



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

The Boards of Appeal  
The Registry

R420b

Alicante, 29/11/2012  
R0332/2010-4

Antonio Campagnoli  
via Lanzone, 7  
I-20123 Milano  
ITALIA

Subject: Appeal No. R0332/2010-4  
Your ref.: 29041942

### **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 10/03/2010 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

Enc.: 1 (9 pages)  
Sent to fax No.: 0039028057446



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 332/2010-4

**European Citizen's Band Federation (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 Lanzoni, 7

I-20123 Milan

Italy

Respondent / Applicant

APPEAL relating to Opposition Proceedings No B 1 119 389 (Community trade mark  
application No 5 082 748)

**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

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Language of the case: English

DECISION OF 28 NOVEMBER 2012 -- R 332/2010-4 -- European Citizen Band Federation (E.C.B.F. or ECBF)  
EUROPEAN CITIZEN'S BAND FEDERATION (ECBF)

**Decision**

**Summary of the facts**

1 On 27 April 2006 Mr. Enrico Campagnoli sought to register the word mark

**European Citizen Band Federation (E.C.B.F.)**

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

Class 9 – Apparatus for signaling and for recording or reproduction of sound and images.

Class 38 – Telecommunications.

Class 41 – Education; providing of training; entertainment; sporting and cultural activities.

The CTM application was subsequently transferred to the European Citizen's Band Federation ('applicant') in Milan / Italy.

2 The French association 'European Citizen's Band Federation (ECBF)' ('opponent') filed on 16 January 2007 a notice of opposition against the application based on the use of the sign 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 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 within the substantiation period English translations of documents concerning the legal status and functioning of its association. The applicant claimed rights on the mark applied for previous to the application date and earlier than the opponent's rights. The opponent contested it.

5 On 13 January 2010 the Opposition Division adopted the contested decision which rejected the opposition. It reasoned essentially as follows:

- The evidence of use of the earlier sign, a necessary requirement of Article 8(4) CTMR, and submitted in due course consisted only of English translations of several documents without the respective originals. Such evidence does not have any probative value.
- In any event, the type of business identifier on which the opposition is based, namely a non-profit organization name is not listed in the Office's published guidelines. In such circumstances it was up to the opponent to provide evidence as regards the protection granted by the applicable national law, both in terms of requirements for acquisition of exclusive rights to the sign, and also as regards whether it confers upon its proprietor the right to prohibit the

use of a subsequent trade mark. The opponent did not provide any evidence in this respect.

- Even if the Office would construe the opposition as based on a trade name, the acquisition of exclusive rights to the name in question, according to the Office's published guidelines, requires use and knowledge throughout France. However, there is no evidence to this effect. Apart from not having any probative value, the submitted documentation does not provide any indications that the opponent's name has been used in the course of trade, and less so one of more than local significance. No knowledge throughout France has been substantiated either.

#### Submissions and arguments of the parties

6 On 10 March 2010 the opponent filed a notice of appeal against the contested decision, followed on 17 May 2010 by the statement of grounds. The opponent requests to reject the mark applied for. Its reasoning can be summarized as follows:

- The original documents, which the Opposition Division had declared to be missing, were filed together with the opposition notice on 16 January 2007.
- The opponent is the successor of the organisation founded on 29 April 1977, not the applicant.
- The opponent's sign has a wide scope of protection under French law. It is referred to in particular in Article 711.4 of the French Intellectual Property Code. Also, a trade name of a musical group without legal status (judgment of the Appeal Court of Paris No 06/22447 of 5 December 2007) was held to entitle the group to prohibit a subsequent commercial name.
- The opponent has used the name 'ECBF' in France since 1994 as evidenced by the following documents:
  - page 7 of the French magazine FRANCE CB, REVUE DE RADIOCOMMUNICATION (appendix 21 filed with the statement of grounds),
  - page 4 of the newspaper EXPRESSEN of 3 November 1992 (appendix 22),
  - pages 3 and 10 of the number 126 of June 1997 of the nation-wide magazine FRANCE CB (appendix 23),
  - excerpt of the website [www.camal-2.org](http://www.camal-2.org) (appendix 24).
- 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 entitled to act under the name 'European Citizen's Band Federation'. The applicant's organisation does not have legal existence. Instead of evidencing registration of the applicant's 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 Lombardy (app. 23). The Register of Companies of the Prefecture of Milan confirmed that the applicant is not registered in the Register (app. 24, 25). But, even if the applicant existed legally, the opponent would be the older one, dating back to 1977.

- 7 The applicant requests to uphold the contested decision and to reject the appeal. It supports the contested decision and submits the following further arguments:
- According to Italian law it is not necessary to be registered at a 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 statement of grounds), according to which the opponent enjoys legal capacity.
  - 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's organisation did not even exist. The Internet site [www.europeanacbf.org](http://www.europeanacbf.org) does not refer at all to the denomination in question. The same is true for the Internet site [www.ecbf.eu](http://www.ecbf.eu). The site [www.canal-9.org](http://www.canal-9.org) is managed by the general secretary of the opponent. The mention in the other web site [www.ndownlistwo.org](http://www.ndownlistwo.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 claimed goods and services in France.

#### *Preliminary remark*

- 9 The opponent claimed to have transmitted together with the opposition notice original documentation in support of the opposition. The Opposition Division stated that such documentation was not received within the deadline of the substantiation period. The Board observes that the opposition notice consisted of 10 pages according to the handwritten notes on each page. These ten pages consisted of the opposition notice form, the copy of the contested application and the grounds. No appendix was included. The further brief of 10 July 2007 was received on 13 July 2007. This brief contained as annexes diverse documents, all of them consisting of English translations of French original documents. The original French documents were not provided within the deadline of the substantiation period.

*Article 8(4) CTMR*

10 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.

11 Thus, the grounds of refusal of Article 8(4) CTMR are subject to the following requirements:

- The earlier sign must be of more than local significance and must have been used in the course of trade prior to the filing of the contested application;
- The opponent must have acquired rights to the sign on which the opposition is based, including the right to prohibit the use of a subsequent trade mark prior to the filing of the contested application;
- The conditions under which the use of a subsequent trade mark may be prohibited are fulfilled in respect of the contested trade mark.

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

13 The opponent has duly proven its existence as an 'association' under French law. Names of such associations can be relied on to prohibit the use of confusingly similar junior trade marks.

*Use in the course of trade*

14 The condition of use in the course of trade is a fundamental one. Lack of compliance with it means that the sign cannot enjoy protection against the registration of a Community trade mark, even if the requirements under national law in order to acquire exclusive rights are met. Furthermore, the sign must be of more than mere local significance. The rationale of that provision is to restrict the number of conflicts between signs: earlier signs which are not sufficiently important or significant cannot be used to challenge the registration or the validity of a Community trade mark.

15 When determining the significance of the use made of a trade sign under Article

8(4) CTMR the following should be considered: 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).

- 16 The contested CTM application was filed on 27 April 2006. The opponent was therefore required to prove that the sign on which the opposition is based was used in the course of trade in France before 27 April 2006. The use in trade must relate to the goods and services claimed by the opponent, i.e. 'telecommunications business and related products and services'.
- 17 The English translations, the only documents provided within the substantiation period, cannot be taken into account as the original French documents were not provided. In the absence of the original documents, the translations do not have probative value. The documents provided at a later stage are belated and cannot be taken into account for this reason.
- 18 Even if the whole set of documents provided would have been filed in time it is not sufficient to prove the use in trade of the earlier sign in France for the claimed goods and services.
- 19 The documents provided in the first instance only show the existence of the opponent as a non-profit organization with the aim to represent citizen band users and promote initiatives in their benefit. The opponent claims that it represents 3 000 000 users in France. However, it does not indicate and even less prove the number of members. It did not prove the sale of any products and services and namely not of the goods and services claimed.
- 20 The opponent filed further documents with the appeal and relies now for proving the use of the sign namely on these documents. Even if such documents had been filed in time, they would have not been sufficient since they do not serve the purpose of proving use of the earlier sign. Firstly, all the documents submitted refer to a different sign, i.e. a figurative sign, in which 'E.C.B.F.' is represented within a circle of 12 stars and with no mention of the opposing sign. Such a figurative sign cannot constitute use of the sign in question as the distinctive element "European Citizen's Band Federation" simply does not appear. In addition, appendix 22 of the opponent is an excerpt of a Swedish publication EXPRESSEN which, as such, cannot serve to evidence use of the sign in France.
- 21 Furthermore the documents do not prove that the opponent has used the mark in trade. None of the documentation provided evidences that the opponent has actually sold products or services. It infers rather from the allegations of the opponent and the documents filed that it is an association which provides lobby work in relation to the citizen band on an international or Community level with even no special focus on the French users. It follows that the opponent has not proven to have used its mark in trade. The opponent has not even provided a list of the French members of the association and/or the number of members it has in France from an independent source; its quantitative distribution among the

interested French public which could have proven at least that the name had had an impact on the relevant French public. In the absence of such information not even the impact on the French public could be assessed.

- 22 The opponent has furthermore not proven that the sign has been used in France for the goods and services claimed, i.e. for 'telecommunications business and related products and services'. The opponent did not claim to have sold these goods and services in France and no turnover figures for whatever product or service was submitted.
- 23 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.
- 24 The opponent relies also on third party Internet sites. The submitted excerpt of the Internet site [www.canal-9.org](http://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.ratowiswo.org](http://www.ratowiswo.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.
- 25 The further discussion points among the parties concerning previous rights of the applicant, bad faith etc. and the further conditions of Article 8(4) CTMR are in the present circumstances not relevant for the outcome of the case. It is therefore not necessary for the Board to address them.
- 26 Since one of the conditions of Article 8(4) CTMR is not complied with the opposition is not successful. Thus the appeal has to be dismissed.



**Costs**

- 27 As the opponent ('appellant') is the losing party, it must be ordered to bear the corresponding costs incurred by the applicant ('respondent') in the appeal proceedings.

**Fixing of costs**

- 28 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**

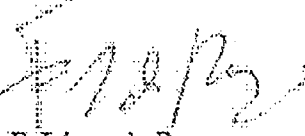
On those grounds,

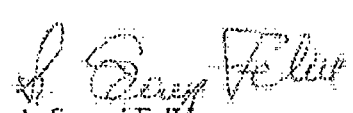
**THE BOARD**

hereby:

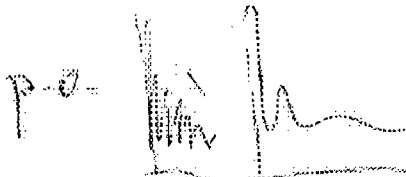
1. Dismisses the appeal;
2. Orders the appellant to bear the costs of the respondent in the appeal proceedings;
3. Fixes the amount of costs to be paid by the appellant to the respondent with respect to the opposition and appeal proceedings at EUR 0.

  
D. Sefremén

  
F. López de Rego

  
A. Szanyi Felki

Registrar:

  
P-0-

P. López Fernández de Corres