

Decision issued on 19 March 2007

Case No. 1238 C filed on 31 May 2005

1. Cancellation
2. OHIM Cancellation Division procedures

PRECIS: The Cancellation Division of the Office for the Harmonization of the Internal Market, has decided in favour of the partial invalidity action filed by the Greek company ELCO VAGIONIS AE against the Community Trademark ELCO on the basis of the Greek company's prior registered Greek trademark ELCO.

National ELCO trademark sufficient for partially canceling ELCO CTM

The Greek company ELCO VAGIONIS A.E. ("Petitioner") filed a partial invalidity action against the Community Trademark ELCO with regard to goods in class 11, on the basis of its prior, national trademark ELCO, registered in Greece already from 1957, and used continuously and extensively since then, in the Greek market.

The CTM holder, MERLONI BRANDS KFT, a Hungarian company, argued, among else, that the goods in class 11 covered by the prior national registration ELCO, which were, verbatim, "household electrical appliances and electrical kitchen utensils" were not precise enough and due to their vagueness, they were not sufficient for proving confusion. In addition, it alleged that the two marks ELCO and ELCO co-existed in Greece for 10 years.

These arguments were dismissed ab initio by the Cancellation Division, due to the lack of substantive evidence submitted in support thereof.

The Cancellation Division begun its ruling by elaborating on the issue of 'genuine use' as a necessary pre-requisite for justifying the legitimate interest of the Petitioner. As such, by referring to the Ansul Case C-40/01, it reiterated the strict threshold for establishing 'genuine use' by applying the principle that token use is not sufficient per se for qualifying as 'genuine use'. Rather, 'genuine use' is use, which is in fact intertwined with the essential function of a trademark, which is to consistently guarantee the identity of the origin of the goods or services covered.

Based on the facts before it and the plethora of evidence submitted by the Petitioner, in the form of advertisements, invoices, etc. the Cancellation Division was satisfied that the Petitioner's use of the mark ELCO in Greece was 'genuine' within the legally required time

frames, given also the volume of sales of products bearing the Petitioner's trademark ELCO in Greece. As evidence of such use was only submitted for the Greek market, the Cancellation Division went on to underline the principle that use in a single member state of the Community is sufficient for the purposes of establishing 'genuine use'. Moreover, the Cancellation Division determined that the minor difference in the form of using the trademark  from the form it was actually registered in  did not affect the distinctive character of the trademark.

When comparing the word CTM ELCO on trial, with the prior registered Greek trademark  the Cancellation Division was clear that the marks virtually coincide, as the minor graphic elements in the Greek  mark were deemed to be "commonplace and unimaginative" and as such did not suffice to differentiate the two marks at all.

In examining the potential similarities between the goods respectively covered, the famous Canon Case No. C-39/97 was quoted; the factors required for assessing the issue of similarity of goods, were recited as being the respective goods' nature, purpose, method of use and whether they are in competition or are complimentary with each other.

In applying the above guidelines to the facts before it, the Cancellation Division determined that the more generically and succinctly phrased goods in class 11 covered by the earlier Greek trademark ELCO, i.e. "household electrical appliances and electrical kitchen utensils" encompassed and in effect overlapped with the very detailed specification of goods of the CTM ELCO under review, essentially categorized by the Division as "heating, ventilating and water heating apparatus and various parts and fittings for these goods". Thus, as the same purpose, target group and place of distribution were found to apply in both situations, the risk of confusion to consumers was clear in the Cancellation Division's view, which based on the foregoing, decided to grant the partial invalidity action filed by the Greek company ELCO VAGIONIS AE against the CTM ELCO.

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