



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

Trade Marks Department

B206h

Notification to the applicant/holder of a decision

Alicante, 20/10/2008

European Citizen's Band Federation
Via Lanzone, 7
I-20123 Milano
ITALIA

<i>Your reference:</i>	ecbf
<i>Number of the opposition:</i>	B 1137712
<i>Trade mark number:</i>	005196274
<i>Name of the applicant/holder:</i>	European Citizen's Band Federation

Please see the attached decision which ends the opposition proceedings referred to above. It was delivered on **20/10/2008**.

Dorothee SCHLIEPHAKE

Enclosures (excluding the cover letter): 07 pages

Sent to fax number: 00 39-028057446

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 according to Rule 55(1) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark.



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

Opposition Division

11280

DECISION

of 20/10/2008

RULING ON OPPOSITION No B 1 137 712

Opponent: **European Citizen's Band Federation (ECBF)**
1 rue Salvador Allende
64000 Pau
France

Representative: **Cabinet German & Maureau**
8, avenue du Président Wilson
75016 Paris
France

Earlier sign: **EUROPEAN CITIZEN'S BAND FEDERATION**
(ECBF)

against

Applicant: **European Citizen's Band Federation**
Via Lanzone, 7
20123 Milano
Italy

Contested trade mark: **European Citizen's Band Federation (E.C.B.F.**
or ECBF)

I. FACTS AND PROCEDURE

On 27/06/2006 the applicant filed application No 5 196 274 to register the trade mark shown on the cover page for goods and services in classes 9, 38, 39, 41 and 45.

The opposition is directed against all of the goods and services covered by the contested trade mark.

The opposition is based on the name of the non-profit organization "EUROPEAN CITIZEN'S FEDERATION (ECBF)" used since 1976 in France and through national organizations also in Europe for the following activities:

- promote initiatives for setting free, checking, harmonizing and controlling citizen's band (CB) in Europe;
- represent users of citizen's band in Europe;
- be the sole European official entity in charge of matters concerning citizen's band and radio electric frequencies of individuals;
- help and produce useful technical rules to perform the above mentioned purposes;
- obtaining freedom for the whole 11 meters band (27 MHz);
- intervene in the process of free use for every citizen's band radio electric frequencies equipment, including AM, FM, SSB and every kind of antenna;
- intervene in a general way in every issue concerning the citizen's band which is a mean of all citizens and rescue operations, guard services;
- assist its members for putting their means in place (technical and legal advices; supply of some apparatus for a CB structure).

The federation was legally created on 08/09/1989.

The opponent bases its opposition on all of the activities that are covered by its earlier sign.

The grounds of the opposition are those laid down in Article 8(4) of the Community Trade Mark Regulation (CTMR).

The applicant argues that there are two different organizations with similar names, one is the opponent's organization and the other one the Italian organization founded by the applicant even before the opponent's organization has been founded. The applicant furthermore states that the French organization has only been created in order to function as a "service organization" of the Italian organization under a French General Secretary. It furthermore contests the validity of the certificates submitted by the opponent and insists that the activities of both organizations have been globally different over the years.

The applicant submitted extensive documentation to prove the existence and the activities of its organization.

The applicant puts furthermore forward that it was the representative, without any controversy, of the opponent's organization until October 2006.

The Office resumes that in the case at hand, both parties allege to be the owner or the creator of a non-profit organization EUROPEAN CITIZEN'S BAND FEDERATION (ECBF).

II. DECISION

2. Non-registered sign used in the course of trade – Article 8(4) CTMR

The opponent has relied on an earlier sign used in the course of trade as a base for its opposition, namely, the denomination of the non-profit organization "EUROPEAN CITIZEN'S BAND FEDERTION (ECBF)", used since 1976 in France and through national organizations also in Europe for the following activities:

- promote initiatives for setting free, checking, harmonizing and controlling citizen's band (CB) in Europe;
- represent users of citizen's band in Europe;
- be the sole European official entity in charge of matters concerning citizen's band and radio electric frequencies of individuals;
- help and produce useful technical rules to perform the above mentioned purposes;
- obtaining freedom for the whole 11 meters band (27 MHz);
- intervene in the process of free use for every citizen's band radio electric frequencies equipment, including AM, FM, SSB and every kind of antenna;
- intervene in a general way in every issue concerning the citizen's band which is a mean of all citizens and rescue operations, guard services;
- assist its members for putting their means in place (technical and legal advices; supply of some apparatus for a CB structure).

a) Legal Framework

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 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.

Article 8(4) CTMR lays down the following cumulative requirements, which must be satisfied for this provision to be applicable:

- 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.

According to Article 74(1) CTMR, in proceedings before it the Office shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

Therefore, the onus is on the party concerned to provide the Office with all the information necessary for the decision, and as regards rights falling under Article 8(4) CTMR specifically, with all the necessary information, including the applicable law concerning the existence of such right and its scope of protection.

As regards the law of the Member States applicable by virtue of Article 8(4) CTMR, in principle the Office treats this as an issue of fact. The Office is not in a position to determine with sufficient accuracy on its own motion what the law relating to Article 8(4) rights is in all the Member States. Treating this as an issue of fact, subject to proof by the party alleging such right, is in accordance with the approach of the courts in the Member States with respect to foreign law under their private international law principles.

b) Evidence filed by the opponent

In order to substantiate its claim the opponent filed the following evidence within the prescribed time limit:

- Copy of the Status of "FEDERATION EUROPEEN DE LA C.B." dated 08/09/1989 and the translation thereof.
- Recordal receipt issued by the Court of First Instance of Illkirch/France and the translation thereof.
- Publication of the inscription of the association in the register in the newspaper "L'ami du peuple", dated 25/02/1990 and the translation thereof.
- Copy of the statutes adopted in April 2000 and translation thereof.
- 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 and translation thereof.
- Copy of the law governing French non-profit organizations:
 - Law of 1901
 - Articles 21 to 71 of the Alsatian Civil Code and translation of these documents.
- List of the Members of the Board, drafted on 01/10/2006, at the Meeting of the Board. The modifications were reported to the corresponding authority (Préfecture des Pyrénées-Atlantiques) and translation thereof.

- 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 website giving general information about the Federation and translation thereof.
- Article about the 11th congress of the ECBF at the UNESCO at Paris, issued by the opponent.
- Extract from the French Intellectual Property Code

c) Assessment of the opponent's claim under Article 8(4) CTMR

The types of rights provided for in Article 8(4) CTMR are unregistered trade marks and other signs of a similar character to trade marks, referred to as "another sign" in the article. In these proceedings the opposition is based on the denomination of a non-profit organization, corresponding to a company name, claimed to be used for the following activities:

- promote initiatives for setting free, checking, harmonizing and controlling citizen's band (CB) in Europe;
- represent users of citizen's band in Europe;
- be the sole European official entity in charge of matters concerning citizen's band and radio electric frequencies of individuals;
- help and produce useful technical rules to perform the above mentioned purposes;
- obtaining freedom for the whole 11 meters band (27 MHz);
- intervene in the process of free use for every citizen's band radio electric frequencies equipment, including AM, FM, SSB and every kind of antenna;
- intervene in a general way in every issue concerning the citizen's band which is a mean of all citizens and rescue operations, guard services;
- assist its members for putting their means in place (technical and legal advices; supply of some apparatus for a CB structure).

The evidence submitted by the opponent shows clearly that the association has been legally established, that it holds congresses. On the other hand there is no indication of real use of the company name. The Office is not able to establish if the denomination "EUROPEAN CITIZEN'S BAND FEDERATION" is known by the public in France and in other European countries. Although the opponent submitted documents certifying that there are representations in several European countries. Nevertheless, all pieces of evidence, with the exception of the certificates of the inscription of the association and the modification of the association, are produced by the opponent itself.

"Used in the course of trade" is a specific European requirement, independent of any national requirements. In the absence of evidence of use a notice of opposition based on Article 8(4) CTMR will be rejected. At issue, there is no proof that the sign has been used in the field of activities it claimed to be used for.

The Office is aware that a non-profit organization like the opponent will not be able to present sales figures or similar evidence as proof of its activities. However, it could

have submitted brochures, official correspondence, press articles by third parties, etc. enabling the Office to estimate the importance of the use of the earlier sign.

d) Conclusion

The opponent did not prove that the earlier sign has been used in the course of trade and that this use was of more than local significance.

Therefore, two of the cumulative requirements of Article 8(4) CTMR are not fulfilled. The claim based on Article 8(4) CTMR is thus not well-founded and must be rejected.

e) Final remarks

For the sake of completeness the Office would like to comment on the arguments put forward by the applicant who sustained that its association has been founded before the opponent's association and that in fact the French association has been founded as a "service organization" of the Italian organization.

The right to a CTMA begins on the date when the CTMA is filed and not before, and from that date on the CTMA has to be examined with regard to opposition proceedings.

Therefore, when considering whether or not the CTMA falls under any of the relative grounds for refusal, events or facts which happened before the filing date of the CTMA are irrelevant because the rights of the opponent, insofar as they predate the CTMA, are earlier to the applicant's CTMA.

III. COSTS

According to Article 81(1) CTMR, 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 (7)(d)(ii) of Community Trade Mark Implementing Regulation (CTMIR), 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. In the present case the applicant did not appoint a representative within the meaning of Article 89 CTMR and therefore it did not incur in costs of representation.

Decision on Opposition No B 1 137 712

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**THE OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
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DECIDES TO:

1. Reject opposition number B 1 137 712 in its entirety.
2. Order the opponent to bear the costs.



The Opposition Division

Arne Führer

Dorothee Schliephake

Ralph Pethke

Under Article 58 CTMR any party adversely affected by this decision has a right to appeal against this decision. Under Article 59 CTMR notice of appeal must be filed in writing at the Office within two months from the date of notification of this decision and within four months from the same date a written statement of the grounds of appeal must be filed. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.