

Notification to the applicant/holder of a decision

Alicante, 28/09/2017

BIRD & BIRD LLP
12 New Fetter Lane
London London, City of EC4A 1JP
REINO UNIDO

Your reference: **MarcaUDS**

Opposition number: **B 002714361**

Contested trade mark number: **014718431**

Name of the applicant/holder: **Unionistas de Salamanca Club de Futbol**

Please see the attached decision which ends the abovementioned opposition proceedings. It was taken on **28/09/2017**.

Manuela RUSEVA

Enclosures (excluding the cover letter): 09 pages.

Please note that the decisions of the Opposition Division will not be signed by the responsible officials, but will only indicate their full name and carry a printed seal of the Office in accordance with Rule 55(1) EUTMIR.

OPPOSITION No B 2 714 361

Union Deportiva Salamanca S.A.D., Estadio Helmantico (Ctra. de Zamora, S/N), 37184 Salamanca, Spain (opponent), represented by **García, Domínguez & Asociados**, Plaza del Corriño, 19, 3º - 2, 37002 Salamanca, Spain (professional representative)

a g a i n s t

Unionistas de Salamanca Club de Futbol, C/ Badajoz, 14, 37003 Salamanca, Spain (applicant), represented by **Bird & Bird LLP**, 12 New Fetter Lane, London EC4A 1JP, United Kingdom (professional representative).

On 28/09/2017, the Opposition Division takes the following

DECISION:

1. Opposition No B 2 714 361 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300.

REASONS:

The opponent filed an opposition against all the goods and services of European Union trade mark application No 14 718 431 for the word mark 'UNION DEPORTIVA SALAMANCA', namely against all the goods and services in Classes 18, 25 and 41. The opposition is based on Spanish trade mark registrations No 2 116 185 for goods in Class 16, No 2 116 187 for goods in Class 18, No 2 116 197 for goods in Class 28, No 2 116 193 for goods in Class 24 and No 2 116 194 for goods in Class 25, all for



the figurative mark and (b) and Article 8(5) EUTMR.

. The opponent invoked Article 8(1)(a)

PROOF OF USE

In accordance with Article 42(2) and (3) EUTMR, if the applicant so requests, the opponent must furnish proof that, during the five-year period preceding the date of filing or, where applicable, the date of priority of the contested trade mark, the earlier trade mark has been put to genuine use in the territories in which it is protected in connection with the goods or services for which it is registered and which the opponent cites as justification for its opposition, or that there are proper reasons for non-use. The earlier mark is subject to the use obligation if, at that date, it has been registered for at least five years.

The same provision states that, in the absence of such proof, the opposition will be rejected.

The applicant requested that the opponent submit proof of use of the trade marks on which the opposition is based, namely Spanish trade mark registrations No 2 116 185, No 2 116 187, No 2 116 197, No 2 116 193 and No 2 116 194.

The request was submitted in due time and is admissible given that the earlier trade marks were registered more than five years prior to the relevant date mentioned above.

The date of priority of the contested application is 22/04/2015. The opponent was therefore required to prove that the trade marks on which the opposition is based were put to genuine use in Spain from 22/04/2010 to 21/04/2015 inclusive.

Furthermore, the evidence must show use of the trade marks for the goods on which the opposition is based, namely the following:

Spanish trade mark registration No 2 116 185

Class 16: *Paper, cardboard and articles of these materials not included in other classes, forms, pamphlets, catalogues, magazines, books and publications, printed matter, bookbinding tools, maps, posters, stickers, cards, photographs, stationery, adhesives (glues) for stationery or household purposes, artists' materials, brushes, typewriters and office supplies (except furniture), instruction material or teaching material (except apparatus), plastic materials for packaging (not included in other classes), cards, block letters, printing blocks.*

Spanish trade mark registration No 2 116 187

Class 18: *Leather and imitations of leather, and goods made of these materials not included in other classes, animals skins, trunks and traveling bags, umbrellas, parasols, and walking sticks, whips and saddlery.*

Spanish trade mark registration No 2 116 197

Class 28: *Games and toys; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.*

Spanish trade mark registration No 2 116 193

Class 24: *Textiles and textile goods, not included in other classes, bed and table covers.*

Spanish trade mark registration No 2 116 194

Class 25: *Clothing, footwear and headwear.*

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

Since the opposition is based on earlier registrations of the identical figurative mark



, registered for goods in Classes 16, 18, 24, 25 and 28, the Opposition Division will refer to the earlier rights as 'the earlier mark/sign' wherever appropriate.

Preliminary remark on the substantiation time frame

On 30/08/2016, according to Rule 22(2) EUTMIR, the Office gave the opponent until 18/10/2016 to submit evidence of use of the earlier trade marks. On 18/10/2016, within the time limit, the opponent submitted evidence of use.

However, it should be noted that, due to an oversight, the Office erroneously set the deadline for the opponent as 18/10/2016, whereas it should have been set as 30/10/2016. The Office corrected its mistake by giving the opponent until 30/10/2016 to submit the relevant proof of use and additional facts and evidence to substantiate its opposition. On 28/10/2016 and 31/10/2016, the opponent made additional submissions, within the corrected time limit set by the Office, and these will also be taken into account for the reasons explained in the Office's communication to both parties.

As the opponent requested to keep certain commercial data contained in the evidence confidential vis-à-vis third parties, the Opposition Division will describe the evidence only in the most general terms without divulging any such data.

Preliminary remark on the language of the evidence

In the present case, most of the relevant evidence is in Spanish and no translations into the language of the proceedings were provided by the opponent, nor were any explanatory notes attached to the items of evidence. The applicant questioned the content of the evidence and requested translations of the relevant information.

According to Rule 22(6) EUTMIR, where the evidence supplied pursuant to paragraphs 1, 2 and 3 is not in the language of the opposition proceedings, the Office may require the opponent to submit a translation of that evidence in that language, within a period of two months. It is left to the discretion of the Office whether or not the opponent has to submit a translation of the evidence of use into the language of the proceedings. Nevertheless, in exercising its discretion, the Office must balance the interests of both parties. Consequently, it has to be borne in mind that it might be extremely costly and burdensome for the opponent to translate the evidence of use submitted into the language of the proceedings.

On the other hand, the applicant has the right to be informed about the content of the evidence filed so that it is capable of defending its interests. It is absolutely necessary that the applicant is able to assess the content of the evidence of use submitted by the opponent. In this regard, the nature of the documents submitted has to be taken into account. If the applicant explicitly requests a translation of the evidence into the language of the proceedings, the Office, in principle, will require a translation from the opponent.

However, for reasons of procedural economy (i.e. to avoid time-consuming and costly proceedings), the Opposition Division will comment on the evidence, considering the best-case scenario for the opponent and presuming that the applicant is familiar with the substance of the evidence to the extent that it has already commented on its content in its observations of 21/03/2017. The Opposition Division will list the evidence in a general manner and will draw conclusions on the overall assessment on the basis of the facts that are clear for both of the interested parties.

Substance of the evidence

Therefore, the evidence to be taken into account is the following:

- **Documents 1 and 4-7:** a set of invoices issued by the opponent's company Union Deportiva Salamanca S.A.D. and addressed to clients in Spain, in particular in Salamanca. The documents are dated between 01/08/2014 and 05/05/2015 and presumably relate to sales of sporting articles in Class 28 and clothing articles in Class 25 and the provision of services, in particular the renting of space. This can be inferred, to some extent, from the opponent's observations of 18/01/2016 (in Spanish), which contain some references to those classes. However, the Opposition Division notes that, apart from the depiction of the verbal elements 'Unión Deportiva Salamanca S.A.D.' in the upper right-hand corner of the invoices, the opponent's mark does not appear in its entirety (as a complex sign) in any of the invoices in connection with the relevant goods.
- **Document 2:** an invoice concerning the rental of a property in 'Pasaje Coliseum', on which the earlier sign appears depicted as



Unión Deportiva Salamanca, S.A.D.

; the document is dated 30/03/2012 and is addressed to the company Inversiones y Desarrollos UDS S.L. in Salamanca. However, it should be noted that none of the opponent's marks has been registered for services (in particular the renting of retail space) and therefore this evidence does not relate to the relevant scope of protection.

- **Document 3:** an invoice issued by Inversiones y Desarrollos UDS S.L. to the opponent, dated 30/10/2012, on which the earlier mark does not appear in its entirety. It may be inferred from the evidence that the relevant company is in an economic relationship with the opponent as a distributor of products sold in the Pasaje Coliseum (referred to in Document 2). The invoice concerns the sale of goods in Class 25 (T-shirts, pants, hats, etc.), as indicated in the opponent's observations, in which this class is mentioned.
- **Documents 8-10:** extracts containing accounting information about the commercial activities of the opponent's company Union Deportiva Salamanca, S.A.D. (empresa) at different points in time. In particular, the first extract refers to 'arrendamiento local pasaje' (the rental of local commercial property) between 30/09/2011 and 01/08/2014; the second extract refers to invoices issued by the company Erreà Sport S.p.A. for the period between 05/09/2011 and 01/07/2015. The third extract concerns the companies Inversiones y Desarrollos UDS S.L. and Erreà Sport S.p.A. and relates to the

period between 27/08/2011 and 29/12/2011. The earlier mark does not appear in its entirety in any of these extracts.


- **Document 11:** invoices issued by the company Erreà Sport S.p.A. to the opponent's company Inversiones y Desarrollos UDS S.L. or Boutique Salamanca, dated between 27/08/2011 and 15/06/2013. It is obvious that the company Erreà is an Italian technical sportswear producer delivering goods (in Classes 16 and 35, according to the opponent's observations) ordered by the opponent and possibly by its economic partners for their commercial activities. The earlier mark is not depicted on any of the relevant documents.
- **Document 12:** an affidavit signed by the opponent's administrator, Eduardo Perez Cruz, on 14/10/2016 and referring to the opponent's sign 'UNION DEPORTIVA SALAMANCA' and in particular, according to the statement, to extracts from inventory lists proving its commercial use.
- **Documents 13-17:** inventory lists referring to various products, most probably sold by the company Boutique U.D.S., dated 16/10/2012, 28/11/2012 and during the period from 11/12/2012 to 05/01/2013. It should be noted that some of the products feature other trade marks and none of them relates to the opponent's mark (apart from the possible abbreviation of the company name Unión Deportiva Salamanca to 'UDS'). Nevertheless, none of the goods offered bears the opponent's trade mark.
- **Document 18:** extracts from invoices dated between 2012 and 2013 and issued by the companies Inversiones y Desarrollos and I3 Iniciativas y Desarrollos. Although it is not particularly clear what the goods and services referred to are, it can be inferred that none of them relates to or bears the opponent's figurative mark.
- **Document 19:** a comic entitled 'Hala Unión! El Cómic ... para niños y no tan niños. 1981 al 2001, Una Odisea en el fútbol Español', dated 2015, containing an a figurative version of the opponent's logo (p. 45).
- **Document 20:** a comic entitled 'Hala Unión! El Cómic ... para niños y no tan niños. La Época Dorada', dated 2015. The comic contains, inter alia, a reference to the football club Unión Deportiva Salamanca and the earlier mark appears within the pages in a very stylised manner, in a figurative version incorporated among other images (page 11). Nevertheless, this document and Document 19 were produced by third parties and cannot be accepted as proof of use of the trade marks by the opponent. Furthermore, comics relating to a football club have no direct relation to any of the relevant goods for which the earlier marks are registered.
- **Document 21:** a copy of a contract for the licensing of trade marks, signed by



the opponent (with the sign depicted at the top as follows: Unión Deportiva Salamanca, S.A.D.) and the company Í3 Iniciativas y Desarrollos S.L. on 30/01/2012. The contract obviously refers to the opponent's mark No 2 116 194 for goods in Class 25. However, this agreement cannot in itself provide evidence of any sales realised by the opponent or its licensee in relation to the marks and for the relevant goods.

- **Document 22:** a copy of a sponsorship contract between the opponent's company and the company Hijos de Rivera S.A., for the purposes of promoting the latter, dated 01/09/2011.



- **Document 23:** an invoice bearing the mark  , dated 19/02/2012, possibly relating to sponsorship by the company Hijos de Rivera.
- **Document 24:** a copy of a sponsorship contract between the opponent and the company Mobel Sport Totana, signed on 01/06/2007.
- **Document 25:** a copy of contract, signed on 04/10/2006, between the opponent and the company Inversiones y Desarrollos Unión Deportiva Salamanca S.L., establishing an economic relationship between the parties (for the rental of a local property).
- **Document 26:** extracts from *La Gaceta*, a local newspaper, dated 2012, 2013 and 2014 and referring to the opponent's football team; the articles are accompanied by pictures in which the figurative element of the earlier marks can be seen affixed to the T-shirts of football players and in which the entire earlier mark is used as the official logo of the team.
- **Document 27:** an extract from opponent's official Twitter account, in which



the opponent's logo appears depicted as together with the verbal elements 'UD Salamanca SAD'.

- **Document 28:** an article, dated October 2012, published in *La Gaceta* and referring to, inter alia, some of the opponent's T-shirts, on which the same



logo referred to above () can be seen.

Firstly, it should be noted that some of the evidence is dated outside the relevant period, in particular some of the invoices, as well as Documents 24 and 35. These items of evidence will not be taken into account on their own, but may be taken into account in the overall assessment as supplementary evidence. As may be inferred from the evidence, the relevant territory is Spain; in particular, the evidence refers to Salamanca.

On the nature of use


In the context of Rule 22(3) EUTMIR, the expression 'nature of use' includes evidence of the use of the sign as a trade mark in the course of trade, of the use of the mark as registered, or of a variation thereof according to Article 15(1), second subparagraph, point (a) EUTMR, and of its use for the goods and services for which it is registered.


According to Article 15(1), second subparagraph, point (a) EUTMR, the following will also constitute use within the meaning of paragraph 1: use of the European Union

trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor. When examining the use of an earlier registration for the purposes of Article 42(2) and (3) EUTMR, Article 15 may be applied by analogy to assess whether or not the use of the sign constitutes genuine use of the earlier mark as far as its nature is concerned.

In the present case, as noted in the list of evidence, the earlier mark appears only occasionally in its entirety, namely as a complex sign consisting of a fanciful distinctive figurative element and the verbal element 'Unión Deportiva Salamanca S.A.D.' written underneath; in particular, it can be seen in its entirety in Documents 2, 21 and 23. On the other hand, the remaining pieces of evidence contain only parts of




the relevant trade mark , in particular either the verbal element 'Unión Deportiva Salamanca S.A.D.' (in Documents 1 and 4-7) or only the logo

 (in, for instance, Document 26). Nevertheless, the Opposition Division does not consider any of these appearances of parts of the sign (i.e. the verbal element only or the figurative element only) as a legitimate depiction of the sign. The omission of any of the relevant elements alters the distinctive character of the mark as a whole, as such omissions do not constitute a negligible change and will have an impact on the overall perception of the signs.

The Opposition Division further notes that in most of the relevant documents (for instance, in the various invoices and contracts submitted in which the opponent is one of the parties) the opponent has used the verbal element 'Unión Deportiva Salamanca S.A.D.' as a business name. In principle, the use of the sign as a company name or trade name, is not, of itself, intended to distinguish goods or services. The purpose of a company name is to identify a company. Accordingly, where the use of a company name, trade name or shop name is limited to identifying a company or designating a business which is being run, such use cannot be considered as being 'in relation to goods or services' (11/09/2007, C-17/06, Céline, EU:C:2007:497, § 21; 13/05/2009, T-183/08, Jello Schuhpark II, EU:T:2009:156, § 31-32). The documents listed above refer to the opponent's company as a business unit only and most of them do not designate particular categories of goods (in Classes 16, 18, 24, 25 and 28) and thus do not demonstrate a clear economic connection with the relevant earlier trade marks. By way of example, most of the contracts and agreements (e.g. Documents 8-10 and 21-23) serve to establish and manage economic relationships, including in relation to licensing, promotion and sponsorship, between the opponent's company and third parties (Inversiones y Desarrollos, I3 Iniciativas y Desarrollos, Hijos de Rivera S.A., etc.).

It should be recalled that, as a trade mark has, inter alia, the function of operating as a link between the goods and services and the person responsible for their marketing, the proof of use must establish a clear link between the use of the mark and the relevant goods and services. As clearly indicated in Rule 22(4) EUTMIR, 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). In the present case, it is true that the




logo of the earlier mark, , appears affixed to T-shirts used by a football team (presumably the opponent's football club).

In principle, assessing the circumstances of the case may include giving consideration, *inter alia*, to the nature of the goods or services at issue, the characteristics of the market concerned and the scale and frequency of use of the mark (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, 39).

As noted above, the use of the figurative element of the earlier trade marks on its own cannot be accepted as genuine use, as such use alters the distinctiveness of the mark as a whole. In addition, the opponent has not provided sufficient evidence that it is the manufacturer of the designated products. It is clear from the evidence that the T-shirts used by the football team are manufactured by an external company, *Erreà Sport S.p.A.*, as the sign 'Erreà' also appears affixed to the products. For the sake of completeness, the Opposition Division notes that it is a well-known fact that in the football sector products worn or used by football players such as T-shirts, trainers and balls are usually produced by third-party manufacturers that are often involved in a sponsorship relationship with the relevant football clubs. In any event, even though some of the evidence refers to a particular category of products (e.g. Document 21 refers to goods in Class 25), the materials as a whole do not provide any information about the use of the earlier trade marks in relation to the relevant goods for which the marks have been registered and in the form in which they have been registered.

In conclusion, taking all the relevant documents as a whole, the Opposition Division



considers that the evidence of use shows that the figurative mark  has been used to some extent for *providing entertainment services in relation to sporting activities, in particular a football club* in Class 41. This finding is also referred to by the opponent in its observations of 18/10/2016 (page 11). Nevertheless, services in Class 41 do not fall within any of the categories for which the earlier marks are registered, namely goods in Classes 16, 18, 24, 25 and 28. Therefore, although it has demonstrated some use for services for which it has no protection, the opponent has not demonstrated use for the goods for which its national marks are registered.

In view of the above, the Opposition Division considers that the evidence does not show use of the sign as registered within the meaning of Article 15(1), second subparagraph, point (a) EUTMR.

Conclusion

The Court of Justice has held that there is 'genuine use' of a mark where it 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. Furthermore, the condition of genuine use of the mark requires that the mark, as protected in the relevant territory, be used publicly and outwardly (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, and 12/03/2003, T-174/01, *Silk Cocoon*, EU:T:2003:68).

The Opposition Division concludes that the evidence furnished by the opponent is insufficient to prove that the earlier trade marks were genuinely used as registered in relation to the relevant goods in the relevant territory during the relevant period of time.

Therefore, the opposition must be rejected pursuant to Article 42(2) and (3) EUTMR and Rule 22(2) EUTMIR.

COSTS

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

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

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



The Opposition Division

Volker MENSING

Manuela RUSEVA

Pedro JURADO
MONTEJANO

According to Article 59 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 720 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. According to Rule 94(4) EUTMIR, such a request must be filed within one month from the date of notification of this fixation of costs and will be deemed to be filed only when the review fee of EUR 100 (Annex I A(33) EUTMR) has been paid.