



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

The Boards of Appeal
The Registry

R420a

Alicante, 07/10/2015
R0352/2015-1

BOULT WADE TENNANT
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REINO UNIDO

Subject: Appeal No. R0352/2015-1 LAMBRETTA
Your ref.: EJP/CW/T115065EM00

Notification of a decision of the Boards of Appeal

Please find enclosed the decision of the First Board of Appeal dated 23/09/2015 concerning the appeal R0352/2015-1.

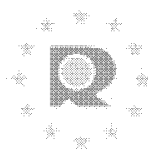
Article 65 CTMR provides that an action may be brought before the General Court against decisions of the Boards of Appeal. The action shall be brought within two months from the date of notification of the decision of the Board of Appeal.

Please be informed that the texts governing the procedure before the General Court, in particular the Rules of Procedure and the Decision on the lodging and service of procedural documents by electronic means (e-Curia) may be consulted on the Curia web site at http://curia.europa.eu/jcms/jcms/Jo2_7040/.

To the extent that you are adversely affected by the attached decision and you nonetheless decide not to challenge it, please inform us accordingly as soon as possible.

Elisabeth MATTHIAS RAMON
Registry

Enc.: 1 (14 pages)



OFFICE FOR HARMONIZATION IN THE INTERNAL
MARKET
(TRADE MARKS AND DESIGNS)
The Boards of Appeal

DECISION
of the First Board of Appeal
23 September 2015

In Case R 352/2015-1

Scooters India Limited

Post Bag No 23
Sarojini Nagar
Lucknow 226 008
India

CTM Proprietor / Appellant

represented by BOULT WADE TENNANT, Verulam Gardens 70 Gray's Inn Road,
London WC1X 8BT, United Kingdom

v

Brandconcern BV

Goudstraat 99
NL-2718 RD Zoetermeer
Netherlands

Revocation Applicant / Respondent

represented by Walter Scheffrahn, Herengracht 23, NL-1015 BA Amsterdam,
Netherlands

APPEAL relating to Cancellation Proceedings No 2 555 C (Community trade mark
registration No 1 618 982)

THE FIRST BOARD OF APPEAL

composed of Th. M. Margellos (Chairperson), Ph. von Kapff (Rapporteur) and
C. Rusconi (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 19 April 2000, Scooters India Limited ('the CTM proprietor') sought to register the word mark

LAMBRETTA

for the following list of goods:

Class 6 – Badges and signs of metal, metal rods, bars, tubes and pipes; non-electric cables and wires; non-electric cables and wires of common metal; iron mongery, small items of metal hardware; nuts and bolts; screws, shims, washers and rivets; metal boxes and containers; fuel tanks; locks, padlocks and keys; chains, safety chains; springs;

Class 7 – Engines; alternators; ball and roller bearings; dynamos, brake linings and shoes; carburettors; catalytic converters; clutches, control cables; crank cases, crank shafts and cranks; cylinders and cylinder heads, dynamos and generators; sparking plugs and glow plugs; vehicle jacks; lubricators; magnetos; pistons, cylinders; cylinder heads; connecting rods; speed governors; springs; starters for motors and engines;

Class 28 – Games and playthings; gymnastic and sporting articles not included in other classes.

- 2 The application was published in the Community Trade Marks Bulletin No 008/2001 of 15 January 2001 and the mark was registered on 11 September 2001.
- 3 On 19 November 2007 Brandconcern BV ('the revocation applicant') filed a request for revocation in respect of all the goods covered by the trade mark claiming that there had been no genuine use of that mark within a continuous five-year period. The grounds for revocation were those laid down in Article 51(1)(a) CTMR.
- 4 After an extension of the deadline, the CTM proprietor submitted its observations and proof of use on 29 April 2008 in reply to the request for revocation of its trade mark. The CTM proprietor filed the following evidence:
 - A witness statement dated 28 April 2008 by Steven David Wilch, 'Finance Director and shareholder of the company 'Fine White Line Limited' (FWL), exclusive licensee' of the CTM proprietor;
 - He holds the position of the Finance Director and shareholder of the 'Company Fine White Limited' (FWL) since 11 January 2008 but was prior to that date from March 1999 involved with 'Derry Kunman Limited', the CTM proprietor's previous exclusive licensee and 'Fine White Line Limited' (FWL) as their external accountant and since 1 May 2006 as their internal financial advisor;

- Fine White Line Limited (FWL) became the CTM proprietor's exclusive licensee in the UK for the trade mark 'LAMBRETTA' after having taken over the licence agreement from 'Derry Kunman Limited' in March 1997. The current licence agreement (SDW1) dates from 8 September 2006 'with an effective date of 1 April 2006';
 - An agreement was reached on 13 August 1999, between the CTM proprietor, the 'Lambretta Club of Great Britain' and 'Derry Kunman Limited' (as the former licensee of the 'LAMBRETTA' trade mark) regarding use of the trade mark 'LAMBRETTA' (SDW2);
 - The 'Lambretta Club of Great Britain' sells metal goods and engines, as well as a range of other goods under the trade mark 'LAMBRETTA' with the consent of the CTM proprietor (SDW3).
- (SDW1) Copy of a license contract between the CTM proprietor and 'Fine White Line Limited' (FWL) dated 28 January 2005;
- The contract *inter alia* gives 'Fine White Line Limited' (FWL) an exclusive right to use the trade mark 'LAMBRETTA' (represented in 'ordinary block alphabets' and in a stylised representation similar to '**Lambretta**') for goods in Classes 3, 9, 12, 14, 18, 25 and 26, none of which are included in the list of goods in issue here, in a number of European countries and in Canada (Letter C);
 - The contract refers to two previous licence contracts being no longer in force. The first dated 12 June 1998 between SIL and 'Derry Kunman Limited' permitting the latter to use the trade mark 'LAMBRETTA' in respect of the goods in Class 25. The second between the CTM proprietor and FWL dated 18 September 2001 which replaced the first contract.
- Copy of a licence contract between the CTM proprietor and 'Fine White Line Limited' (FWL) dated 8 September 2006:
- The contract *inter alia* gives the right to use the trade mark 'LAMBRETTA' (in block letters and in stylised format) in the European Union and Brazil;
 - The annexed 'Schedule 1 – Marks – Part 1 – Marks' lists a number of registered trade marks being the object of the licence contract, including the contested CTM (identified by No 1 618 982, referring to Classes 6, 7 and 28, without specifying any goods individually).
- (SDW2) Copy of a settlement agreement between Kevin J. Walsh, acting in his capacity as General Secretary of 'Lambretta Club of Great Britain' on the one hand and the CTM proprietor, Mr Derry Kunman and 'Derry Kunman Limited' on the other. The agreement is dated 13 August 1999.

- It explains that the ‘Lambretta Club of Great Britain’ has used signs consisting of, and including, the word ‘LAMBRETTA’ for ‘various goods and services’ and has applied for the registration of the UK trade mark No 2 124 446 ‘LAMBRETTA’. The CTM proprietor has used the mark in relation to ‘motor scooters and other goods and services’ and is the proprietor of various UK trade marks of that name;
- In paragraph 1, Mr Walsh promises that the Club will not interfere with future use or registration of the mark in the United Kingdom by the CTM proprietor, by Mr Kunman or by ‘Derry Kunman Limited’;
- Moreover, Mr Walsh promises that the Club will use the ‘LAMBRETTA’ mark only in relation to goods offered by the Club via mail order or via the Club’s points of sale at special scootering events; this restriction being without prejudice to the Club’s freedom to provide services under the mark in the United Kingdom on a non-profit basis;
- The other contracting parties promise not to interfere in the future use of the mark in the United Kingdom by the Club in the aforementioned sense;
- The agreement does not specify any goods more precisely.
- (SDW 3) The copy of a cover page from the magazine ‘*Scootering*’, edition 211, January 2004. The page shows the front of a scooter with a ‘LAMBRETTA’ logo on it;
- Five copies of advertising pages, presumably from the same edition of this magazine (indicated on page 2) but without further indication from the CTM proprietor about the content.
 - The pages contain advertisements from different shops (such as: www.allstyles-scooters.com; www.scooterrestorations.com; www.scooterproducts.com; www.bdevelopments.co.uk) selling spare parts for ‘Lambretta’ and ‘Vespa’ scooters as well as stickers, posters, books about such scooters, etc.;
 - On the first copy with an advertisement from a company called ‘Allstyles Scooters’ the indication ‘Lambretta Club of Great Britain Super Dealer’ can be found on the left and right of the address for ‘Allstyles Scooters’. This sales advertisement contains *inter alia* articles such as restored and non-restored scooters, ‘vintage parts’ (‘vintage parts ... some are genuine spec.’) for scooters, ‘Vespa’ parts and ‘Vespa’ books as well as ‘Lambretta’ books and ‘Lambretta’ stickers. Further the advertisement gives the information: ‘Don’t forget, we keep many Spare Parts and Accessories for all Lambretta & Vespa Models’. The advertisement itself also shows a small photo subscribed ‘Lambretta’ stickers while the stickers themselves cannot be perceived well, as the picture is too small.
- Another copy of a cover page from the magazine ‘*Scootering*’, No 256, October 2007.

- The page contains *inter alia* the header ‘Lambretta – 60th anniversary – unseen factory images’;
 - Two copies of advertisements for spare parts for ‘Lambretta’ scooters by ‘Resurrection Scooters UK’, www.resurrection-scooters.co.uk.
- (SDW4) Four photographs showing a picture of a cardboard box with the ‘Lambretta’ logo on it, as well as other articles such as a T-shirt, pins or a box with the ‘Lambretta’ logo on them.
- 5 The revocation applicant argued in its reply that use was not demonstrated sufficiently, *inter alia* because none of the documents refers to the contested goods in Classes 6 and 7. No use was alleged for goods in Class 28.
- 6 The CTM proprietor replied by letter of 11 May 2009 that use by ‘Fine White Line Limited’ (FWL) amounts to use by the CTM proprietor who consents to that use. The evidence of a licence agreement between the CTM proprietor and ‘Fine White Line Limited’ (FWL) is sufficient to show use. The licence agreement foresees that further products to those mentioned in Schedule 3 of the licence agreement may be added by further agreement. The licence agreement is, therefore, not limited to those goods.
- 7 A further exchange of observations took place but no new evidence of use was filed.
- 8 On 24 September 2010 the Cancellation Division declared the rights of the CTM proprietor to be revoked as of 19 November 2007 in respect of all the goods for which the CTM was registered. In essence the Cancellation Division held that the CTM proprietor had not proved genuine use of the contested trade mark in relation to any of the goods it was registered for in Classes 6, 7 and 28. In particular it held that use by the ‘Lambretta Club of Great Britain’ due to the settlement agreement was not use of the trade mark with the consent of the proprietor, but rather restricting the use the CTM proprietor may tolerate. In addition, the ‘Lambretta Club of Great Britain’ had not used the trade mark but just offered a platform for spare-part dealers to promote their spare parts.
- 9 On 23 November 2010 the CTM proprietor filed an appeal against the Cancellation Division’s decision in its entirety. The appeal was limited later in the statement of grounds to the goods in Classes 6 and 7. Essentially, the CTM proprietor claims that the Cancellation Division failed to properly assess the evidence of use of its mark. In the course of the appeal and in addition to the evidence filed before the Cancellation Division, the CTM proprietor filed the following evidence:
- A written statement from the technical director of the CTM proprietor, P. P. Sarkar, dated 19 January 2011, referring to the following invoices for spare parts for ‘Lambretta 2 wheeler’, indicating the CTM proprietor as sender/exporter of:
 - Invoices:

Invoice No	Date	Location of purchaser	Description of goods	Amount in GBP
EXP/01/2005-2006	22 September 2005	United Kingdom	Spare parts of 2 Wheeler / 3 Wheeler	20 080.71
EXP/02/2005-2006	11 March 2006	United Kingdom	Spare parts of Lambretta 2 Wheelers	4 371.17
EXP/03/2005-2006	27 March 2006	United Kingdom	Spare parts of Lambro 3-Wheeler	334.34
EXP/04/2005-2006	27 March 2006	United Kingdom	Spare parts of Lambretta 2 Wheelers	22 646.33

- On the invoices the only reference to the trade mark can be found in the 'Description of Goods: Spare Parts of Lambretta 2-Wheeler' or '... 3-Wheeler';
- A copy of an ocean bill of lading dated 31 March 2006, which relates to invoice EXP/04/2005-2006 of 27 March 2006;
- A copy of an ocean bill of lading dated 31 March 2006, which relates to invoice EXP/03/2005-2006 of 27 March 2006;
- A copy of an ocean bill of lading dated 21 March 2006, which relates to invoice EXP/02/2005-2006 of 11 March 2006;
- A copy of a hand written order dated 28 May 2005 without an indication of any customer or sender;
- A copy of a letter addressed by a UK company named 'Scooter Restorations' to the CTM proprietor dated 10 March 2006 confirming the payment of four invoices issued by the latter on 16 February 2006 for a total amount of GBP 48 328.74; The letterhead mentions that the purchaser is a 'Lambretta Specialists Scooter Spares & Accessories'. Moreover, the letter refers to a certain amount of '200 GP200 damaged crankshafts' delivered on November 2005. It can therefore be inferred that these four invoices relate to scooter spare parts manufactured and delivered to the United Kingdom by the CTM proprietor;
- A copy of an advertisement from the company 'Scooter Restorations' published in 'Scootering' magazine distributed under the title 'Scooter Trader', dated January 2004 advertising the sale of 'Lambretta' spare parts. The prices are indicated in GBP and it can, therefore, be presumed that this publication was circulated in the United Kingdom;
- A copy of an undated photograph showing a row of scooters bearing the 'LAMBRETTA' logo. The photo has the subtitle: 'Steering its way to another successful decade of exports'. The CTM proprietor has not provided any further explanation as regards the photo;

- Copy of the explanatory notes of Classes 6, 7 and 12 of the 9th Edition of the Nice Classification.
- 10 On 12 July 2011 the revocation applicant sent its observations in reply to the CTM proprietor's intervention. Essentially the revocation applicant claims, that:
- The additional evidence should not be taken into consideration by the Board as it is belated evidence;
 - The evidence given does not bear the mark, has no reference to the mark or has no reference to the date, territory, quantity of the goods, marketing, distribution or sales;
 - No specific 'Lambretta' branded spare parts have entered the (European) market during the relevant period.
 - The UK Office revoked the 'Lambretta' trade marks belonging to the CTM proprietor as no evidence of use had been filed.
- 11 In support of its observations the revocation applicant filed *inter alia* the following evidence:
- Witness statement of Vittorio Tessera, Director 'Casa Lambretta' (Restauri, Ricambi, Archivio Storico), Director 'Lambretta Museum' and Vice President 'Lambretta Club Italia', dated 12 September 2008. The statement claims *inter alia* that since 1991 there have been no motorcycles distributed or sold on Italian territory by or via the CTM proprietor;
 - Witness statement of Tino Sacchi, owner of www.lambretta.it and buyer of spare parts from the CTM proprietor, dated 26 October 2008. Mr Sacchi claims that the spare parts supplied by the CTM proprietor to him do not imply that they should relate to the 'Lambretta' brand or be original 'Lambretta' parts. The replacement parts were generic, unbranded and shipped as such. The CTM proprietor never mentioned the necessity of licensing agreements to use the 'Lambretta' brand to him. The CTM proprietor supplies certain replacement parts for a number of old 'Lambretta' scooters and does not produce original 'Innocenti Lambretta' parts. For the last 30 years no 'Lambretta' Scooters have been put on the market by or via the CTM proprietor;
 - Witness statement of Paul Brierley, managing director of 'Scooter Restorations', dated 4 May 2011. Mr Brierley states that the spare parts bought from the CTM proprietor are branded as 'Scooters India Limited original spares'. The word 'Lambretta' in the correspondence with the CTM proprietor (letters, invoices) is often used to indicate the range or model types of the 'Lambretta' scooters in order to identify the spare parts requested beyond the basic part's number. The CTM proprietor never mentioned the necessity to use the 'Lambretta' brand for spare parts. He has never received spare parts from the CTM proprietor branded under the name 'Lambretta'. The last 'Lambretta' produced by the CTM proprietor was in 1997 in India;

- Decisions of the UK IPO.
- 12 By decision 12/01/2012, R 2308/2010-1, LAMBRETTA the First Board of Appeal dismissed the appeal. In particular it found that the evidence furnished by the CTM proprietor during the course of the appeal was insufficient to prove that the mark 'LAMBRETTA' had been put to genuine use.
- 13 On 23 March 2012 the CTM proprietor lodged an application to the General Court pursuant to Article 65 CTMR against the decision of the First Board of Appeal alleging the infringement of Article 51(1)(a) CTMR. The CTM proprietor maintained that:
- The Board of Appeal reviewed the evidence of use supplied to it in isolation, and not in combination with the evidence already supplied to the Cancellation Division, including the witness statement of Mr Wilch (Finance Director and shareholder of the company 'Fine White Line Limited' (FWL) as the CTM proprietor's exclusive licensee;
 - The Board of Appeal did not regard as proof of use the invoices produced which make clear reference to goods bearing the 'LAMBRETTA' mark;
 - The Board of Appeal considered only whether the use of the mark by a third party was made with the CTM proprietor's consent, whereas the sale, by 'Scooter Restorations', of spare parts under Classes 6 and 7, intended to be for 'LAMBRETTA' products, was in itself use of the mark, whether or not it happened under the 'LAMBRETTA' mark or with the CTM proprietor's consent.
- 14 By decision 30/09/2014, T-132/12, Lambretta, EU:T:2014:843 the General Court annulled the decision of the First Board of Appeal. In essence the General Court held that the Board did not take into account all the relevant factors for the examination of genuine use. In particular it rejected the Office's argument that the first set of evidence filed in the first-instance proceedings fell outside the scope of the appeal. This was because firstly the CTM proprietor had made express reference in its statement of grounds to all submissions previously made (§ 20) and secondly because the Board was, even in the absence of an express request from the appellant, under the obligation to carry out a global assessment which took into account all the relevant factors of the particular case to examine the full file (§ 23-25).
- 15 After the decision 12/01/2012, R 2308/2010-1, LAMBRETTA had been annulled by the General Court (30/09/2014, T-132/12, Lambretta, EU:T:2014:843) it was reallocated to the First Board of Appeal as Case R 352/2015-1 by decision of the Presidium of the Boards of Appeal of 30 January 2015 in order for it to take a new decision.

Reasons

- 16 The appeal complies with Articles 58, 59 and 60 CTMR and Rules 48 and 49 CTMIR. It is, therefore, admissible.

Scope of examination

- 17 The CTM proprietor limited its appeal against the Cancellation Division's decision to the goods in Classes 6 and 7 protected by the trade mark.
- 18 The Cancellation Division's decision is, therefore, no longer an object to these proceedings as far as it declared the trade mark 'LAMBRETTA' revoked for the goods in Class 28. The decision to revoke the goods in Class 28 has, therefore, become final.

Article 51(1)(a) – Grounds for revocation

- 19 Pursuant to Article 51(1)(a) CTMR the rights of the proprietor of the Community 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 EU in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use.
- 20 Pursuant to Rule 40(5) in conjunction with Rule 22(3) and (4) CTMIR, the indications and evidence for the furnishing of proof of use shall consist of indications concerning the place, time, extent and nature of use of the trade mark for the goods and services in respect of which it is registered.
- 21 There is 'genuine use' of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 43).
- 22 The examination of genuine use needs to take into account all the relevant factors including all the evidence submitted by the CTM proprietor before the Cancellation Division and the Boards. The examination needs to carry out a global assessment which takes into account all the relevant factors of the particular case.
- 23 The request for revocation was filed on 19 November 2007. The CTM was registered on 11 September 2001. Thus the CTM had been registered for more

than five years at the filing date of the request and the relevant period for assessing use of the sign is between 19 November 2002 and 18 November 2007, inclusive.

- 24 The Cancellation Division's view that the evidence filed before it did not demonstrate use is confirmed. The witness statement of Mr Wilch (Finance Director and shareholder of the company 'Fine White Line Limited' (FWL) as the exclusive licensee of the CTM proprietor alleged that the 'Lambretta Club of Great Britain' sells metal goods and engines, as well as a range of other goods under the 'LAMBRETTA' trade mark with the consent of the CTM proprietor. This allegation, however, is not supported by the evidence. As evidence for this a range of copies from two editions of '*Scootering*' magazine were filed. The copies prove that at least during the two respective years 2004 and 2007 there was a market (in the UK) for (new and old) spare parts that may fit 'Lambretta' scooters and other articles. Only few of these goods were shown to bear the 'Lambretta' logo such as stickers or pins.
- 25 Only in the first copy of the 2004 edition of '*Scootering*' magazine, can two small logos of the 'Lambretta Club of Great Britain', which the CTM proprietor claims to be its licensee, be found next to the name of the company ('Allstyles Scooters') indicated as the sales outlet. Though there is no clear link between these logos and the shop appearing in the advertisement. The 'Lambretta Club of Great Britain', therefore, cannot clearly be identified as the author of the advertisement.
- 26 Even if the 'Lambretta Club of Great Britain' were to have made use of the CTM with the CTM proprietor's consent there was no clear evidence given, that the 'Lambretta Club' used the mark as an indicator of origin in accordance with its main function and not only as a descriptive indication that the spare parts and accessories offered were compatible with (old) 'Lambretta' scooters.
- 27 It remains unclear and not proven whether the spare parts publicised were new and produced under the trade mark 'LAMBRETTA', or whether they were already placed by others including the original manufacturer on the market (second hand) or whether they are (new) copies of old-style spare parts (vintage), not protected under design laws by third parties. It also remains unclear whether they were simply meant to repair or restore old 'Lambretta' scooters and might have been produced by third parties or whether they were produced under the brand and with the contested trade mark on them.
- 28 The allegation that the spare parts were actually not produced and sold under the trade mark 'LAMBRETTA' but that the mark only served to describe the intended purpose to serve as spare parts for 'LAMBRETTA' scooters (cf. Article 12(c) CTMR) was argued by the revocation applicant repeatedly.
- 29 The evidence does not show convincingly that use was more than merely descriptive use indicating that the goods were compatible with 'LAMBRETTA' products. Since the revocation applicant concentrated on that point extensively, the CTM proprietor should have been more meticulous in providing evidence for actual use under that trade mark.

- 30 In this respect the witness statements of Mr Sacchi and Mr Brierley filed by the revocation applicant state that the spare parts provided by the CTM proprietor are 'generic and brandless' (witness statement of Mr Sacchi) or branded as 'Scooters India Limited original spares'.
- 31 The evidential value of 'statements in writing sworn or affirmed or having a similar effect under the law of the State in which the statement is drawn up' has to be assessed in light of the credibility and veracity of the account they contain considering 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 the face of it, the document appears sound and reliable (18/01/2011, T-382/08, Vogue, EU:T:2011:9, § 43).
- 32 In the present case, the declarations have been drafted and signed by people who are not a party to, and have no visible interest in the outcome of, the appeal proceedings. Moreover, the Board sees no reason to question the accuracy of the statements made by the witnesses, which were given independently and at different times.
- 33 The copies from '*Scootering*' magazine prove that there were various retailers (in the UK) for (new and old) spare parts for 'Lambretta' scooters. It cannot be seen from the advertisements though, whether the spare parts offered are produced under the 'LAMBRETTA' brand or whether they just refer to (old) 'LAMBRETTA' scooters and are produced by third parties to allow old 'LAMBRETTA' scooters to be repaired or restored. In this case the services offered by the advertisers would eventually fall under Class 35 of the Nice Classification. The simple existence of a market for spare parts for scooters which are no longer produced, does not provide any evidence that the CTM proprietor used the trade mark 'LAMBRETTA' actively on this market, for example, to produce new spare parts (for old scooters). This is particularly true for second-hand spare parts where trade mark rights are exhausted.
- 34 The copy of an advertisement published in a magazine distributed under the title '*Scooter Trader*', dated January 2004 (the 'ad') advertises the sale in England of 'Lambretta' spare parts by a company doing business under the trade name Scooter Restorations and not he CTM proprietor.
- 35 It is not disputed that there is a business relationship between the CTM proprietor and a company doing business under the trade name 'Scooter Restorations'. But as evidenced by the witness statement of Mr Brierley of 4 May 2011 this relationship pertains to the supply of spare parts branded as 'Scooters India Limited original spares' and not as 'LAMBRETTA'. Such use is descriptive use, in order to describe the destination of the product, but not use of the trade mark 'LAMBRETTA' itself. Therefore, it cannot be presumed from the mere existence of that relationship that the CTM proprietor has implicitly consented to the use of the disputed trade mark as an indicator of origin either.
- 36 Moreover, as it appears from the same witness statement, the CTM proprietor also never requested Scooter Restorations to use the 'LAMBRETTA' mark in connection with the sale of the spare parts that it supplied.

- 37 The use of a mark with the consent of the proprietor is deemed to constitute use by the proprietor according to Article 15(2) CTMR. Even if some of the parts or accessories for 'Lambretta' scooters were offered under the trade mark 'LAMBRETTA' the burden of proof lies with the CTM proprietor who shall provide evidence that it consented to the alleged use of its trade mark by a third party (11/05/2006, C-416/04 P, Vitafruit, EU:C:2006:310, § 44).
- 38 The CTM proprietor also did not provide any evidence for other retailers appearing in the advertisements or the other evidence submitted, such as 'Scooter Restorations', to have used its trade mark with its consent.
- 39 The four photos submitted as evidence are undated and therefore whether they fall within the relevant period of time cannot be identified. Nor do they show the relevant goods but T-Shirts or simple boxes.
- 40 The further evidence given before the First Board of Appeal, especially the invoices and bills of lading, given before the Boards in case R 2308/2010-1 cover a short six-month period between September 2005 and March 2006. They show that the CTM proprietor sold spare parts for 'Lambretta' scooters but not that these spare parts were sold under the trade mark 'LAMBRETTA'.
- 41 While it is true that trade marks are not usually reproduced on spare parts, in particular on small pieces of equipment such as screws, cables, nuts and spring pipes, it is also true that the marks generally appear on the packaging of these goods, or in trade catalogues, price lists, promotional documents (flyers, internet pages, advertising published in magazines, newspapers). The invoices and bills of lading do not bear the mark 'LAMBRETTA' or show any reference to the trade mark, except for the description of the goods as 'Spare parts of Lambretta 2 Wheeler / 3 Wheeler'. As seller and exporter only the CTM proprietor, 'Scooters India Limited', appears.
- 42 The CTM proprietor also failed to file any valid sample of use of its trade mark on the packaging of the spare parts exported indicating a date and the sender.
- 43 The witness statements of Mr Sacchi and Mr Brierley who both declared that the replacement parts were not branded and shipped as 'Lambretta' parts prove further that the trade mark was not used by the CTM proprietor in its trade relationships.
- 44 With regard to the goods in Class 6 the evidence given is insufficient as from the advertisements in '*Scootering*' magazine of January 2004, where *inter alia* 'Lambretta' stickers are offered, the scale and frequency of use of the mark for these products and whether the CTM proprietor used the trade mark to maintain or create a share in the market for these goods cannot be seen (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 43).
- 45 In view of the foregoing, it follows that the CTM proprietor has not proven that its mark 'LAMBERETTA' had been put to genuine use as a trade mark in relation to the goods the trade mark is registered for in Classes 6 and 7.

- 46 Therefore, there is no need to decide whether the evidence filed before the Boards of Appeal, outside the various time-limits granted before the Cancellation Division should be admitted under Article 76(2) CTMR. Even if the Board had to do so, the discretion is exercised against the CTM proprietor, as the evidence for the goods in Classes 6 and 7 is entirely new and does not merely supplement the previous evidence for those goods (18/07/2013, C-621/11 P, *Fishbone*, EU:C:2013:484). Nor is it acceptable that the CTM proprietor did not take up the various possibilities of filing evidence in reply to the diverse and specific observations filed by the revocation applicant, in particular on the contested trade mark's nature of use but rather shows delaying tactics.
- 47 Moreover, lists of goods that are enumerated in long lists of invoices and that may not be found in the list of goods as registered do not provide evidence of use. As may be seen from Rule 22(3) CTMR, which describes standards of proof, the CTM proprietor must give 'indications' of use for each good registered, then file 'evidence' of that use for that good and further establish the specific link between the facts alleged and the evidence filed. It is not sufficient to provide the Office with unorganized evidence concerning proof of use, as the facts to be demonstrated by evidence are not clearly established (see more in detail 11/06/2015, R 1840/2011-1, *GALILEO*, § 37-40).

Costs

- 48 Since the revocation applicant's appeal is successful and the CTM proprietor is the losing party, it must bear the revocation applicant's fees and costs in accordance with Article 85(1) CTMR and Rule 94(1) CTMR.
- 49 Pursuant to Article 85(6) CTMR the Board shall fix the amount of the costs to be paid when they are limited to the fees paid to the Office and to the winning party's representation costs of a professional representative in the sense of Article 93(1) CTMR. Since the revocation applicant did not appoint a professional representative in the sense of Article 93 CTMR, but was represented by its employee in accordance with Article 92(3) CTMR, it is not entitled to representation costs, as results from Rule 94(7) CTMR (17/07/2012, T-240/11, *MyBeauty*, ECLI:EU:T:2012:391, § 15). The costs of the cancellation proceedings amount to the fee for the application for revocation of EUR 700. Since the appellant is the CTM proprietor the appeal fee of EUR 800 was already paid by it. Any final decision fixing the amount of costs shall be enforceable pursuant to Article 86 CTMR.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the CTM proprietor to bear the fees of the cancellation request which are fixed at EUR 700.**

Signed

Th. M. Margellos

Signed

Ph. von Kapff

Signed

C. Rusconi

Registrar:

Signed

H.Dijkema

