



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

The Boards of Appeal
The Registry

R420b

Alicante, 29/11/2012
R1772/2008-4

Antonio Campagnoli
via Lanzone, 7
I-20123 Milano
ITALIA

Subject: Appeal No. R1772/2008-4
Your ref.: ecbf

Notification of a decision of the Fourth Board of Appeal

Please find enclosed the decision of the Fourth Board of Appeal dated 28/11/2012 concerning the appeal filed on 12/12/2008 in the name of EUROPEAN CITIZEN'S BAND FEDERATION (ECBF).

Article 65 of the Regulation on the Community Trade Mark provides that an action may be brought before the Court of Justice of the European Union (General Court) in Luxembourg against decisions of the Boards of Appeal within 2 months after notification of the decision.

Your attention is drawn to the fact that the proceedings before the European Court of Justice are regulated by specific requirements stated in the *Statute of the Court of Justice of the European Union*, in the *Rules of Procedure of the General Court* as well as in the *Court of First Instance Practice Directions to parties*. Further information concerning the proceedings before the General Court may be obtained on the homepage of the European Court of Justice 'curia.europa.eu' under *General Court / Procedure / Practice Directions to Parties*.

Information related to appeals filed against Boards of Appeal decisions may also be obtained on the same homepage indicated above.

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

Christelle BERAT
Registry

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

The Boards of Appeal

DECISION
of the Fourth Board of Appeal
of 28 November 2012

In Case R.1772/2008-4

EUROPEAN CITIZEN'S BAND FEDERATION
(E.C.B.F. OU ECBF)

12 allée des Asturies

F-35000 Rennes

France

Appellant / Opponent

represented by AGUILAR & REVENGA, Consell de Cent, 415, E-08009 Barcelona,
Spain

v

European Citizen's Band Federation

Via Lanzene, 7

I-20123 Milan

Italy

Respondent / Applicant

APPEAL relating to Opposition Proceedings No B 1 137 712 (Community trade mark
application No 5 196 274)

THE FOURTH BOARD OF APPEAL

composed of D. Schennen (Chairman), F. López de Rego (Rapporteur) and A. Szanyi
Felkl (Member)

Registrar: P. López Fernández de Corres

gives the following

Language of the case: English

DECISION OF 28 NOVEMBER 2012 -- R.1772/2008-4 -- EUROPEAN CITIZEN'S BAND FEDERATION
(E.C.B.F. or ECBF) EUROPEAN CITIZEN'S BAND FEDERATION (ECBF)

Decision

Summary of the facts

- 1 On 27 June 2006 the European Citizen's Band Federation, 'associazione' under Italian law ('applicant'), sought to register the word mark

European Citizen's Band Federation (E.C.B.F. or ECBF)

as a Community trade mark ('CTM') for the following goods and services:

Class 9 – Radio apparatus.

Class 38 – Telecommunications; digital communications, by radio and via the Internet.

Class 39 – Vehicle towing.

Class 42 – Providing of training.

Class 45 – Guard services; security consultancy; rescue operations (transport).

- 2 On 26 March 2007, the French association 'EUROPEAN CITIZEN'S BAND FEDERATION (E.C.B.F. OU ECBF)' ('opponent') filed a notice of opposition against the application based on the sign used in the course of trade

EUROPEAN CITIZEN'S BAND FEDERATION (ECBF)

for 'telecommunications business and related products and services' in France.

- 3 The grounds of the opposition were those laid down in Article 8(4) CTMR. The opposition was directed against all the goods and services applied for.
- 4 In support of its allegations the opponent submitted, *inter alia*, the following documents:
- Statutes of "FEDERATION EUROPEENNE DE LA C.B." of 08/09/1989;
 - A recordal receipt issued by the Court of 1st Instance of Wikirch/France;
 - Publication of the inscription of the association in the register (newspaper "L'ami du peuple", dated 25/02/1990);
 - Copy of the Statutes adopted in April 2000;
 - Certification of the change of address of the association dated March 2002 and publication in the "Journal Officiel de la République Française";
 - Certification about the inclusion of the organization in the "Repertoire National des Entreprises et de leurs Etablissements" (National Directory of Companies) on 26/07/2002;

- Copy of the law governing French non-profit organizations:
 - Law of 1901
 - Articles 21 to 71 of the Alsatian Civil Code;
 - List of the Members of the Board, drafted on 01/10/2006, at its meeting. The modifications were reported to the corresponding authority (Préfecture des Pyrénées-Atlantiques);
 - Membership certificate of the European Telecommunications Standards Institute. The European Citizen's Band Federation is a member since November 1992;
 - Extracts from the opponent's Internet site giving general information about the Federation;
 - Extract from Internet site www.canal-9;
 - Article about the 11th congress of the ECBF at the UNESCO in Paris, issued by the opponent;
 - Extract from the French Intellectual Property Code.
- 5 On 20 October 2008 the Opposition Division adopted the contested decision which rejected the opposition. It reasoned essentially as follows:
- The evidence submitted shows that the opposing association has been legally established and that it holds congresses.
 - However, there is no indication of real use of its name. The evidence submitted does not allow the Office to conclude that the earlier sign was known to the relevant French public. All items of evidence, with the exception of the certificates of the inscription of the association and its modifications, were produced by the opponent itself. Furthermore, no brochures, official correspondence, press articles etc have been produced by the opponent.
 - Use of the applied for sign by the applicant, prior to the filing of the CTM is not relevant for the outcome of the case as the right to a CTM begins only with its filing, not before.

Submissions and arguments of the parties

- 6 On 12 December 2008 the opponent filed a notice of appeal against the contested decision, followed by the statement of grounds. The opponent requests that the mark applied for be rejected. Its reasoning can be summarized as follows:
- As to the use of the earlier sign, the contested decision did not take into account the following documentation, submitted in due course:

- a) Certificate of admission as a member by right of the European Telecommunications Standards Institute ('ETSI') on 31 October 1989.
 - b) Excerpts of the opponent's Internet site presenting its activity and specifying the members established in various European countries.
 - c) Extracts from third party Internet sites www.canal-9.org and www.raifownictow.org evidencing the organisation of congresses.
- During the 1980s the opponent represented the interests of more than 30.000.000 users in Europe (of which about 3.000.000 in France).
 - The opponent is the only entity to legally bear the name 'European Citizen's Band Federation'. The applicant organisation does not have legal existence. Instead of evidencing registration of the applicant entity in the Register of Federations and of Legal Entities of the Prefecture of Milan, just the seal of the Register of the Ministry of the Economy in Abbiategrasso, near Milan, had been stamped on the minutes of the Notary. This did not grant legal capacity to this entity under Italian law. Reference is made to the communication of the Regional Department of the Lombardy (app. 23). The Register of Companies of the Prefecture of Milan confirmed that the applicant is not registered (app. 24, 25). But, even if the applicant existed legally, the opponent would be older, dating back to 1977.

7 The applicant requests to uphold the contested decision and to reject appeal. It supports the contested decision and submits the following further arguments:

- According to Italian law, it is not necessary to be registered at the Prefecture in order to have legal capacity. Italian law does not require that the statutes of associations be registered and the fact of not being registered does not exclude legal capacity. The documents provided by the opponent are misleading. Reference is made to the communication of the Director of Agenzia della Entrata (submitted with the brief) according to which the opponent enjoys legal subjective capacity. The legal capacity of the applicant's entity is based on 'Capo III of Italian Civil Code', in particular its Article 36. In fact, the opponent has concluded contracts in the past.
- The applicant entity is the original one, dating back to 1977, whereas the opponent was founded only in September 1989.
- The contested sign has always been used by the applicant. The opponent tries to acquire the right to it through the opposition.
- As to the proof of use of the earlier sign: The certificate of ETSI membership dates back to 31 March 1989, a period when the opponent organisation did not even exist. The Internet site www.europeanecbf.org does not refer at all to the denomination in question. The same is true for the Internet site www.ecbf.eu. The site www.canal-9.org is managed by the general secretary of the opponent. The mention in the other web site www.raifownictwo.org refers to the applicant's denomination.

Reasons

8 The appeal is admissible but not well-founded. The opponent has not proven use in the course of trade of the earlier right for the goods and services claimed in France, which is a basic requirement under Article 8(4) CTMR.

Article 8(4) CTMR

9 According to Article 8(4) CTMR, upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Community legislation or the law of the Member State governing that sign:

(a) rights to that sign were acquired prior to the date of application for registration of the Community trade mark, or the date of the priority claimed for the application for registration of the Community trade mark;

(b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

10 The grounds of refusal of Article 8(4) CTMR are therefore subject to the following requirements:

- i. the earlier right must be a non-registered trade mark or a similar kind of sign;
- ii. the sign must be used in the course of trade;
- iii. the use must be of more than mere local significance;
- iv. the right must be acquired prior to the filing date of the contested mark;
- v. the proprietor of the sign must have the right under the terms of the national law governing this right to prohibit the use of the contested mark.

11 These conditions are cumulative. Thus, where a sign does not satisfy one of those conditions, the opposition based on the existence of a non-registered trade mark or of other signs used in the course of trade within the meaning of Article 8(4) CTMR cannot succeed.

12 Use in the course of trade of the earlier sign of more than local significance is a fundamental requirement, without which the sign in question cannot enjoy any protection against the registration of a Community trade mark, irrespective of the requirements to be met under national law in order to acquire exclusive rights. Furthermore, such use must be such as to indicate that the sign in question is of more than mere local significance. The rationale of that provision is to restrict the number of conflicts between signs, by preventing an earlier sign which is not sufficiently important or significant, from making it possible to challenge either the registration or the validity of a Community trade mark.

- 13 When determining the significance of the use made of a trade sign under Article 8(4) CTMR one must consider the territory in which it is used, the length of time and economic dimension of such use, the group of addressees among which the sign in question has become known as a distinctive element, namely consumers, competitors or even suppliers, or even of the exposure given to the sign, for example, through advertising or on the Internet (judgment of 24 March 2009, T-318/06 to T-321/06, "General Optica", par. 37).
- 14 The contested CTM application was filed on 27 June 2006. Therefore, the opponent was required to prove that the sign had been used in the course of trade in France before 27 June 2006 for the goods and services claimed.
- 15 The evidence provided by the opponent consists in its majority of a series of documents which refer to the legal status or administrative situation of the opponent, its membership in international organisations or the organisation of international congresses, mainly outside France. These documents are evidence of the existence of the opponent but cannot prove that the sign is known by a significant part of the French consumers.
- 16 The opponent furthermore claims to represent or have represented 3.000.000 French citizens. No evidence is however provided to show that the represented people know of its existence nor of the specific kind of activity which has been carried out under the sign. In order to prove the use of the sign it would have been necessary for the opponent to file, for example, a list of the members of the association living in France or indicate at least the number of members, through an independent source. No circulars or its quantitative distribution among interested people or members in France or any other document has been filed which permits to conclude that the claimed name has been used in relation to users in France for a specific relevant activity.
- 17 In its statement of grounds the opponent indicates that the Opposition Division has overlooked to assess the "certificate of admission as a member by right of the European Telecommunications Standards Institute (ETSI)". Such certificate proves only that the sign has been used on an international level, i.e. with regard to comparable institutions of other countries. It might even prove that certain representatives of third countries have encountered the representatives of the opponent's association. It does however not prove anything with regard to the here relevant French public and how impacted the sign on it.
- 18 The opponent remits further to its Internet site. Firstly, there is no evidence that the Internet site existed before June 2006. Secondly, the Internet site referred to is in English and cannot serve to prove that it has been used with regard to the here relevant French public. Thirdly, the mere fact that the Internet site existed would not be sufficient evidence of use. Such information should be complemented by statistics of visits to the Internet site by French users.
- 19 The opponent relies also on third party Internet sites. The submitted excerpt of the Internet site www.canal-9.org does not show the denomination "European Citizen's Band Federation". It is therefore not capable of demonstrating its use. The further Internet site www.rstowhictwo.org does not constitute a suitable

evidence of use either. Firstly, it is dated only on 23 March 2007 instead of on a date previous to the filing date of the application. Secondly, it is an English site which is, in principle, not consulted by the here relevant French public. Thirdly, the activity of the site has not been evidenced.

- 20 The Board observes further that it follows from the filed article on the 11th Congress of the ECBF at the UNESCO in Paris, issued by the opponent, that it understands itself as an umbrella organisation for European national associations. This would imply that it would basically relate in France with the corresponding French national organisation but not the individual French users or the French public.
- 21 Finally, the opponent claims to have used the sign for 'providing apparatus for its members, providing technical advice and for promotion of services of different kind'. However, none of the documents filed proves that the opponent rendered the services claimed.
- 22 The opponent has further not proved the use of the sign in trade. It has in fact not submitted any evidence of market appearance, i.e. to have sold any goods or services to a French public and namely no telecommunication goods as it claimed. The documents submitted suggest rather that the opponent is a lobbying organisation without any commercial activity.
- 23 The Board concludes that the opponent has not proven the use of the earlier sign 'European Citizen's Band Federation (ECBF)' for the goods and services claimed in France. For this reason the opposition is not well-founded. For reasons of procedural economy the Board will not assess the other conditions of Article 8(4) CTMR or the other discussion points between the parties.
- 24 It follows from the foregoing that the appeal has to be dismissed.

Costs

- 25 As the opponent ('appellant') is the losing party in the appeal proceedings within the meaning of Article 85(1) CTMR, it must be ordered to bear the costs incurred by the applicant ('applicant').

Fixing of costs

- 26 Pursuant to Article 85(6) CTMR in conjunction with Rule 94(3) CTMR, the decision of the Board shall, where applicable, include the fixing of the amount of the costs to be paid by the losing party. Since the respondent was not represented by a professional representative no representation costs are to be reimbursed.

Order

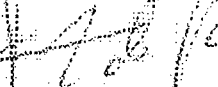
On those grounds,

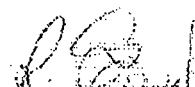
THE BOARD

hereby:

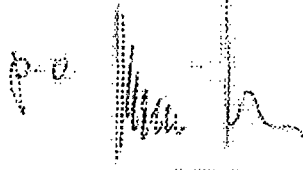
1. Dismisses the appeal;
2. Orders the appellant to bear the costs of the appeal proceedings;
3. Fixes the total amount of costs to be paid by the appellant to the respondent with respect to the opposition and appeal proceedings at EUR 0.


D. Schennen


P. López de Rego


A. Szanyi Félki

Registrar:



P. López Fernández de Corres