

CANCELLATION No 34 124 C (INVALIDITY)

Interstyle B.V., Breedstraat 7, 3512 TS Utrecht, The Netherlands (applicant), represented by **Robert Sampat**, Enny Vredelaan 299, 3484 ZK Utrecht, The Netherlands and **Leentje Marianne Splinter**, Jan Huijgenstraat 3, Haarlem, 2012 VC, The Netherlands (professional representatives)

a g a i n s t

Casa International naamloze vennootschap, Domuslaan 4, 2250 Olen, Belgium (EUTM proprietor), represented by **Bureau M.F.J. Bockstael NV**, Arenbergstraat 13, 2000 Antwerpen, Belgium (professional representative).

On 08/05/2020, the Cancellation Division takes the following

DECISION

1. The application for a declaration of invalidity is upheld.
2. European Union trade mark No 3 017 662 is declared invalid in its entirety.
3. The EUTM proprietor bears the costs, fixed at 1 080.

REASONS

The applicant filed an application for a declaration of invalidity against European Union



trade mark No 3 017 662 (figurative mark) (the EUTM). The request is directed against all the goods and services covered by the EUTM, namely:

Class 4: *Candles, wicks (lighting).*

Class 16: *Paper, cardboard and goods made from these materials, not included in other classes; printed matter; stationery; adhesives for stationary or household purposes; artist' materials; brushes; typewriters and office requisites (except furniture); plastic materials for packing (not included in other classes); plastic materials for packing (not included in other classes); printing types; all relating to investment matters.*

Class 20: *Furniture, mirrors and picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber,*

mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

Class 21: *Household or kitchen utensils and containers (not of precious metal or coated therewith or silver-plated); combs and sponges; hair for brushes; brush-making materials; materials for cleaning purposes; steel-wool; unworked or semi-worked glass (except glass used in buildings); articles of glass, porcelain or earthenware not included in other classes.*

Class 24: *Textile fabrics and products not included in other classes; bed blankets; bedding; table covers; curtains; household linens.*

Class 35: *Wholesale and retail trading in furniture, decorative articles, domestic goods and household products.*

The applicant invoked Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) and (c) EUTMR.

SUMMARY OF THE PARTIES' ARGUMENTS

The applicant argues in both its submissions that the word CASA derives from Latin and Spanish language and it is currently used in writing as well as daily used in the meaning of home/house/barrack. It considers that at least a considerable part of the (relevant) public of the European Union, partly in view of the frequent use of this Latin word within the public domain, is (and in 2003: was) informed of the general meaning of the word CASA and its descriptive nature, namely "house/dwelling" or products intended for use in and around a house or at home. To substantiate the above, the applicant makes reference to the relatively large number of entries in the European Trademark Register (in total 2400), as well as the more than 1100 entries in the Tradename Register of the Chamber of Commerce in the Netherlands and the 200 entries in the Crossroads Bank of Enterprises in Belgium, in which the word CASA is incorporated. In addition, it makes reference to the many trademark applications at both EUIPO and BOIP including the word CASA and the many refusals of EUTM applications, including, but not limited to, CASA MEVA, OTTIMA CASA, CASA.IT, MI CASA, CASA (class 9), CASA DEL BIANCO (class 24), CASA RUSTICA (class 20).

Therefore the applicant considers that the contested mark consists exclusively of signs or designations which may serve, in trade, to designate the kind, quality, intended purpose, performance of the service or other characteristics of the goods or services, as described in Article 7 (1) (c) EUTMR in conjunction to Article 59(1)(b) EUTMR, and thus in relation to the goods and services for which the contested mark is registered (in short, home articles/home accessories). The applicant also considers that the additional elements in the contested mark are not so independently distinctive compared to the dominant and purely descriptive element CASA therein. Consequently, these additional elements cannot serve to fulfil the essential function of a trademark for the goods and services in question.

In addition, it considers that the contested mark has not acquired distinctive character through use before its filing date or between its registration date and the present application in invalidity in 2019. Before 2003, it was not used in many territories composing the EU at that time. Between 2007 and 2019, the evidence of use does not

show that the public in the EU is able to identify the goods or services as originating from the proprietor's company.

In both its submissions, **the EUTM proprietor** argues that it is impossible to maintain that the word "CASA" is commonly used in the countries of the European Union, since this word has only a meaning in Spanish, Italian and Portuguese. In these languages the word "CASA" means "HOUSE". The attacked EUTM No.003017652 consists of a combination of word and figurative elements. This combination has distinctive character. At the time of the filing of this trademark in 2003, the EUIPO clearly was of the opinion that the combination of the word "CASA" in a green square had distinctive character as it accepted the trademark without any objections. The first use of the trademark "CASA" goes back to 1975. Regularly stores at other locations were opened and in 1985 there were already 41 "CASA" shops in the Benelux countries (39 in Belgium and 2 in The Netherlands). We enclose a brochure of April 1985. After a period of gradual growth, CASA expanded exponentially as from 1988. In 1999 there existed 72 "CASA" shops. In 2003, at the time of filing of the attacked EUTM, there already existed 465 "CASA" shops. At present there are more than 500 "CASA" shops in 11 European countries. 8 countries are members of the European Union (Belgium, France, Italy, Luxembourg, The Netherlands, Portugal and Spain) and 3 countries are outside the European Union (Aruba, Morocco and Switzerland). The EUTM proprietor considers that the contested trademark has gained a serious level of distinctive character over these past years and can count on the appreciation of the consumers who recognise this trademark as an identifier. This distinctive character has only increased between 2003 and 2019 because of the continued, uniform and consistent use of the contested trademark.

In support of its observations, the EUTM proprietor filed the following evidence:

- Before 1989 : 2 brochures of 1985 and of 1988
- From 1989 onwards: 2 brochures per year used in Belgium and in France
- From 1990 onwards: 2 brochures per year showing the use in Portugal
- From 1993 onwards: 2 brochures per year showing the use in Spain
- From 2008 onwards: 2 brochures per year showing the use in Italy
- From 2018 onwards: 2 brochures per year showing the recommenced use in the Netherlands.
- Current overview of the locations of CASA shops in Europe.

ABSOLUTE GROUNDS FOR INVALIDITY – ARTICLE 59(1)(a) EUTMR IN CONJUNCTION WITH ARTICLE 7 EUTMR

According to Article 59(1)(a) and (3) EUTMR, a European Union trade mark will be declared invalid on application to the Office, where it has been registered contrary to the provisions of Article 7 EUTMR. Where the grounds for invalidity apply for only some of the goods or services for which the European Union trade mark is registered, the latter will be declared invalid only for those goods or services.

Furthermore, it follows from Article 7(2) EUTMR that Article 7(1) EUTMR applies notwithstanding that the grounds of non-registrability obtain in only part of the Union.

As regards assessment of the absolute grounds of refusal pursuant to Article 7 EUTMR, which were the subject of the ex officio examination prior to registration of the EUTM, the Cancellation Division, in principle, will not carry out its own research but will confine itself to analysing the facts and arguments submitted by the parties to the invalidity proceedings.

However, restricting the Cancellation Division to an examination of the facts expressly submitted does not preclude it from also taking into consideration facts that are well known, that is, that are likely to be known by anyone or can be learned from generally accessible sources.

Although these facts and arguments must date from the period when the European Union trade mark application was filed, facts relating to a subsequent period might also allow conclusions to be drawn regarding the situation at the time of filing (23/04/2010, C-332/09 P, *Flugbörse*, EU:C:2010:225, § 41 and 43).

No legitimate expectations arising from registration

The registration of a European Union trade mark cannot give rise to a legitimate expectation for the proprietor of that mark with regard to the result of subsequent invalidity proceedings, since the applicable rules expressly allow for that registration to be challenged subsequently in an application for a declaration of invalidity or a counterclaim in infringement proceedings (19/05/2010, T 108/09, *Memory*, EU:T:2010:213, § 25).

Otherwise, challenging the registration of an EUTM in the context of invalidity proceedings would, where the subject-matter and the grounds were the same, be deprived of any practical effect, even though such a challenge is permitted under the EUTMR (22/11/2011, T 275/10, *Mpay24*, EU:T:2011:683, § 18).

Descriptiveness – Article 59(1)(b) EUTMR in relation with Article 7(1)(c) EUTMR

Under Article 7(1)(c) CTMR, ‘trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’ are not to be registered.

It is settled case-law that each of the grounds for refusal to register listed in Article 7(1) CTMR is independent and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration must reflect different considerations according to the ground for refusal in question (see judgment of 16/09/2004, C-329/02 P, *SAT.1*, paragraph 25).

According to settled case-law, the signs and indications referred to in Article 7(1)(c) CTMR are those which may serve in normal usage, from a consumer’s point of view, to designate, either directly or by reference to one of their essential characteristics, goods such as those in respect of which the contested CTM is registered (see judgment of 22/06/2005, T-19/04, *PAPERLAB*, paragraph 24).

In accordance with the same case-law, for a sign to be caught by the prohibition set out in Article 7(1)(c) CTMR, there must be a sufficiently direct and specific relationship between the sign and the goods in question to enable the public concerned immediately to perceive, without further thought, a description of the goods in question or one of their characteristics (*PAPERLAB*, loc. cit., paragraph 25). Moreover, in order to be caught by Article 7(1)(c) CTMR, it is sufficient that at least one of the possible meanings of a word sign designates a characteristic of the goods concerned (see judgment of 10/02/2010, T-344/07, *Homezone*, paragraph 21).

The existence of such a relationship must be assessed, firstly, in relation to the goods covered by the contested CTM and, secondly, in relation to the perception of the relevant public (see judgment of 14/06/2007, T-207/06, EUROPIG, paragraph 30).

By prohibiting the registration as Community trade marks of the signs and indications to which it refers, Article 7(1)(c) CTMR pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see judgment of 23/10/2003, C-191/01 P, Wrigley, paragraph 31).

Relevant point in time, relevant public and level of attention

The Cancellation Division notes that the relevant point in time in respect of which the assessment on the claimed descriptive and non-distinctive character of the sign must be made is the filing date. In other words, it is necessary to establish whether the term was seen as a term designating an essential feature of the goods concerned, or was perceived as non-distinctive in relation to those goods, at the time of its filing (i.e. 22/10/2003). The contested trade mark has been registered with numerous seniorities but none from the three countries where the absolute grounds for refusal were raised, therefore this fact is without relevance in the present case and in any event, it has not been mentioned by the EUTM proprietor.

The contested goods and services are included in classes 4, 16, 20, 21, 24 and 35 as listed above.

They are broadly speaking intended for the general public and can be purchased by all kinds of consumers. In accordance with settled case-law, the general public must be deemed to pay a normal degree of attention. Therefore, as regards these goods, the degree of attentiveness to be taken into consideration is that of the average consumer, deemed to be reasonably well informed and reasonably observant and circumspect (judgment of 22/06/1999, C-342/97, Lloyd Schuhfabrik Meyer, paragraph 26), even if some specific goods that are not bought on a daily basis, the level of attention can be higher (furniture in particular). The services in Class 35 are directed at both public at large and business consumers (wholesale) who may have a higher than average degree of attention.

Furthermore, the mark consists of an Italian, Spanish or Portuguese word CASA meaning house or home. Although the applicant makes reference to all the territories of the European Union, the arguments provided in order to show that the word at issue is normally understood all over the European Union are not convincing. The Latin root is not enough to consider that the word would be understood outside the three countries mentioned above without additional arguments (such as proximity between the equivalent word in other languages or evidence of use of CASA in other languages). Therefore, the Cancellation Division agrees with the EUTM proprietor that relevant public is the Italian, Spanish and Portuguese speaking parts of that public.

Trade marks which meaning is mainly perceived by the target consumer as an informative message more than the indication of the commercial origin of the services are devoid of distinctive character (see judgement of 03/07/2003, T-122/01, Best Buy, paragraph 30). While the goods and services of course can be used in locations other than the home, there is a specific market for goods and services that are intended for the

home and therefore consumers would not see a term such as this as unusual, in fact it is usual to refer to “homewares” – i.e. goods for the home.

Therefore, the mark consists essentially of an expression that, notwithstanding certain stylised elements, conveys obvious and direct information regarding the kind and intended purpose of the goods in question and related services. It follows that the link between the word element 'CASA' and the goods and services referred to in the contested registration is sufficiently close for the sign to fall within the scope of the prohibition laid down by Article 7(1)(c) in conjunction with Article 7(2) EUTMR.

Contested goods and services

The contested goods and services are included in classes 4, 16, 20, 21, 24 and 35 as listed above.

It is not to be noted that the contested trade mark was filed in French and according to Article 147(3) EUTMR, in cases of doubt, the text in the language of the Office in which the application for the EU trade mark was filed shall be authentic. In the present case, the contested application was filed in French and the list of goods in French is, therefore, the authentic version. In case of discrepancy between the first and second language, the legally binding version is the first language, therefore the limitation “*all relating to investment matters*” in class 16 will be ignored as it is not present in the original French version .

In the present case, the contested goods are basically furniture, decorative articles, domestic goods and household products in classes 4, 20, 21, 24 and the services in class 35 are all related to these goods as well. In addition, there are different materials, including raw materials of different types (paper, cardboard, plastic, textile, glass, undefined brush making materials) in classes 16, 21 and 24. It is common knowledge that if these materials are offered for sale under the word “home” or “house”, it will be understood that they can be offered and used by the average public in order to make or even pack its own decorative articles and crafts at home.

As to the contested typewriters and office requisites (except furniture) in class 16, considering the expansion of teleworking, this type of goods traditionally reserved to offices are more and more specifically offered as household goods (knowing that typewriters are probably collector or even decorative goods nowadays).

When applied to the goods and services, 'CASA', immediately informs consumers without further reflection that the offered goods and services are designed for the house or offered for customers home. The verbal element 'CASA' will be perceived by the relevant customers merely as a reference to the intended purpose and the category of the goods and related services, namely goods designed for the house or home.



The addition of figurative elements or characteristics does not render the mark distinctive as the squared background is a very basic shape, the

stylisation of letters is banal and the colours are basic colours (white and green). Therefore, the Cancellation Division concurs with the applicant that the figurative elements of the mark do not render the mark as a whole distinctive, and that the relevant public will simply view the mark in its entirety as a descriptive indication as detailed above.

Based on the above, the Cancellation Division finds that contested mark is descriptive for all the goods and services for which it is registered, including for the part of the public displaying a higher than average level of attention considering the plain meaning of the word CASA in the relevant languages.

Consequently, the trade mark as a whole is descriptive of the goods and services registered under the contested mark. It follows that the EUTM has been registered contrary to Article 7(1)(c) in conjunction with Article 7(2) EUTMR in relation to the contested goods and services.

Non-distinctiveness – Article 59(1)(b) EUTMR in relation with Article 7(1)(b) EUTMR

Under Article 7(1)(b) EUTMR, ‘trade marks which are devoid of any distinctive character’ are not to be registered.

The marks referred to in Article 7(1)(b) EUTMR are, in particular, those that do not enable the relevant public ‘to repeat the experience of a purchase, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition of the goods or services concerned’ (judgment of 27/02/2002, T-79/00, ‘LITE’, paragraph 26). This is the case for, inter alia, signs commonly used in connection with the marketing of the goods or services concerned (judgment of 15/09/2005, T-320/03, ‘LIVE RICHLY’, paragraph 65).

The applicant claims that the mark is non-distinctive because it is descriptive, and also because the figurative element in the mark does not endow it with distinctiveness.

As concluded above, the Cancellation Division finds that the contested mark is descriptive for all the registered goods and services, and that the figurative device included in the mark does not endow the mark as a whole with distinctiveness.

The Cancellation Division has come to the conclusion that the mark is descriptive for all the goods and services at issue. In addition, it would not be seen as an indication of commercial origin as the term “CASA” when it is seen together with goods and services in relation with homes, the relevant consumers would not give the term any trade mark significance.

In light of the above, the application based on Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) and Article 7(2) EUTMR is endorsed.

Acquired distinctiveness

The EUTM proprietor claims that the contested EUTM had acquired distinctiveness before and/or after the filing of the EUTM application/registration of the EUTM. The EUTM proprietor has supplied the Office with evidence, pursuant to Article 59(2) EUTMR and Article 7(3) EUTMR, in support of a finding of acquired distinctiveness.

In this case, it was incumbent upon the EUTM proprietor to demonstrate to the Cancellation Division that its EUTM had acquired distinctive character in the part of the European Union where the absolute ground for refusal arose, namely in Italy, Spain and Portugal either before the date of filing of the mark on 22/01/2003 or between the date of registration on 13/04/2007 and the application for declaration of invalidity on 22/03/2019.

The evidence establishes without question that CASA is a brand name in relation to household goods and services over numerous countries including Italy, Spain and Portugal.

When assessing in a particular case whether distinctive character has been acquired through use, account must be taken of factors such as, inter alia, the market share held by the mark, the intensity, geographical scope and duration of the use of the mark and the amount invested by the undertaking in promoting the mark. Proof that distinctive character has been acquired may, in particular, be found in statements made by chambers of commerce and industry or other trade and professional associations or in the results of surveys (10/11/2004, T 396/02, Karamelbonbon, EU:T:2004:329, § 56-59).

The material submitted as evidence by the EUTM proprietor is mainly composed of leaflets and there is no qualitative evidence whatsoever showing the perception of the public and not only use of the mark. Leaflets are no basis on which to conclude that the contested mark is recognised as the EUTM proprietor's trade mark in three big Member States of the internal market.

There must be a close nexus established, on the evidence, between the imposing market share figures, turnover, advertising expenditure, and notoriety of the CASA on the one side, and the exposure of the public to the contested mark, on the other. The EUTM proprietor has not made that connection. There is no way of knowing, on this evidence, whether the expansion of CASA around Europe translate into public recognition of the mark in question in this case. It is not even possible to make a reasonable extrapolation, since there is no qualitative evidence.

It must be shown that the mark had acquired distinctiveness among the relevant public and the applicant has clearly failed to do so.

Consequently, the EUTM proprietor has not shown that the mark has acquired distinctiveness among the relevant consumers in the relevant territories, and the claim under Article 7(3) EUTMR and Article 59(2) EUTMR is rejected.

Conclusion

In the light of the above, the Cancellation Division concludes that the application is totally successful and the European Union trade mark should be declared invalid for all the contested goods and services.

COSTS

According to Article 109(1) EUTMR, the losing party in cancellation proceedings must bear the fees and costs incurred by the other party.

Since the EUTM proprietor is the losing party, it must bear the cancellation fee as well as the costs incurred by the applicant in the course of these proceedings.

According to Article 109(1) and (7) EUTMR and Article 18(1)(c)(ii) EUTMIR, the costs to be paid to the applicant are the cancellation fee and the costs of representation, which are to be fixed on the basis of the maximum rate set therein



The Cancellation Division

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PALOMARES

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 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.