counsel of American Eagle Outfitters that the said entity is a parent company of the EUTM proprietor.
- According to Article 18(2) EUTMR, use of the European Union trade mark with the consent of the EUTM proprietor is deemed to constitute use by the EUTM proprietor. The fact that the EUTM proprietor submitted evidence of use of its marks by a third party shows that it consented to this use (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225).
- Consequently, the evidence filed by the EUTM proprietor is an indication that the use was with its consent.
- To this extent, and in accordance with Article 18(2) EUTMR, the Cancellation Division considers that the use by those other companies was with the EUTM proprietor's consent and, therefore, is equivalent to use by the EUTM proprietor itself.

On the probative value of the witness statements

- As far as the witness statements are concerned, Article 10(4) EUTMDR (applicable to cancellation proceedings by virtue of Article 19(1) EUTMDR) expressly mentions written statements referred to in Article 97(1)(f) EUTMR as admissible means of proof of use. Article 97(1)(f) EUTMR lists, as means of giving evidence, sworn or affirmed written statements or other statements that have a similar effect under the law of the State in which they were drawn up. As far as the probative value of this kind of evidence is concerned, statements drawn up by the interested parties themselves or their employees are generally given less weight than independent evidence. This is because the perceptions of a party involved in a dispute may be more or less affected by its personal interests in the matter.
- However, this does not mean that such statements do not have any probative value at all.
- The final outcome depends on the overall assessment of the evidence in the particular case. The probative value of such statements depends on whether or not they are supported by other types of evidence (labels, packaging etc.) or evidence originating from independent sources. In view of the foregoing, the remaining evidence must be assessed in order to see whether or not the contents of the declaration are supported by the other items of evidence.
- As regards the exhibits attached to the witness statements, they are independent pieces of evidence which back up the statements made in the said

witness statements, and therefore, the Cancellation Division considers that they are valid evidence which must be duly considered.

Assessment of genuine use – factors




Time of use

- Although some documents are not dated (i.e. exhibit AW8 and attachment AW15) or are dated outside of the relevant period (i.e. exhibit AW9 and attachment AW7), it must be noted that the majority of the extracts from the Wayback Machine (exhibits AW1-4), some online sale figures (exhibit AW7) and the articles and reports inserted in several publications (attachments AW17 and AW20), provide sufficient indications as to the use of the contested mark during the relevant time period, namely, from 18 June 2014 to 17 June 2019 inclusive.
- According to case-law, it is sufficient that a trade mark has been put to genuine use during a part of the relevant period for it not to be subject to sanctions (25/03/2009, T-191/07, Budweiser, EU:T:2009:83, § 108). Therefore, the evidence filed by the EUTM proprietor contains sufficient indications concerning the time of use.




Place of use

- Some of the documents show that the products are offered in the USA. Moreover, the Cancellation Division observes that the prices of the products are, in some documents, displayed in US dollars (some extracts from the EUTM proprietor's website www.aeo.com).
- However, there are extracts showing the mark in several markets such as the UK or Greece (attachments AW29, AW32, AW40 and AW42). Moreover, the orders show that American Eagle Outfitters products were shipped to various EU countries such as Belgium, Bulgaria, France, Spain, Sweden, Austria and the Czech Republic and the amounts are in euros or in their local currency (attachment AW35).
- Moreover, extracts and marketing initiatives have been provided in different languages showing the mark in several EU countries (Poland, Greece and the UK).
- In the Cancellation Division's view, the evidence provided shows that the contested mark has reached customers in many countries within the European Union and not only the US market. The evidence provided shows that the contested mark has been exposed to customers in several countries within the European Union. The geographical area shown is sufficient to prove the territorial extent of use of the contested mark within the European Union.
- Therefore, the evidence relates to the relevant territory and is sufficient to show the place of use of the contested mark.

Nature of use: use as a trade mark

- In the present case, the majority of the documents show that the signs  ,  and  are used in connection with certain goods to indicate the commercial origin and therefore it is used as a trade mark. Consequently, the consumers can distinguish the goods from those of different manufacturers.

Nature of use: use of the mark as registered

- The revocation applicant argues that the evidence does not prove use of the mark as registered since the registered sign has a different distinctive character compared to the eagle standing alone. It adds that the bald eagle or golden eagle are understood as a reference to the US. This is particularly true for companies which have their origin in the US as the American Eagle is one of the strongest national symbols in America. Therefore, and according to the revocation applicant, the distinctive character of the contested mark is rather low and the circular element surrounding the eagle is one of the most important aspects with respect to the distinctive character of the sign. The eagle alone, without the circle element, as well as other features such as the different colours and the addition of the terms ‘AMERICAN EAGLE OUTFITTERS’ are creating a completely different impression.
- In contrast, the EUTM proprietor argues that the use of the Eagle mark is sufficient to justify the use of the contested mark as registered. It considers that whilst bald eagle imagery features in the Great Seal of the United States, it does not follow that the use of a silhouetted eagle would be interpreted by the average consumer as indicating goods originating from America. The EUTM proprietor also asserts that the flying eagle element is neither decorative nor descriptive and it does act as a distinctive trade mark. Moreover, the other element, that is, the circle and arrow element is very simple and circular elements are not typically considered to contribute much to the overall distinctive character of trade marks. The change in colourway (which is in fact a simple colour inversion) does not alter the distinctive character of the Eagle Mark either. The EUTM proprietor also points out that the Eagle Mark maintains an independent distinctive role even where it is used alongside ‘American Eagle Outfitters’ or other word elements.
- In the present case, it has to be noted that the contested mark is a figurative mark which consists of the silhouette of a flying eagle surrounded by a circle and arrow element. Since it has not relation to the concerned goods, it is, as a whole, normally distinctive, contrary to the revocation applicant’s claim.
- In this case, some of the evidence, namely, the extracts and the pictures and the press articles show the signs as follows:  ,  and  . The figurative sign appears together with the verbal elements ‘AMERICAN EAGLE OUTFITTERS’. Those verbal elements are distinctive.

- The revocation applicant points out that the figurative element on one hand and the word element on the other cannot be separated as two different marks but the sign must be acknowledged as one trade mark.
- It is quite common in some market areas for goods and services to bear not only their individual mark, but also the mark of the business or product group ('house mark'). In these cases, the registered mark is not used in a different form, but the two independent marks are validly used at the same time.
- There is no legal precept in the European Union trade mark system that obliges the EUTM proprietor to provide evidence of the mark alone when genuine use is required. Two or more trade marks may be used together in an autonomous way, or with the company name, without altering the distinctive character of the earlier registered trade mark (06/11/2014, T-463/12, MB, EU:T:2014:935, § 43) as in the present case.
- In the present case, the silhouette of a flying eagle and the expression 'AMERICAN EAGLE OUTFITTERS' are clearly recognised as independent elements. The eagle appears on its own or above the elements 'AMERICAN EAGLE OUTFITTERS'. Therefore, they will be seen as two independent trade marks. In addition, the omission of the circle and arrow element, which is merely decorative with less distinctive character, does not alter the distinctive character of the mark as registered. As regards the colours and other different backgrounds, they are merely decorative and do not alter the distinctive character of the mark as registered.
- In relation to the revocation applicant's argument that the bald eagle or golden eagle are understood as a reference to the US, the Cancellation Division observes that the revocation applicant does not provide examples that the bald eagle would make the consumers link them to a reference to the goods originating from the USA, as argued by the EUTM proprietor. The revocation applicant's argument is dismissed.
- Therefore, the evidence submitted shows use of the mark as registered or in a form essentially the same as that registered and, therefore, such use constitutes use of the contested registration under Article 18 EUTMR contrary to the revocation applicant's claim. Therefore, the nature of use requirement has been fulfilled in relation to some of the contested goods.

Extent of use

- The extracts from the EUTM proprietor's websites, the insertions in certain publications and the pictures of products do not give any indication as regards sales figures or commercial volume. However, some extracts show advertising campaigns through social media (Facebook, Twitter and Instagram). Moreover, the evidence also shows banners in public transports as well as insertions in a newspaper in the UK.
- In relation to this type of evidence, it has to be noted that even circumstantial evidence featuring the trade mark, despite not providing direct information on the quantity of goods actually sold, can be sufficient by themselves to prove the extent of use in an overall assessment (15/07/2015, T-398/13 TVR ITALIA (fig.) / TVR et al., EU:T:2015:503, § 57-58; 08/07/2010, T-30/09, Peerstorm, EU:T:2010:298, § 42 et seq.).

- Furthermore, several news reports and articles published in, inter alia, *The Telegraph* (2017), *Fashion United* (2014), *LDN Fashion* (2014), *Fashion Beans* (2014), *Retail Week* (2014), *Daily Mail, Standard* (2014) relate to the opening of AEO's UK stores. The EUTM proprietor provides figures of the numbers of visits of the online editions (attachment AW17). The EUTM proprietor also shows details of total website hits to www.ae.com between 2013 and 2018. It specifies the country, the page visits and the total visits. The information has been compiled by Adobe Analytics (attachment AW44).
- According to case-law, although the insertions in certain publications and the extracts from the websites do not add any information about the extent of use in terms of sales volumes, there are references to the presence of some goods on the market in some European countries. It is true that those websites provide no information on the quantity of goods actually sold under the trade mark however they provide the number of visits of the online editions. It is necessary to take into account, in that regard, the fact that a large number of items designated by the trade mark were offered and that those items were available for a significant part of the relevant period. Those factors support the conclusion, in the context of a global assessment of whether the use to which the mark was put was genuine, that the extent of its use was fairly significant. In that regard, it must also be remembered that the purpose of the requirement for genuine use of the mark is not to assess the commercial success of the undertaking in question (08/07/2010, T-30/09, Peerstorm, EU:T:2010:298, § 43).
- In addition, the orders from, at least, 2014 to 2016 and addressed to several EU countries show modest amounts taking into account the relevant products. The turnover and volume of sales of the product must always be assessed in relation to all the other relevant factors, such as the volume of business, production or marketing capacity, or the degree of diversification of the undertaking using the trade mark, and the characteristics of the products or services on the relevant market. Use need not always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or services concerned on the corresponding market (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 39; 08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 42).
- Therefore, taking into account all the evidence provided, the Cancellation Division considers that the evidence, taken as a whole, is sufficient to prove the extent of use of the registered mark, and exceeds mere token use, in respect of certain goods.
- Consequently, the Cancellation Division finds that the documents filed provide sufficient information concerning the commercial volume, the duration and the frequency of use at least for some of the contested goods.

Use in relation to the registered goods


- The contested EUTM is registered for the goods in Classes 3, 18, 21, 24, 25, 26 and 27 listed in paragraph 1. However, the evidence filed by the EUTM proprietor does not show genuine use of the trade mark for all the contested goods for which it is registered.

- According to Article 58(2) EUTMR, where there are grounds for revocation in respect of only some of the goods or services for which the contested mark is registered, the EUTM proprietor's rights will be revoked only for these goods and services.

Contested goods in Class 3

- In the Cancellation Division's view, only few extracts (pictures, extracts from the EUTM proprietor's website) are insufficient to show genuine use of the contested goods in this class. Some of the extracts include the eagle logo, the prices are expressed in US dollars indicating that the goods were introduced in the US and not in Europe. Only few extracts show the representation of the




eagle as follows , however, there are not enough indications that the EUTM proprietor has seriously tried to acquire a commercial position in the relevant market for these goods.

- Therefore, genuine use has not been proved as regards the contested goods *fragrance; toiletries namely body wash and deodorants* in Class 3.

Contested goods in Class 18


- In connection with Class 18, the evidence shows sufficient indications of use



of the contested mark for a variety of bags, for instance . It is clear that the evidence shows genuine use in relation to tote bags.

- As regards the contested *all-purpose carrying bags*, the evidence shows that the contested mark has been used for a variety of handbags, for instance



. The contested EUTM is registered for all-purpose carrying bags. It is clear that this category of goods is sufficiently broad for several sub-categories to be identified within it. The evidence proves use for handbags. On the basis of the purpose of the goods used, the Cancellation Division finds that the use for these goods falls under the broad category of all-purpose carrying bags and constitutes use for the sub-category handbags. Tote bags are a kind of all-purpose carrying bag and can also be classified as a handbag.

- However, the evidence does not contain any indications of use for the contested *athletic bags, all-purpose athletic bags, drawstring pouches*. As regards the contested *duffel bags*, only few extracts include them however it is clear that these products do not bear the 'Eagle' mark, but again, the place of use of these goods is the USA, given the currency of US dollars.

Contested goods in Class 21

- The Cancellation Division considers that only few extracts (pictures, extracts from the EUTM proprietor's website) are insufficient to show genuine use of these goods since it does not provide enough indications that the EUTM proprietor has seriously tried to acquire a commercial position in the relevant market for these goods. Moreover, the extracts do not show those products bearing the contested mark. It follows from the above that the submitted documents, individually or taken together as a whole, do not provide sufficient information about the extent of use of the challenged EUTM in relation to the contested goods in this class.

Contested goods in Class 24

- The Cancellation Division considers that only few extracts (pictures, extracts from the EUTM proprietor's website) are insufficient to show genuine use of these goods since it does not provide enough indications that the EUTM proprietor has seriously tried to acquire a commercial position in the relevant market for these goods. Moreover, the extracts do not show those products bearing the contested mark. It follows from the above that the submitted documents, individually or taken together as a whole, do not provide sufficient information about the extent of use of the challenged EUTM in relation to the contested goods in this class.

Contested goods in Class 25

- From the documents as a whole and in particular from the extracts, articles and online sale figures, in combination with the excerpts from websites it is evident that the mark has been used for a variety of clothing, footwear and headgear articles.
- It needs to be clarified that the term 'including', used in the contested list of goods after clothing, indicates that the specific goods listed thereafter are only examples of items included in the category and that protection is not restricted to them. In other words, it introduces a non-exhaustive list of examples (see, by analogy, 09/04/2003, T-224/01, Nu-Tride, EU:T:2003:107). Therefore, when assessing genuine use of the mark in relation to the contested goods, only use for the registered categories identified by the term preceding the word 'including' (clothing) will be examined, as the examples listed after the term 'including' (that is, including tops, bottoms, socks, gloves, scarves, legwarmers, dresses, skirts, outerwear, bras and underwear) do not affect the scope of protection of the mark, which covers the entire category of clothing regardless of the examples listed.
- As regards clothing, footwear and headwear, the Cancellation Division finds that taking into account the fact that the evidence shows use of the EUTM for various articles of clothing (PJ pants, bottoms, kimonos, tanks, t-shirts), footwear (shoes, sneakers, flip flops, boots, casual shoes, sandals), headgear (hats, beanies, caps), it is considered that the evidence shows genuine use of those categories of goods for which the mark is registered.
- Since in practice it is impossible for the EUTM proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration, the evidence shows use for clothing, footwear,

headgear in Class 25. Therefore, use has been proven for clothing including tops, bottoms, socks, gloves, scarves, legwarmers, dresses, skirts, outerwear, bras and underwear, footwear and headwear.

Contested goods in Class 26

- The Cancellation Division considers that only few extracts (pictures, extracts from the EUTM proprietor's website) are insufficient to show genuine use of these goods since it does not provide enough indications that the EUTM proprietor has seriously tried to acquire a commercial position in the relevant market for these goods. Moreover, the extracts do not show those products bearing the contested mark. It follows from the above that the submitted documents, individually or taken together as a whole, do not provide sufficient information about the extent of use of the challenged EUTM in relation to the contested goods in this class.

Contested goods in Class 27

- There is no evidence whatsoever that demonstrates genuine use of the contested mark for these goods. It follows from the above that the submitted documents, individually or taken together as a whole, do not provide sufficient information about the extent of use of the challenged EUTM in relation to the contested goods in this class.

Overall assessment

- In the present case, the Cancellation Division considers that genuine use of the contested mark has been sufficiently demonstrated for the relevant factors, namely, the time, the place, the nature and the extent of use for certain goods as detailed above in the previous section.
- It follows from the above that the EUTM proprietor has not proven genuine use of the EUTM for the following goods, for which it must, therefore, be revoked:

Class 3: Fragrance; toiletries namely body wash and deodorants.

Class 18: Athletic bags, all-purpose athletic bags, duffel bags, all-purpose carrying bags, except handbags and tote bags, drawstring pouches.

Class 21: Water bottles sold empty.

Class 24: Towels.

Class 26: Shoe laces; hair accessories, namely hair bands, barrettes and hair ties.

Class 27: Yoga mats.

- The EUTM proprietor has proven genuine use for the remaining contested goods; therefore, the application is not successful in this respect.
- 7 On 25 March 2022, the EUTM proprietor filed an appeal against the contested decision, requesting that the decision be partially set aside to the extent that the revocation request was upheld. The statement of grounds of the appeal was received on 30 May 2022.

- 8 In its response received on 5 August 2022, the revocation applicant requested that the appeal be dismissed.
- 9 On 22 August 2022, the EUTM proprietor requested a second round of submissions.
- 10 On 23 August 2022, the Registry of the Boards acknowledged receipt of the request and informed both parties that the request would be dealt with in due time by the Board.
- 11 By a notification dated 8 December 2022, the parties were informed that the request for a second round of submissions was refused by the Board.

Submissions and arguments of the parties

- 12 The arguments raised in the statement of grounds by the EUTM proprietor may be summarised as follows:
 - The Opposition Division erred in its finding that the EUTM proprietor did not show genuine use of the eagle mark for the revoked goods. While the EUTM proprietor agrees with the Office’s findings as regards time, place, nature and extent of use of the eagle mark, the Office erred when finding that the eagle mark was not used for the revoked goods. The substantial evidence submitted by the EUTM proprietor shows the contrary.

Goods in Class 3

- With regard to the revoked goods of Class 3, the Office took the view that the few extracts (pictures, extracts from the EUTM proprietor’s website) are insufficient to show genuine use of the contested goods in this class. Some of the extracts include the eagle logo, the prices are expressed in US dollars indicating that the goods were introduced in the US and not in Europe.



- Only few extracts show the representation of the eagle as follows , however, they are not enough indications that the EUTM proprietor has seriously tried to acquire a commercial position in the relevant market for these goods.
- In light of the substantial evidence submitted by the EUTM proprietor, this understanding is fundamentally incorrect. The eagle mark has been put to genuine use for ‘fragrance; toiletries namely body wash and deodorants’ in Class 3.
- **Exhibit 1** including various printouts from the Wayback Machine of www.ae.com falling within the relevant time frame showing fragrances/body sprays (meaning deodorants) depicting the eagle mark on its packaging, such



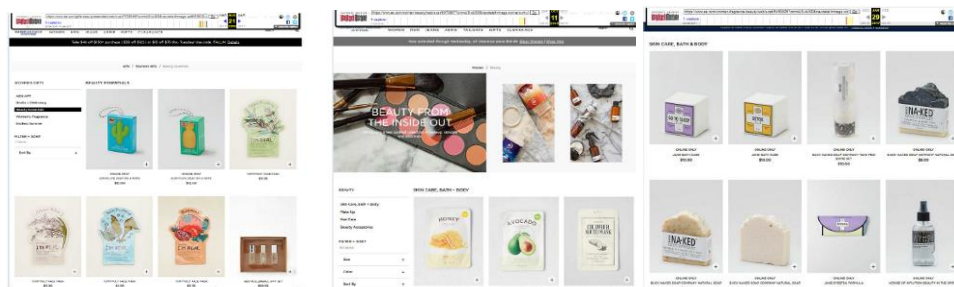
- More importantly not all of these offers indicate prices in USD. Rather, there are various offers showing prices in EUR, such as the below:



- Furthermore, there are examples of fragrances sold under the Eagle mark with prices indicated in GBP:



- **Exhibit AW12** includes printouts from the Wayback Machine, which do not only show various types of fragrances, but also other beauty products (including body wash), which have been offered for sale in the relevant time frame. The relevant parts are provided hereafter:



- Though some of the above products are third part products, these products were sold via www.ae.com, a webpage which was marked with the eagle mark at the time, as exemplified by the screenshot above.
- Furthermore, the First Witness Statement of Mr Alexander Walsh, Corporate Counsel of Intellectual Property and Brand Protection of American Eagle Outfitters, signed on 8 June 2018 and submitted in Opposition division proceedings No B 3 001 974, explicitly confirms that all offers under www.ae.com were available for shipping to the EU and the UK. Therefore, even where the prices were indicated in USD, this does not mean that these products were not also available in the EU/UK during the relevant time frame.

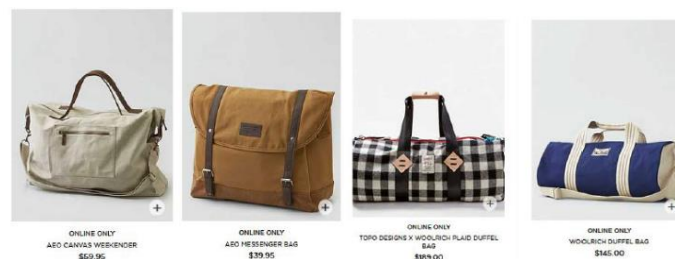
- The EUTM proprietor, of course, did all this to gain a market share in the EU. In light of that, the Office erred in finding that the eagle mark was not used for the revoked goods in Class 3.

Goods in Class 18

- With regard to the revoked goods of Class 18, the Office took a similar view as for the goods of Class 3. Again, this assessment is found to be erroneous since the evidence submitted clearly shows genuine use for all the contested goods, including the revoked goods: *athletic bags, all-purpose athletic bags, duffel bags, all-purpose carrying bags, except handbags and tote bags, drawstring pouches*.
- The EUTM proprietor submitted printouts from the Wayback Machine as **Exhibit 3** and **Exhibit AW13**, which show various types of bags:
- The below is clearly a ‘drawstring pouch’ marketed under the Eagle mark:



- The below shows depictions of ‘athletic bags, all-purpose athletic bags, duffel bags, all-purpose carrying bags’ offered by the EUTM proprietor during the relevant time frame in the EU:



- The Office disregarded this substantial evidence for the use with regard to a variety of the revoked goods in Class 18 and dismissed it as ‘only few extracts’. However, these extracts are far from ‘few’.
- Aside from that, the mere fact that prices were indicated in USD does not mean that the EUTM proprietor did not offer these goods in the EU/UK during the relevant time frame with the aim to acquire a market share. Again, this has to be considered in conjunction with the witness statements of Mr Alexander Walsh submitted in Opposition Division proceedings No B 3 001 974.
- The Office also completely disregarded that all these goods were available to the EU/UK public and that these were clearly sold under the Eagle Mark; even if direct attachment to the product itself is not visible from the evidence provided. That said and as noted at several points throughout the First and Second Witness Statements of Alexander Walsh, the EUTM proprietor’s goods almost always bear labels or swing tags bearing the Eagle mark. Examples of swing tags and labels showing the eagle mark are e.g. provided at Exhibits **AW15**, **AW16**, **AW28**. Use on swing tags/labels would clearly

constitute use of the eagle mark for the revoked goods of Classes 21, 24 and 26.

- Furthermore, the Office disregarded the sales details provided for these goods, e.g. as part of **Confidential Exhibit 7**. Whilst these do not show the eagle mark itself, consumers making purchases via the EUTM proprietor's website were exposed to the eagle mark at the time of placing their orders. As evidenced by the Wayback Machine prints, the eagle mark has featured on the website banners and at various points throughout the site during the relevant period.
- As a result, the eagle mark was wrongfully revoked for most of the goods of Class 18, for which strong evidence of use existed and the Board is kindly requested to remedy this wrong. In particular, the submitted evidence shows genuine use for 'athletic bags, all-purpose athletic bags, duffel bags, all-purpose carrying bags, except handbags and tote bags, drawstring pouches'.

Goods in Classes 21, 24 and 26

- As regards the revoked goods of Classes 21, 24 and 26, the Office applied the same reasoning, namely:
- 'The Cancellation Division considers that only few extracts (pictures, extracts from the EUTM proprietor's website) are insufficient to show genuine use of these goods since it does not provide enough indications that the EUTM proprietor has seriously tried to acquire a commercial position in the relevant market for those goods. Moreover, the extracts do not show those products bearing the contested mark. It follows from the above that the submitted documents, individually or taken together as a whole, do not provide sufficient information about the extent of use of the challenged EUTM in relation to the contested goods in this class.'
- Again, the Office disregarded that all these goods were available to the EU/UK public and that these were clearly sold under the eagle mark and the sales details provided for these goods. In light of that, the Office erred in revoking the eagle mark for these goods.

Overall Assessment

- Furthermore, the Office mistakenly did not take into consideration the further evidence submitted. The Office has to evaluate the evidence submitted in an overall assessment, whereby all the circumstances of the specific case have to be taken into account and all the materials submitted must be assessed in conjunction with each other (see EUIPO Trade mark guidelines, Part C Opposition, Section 6 Proof of Use, 2.2). As a result, even evidence that may be insufficient to prove use by itself to prove may contribute to proving use in combination with other documentation and information. As a result, not just the evidence submitted with regard to the specific goods/services have to be considered, but rather these need to be regarded together with the further evidence submitted.
- For example, the EUTM proprietor submitted the following additional evidence:

- **Exhibit AW7** showing a copy of the BrandZ 2007 Ranking report, compiled by independent market research company Kantar Millward Brown, which lists the American Eagle Outfitters as one of the top global apparel brands:

Apparel						
#	Brand	Parent	Brand Value (\$m)	Brand Contribution	Brand Momentum	Brand Value Change (%)
1	Nike	Nike Inc	10,290	3	6.5	-5%
2	H&M	Hennes & Mauritz	8,711	2	4	9%
3	Zara	Inditex	6,469	3	7	27%
4	Esprit	Esprit Holdings Ltd	5,411	3	5	29%
5	Next	Next Plc	2,888	2	5.5	-6%
6	Ralph Lauren	Polo Ralph Lauren Co.	2,765	3	6	48%
7	Adidas	Adidas Ag	2,748	3	3.5	19%
8	Puma	Puma Ag	1,855	3	4.5	3%
9	Gap	Gap Inc/The	1,831	2	4	-34%
10	American Eagle Outfitters	American Eagle Outfitt.	1,609	2	8.5	43%

- **Exhibit AW9** including web prints of www.aeo.com/eu and www.aeo.com/uk showing that the goods are available for sale in EUR and GBP.
- **Exhibit AW10** showing the extensive list of countries to which products offered via the www.ae.com website can be shipped including 22 EU Member State countries.
- The UK subsidiaries turnover shown on page 10 of **Exhibit AW18**.
- The use of the eagle mark in the context of the Polish stores as contained in **Exhibit AW27**.
- Use of the eagle mark on www.ae.com as depicted in **Exhibit AW21**.
- The impressive number of internet sales of the relevant goods to customers in the EU contained in **Confidential Exhibit AW22**.
- **Confidential Exhibit AW23** showing the EU online sales details of several contested goods.
- Secondary market sales examples as submitted in **Exhibit AW24**.
- Examples of use of the eagle mark in the UK, Greece and Poland as submitted in **Exhibits AW25, AW26 and Confidential AW27**.
- The representative UK retail store sales details as submitted in **Confidential Exhibit AW29**.
- **Confidential Exhibit AW31** setting out substantial online sales figures for products bearing the eagle mark in the UK, sales figures for the fiscal year 2014 in the UK, sales figures for products sold through the AEO websites between 2006 and 2014 to consumer within the EU.
- **Confidential Exhibit AW32** setting out sales figures for 2016 for the Greece stores.
- **Confidential Exhibit AW33** showing sales figures for the Greek and Polish stores.
- **Confidential Exhibit AW34** including a spreadsheet providing details of EU customer orders placed via www.ae.com in 2015.

- **Confidential Exhibit AW35** showing order details of several of the contested goods.
 - **Confidential Exhibit AW36** showing the worldwide advertising spends since 2002.
 - **Exhibit AW37** showing mail shots from 2012 which feature the Eagle mark.
 - Press materials and advertising submitted as **Exhibits AW38 et seq.**
 - **Exhibit AW43** setting out the number of consumer visits to www.ae.com between 2011 and 2015.
 - **Exhibit AW44** details of total website hits in the EU between 2013 and 2018.
 - **Exhibit AW45** including details of the internet web traffic statistics for www.aeo.com
 - **Exhibit AW46** setting out the number of calls received from consumers in the UK and EU to customer service numbers.
 - **Exhibit AW47** showing the eagle mark used in the Mobile App.
 - **Exhibits AW49 and AW50** containing a printout of the EUTM proprietor's Facebook page.
 - **Exhibit AW51** showing screenshots of third-party social media sites used to promote the Eagle mark.
- Yet, when assessing the use for the revoked goods, the Opposition Division appears to have only taken evidence into account relating directly to these goods. This is exemplified by statements such as on page 16 of the contested decision referring to 'only few extracts'. However, since the evidence submitted overall is far from few, the Office appears to have refrained from such an overall assessment.
 - If the Office would have carried out an overall assessment, it would have had to come to the conclusion that the eagle mark was genuinely used for the revoked goods.

Conclusion

- The EUTM proprietor respectfully submits that the Office erred in reaching the conclusion that the eagle mark has not been genuinely used, if not for all, at least for a substantial part of the revoked goods.
 - As a result, the EUTM proprietor requests the Board to uphold the appeal, annul the contested decision, and declare that the Eagle mark remains registered for the revoked goods.
- 13 The arguments raised in reply to the appeal by the revocation applicant may be summarised as follows:

- The appeal is not well founded due to the fact that the contested mark is as



follows:

- It has been pointed out in the proceedings at the Cancellation Division that the actual use showing the eagle alone or the eagle in combination with the dominant element ‘AMERICAN EAGLE OUTFITTERS’ do not create genuine use of the contested mark.

- However, despite this obvious fact, the Cancellation Division took the view:

‘In the present case, the silhouette of a flying eagle and the expression ‘AMERICAN EAGLE OUTFITTERS’ are clearly recognised as independent elements. The eagle appears on its own or above the elements ‘AMERICAN EAGLE OUTFITTERS’. Therefore, they will be seen as two independent trade marks. In addition, the omission of the circle and arrow element, which is merely decorative with less distinctive character, does not alter the distinctive character of the mark as registered.’

- These findings are not in line with European trade mark law.
- Firstly, the term ‘AMERICAN EAGLE OUTFITTERS’ cannot be separated from the device of an eagle. The word ‘EAGLE’ and the eagle picture are inseparably connected with each other. Therefore, it is not permissible to



artificially dissect the combination

- It might be correct that there are other trade marks in which the figurative element and the word element do not have such a connection like it is the case with ‘Nike’ and the Swoosh or Adidas and the trefoil-logo. However, in the case at hand, the situation is different as the figurative element and the word part are clearly connected.
- Secondly, it is untrue that the omission of the circle and arrow element does not alter the distinctive character. Obviously, this element is not decorative. The arrows in a circle are very distinctive themselves. Looking at the whole, it is dominating the trade mark.
- Even if it is not dominating, it is interacting with the figurative element: the eagle is not free but is surrounded by circles. This is creating an impression of coverage. This impression is very different compared to the eagle alone which can freely fly. Therefore, as the documents submitted do only show the eagle alone or in combination with ‘AMERICAN EAGLE OUTFITTERS’, there is no use of the trade mark as registered.
- With respect to the documents already submitted, the revocation applicant agrees with the findings of the Cancellation Division. They were not sufficient in order to create genuine use of the goods as far as the trade mark has been cancelled. Again, the pictures displayed, for example on pages 7 and 8, are pictures in which the products are offered in USD.
- In this respect, it once again must be clarified that the fact that the goods are offered in the US and might have been available to the public outside the US

is not sufficient in order to create genuine use outside the US. It is standard practice that if goods are offered in web shops, this, first of all, only creates use of the sign in the country in which the web shop is domiciled. The fact that the web shop can be visited from all over the world does not create use of the trade mark all over the world.

- The ECJ held that it would be an infringement of the principles of free movement of services if an offer on the internet must be assessed on the basis of the regulations which are in force in every country in which the website can be visited (06/11/2003, C-243/01, ECLI:EU:C:2003:597, § 54). This, however, also means that the availability of a website only does not create genuine use.
- Therefore, the arguments in the grounds of appeal are not convincing.
- The revocation applicant therefore requests the Board to dismiss the appeal and uphold the contested decision.

Reasons

- 14 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 15 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

Scope of the appeal

- 16 The EUTM proprietor challenged the contested decision with respect to the use of the mark by third parties and the use in relation with its essential function for the contested goods, namely:

Class 3: *Fragrance; toiletries namely body wash and deodorants.*

Class 18: *Athletic bags, all-purpose athletic bags, duffel bags, all-purpose carrying bags, except handbags and tote bags, drawstring pouches.*

Class 21: *Water bottles sold empty.*

Class 24: *Towels.*

Class 26: *Shoe laces; hair accessories, namely hair bands, barrettes and hair ties.*

Class 27: *Yoga mats.*

- 17 In its observations in reply to the statement of grounds, the revocation applicant contests the findings of the Cancellation Division with respect to the alteration of the distinctive character of the contested mark and considers that the actual use showing the eagle alone or the eagle in combination with the dominant element ‘AMERICAN EAGLE OUTFITTERS’ do not create genuine use of the contested mark.
- 18 The revocation applicant focuses on its response to the statement of grounds on the examination of the proof of use and the nature of use of the contested sign. Explicitly, the revocation applicant does not contest the outcome of the contested decision. The revocation applicant is the partially winning party in the cancellation

proceedings and did not contest it to the extent to which the cancellation application was refused. Therefore, no cross-appeal was filed.

- 19 Thus, for the goods for which the contested sign is considered genuinely used by the Cancellation Division, as listed in paragraph 6 above, the contested decision is final.

Article 58 (1)(a) EUTMR

- 20 Pursuant to Article 58(1)(a) EUTMR, the rights of the proprietor of the EU trade mark shall be declared revoked on application to the Office, if, within a continuous five-year period, the trade mark has not been put to genuine use in the Union in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use; however, no person may claim that the proprietor's rights in an EU trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application, genuine use of the trade mark has been started or resumed; the commencement or resumption of use within a period of three months preceding the filing of the application which began at the earliest on expiry of the continuous period of five years of non-use shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application may be filed.
- 21 According to Article 19(1) EUTMDR if the proprietor of the EU trade mark does not provide proof of genuine use of the contested EUTM within the time-limit set by the Office, the EU trade mark shall be revoked.

Use of the mark by licensed/authorised third parties

- 22 According to Article 18(2) EUTMR, which is sufficiently clear on this matter, use of the mark with the consent of the proprietor is deemed to constitute use by the proprietor. This means that the owner must have given its consent prior to the use of the mark by the third party. Acceptance later is insufficient.
- 23 At the evidence stage it is prima facie sufficient that the opponent only submits evidence that a third party has used the mark. The Office infers from such use, combined with the opponent's ability to present evidence of it, that the opponent has given prior consent (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 25; further confirmed 11/05/2006, C-416/04 P, Vitafruit, EU:C:2006:310).
- 24 Consequently, the evidence filed by the EUTM proprietor (such as the Witness Statement of Mr Alexander Walsh, Corporate Counsel of Intellectual Property and Brand Protection of American Eagle Outfitters, a parent company of the EUTM proprietor, provided as Exhibit Annex 1 in Opposition Division proceedings No B 3 001 974) is an indication that the use was with its consent.
- 25 To this extent, and in accordance with Article 18(2) EUTMR, the Cancellation Division correctly considered that the use by those other companies was with the EUTM proprietor's consent and, therefore, is equivalent to use by the EUTM proprietor itself.

Probative value of the First Witness Statement and Second Witness Statement of Mr Alexander Walsh, Corporate Counsel of Intellectual Property and Brand

Protection of American Eagle Outfitters dated on 8 June 2018 and 13 December 2018

- 26 Article 97(1)(f) EUTMR lists, as means of giving evidence, ‘statements in writing sworn or affirmed or having a similar effect under the law of the State in which the statement is drawn up’ among the means of evidence that can be submitted before the Office. No definition or explanation is given on what might be their probative value and what could be the criteria for its assessment. As with any other piece of written evidence, affidavits are subject to the rules set up by Article 55 EUTMR.
- 27 Affidavits, as any other piece of evidence, are subject to the principle of free evaluation of their evidential value.
- 28 The General Court underlined that ‘irrespective of the position under national law, the evidential value of an affidavit has to be assessed freely’ as there is nothing in the relevant regulations to support the conclusion that the evidential value of items of evidence of the use of the mark, including affirmations, must be assessed in the light of the national law of a Member State (28/03/2012, T-214/08, Outburst, EU:T:2012:161, § 33).
- 29 In order to assess the evidential value of a document, regard should be had first and foremost to the credibility of the account it contains. Regard should be had in particular to the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on its face, the document appears sound and reliable (28/03/2012, T-214/08, Outburst, EU:T:2012:161, § 34; 07/06/2005, T-303/03, Salvita, EU:T:2005:200, § 42). For example, statements including detailed and concrete information have a higher probative value than very general and abstractly-drafted declarations.
- 30 It is true that usually the content of an affidavit must be corroborated by other evidence. However, there are instances, albeit rare, whereby the affidavit has been used to further clarify or explain the main evidence filed, such as for instance the information (e.g. order/product numbers etc., which relate to the mark at issue) provided by the EUTM proprietor.
- 31 In the Witness Statement Mr Alexander Wash declares the following:

The Opponent's brand targets male and female consumers primarily between the ages of 15 and 25. The Opponent has achieved significant commercial success in the UK and throughout the EU after starting to sell its products there in 2004 via its website www.ae.com and in 2014 via its UK stores. The Opponent also has stores located in Greece, the first of which opened in Fall 2015, and Poland, which opened in 2012.

Attached at **Exhibit AW10** are printouts from the Wayback Machine web archive (www.web.archive.org) (“the Wayback Machine”), dated between 2011 – 2017 showing the list of countries to which products offered via the www.ae.com website can be shipped. The list of countries includes the UK and Greece (where the Opponent and its licensed partner operate, or have operated, physical stores), as well as Austria,

Belgium, Bulgaria, Croatia, Czech Republic, Denmark, Finland, France, Germany, Hungary, Ireland, Italy, Luxembourg, the Netherlands, Poland, Portugal, Romania, Slovenia, Spain, Sweden.

- 32 The General Court stated that ‘the content of the sworn declarations made by the sales manager of the opponent’s company contained ‘precise particulars as to the volumes of sales of shoes bearing the [earlier trade mark] and as to the turnover generated by such sales’ to establish the extent of use of the trade mark, which was also corroborated by the brochures submitted by the opponent. Moreover, given the particular plausible circumstances of the case, it was stated that it was not possible for the party to bring any other piece of evidence (such as invoices)’. The evidence submitted was thus considered to be sufficient to prove the genuine use of the earlier rights (16/12/2008, T-86/07, Deitech, EU:T:2008:577).
- 33 In the round of submissions, such witness statements are a functional input to the ‘overall assessment’ of all the material submitted as evidence on appeal or at first instance and facilitate the appraisal and comprehension of the various pieces of evidence, as well as supplementing the information the latter contains (28/03/2012, T-214/08, Outburst, EU:T:2012:161, § 30, 34).
- 34 As regards, the probative value of the Witness Statement dated 8 June 2018 provided by the EUTM proprietor, it must be taken into account that it has been made by the Corporate Counsel of the EUTM proprietors parent company. Statements drawn up by the interested parties themselves or their employees are generally given less weight than independent evidence and must be supported by other evidence (11/12/2014, T-498/13, la nana, EU:T:2014:674, § 32). That does not mean however, that the affidavit in question must be disregarded or dismissed as unreliable. Therefore, it is necessary to examine in line with the existing jurisprudence, whether the statements mentioned in the affidavit are corroborated by other evidence (13/06/2012, T-312/11, Ceratix, EU:T:2012:296, § 30).

Assessment of the evidence of use

- 35 Pursuant to Article 19(1) EUTMDR in conjunction with Article 10(3) EUTMDR, the indications of evidence of use shall establish the place, time, extent and nature of use of the contested EUTM for the goods and services in respect of which it is registered. Thus, the sufficiency of the indications and proof as to the place, time, extent and nature of use has to be considered in view of the entirety of the evidence submitted the present case, the EUTM proprietor only challenges the contested decision’s findings regarding the nature of use of the mark at issue with respect to the goods within the scope of the appeal, listed above in paragraph 16.
- 36 The evidence must show genuine use of the European Union trade mark within the relevant period preceding the date of the revocation request, that is, from 18 June 2014 to 17 June 2019 inclusive.

Time and place of use





- 37 As correctly stated by the Cancellation Division, although some documents are not dated (i.e. exhibit AW8 and attachment AW15) or are dated outside of the relevant period (i.e. exhibit AW9 and attachment AW7), it must be noted that the majority of the extracts from the Wayback Machine (exhibits AW1-4), some online sale figures (exhibit AW7) and the articles and reports inserted in several publications (attachments AW17 and AW20), provide sufficient indications as to the use of the contested mark during the relevant time period, namely, from 18 June 2014 to 17 June 2019 inclusive.

- 38 With respect to the place of use, as stated by the Cancellation Division the EUTM proprietor has submitted, inter alia, evidence relating to the United Kingdom (UK) with a view to demonstrating use of the contested mark. All that evidence relates to a period prior to 1 January 2021 and should be taken into account.
- 39 The extracts are showing the market sales in several markets of the EU and numerous Member States such as Austria, Belgium, Croatia, the Czech Republic, Denmark, Finland, Ireland, Italy, Luxembourg, the Netherlands, Poland, Spain, Sweden, Greece, Hungary, Germany and the United Kingdom (Exhibit 7)). Moreover, the orders show that American Eagle Outfitters products were shipped to various EU countries such as Belgium, Bulgaria, France, Spain, Sweden, Austria and the Czech Republic and the amounts are in euros or in their local currency (Exhibit 9 and attachment AW35).
- 40 Moreover, extracts and marketing initiatives have been provided in different languages showing the mark in several EU countries (Poland, Greece and the UK).
- 41 The evidence provided shows that the contested mark has been exposed to customers in several countries within the European Union. The geographical area shown is sufficient to prove the territorial extent of use of the contested mark within the European Union.

Nature of use

- 42 With respect to the nature of use, the term ‘nature of use’ refers to (i) use of a mark in accordance with its essential function, (ii) use of the mark as registered or of a variation thereof in accordance with Article 18(1)(a) EUTMR and (iii) use in connection with the goods and services for which it is registered

Nature of use: use as a trade mark

- 43 The majority of the documents shows that the signs , , , or  are used in connection with certain goods to indicate the commercial origin and therefore it is used as a trade mark. Consequently, the consumers can distinguish the goods from those of different manufacturers, as correctly stated by the Cancellation Division.

Nature of use: use of the mark as registered

- 44 The figurative sign appears together with the verbal elements ‘AMERICAN EAGLE OUTFITTERS’. These verbal elements are distinctive.
- 45 However, as stated by the Cancellation Division, there is no legal precept in the European Union trade mark system that obliges the proprietor to provide evidence of the mark alone when genuine use is required. Two or more trade marks may be used together in an autonomous way, or with the company name, without altering the distinctive character of the earlier registered trade mark (T-463/12, MB, EU:T:2014:935, § 43) as in the present case, where the silhouette of the eagle has a clearly independent position is placed on a different row and would be clearly perceived by the relevant consumer.

- 46 The Court has confirmed that the condition of genuine use of a registered trade mark may be satisfied both where it has been used as part of another composite mark or where it is used in conjunction with another mark, even if the combination of marks is itself registered as a trade mark (18/04/2013, C-12/12, Colloseum Holding, EU:C:2013:253, § 36.). Similarly, the Court has clarified that use can be genuine where a figurative mark is used in conjunction with a word mark superimposed over it, even if the combination of those two marks is itself registered, to the extent that the differences between the form in which that trade mark is used and that in which it was registered do not change the distinctive character of that trade mark as registered (18/07/2013, C-252/12, Specsavers, EU:C:2013:497, § 31).
- 47 The additional omission of the circular logo depicted as arrows is not capable of altering the distinctive character of the contested mark neither. Where the omitted element is non-distinctive, the distinctive character of the mark as registered will not be altered. The distinctive character of the contested mark is essentially derived from the silhouette of an eagle and not from the arrows around it forming a circle. The eagle silhouette is highly distinctive and occupies an important central position in the overall impression created by the mark as registered, while the arrows have lower degree of distinctive character and occupy an ancillary position.
- 48 Therefore, the evidence submitted shows use of the mark as registered or in a form essentially the same as that registered and, therefore, such use constitutes use of the contested registration under Article 18 EUTMR contrary to the revocation applicant 's claim. Therefore, the nature of use requirement has been fulfilled in relation to some of the contested goods.

Extent of use

- 49 As to the extent of the use to which the contested mark has been put, account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use. Furthermore, to examine whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa (08/07/2004, T-203/02, VITAFRUIT, EU:T:2004:225, § 41- 42).
- 50 Furthermore, the turnover and the volume of sales of the goods under the contested mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the goods or services on the relevant market. As a result, use of the contested mark need not always be quantitatively significant in order to be deemed genuine. Even minimal use can therefore be sufficient to be classified as genuine, provided that it is 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. It follows that it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not, with the result that a *de minimis* rule, which would not allow the Board, to appraise all the circumstances of the dispute before it,

cannot be laid down (07/07/2016, T-431/15, FRUIT, EU:T:2016:395, § 26 and the case-law cited).

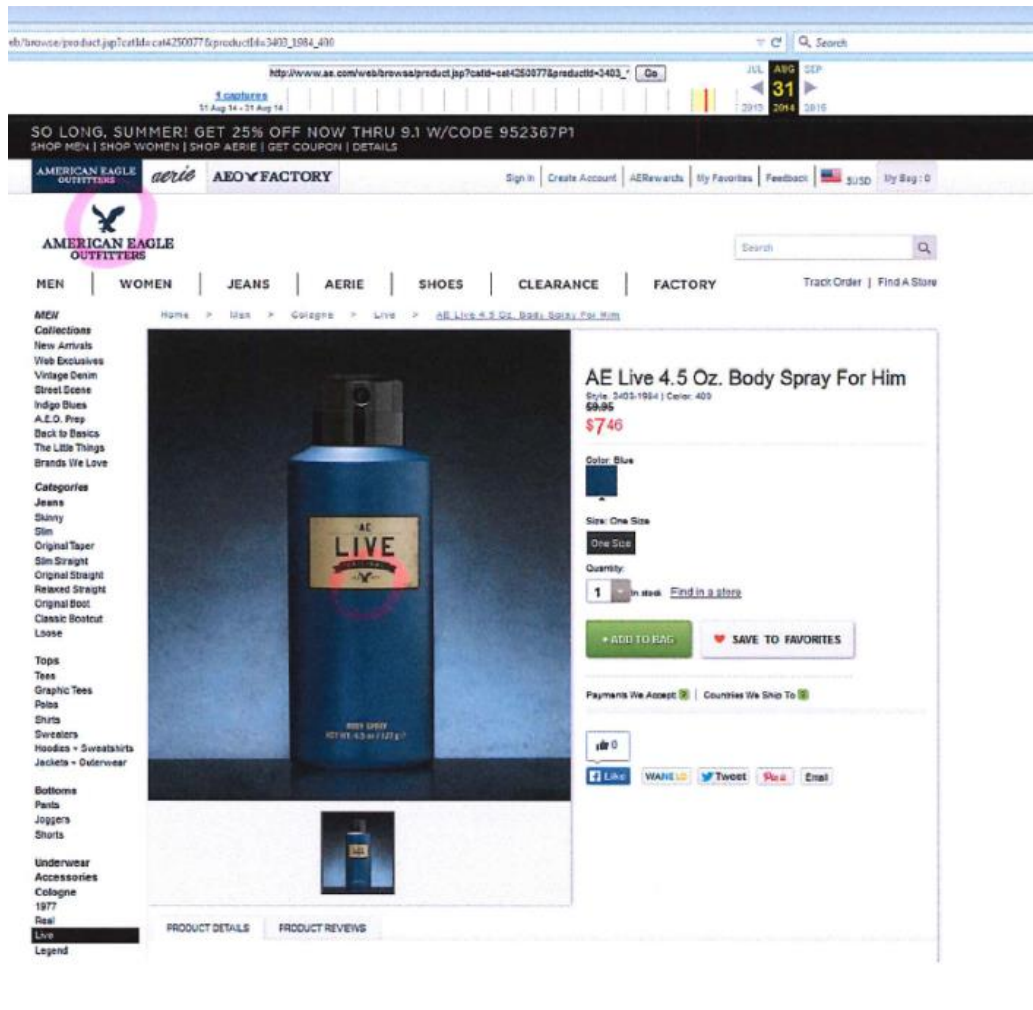
- 51 In interpreting the concept of genuine use, account must be taken of the fact that the *ratio legis* of the requirement that the contested mark must have been put to genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (13/10/2021, T-1/20, INSTINCT, EU:T:2021:695, § 33; 07/07/2016, T-431/15, FRUIT, EU:T:2016:395, § 27).
- 52 However, the smaller the commercial volume of the use of the mark, the more necessary it is for the proprietor of the mark to produce additional evidence to dispel any doubts as to the genuineness of its use (13/10/2021, T-1/20, INSTINCT, EU:T:2021:695, § 35 and § 64; 07/07/2016, T-431/15, FRUIT, EU:T:2016:395, § 28).
- 53 In that regard, the assessment of the extent of use should not rest exclusively on the amount of sales specifically indicated in the invoices. The invoices also give indications indirectly about use of the mark at issue. For instance, the fact that the orders submitted in Exhibit 9 do not bear consecutive numbers, and are mainly dated from different months, leads to the conclusion that the intervener has only filed evidence corresponding to examples of sales. Nevertheless, the fact that these orders are made by various retailers in different Member States shows that the extent of use is sufficiently widespread to amount to a real and serious commercial effort, and that it is not a mere attempt to simulate genuine use by always using the same distribution channels (16/11/2011, T-308/06, Buffalo Milke, EU:T:2011:675, § 71).
- 54 A *de minimis* rule cannot be laid down. Use of the mark by a single client, which imports the products for which the mark is registered, can be sufficient to demonstrate that such use is genuine if it appears that the import operation has a genuine commercial justification for the proprietor of the mark (27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50, § 24 et seq.)
- 55 For the sake of clarity, the Board will analyse the provided evidence for each class of goods within the scope of the present appeal separately.
- 56 Further, as a preliminary remark it should be noted that as correctly stated by the revocation applicant that the fact that a web site can be visited from all over the world does not create use of the trade mark per se is true. Such accessibility should be corroborated by other evidence such as for example invoices, order, volume of sales etc.

Class 3: Fragrance; toiletries namely body wash and deodorants

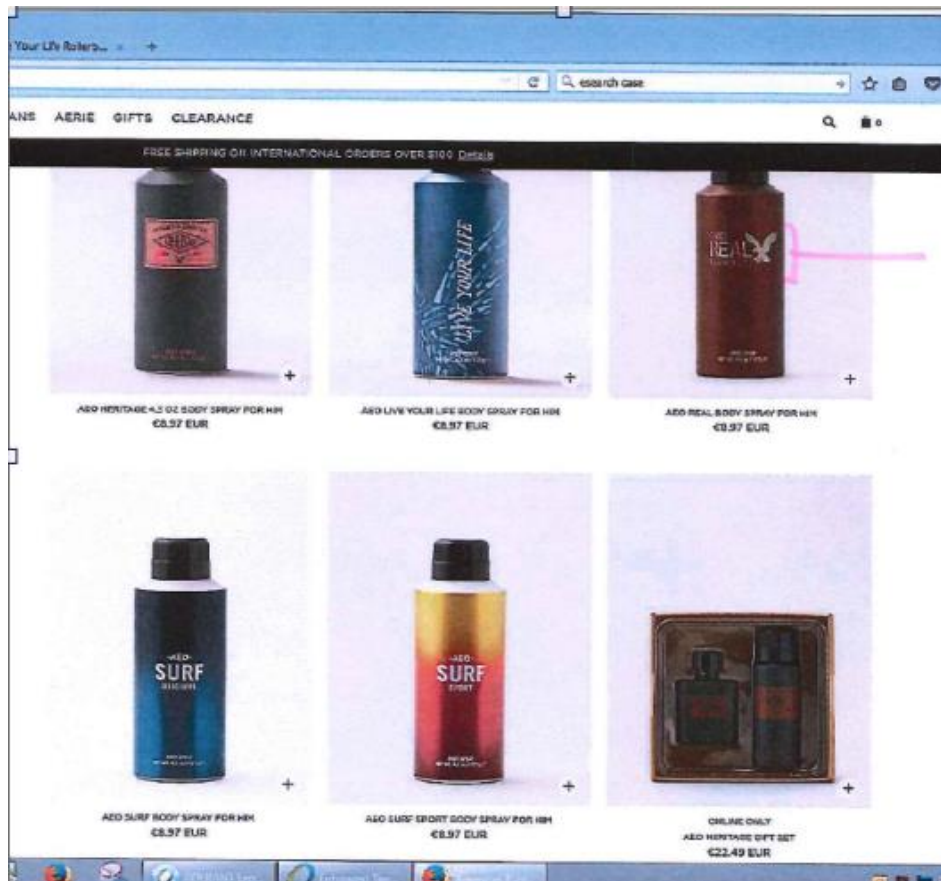
- 57 The EUTM proprietor states that various printouts from the Wayback Machine of www.ae.com falling within the relevant time frame showing fragrances/body sprays (meaning deodorants) depicting the eagle mark on its packaging, such as:



- 58 In addition, **Exhibit AW12** includes printouts from the Wayback Machine, which do not only show various types of fragrances, but also other beauty products (including body wash), which have been offered for sale in the relevant time frame.
- 59 The Cancellation Division concluded that the prices are expressed in US dollars, clearly indicating that the goods were introduced for sales in the USA and not in Europe. Even if it is true that the currency is not a clear indication that the products offered by the EUTM proprietor are not sold in Europe, the EUTM proprietor needs strong evidence to show that it attempts to obtain a market share in the European Union.
- 60 Having analysed the evidence pointed to by the EUTM proprietor, these indeed consist of only few depictions, particularly, considering the plethora of evidence submitted by the EUTM proprietor, although some prices are in EUR or GBP. However, it remains unclear whether there was any sale that was more than insignificant.
- 61 The depiction of a ‘body spray for him’, includes the ‘Eagle’ logo; offered for sale on the US site of the www.ae.com website, i.e. for the USA market, however as stated in the First Witness Statement of Alexander Wash, dated 8 June 2018, the products offered at that website were shipped to various EU countries (see paragraph 31 above) (Exhibit 1, p. 2):



- 62 As stated by the EUTM proprietor some evidence shows body sprays in EUR and perfumes in GPB:

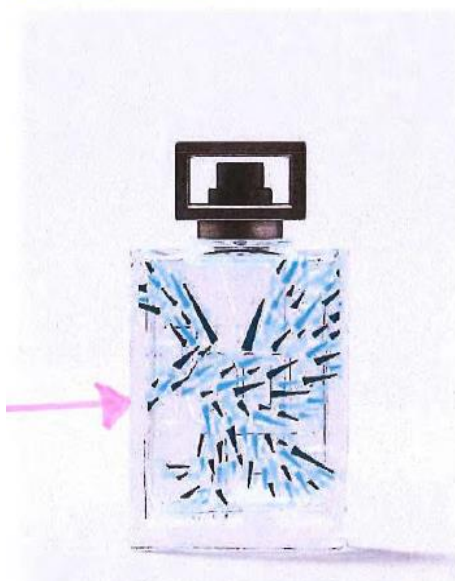


 (<http://www.ae.com/cart?cm=sGB&cGBP>)

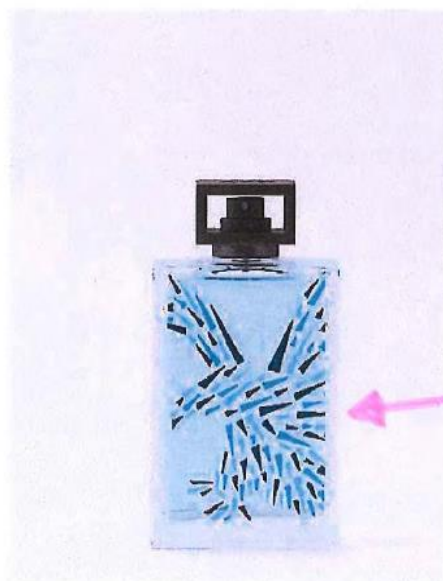
Filter + Sort

3 items

LIVE YOUR LIFE Fresh Citrus, Exhilarating Spices and Sandalwood.



AEO LIVE YOUR LIFE 1.7 OZ COLOGNE FOR HIM
30.56 GBP



AEO LIVE YOUR LIFE 3.4 OZ COLOGNE FOR HIM
38.21 GBP

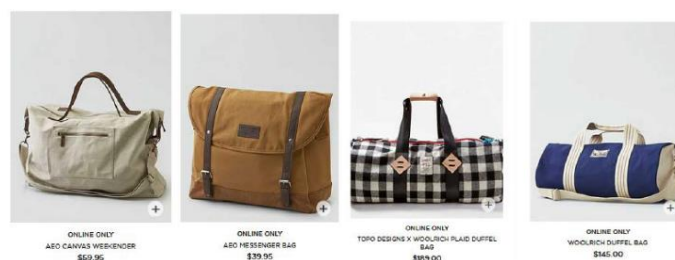
- 63 As clearly indicated in Article 10(4) EUTMDR, it is not necessary for the mark to be affixed to the goods themselves (12/12/2014, T-105/13 TrinkFix, EU:T:2014:1070, § 28-38). A representation of the mark on packaging, catalogues, advertising material or even a website relating to the goods and in question constitutes direct evidence that the mark has been put to genuine use.
- 64 Nevertheless, there are no indications with respect to the sales volume for these goods within the relevant period. It is true that some goods in Class 3 are listed in the sales reports (Exhibit 7) such as:

2017	Jul 7, 2017 Austria	6124520487	24833782 10OZ BODY LOTION	822 AERIE BODY LOTION
2017	Jul 7, 2017 Austria	6124520487	24828907 EXFOLIATING WASH	824 AERIE BODY WASH

- 65 These products differ from the ones for which extracts of EUTM proprietor's website are provided and are not more than two items sold for the whole relevant period.
- 66 Consequently, the assessment does not entail a degree of interdependence between the factors taken into account. Even considering the fact that the main business activity of the EUTM proprietor is the sale of clothing items and the degree of diversification of the activities of undertakings operating in one and the same market varies, the EUTM proprietor did not show even a minimal share of sales for the respective goods in Class 3 (08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 49)
- 67 Thus, the use of the contested marks for the contested goods in Class 3 is not corroborated by the further evidence provided in order to provide a clear picture of a sufficient extent of use. The mere availability on the EU market is not sufficient to prove the genuine use of the goods.

Class 18: Athletic bags, all-purpose athletic bags, duffel bags, all-purpose carrying bags, except handbags and tote bags, drawstring pouches

- 68 The EUTM proprietor argues that the evidence shows depictions of 'athletic bags, all-purpose athletic bags, duffel bags, all-purpose carrying bags' offered by the EUTM proprietor during the relevant time frame in the EU and that the Cancellation Division disregarded this evidence and dismissed it as 'only few extracts':



- 69 However, these bags are sold under the mark 'WOOLRICH':



It is not unusual for a website where a certain brand is advertised to be sold also for products of others to be sold and the EUTM proprietor admits itself that the soaps and face masks shown on its webpage are third party products with the Eagle mark featuring on the website header (page 5 of the EUTM proprietor's reply dated 7 November 2019).

70 Further, the first two examples given by the EUTM proprietor



are named 'weekender' and 'messenger' bag. Such bags fall under the category of goods for which genuine use was already shown:

Class 18: All-purpose carrying bags, namely hand bags and tote bags

71 A tote bag is a large bag with parallel handles that emerge from the sides of its pouch.

72 Therefore, the bags shown by the EUTM proprietor do not fall into the category of *other bags, namely athletic bags, duffel bags, all-purpose carrying bags, except handbags and tote bags, drawstring pouches*.

73 Further the EUTM proprietor states that the following extract shows a 'drawstring



pouch'. However, this firstly is not an item for sale and secondly a drawstring pouch is a small, lightweight bag that is adjustable with two strings from both sides, which is not pictured in the respective example given by the EUTM proprietor.

74 It follows that the Cancellation Division correctly concluded that amongst the plethora of evidence there was insufficient indications of use of the 'Eagle' mark for any of the *athletic bags, all-purpose athletic bags, duffel bags; all-purpose carrying bags, except handbags and tote bags, and drawstring pouches*.

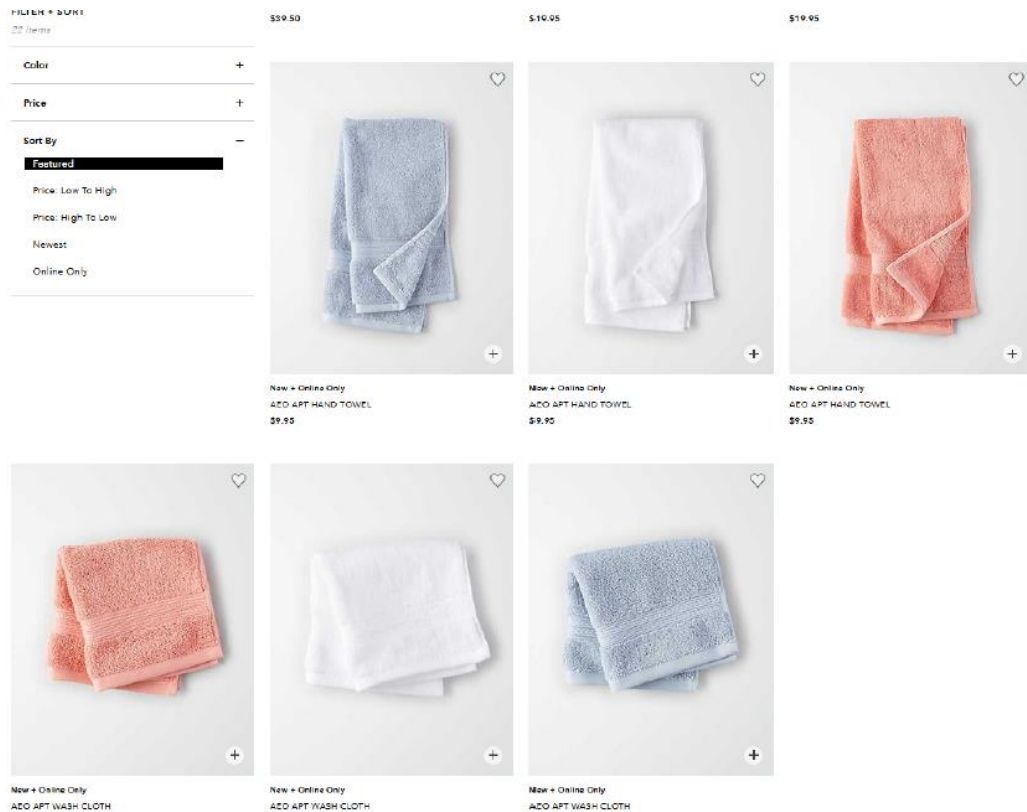
Class 21: Water bottles sold empty

75 The Cancellation Division correctly found that the extracts do not show these products bearing the contested mark. Even if this is not a decisive factor, as stated

above it is not necessary for the mark to be affixed to the goods themselves (12/12/2014, T-105/13 TrinkFix, EU:T:2014:1070, § 28-38). No such goods are listed neither in the sales reports in Class 7 nor in the order details in Exhibit 9. Therefore, the submitted documents, individually or taken together as a whole, do not provide sufficient information about the extent of use of the challenged EUTM in relation to the contested goods in this class. The evidence does not provide enough indications that the EUTM proprietor has seriously tried to acquire a commercial position in the relevant market for these goods.

Class 24: Towels

- 76 There were only few extracts (pictures, extracts from the EUTM proprietor's website) showing these goods, such as:



- 77 Further, items such as 'hand towel, bath towel or wash cloth' are neither listed in the online sales reports in the EU provided in Exhibit 7 nor in the order details in Exhibit 9. As mentioned by the EUTM proprietor, Exhibit 7 lists several sales of 'beach towels' in several countries such as Belgium, France, Sweden, Germany and the United Kingdom. However, no link is provided between 'beach towels' and any of the items shown in the extracts of the EUTM proprietor website.
- 78 The extracts in relation to 'hand towel, bath towel or wash cloth' are not collaborated by any other evidence, and they do not provide enough indications that the EUTM proprietor has seriously tried to acquire a commercial position in the relevant market for these goods. Thus, there is insufficient evidence with respect to the extent of use for these goods.

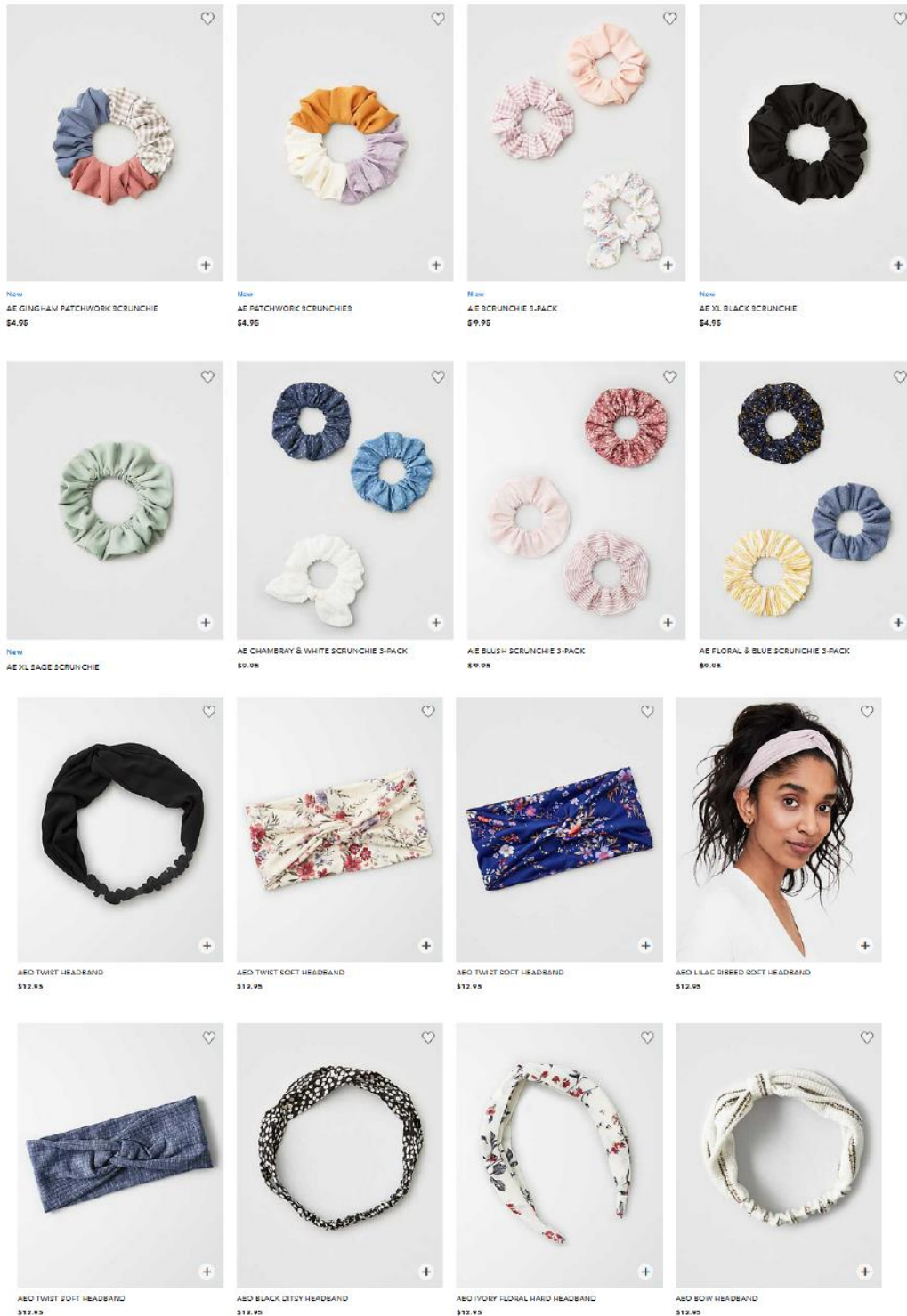
Class 26: Shoe laces; hair accessories, namely hair bands, barrettes and hair ties

- 79 No evidence is provided with respect to *shoe laces* in Class 26.

80 However, contrary to the findings of the Cancellation Division, the EUTM proprietor provided sufficient evidence for *hair accessories, namely hair bands, barrettes and hair ties*.

81 Firstly, the items are depicted in Exhibit 6 provided by the EUTM proprietor, such as:

Hair Accessories



82 Secondly, in the sales reports in Exhibit 7 head accessories are sold in the majority of EU countries, such as Belgium, Croatia, the Czech Republic, Denmark, Finland,

Ireland, Italy, Greece, Luxembourg, the Netherlands, Poland, Spain, Sweden and the United Kingdom during the whole relevant period.

- 83 As stated above and as clearly indicated in Article 10(4) EUTMDR, it is not necessary for the mark to be affixed to the goods themselves (12/12/2014, T-105/13 *TrinkFix*, EU:T:2014:1070, § 28-38). Neither is the currency *per se* determinative factor for the targeting of the EU public.
- 84 Consequently, even if the sales volume is significantly low in comparison with the other goods sold, the assessment entails a degree of interdependence between the factors taken into account, namely that the sales reports are clearly illustrative samples covering the whole relevant period to majority of EU countries. Moreover, the obligation to produce evidence of genuine use of an earlier trade mark is not designed to monitor the commercial strategy of an undertaking. It may be economically and objectively justified for an undertaking to market a product or a range of products even if their share in the annual turnover of the undertaking in question is minimal (08/07/2004, T-334/01, *Hipoviton*, EU:T:2004:223, § 49).

Class 27: Yoga mats

- 85 There is no evidence whatsoever that demonstrates genuine use of the contested mark for these goods in Class 27 and the EUTM proprietor did not provide any arguments in this respect.
- 86 As regards the arguments of the EUTM proprietor that the Cancellation Division did not assess the evidence overall to consider the genuine use of the above goods, it should be noted that genuine use of a trade mark in the sense of Article 58(1)(a) EUTMR in conjunction with Article 18 EUTMR, must be understood to denote real use that is not merely token, serving solely to preserve the rights conferred by the mark (fictitious use).
- 87 Pursuant to Article 58(2) EUTMR where the grounds for revocation of rights exist in respect of only some of the goods or services for which the trade mark is registered, the rights of the proprietor shall be declared revoked in respect of those goods or services only. If, alongside the broad generic term, the trade mark also explicitly claims specific goods covered by the generic term, it must also have been used for these specific goods in order to remain registered for them (02/12/2008, R 1295/2007-4, *LOTUS*, § 25).
- 88 The principle of interdependence applies, meaning that weak evidence with regard to one relevant factor (e.g. low sales volume) might be compensated by solid evidence with regard to another factor (e.g. continuous use over a long period of time).
- 89 The overall assessment of the documents provided does not exclude the burden of proof of the proprietor to provide evidence for each good separately in order to be clear that the contested mark is genuinely used for it.
- 90 In light of the foregoing submissions, contrary to the findings of the Cancellation Division, the EUTM proprietor submitted sufficient evidence with respect to the extent of use for the following goods in Class 26: *Hair accessories, namely hair bands, barrettes and hair ties*.
- 91 Consequently, the appeal is partially well founded, and the contested decision is partially annulled.

Costs

- 92 Pursuant to Article 109(3) EUTMR, where each party succeeds on some and fails on other heads, the Boards of Appeal shall decide a different apportionment of costs. As the appeal is successful in part, it is appropriate to order that each party bears its own costs in the appeal proceedings.
- 93 As to the costs of the cancellation proceedings, it is appropriate that, for the same reasons, each party bears its own costs there as well.

Order

On those grounds,

THE BOARD

hereby:

- 1. Partially upholds the appeal and annuls the contested decision to the extent that the EUTM was declared revoked for the following goods:
*Class 26: Hair accessories, namely hair bands, barrettes and hair ties.***
- 2. Rejects the application for revocation of the contested EUTM registration for the above goods.**
- 3. Dismisses the appeal in respect of the remainder.**
- 4. Orders the parties to bear their own costs in the invalidity and appeal proceedings.**

Signed

V. Melgar

Signed

P. Von Kapff

Signed

S. Rizzo

Registrar:

Signed

H. Dijkema

