

**DECISION  
of the Second Board of Appeal  
of 13 July 2021**

In case R 1280/2020-2

**Casa International**

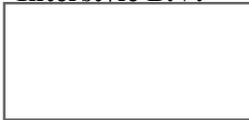


EUTM Proprietor / Appellant

represented by Bureau M.F.J. Bockstael NV, Arenbergstraat 13, 2000 Antwerpen, Belgium

v

**Interstyle B.V.**



Cancellation Applicant / Defendant

represented by Robert Sampat, Enny Vredelaan 299, 3484 ZK Utrecht, The Netherlands and Leentje Marianne Splinter, Jan Huijgenstraat 3, 2012 VC Haarlem, The Netherlands

APPEAL relating to Cancellation Proceedings No 34 124 C (European Union trade mark registration No 3 017 662)

THE SECOND BOARD OF APPEAL

composed of S. Stürmann (Chairperson), H. Salmi (Rapporteur) and C. Negro (Member)

Registrar: H. Dijkema

gives the following

## Decision

### Summary of the facts

- 1 By an application filed on 22 January 2003, Casa International ('the EUTM proprietor') sought to register the figurative mark ('the contested mark')



for the following list of goods and services (in English, the second language of the proceedings):

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; steelwool; 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.

- 2 In French, the first language of the contested mark, the list of the Class 16 goods does not contain the wording 'all relating to investment matters'

- 3 The EUTM proprietor claimed the colours:

Green and white.

- 4 The application was published on 16 August 2004 and the mark was registered on 13 April 2007.
- 5 On 22 March 2019, Interstyle B.V. ('the cancellation applicant') filed a request for a declaration of invalidity of the registered mark for all the above goods and services.
- 6 The grounds of the request for a declaration of invalidity were those laid down in Articles 7(1)(b) and (c) EUTMR.
- 7 By decision of 8 May 2020 ('the contested decision'), the Cancellation Division declared the invalidity of the contested EUTM in its entirety. It gave, in particular, the following grounds for its decision:
  - The goods and services at issue are broadly speaking intended for the general public. 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 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.
  - 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 relevant public is the Italian, Spanish and Portuguese speaking parts of that public.
  - 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.
  - The contested 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.
  - 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. The 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.

- In addition to the finding that the mark is descriptive – and therefore devoid of distinctive character, the contested mark 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, would not give be given any trade mark significance the relevant consumers.
  - As to the acquired distinctiveness claim, the evidence submitted establishes without question that ‘CASA’ is a brand name in relation to household goods and services over numerous countries including Italy, Spain and Portugal.
  - The evidence submitted 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.
  - 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.
- 8 On 23 June 2020, the EUTM proprietor filed an appeal against the contested decision.
  - 9 On 7 July 2020, the Office entered a *right in rem* with respect to the contested EUTM No 3 017 662 in the EUTM Register.
  - 10 On 8 September 2020, the EUTM proprietor filed the statement of grounds of the appeal.
  - 11 On 1 October 2020, the EUTM proprietor submitted further evidence.
  - 12 On 6 October 2020, the cancellation applicant filed a request for a separate and formal decision by the Boards on the additional evidence submitted. Furthermore, it requested the Board to take a decision on possible further evidence submitted. Finally, it requested an extension of two months to file its observations to the statement of grounds.
  - 13 On 23 October 2020, the parties were informed that the Board will decide on the cancellation applicant’s requests of 6 October 2020 in due time as well as that the cancellation applicant would be informed of a new time limit to submit observations.

- 14 On 30 October 2020, the Rapporteur sent a Communication to the cancellation applicant in which it was mentioned that the Board would not grant the request for a separate and formal decision on the additional evidence. Furthermore, the cancellation applicant was invited to file observations on the appeal within a two-month period.
- 15 On 31 December 2020, the cancellation applicant filed its observations.
- 16 On 5 January 2021, the EUTM proprietor, referring to its writings of 1 October 2020, submitted further evidence.
- 17 On 10 February 2021, the cancellation applicant was given one month to file its comments to the EUTM proprietor's communication of 5 January 2021.
- 18 On 9 March 2021, the cancellation applicant submitted its observations

### **Submissions and arguments of the parties**

- 19 The EUTM proprietor requests the Board to reject the contested decision so that the contested mark may continue to registration in the European Union. Its arguments raised in the statement of grounds are summarised as follows :
  - The Office did not raise any absolute ground of refusal with respect to the contested mark or several other 'CASA' trade marks in the name of the cancellation applicant at their time of filing.
  - In the largest part of the European Union, the word 'CASA' is not a generic name or a descriptive sign.
  - The contested mark, in use since 1975, has gained a high level of distinctive character over the past years. The distinctive character was already present at the filing date and has only been increased between 2003 and 2019.
  - At the time of filing the contested mark was used for 465 'CASA' shops. Now, the contested mark is used by more than 500 'CASA' shops in many European Union countries. The use has been uniform and consistent in all the 'CASA' shops and on all brochures, labelling, etc. The own goods have a 'CASA' label and the other goods have price tags, on which the 'CASA' device is represented.
  - The Spanish and Portuguese trade mark authorities – countries in which 'CASA' has a meaning – have granted the contested mark the status of distinctive mark.
- 20 The cancellation applicant requests the Board to confirm the contested decision and to dismiss the appeal in its entirety. The cancellation applicant submits that all its arguments put forward in the proceedings of the Cancellation Division should be considered repeated and inserted in the appeal proceedings. Furthermore, it mentions that it agrees fully with the conclusions of the Cancellation Division and with the considerations that have led to them but with the exception of the following. Firstly, it alleges and elaborates thereupon that the

relevant public should not be limited to only the Italian-, Spanish- and Portuguese-speaking parts of the European Union. It stresses, in particular, the perception of the Dutch-speaking public. Secondly, it alleges that contrary to the Cancellation Division, the evidence submitted by the appellant shows at most use of a company name, a trade name, or a shop name, and not as use of a trade mark in relation to household goods. As to the documents submitted after the expired deadline, the cancellation applicant alleges that these should all be disregarded. Furthermore, it is alleged that these documents, including the market surveys, do not demonstrate acquired distinctiveness.

## **Reasons**

### *Preliminary remarks*

- 21 The date on which the application for registration of the mark was filed, that is 22 January 2003 is decisive for the purposes of identifying the applicable substantive law, the facts of the case are governed by the substantive provisions of Regulation No 40/94 ('CTMR') (16/06/2021, T-215/20, HYAL, EU:T:2021:371, § 17 and case-law cited). For completeness sake, the relevant substantive provisions in the case at hand of Regulation No 40/94 and Regulation 2017/1000 are, in essence, identical.
- 22 Furthermore, procedural rules are generally held to apply on the date on which they enter into force (16/06/2021, T-215/20, HYAL, EU:T:2021:371, § 19 and case-law cited).
- 23 Bearing in mind that the appeal before the Board of Appeal was filed on 23 June 2020, the relevant procedural provisions are those laid down in Regulation 2017/1001 ('EUTMR'), and Delegated Regulation 2018/625 ('EUTMDR').

### *Admissibility of the appeal*

- 24 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

### *Article 51(a) CTMR in conjunction with Article 7(1) and (2) CTMR*

- 25 Pursuant to Article 51(1)(a) CTMR (now 59(1)(a) EUTMR), the invalidity of an EU trade mark is to be declared, on application to the Office, where the EU trade mark has been registered contrary to the provisions of Article 7 of that Regulation.
- 26 Pursuant to Article 51(3) CTMR (now 59(3) 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.
- 27 The provisions of Article 7(1)(b) and 7(1)(c) CTMR overlap to a large extent and a word mark that is descriptive of certain characteristics of the goods and services

in question is on that account necessarily devoid of any distinctive character in relation to those goods and services (12/02/2004, C-265/00, Biomild, EU:C:2004:87, § 18-19). A mark may none the less be devoid of distinctive character in relation to goods or services also for reasons other than the fact that it may be descriptive (25/06/2020, T-133/19, OFF-WHITE (fig.), EU:T:2020:293, § 51-53 and case-law cited).

- 28 Pursuant to Article 7(2) CTMR, the provisions of Article 7(1) are to apply notwithstanding that the grounds of non-registrability obtain in only part of the Union. It has been held that the part of the European Union referred to in Article 7(2) CTMR/EUTMR may, where appropriate, consist of a single Member State (09/09/2020, T-187/19, Colour Purple - 2587C (col.), EU:T:2020:405, § 80 and case-law cited).
- 29 Furthermore, the relevant point in time in respect of which the Article 7(1)((b) and (c) CTMR assessment must be made is the filing date.
- 30 The European Union trade mark is regarded as valid until it has been declared invalid by the Office following invalidity proceedings. It therefore enjoys a presumption of validity, which is the logical consequence of the review carried out by the Office in the examination of an application for registration (21/04/2015, T-359/12, Device of a checked pattern (maroon & beige), EU:T:2015:215, § 60 and the case-law cited).
- 31 By virtue of that presumption of validity, the Office's obligation, to examine of its own motion the relevant facts which may lead it to apply absolute grounds for refusal, is restricted to the examination of the application for a European Union trade mark carried out by the examiners and, on appeal, by the Boards of Appeal during the procedure for registration of that mark. In invalidity proceedings, as the registered European Union trade mark is presumed to be valid. It is for the person who has filed the application for a declaration of invalidity to invoke before the Office the specific facts which call the validity of that trade mark into question (21/04/2015, T-359/12, Device of a checked pattern (maroon & beige), EU:T:2015:215, § 61 and the case-law cited).
- 32 However, the Office (both the Cancellation Division and the Boards of Appeal) can take into consideration well-known facts, which are those to be known by anyone or can be learned from generally accessible sources. Thus, the Office is required to take into account the existence of well-known facts that the examiner might have omitted to take into consideration in the registration procedure (21/04/2015, T-359/12, Device of a checked pattern (maroon & beige), EU:T:2015:215, § 62-63 and the case-law cited).
- 33 Finally, although the aforesaid facts must date from the period when the European Union trade mark 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 23/04/2010, C-332/09 P, FLUGBÖRSE, EU:C:2015:225, § 41-43).

*Legitimate expectations*

- 34 The EUTM proprietor argues that the Office had not raised any absolute ground of refusal with respect to the contested mark or several other ‘CASA’ trade marks in name of the cancellation applicant at their time of filing.
- 35 Firstly, as correctly pointed out by the Cancellation Division, 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. 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 are 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).
- 36 In addition, the Board cannot be bound by decisions of first instance which, as in the case at hand, have not been appealed (28/06/2017, T-479/16, AROMASENSATIONS (fig.), EU:T:2017:441, § 42 and the case-law therein cited; 22/05/2014, T-228/13, EXACT, EU:T:2014:272, § 48). This applies even more for trade marks accepted by the first instance which lack any apparent motivation in their findings as to the accepted distinctive character of the contested mark (see also in this respect, 15/10/2020, T-48/19, smart:)things, EU:T:2020:483, § 58).

*Article 51(a) CTMR in conjunction with Article 7(1)(c) CTMR*

- 37 It follows from Article 7(1)(c) CTMR, that 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.
- 38 According to the case-law, Article 7(1)(c) CTMR prevents the signs and indications referred to therein from being reserved to one undertaking alone because they have been registered as trade marks. That provision thus pursues an aim which is in the public interest, namely that such signs or indications may be freely used by all (02/12/2020, T-26/20, Forex, EU:T:2020:583, § 27 and case-law cited).
- 39 Furthermore, signs or indications which may serve, in trade, to designate characteristics of the goods or service in respect of which registration is sought are, by virtue of Article 7(1)(c) CTMR, regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services, thus enabling the consumer who acquires the goods or services designated by the mark to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (02/12/2020, T-26/20, Forex, EU:T:2020:583, § 28 and case-law cited).

- 40 It follows that, in order for a sign to be caught by the prohibition set out in Article 7(1)(c) CTMR, there must be a link between the sign and the goods or services in question that is sufficiently direct and specific to enable the public concerned to immediately perceive, without further thought, a description of the goods or services in question or of one of their characteristics (02/12/2020, T-26/20, Forex, EU:T:2020:583, § 29 and case-law cited).
- 41 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 (10/02/2010, T-344/07, Homezone, EU:T:2010:35, § 21).
- 42 It must also be borne in mind that the assessment as to whether a sign is descriptive can be carried out only, first, in relation to the perception which the public concerned has of that sign and, secondly, in relation to the goods or services at issue (02/12/2020, T-26/20, Forex, EU:T:2020:583, § 30 and case-law cited).
- 43 It is in the light of the foregoing that the Board will assess the applicability of Article 51(1)(a) in conjunction with Article 7(1)(c) CTMR at the filing date of the contested mark, namely 22 January 2003.
- 44 The contested mark covers the following goods and services:
- Class 4 - Candles, wicks (lighting);
- 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, meerscham 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; steelwool; unworked or semiworked 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.
- 45 With respect to Class 16, there is a discrepancy. The goods in Class 16 read, according to English, the second language of the application as follows (emphasis added):
- 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.
- 46 The list of Class 16 goods in French, the first language of the applicant, does not contain the additional text: ‘all relating to investment matters’.
- 47 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 (see Article 116(3) CTMR). In

the present case, the contested application was filed in French and the list of goods in French is, therefore, the authentic version. As correctly pointed out by the Cancellation Division, 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 (17/02/2017, T-369/15, Paloma / Paloma (fig.), EU:T:2017:106, § 40; 31/01/2013, T-66/11, Babilu, EU:T:2013:48, § 46).

- 48 The relevant public of the goods and the retail services at issue is the professional public as well as the non-professional public or the public at large. The level of attention and awareness of the public at large is either average (e.g. in relation to the Class 4 and 24 goods) or higher than average (e.g. in relation to the furniture in Class 24). The level of attention and awareness of the professional public is in principle higher than that of the public at large.
- 49 As to the wholesale services, these are directed at a professional public with a high degree of attention.



- 50 The contested mark is the figurative mark .
- 51 This figurative mark contains the clearly legible word ‘CASA’. Apart from being a well-known fact, it is common ground between the parties that the word ‘ casa’ means – and meant at the filing date of the contested mark – ‘house’ in Spanish, Portuguese and Italian.
- 52 The Board will first proceed to assess if it can endorse the finding in the contested decision that the contested mark is descriptive and inherently devoid of distinctive character as well as that no acquired distinctiveness has been proven in relation to the goods and services at issue and from the perception of the relevant public in Spain, Portugal and Italy.
- 53 If the Board were to endorse the finding of the contested decision for at least one Member State, it is irrelevant for the purpose of the present proceedings (which is to decide upon whether or not the contested mark is to be declared invalid) if the trade mark is also devoid of distinctive character in the remaining Member States.
- 54 The applicant argues that since ‘CASA’ means ‘house’ it can only be found to be descriptive for ‘houses’. For all other goods and services it is, allegedly, merely referring.
- 55 It should be noted that Article 7(1)(c) CTMR does not apply only to signs or indications which may serve to designate the goods themselves, which would apply to the word ‘CASA’ for ‘houses’. Article 7(1)(c) CTMR is rather broad and applies to 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.

- 56 The contested goods in Class 4, 20, 21 and 24 are basically furniture, decorative articles, goods for domestic use and household products. These are also the goods to which the contested retail and wholesale services in Class 35 relate. Furthermore, the parties do not dispute the consideration in the contested decision that 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 nor that it is common knowledge that if these materials are offered for sale under the word 'house' (casa), 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. The Board sees no reason to deviate from this.
- 57 Moreover, the Board endorses the reasoning in the contested decision with respect to the contested typewriters and office requisites (except furniture) in Class 16. This type of goods are traditionally reserved to offices are more and more specifically offered as household goods (in the knowledge that typewriters are probably collector or even decorative goods nowadays).
- 58 In light of the foregoing, the Board cannot but agree with the Cancellation Division that, in relation to the goods and services at issue, the verbal element 'CASA' will be immediately perceived by the relevant customers as indicating the intended purpose and the category of the goods, namely that these are goods to be used for the house.
- 59 As regards the retail or wholesale services in respect of the goods in furniture, decorative articles, domestic goods and household products, it must be held that the mark in question merely indicates that the goods to be used for the house or home are available at the point of retail or wholesale (see also 15/10/2020, T-48/19, smart:)things (fig.), EU:T:2020:483, § 23).
- 60 Furthermore, the squared background of the sign is a very basic shape, the stylisation of letters is banal and the colours are basic colours (white and green). These are elements which – individually or as a whole – will be perceived as simple decorative elements which do not divert the attention of the relevant public from the clear descriptive message conveyed by the word element (11/04/2019, T-224/17, Bio proof ADAPTA (fig.), EU:T:2019:242, § 100; 26/04/2018, T-220/17, 100% Pfalz (fig.), EU:T:2018:229, § 30-31; 24/06/2015, T-552/14, Extra, EU:T:2015:462, § 20).
- 61 The Cancellation Division was therefore correct in finding that, at the filing date of the contested mark (22 January 2003), the link between the contested mark 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) CTMR. The 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 Spanish, Italian and Portuguese.
- 62 It is sufficient for one of the absolute grounds of refusal to apply for the sign not to be registered as a European Union trade mark.

- 63 Nonetheless, as also considered above, it is apparent from the case-law that the descriptive signs referred to in Article 7(1)(c) EUTMR are also devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR (10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 46 first sentence).

*Article 51(2) CTMR in conjunction with Article 7(3) CTMR*

- 64 Article 51(2) CTMR determines that where the [European Union] trade mark has been registered in breach of the provisions of Article 7(1)(b), (c) or (d), it may nevertheless not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.
- 65 It follows from Article 7(3) and Article 51(2) CTMR that, in the context of invalidity proceedings, the lack of inherent distinctive character of a registered trade mark does not mean that the trade mark is invalid where that trade mark has acquired distinctive character through use which has been made of it, either before it was registered or in the period between being registered and the date on which a declaration of invalidity was sought (19/06/2019, T-307/17, DEVICE OF THREE PARALLEL STRIPES (fig.), EU:T:2019:427, § 18 and the case-law cited).
- 66 In determining whether the sign in question has acquired distinctive character as a consequence of the use which has been made of it, an overall assessment must be made of the evidence that the mark has come to identify the goods or services concerned as originating from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings. For the purposes of that assessment, the following items may be taken into consideration: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (13/05/2020, T-532/19, Pantys (fig.), EU:T:2020:193, § 53 and case-law cited).
- 67 If, on the basis of the factors mentioned in the previous paragraph, at least a significant proportion of the relevant public, identifies goods or services as originating from a particular undertaking because of the trade mark, it must be held that the requirement for registering the mark laid down in Article 7(3) CTMR is fulfilled (06/11/2014, T-53/13, Line which slants and curves, EU:T:2014:932, § 97 and case-law cited).
- 68 The distinctive character of a sign, including that acquired through use, must be assessed in relation, first, to the goods or services in respect of which registration of the mark is applied for and, secondly, to the presumed perception of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (13/05/2020, T-532/19, Pantys (fig.), EU:T:2020:193, § 54 and case-law cited).

- 69 The EUTM proprietor must demonstrate acquired distinctive character for all parts of the European Union in which there is an absolute ground for refusal, (07/09/2006, C-108/05, Europolis, EU:C:2006:530, § 28; 30/03/2000, T-91/99, Options, EU:T:2000:95, § 27). In the present case, the Board has confirmed the finding in the contested decision that the contested mark is descriptive and inherently devoid of distinctive character in Spain, Portugal and Italy. Therefore, the EUTM proprietor had to show acquired distinctive character in all these three Member States.
- 70 It is incumbent on the EUTM proprietor relying on the distinctive character of a trade mark applied for to provide specific and substantive evidence that the trade mark applied for has distinctive character acquired by use (30/11/2017, T-798/16, REAL (fig.), EU:T:2017:854, § 45 and case-law cited therein). It cannot be proved by means of probabilities or suppositions (by analogy, 29/06/2017, T-427/16, AN IDEAL WIFE, EU:T:2017:455, § 21).
- 71 Although an overall assessment must be made of the evidence that the trade mark has come to identify the goods or services concerned as originating from a particular undertaking, in the context of that overall assessment, greater weight may be given to certain evidence. Secondary evidence, which may consist of sales figures and advertising materials, may support, where relevant, direct evidence of distinctive character acquired through use, such as that provided by surveys or market research and by statements from trade and professional associations or the specialist public (see 24/09/2019, T-492/18, Scanner Pro, EU:T:2019:667, § 54 and the case-law cited).
- 72 It is in light of these considerations that it must be examined whether the EUTM proprietor has demonstrated that the contested trade mark has acquired distinctiveness in consequence of the use which has been made of it, within the meaning of Article 51(2) CTMR either before the date of filing of the mark on 22 January 2003 or between the date of registration on 13 April 2007 and the application for declaration of invalidity on 22 March 2019 in the three Member States Italy, Spain and Portugal.
- 73 The EUTM proprietor has submitted various pieces of evidence before the Cancellation Division as well as several documents for the first time before the Board together with the statement of grounds and, twice, after the time limit to file the statement of grounds.
- 74 The cancellation applicant alleges that the evidence submitted outside the time to file the statement of grounds should all be disregarded.

*Evidence submitted before the Cancellation Division*

- 75 In support of its observations, the EUTM proprietor filed, within the set time limit therefor, several brochures concerning use in France, Belgium, the Netherlands as well as the following evidence before the Cancellation Division:
- Brochures concerning use in Italy (2 per year from 2008-2015 which lies well after the filing date of the contested mark, but is within the date of registration and the application for declaration of invalidity);



it markets or to the packaging. Furthermore, even where the sign is not affixed, there is use ‘in relation to goods or services’ where the sign is used in such a way that a link is established between the sign which constitutes the company, trade or shop name and the goods marketed or the services provided. (11/09/2007, C-17/06, Céline, EU:C:2007:497, § 22-23 and the case-law cited).

82 Leaving aside the question of whether the figurative sign  can or does constitute the EUTM proprietor’s company, trade or shop name, the brochures

establish a link between the sign  and the services provided.

83 As to the goods, it is less evident that aforesaid link is established by means of the evidence submitted. In this respect, the Board also notes that the EUTM proprietor did not provide any supporting evidence as to its allegation that the ‘own’ goods have a ‘CASA’ label and the other goods have a price tags on which the ‘CASA’ device is represented. Moreover, the cancellation applicant submitted an article in which the EUTM proprietor’s CEO states that ‘Casa doesn’t sell its own brand. We do try to work with exclusive lines’ (observations of 31 December 2020, Annex 11 <https://retailtrends.nl/item/53665/dag-xenos-hallo-casa>).

84 Be it as it may, even if the combination of the various brochures on file and the list of the various casa-shops were suffice to show genuine use of all goods and services covered by the contested mark, it does not demonstrate that at least a significant proportion of the relevant public identifies the goods and services as originating from the EUTM proprietor because of the trade mark.

85 In light of the above, the Cancellation Division correctly found that the EUTM proprietor had not shown that the contested mark had acquired distinctiveness among the relevant consumers in the relevant territories Spain, Italy and Portugal.

*Evidence submitted before the Board*

86 Before the Board, the EUTM proprietor submitted various pieces of evidence on different dates.

87 Pursuant to Article 95(2) EUTMR, which is applicable in the present appeal proceedings, the Office may disregard facts or evidence which are not submitted in due time by the parties concerned. That provision grants the Board discretion to decide, while giving reasons for its decision, whether or not to take into account facts and evidence submitted out of time (13/03/2007, C-29/05 P, Arcol, EU:C:2007:162, § 43).

88 Furthermore, Article 27(4) EUTMDR – which reflects the procedural rule that is applicable in the case at hand and which also refers to evidence submitted before the first time before the Board concerning invalidity proceedings based on an absolute ground for refusal – determines that, in accordance with Article 95(2) EUTMR, the Board of Appeal may accept facts or evidence submitted for the

first time before it only where those facts or evidence meet the following requirements: (a) they are, on the face of it, likely to be relevant for the outcome of the case; and (b) they have not been produced in due time for valid reasons, in particular where they are merely supplementing relevant facts and evidence which had already been submitted in due time, or are filed to contest findings made or examined by the first instance of its own motion in the decision subject to appeal.

- 89 These provisions are further clarified in Article 54(1) of the Rules of Procedure before the Board of Appeal that it may accept facts or evidence submitted for the first time before it only where (a) those facts or evidence are, on the face of it, likely to be relevant for the outcome of the case, and (b) they have not been produced in due time for valid reasons, in particular where they are merely supplementing relevant facts and evidence which had already been submitted in due time, or are filed to contest findings made or examined by the first instance of its own motion in the decision subject to appeal.

*Evidence within the time limit to submit statement of grounds*

- 90 In the statement of grounds the EUTM proprietor provides some information on the net sales of its 'CASA' shops (excluding web site sales and turnover of its franchise stores).
- 91 Furthermore, it submits the following pieces of evidence:

1. EUTM registration No. 000779561 (5 pages)
2. International registration No. 940971 (2 pages)
3. International registration No. 905139 (2 pages)
4. International registration No. 1238438 (2 pages)
5. Statement of grant of protection by EUIPO on 19/09/2008 (1 page)
6. Statement of grant of protection by EUIPO on 12/12/2008 (1 page)
7. Statement of grant of protection by EUIPO on 15/01/2016 (1 page)
8. List of CASA shops in Belgium (7 pages)
9. List of CASA shops in France (18 pages)
10. List of CASA shops in Italy (9 pages)
11. List of CASA shops in Luxembourg (1 page)
12. List of CASA shops in the Netherlands (4 pages)
13. List of CASA shops in Portugal (3 pages)
14. List of CASA shops in Spain (7 pages)

15. Pictures from Google Streetview (16 pages)
  16. Print screens of web.archive.org (4 pages)
  17. Decision of the Oficina Espanola de Patentes y Marcas of 30 June 2020 (2 pages)
  18. Decision of the Commercial Court of Lisbon of 26 February 2014 (8 pages)
  19. Decision of the Portuguese Trademark Office of 22 April 2016 (7 pages)
  20. Decision of the Court of Appeal of Lisbon of 5 November 2010 (13 pages).
- 92 The evidence may be deemed supplementary to the main evidence. Furthermore, Article 51(1) CTMR refers directly to the grounds for refusal set out in Article 7 of that Regulation, which pursue aims which are in the public interest (see, for example 06/03/2014, C-337/12 P - C-340/12 P, Surface covered with circles, EU:C:2014:129, § 44; 29/04/2004, C-456/01 P & C-457/01 P, Tabs (3D), EU:C:2004:258, § 45). Moreover, at stake here is an invalidity request for a registered EUTM which, as already follows from the evidence submitted before the Cancellation Division, has been used in, amongst others, Spain, Portugal and Italy. Also, the Board had not closed the written proceedings. Finally, the cancellation applicant has been able to give its observations in respect of the supplementary evidence. Therefore, the Board sees no reason not to accept the belated filed evidence.
- 93 However, this evidence is not capable of supplementing the main evidence to such extent that acquired distinctiveness can be found proven in Italy, Spain and Portugal.
- 94 Firstly, the EUTM proprietor provides the net sales of its ‘CASA’ shops (excluding web site sales and turnover of its franchise stores). However, since the EUTM proprietor provides general turnover sales, the Board cannot infer from this general information the net sales in Spain, Italy and/or Portugal. Moreover, the aforesaid net sales information cannot be considered to have been made in a statement in writing sworn or affirmed or having a similar effect under the law of the State in which the statement is drawn up. Therefore its probative value is, at most, very low, and there is no evidence on file capable of corroborating these numbers.
- 95 The EUTM proprietor provides the net sales and the number of customers of, as far as one of the three relevant Member States, 1 CASA shop in Italy (in 2015) and one 1 in Portugal. (2013). Apart from the probative value consideration in the previous paragraph, the numbers of the net sales and amount of customers of these two shops cannot demonstrate acquired distinctiveness / recognition by a significant part of the public at any point of time in Italy or Portugal.
- 96 Insofar as the EUTM proprietor argues that one is immediately referred to its website when searching for the word ‘CASA’ in Google, even if such allegation would have been substantiated, this would not demonstrate that the contested mark has acquired distinctiveness throughout the European Union at any time, including the date when the search would have been made.

- 97 As to the decisions of the Spanish and Portuguese trade mark authorities, it is to be noted, firstly, that they are not translated. Moreover, the circumstances of these cases seem different from the case at hand. Furthermore, insofar as the Spanish trade mark authorities mention in one sentence that the 'CASA' mark has a reputation, there is no information in the decision on the basis of what evidence the examiner came to that conclusion. Finally, no decisions of the Italian trade mark authorities have been provided by the EUTM proprietor.
- 98 As to the evidence in enclosures 10, 13-16, this can at most further strengthen the evidence already provided showing the presence of the EUTM proprietor in the market. It does not demonstrate acquired distinctiveness for any of the goods and services in Spain, Italy or Portugal at any point in time.
- 99 The remaining evidence is irrelevant.

*Evidence outside the time limit to submit statement of grounds*

- 100 On 1 October 2020, that is after the expiry of the time limit to submit its statement of grounds, the EUTM proprietor submits the following evidence:
1. Publication in RetailTrends of 31 August 2018 – 1 page
  2. Several publications Autumn 2017 – 18 pages
  3. Several publications in 2018 - 53 pages
  4. Several publications Summer 2017 – 10 pages
  5. Publication in Femmes D'Aujourd'hui of 3 April 2014 – 4 pages
  6. Publication in Libelle of 27 November 2014 – 2 pages
  7. Publication in Libelle of 28 May 2015 – 6 pages
  8. Publication in Femmes D'Aujourd'hui of 24 September 2015 – 4 pages
  9. Publication in Telepro Magazine of 26 November 2015 – 1 page
  10. Publication in Plus Magazine of 1 January 2016 – 2 pages
  11. Publication in Paris Match of 24 December 2015 – 1 page
  12. Publication in Elle Decoration of 1 October 2016 – 4 pages
  13. Publication in Deco Idees of 1 December 2016 – 4 pages
  14. Publication in Story of 31 January 2017 – 1 page
  15. Publication in Het Nieuwsblad magazine of 29 April 2017 – 1 page
  16. Publication in Goed Gevoel of 1 July 2018 – 2 pages
  17. Publication in plus Magazine of 1 January 2019 – 2 pages
  18. Publication in Sjiem of 19 January 2019 – 1 page
  19. Publication in Elle België of 1 December 2019 – 1 page

20. Photos of CASA shop facades in Belgium – 77 pages
  21. Photos of CASA shop facades in the Grand Duchy of Luxembourg – 11 pages
  22. Photos of CASA shop facades in the Netherlands – 64 pages
  23. Invoices, packing lists, bills of lading and shipping documents of 2020 – 11 pages
  24. Invoices, packing lists, container load plans, waybills and shipping documents of 2016 – 10 pages
  25. Invoices, packing lists, container load plans, waybills and shipping documents of 2017 – 8 pages
  26. Invoices, packing lists, container load plans, waybills and shipping documents of 2019 – 7 pages
  27. Invoices, packing lists, container load plans, waybills and shipping documents of 2015 – 9 pages
- 101 None of the evidence submitted relates to the use or recognition of the relevant public with respect to the contested mark in any of the three relevant Member States, Italy, Spain and Portugal. Therefore, even if this evidence were to be taken into account, it cannot serve the purpose of demonstrating acquired distinctiveness of the contested mark in these Member States.
- 102 Insofar as the EUTM proprietor mentions in its observations of 1 October 2020 that it is still awaiting the results of the market surveys in Spain, Portugal and Italy, on 5 January 2021 it submits the results of the market surveys in Spain and Portugal. According to the EUTM proprietor, the belated filing is due to the COVID-19 crisis.
- 103 The cancellation applicant alleges that the COVID-19 reason is not valid; the market surveys were initiated well after the time limit to submit the statement of grounds.
- 104 The general considerations made with respect to the evidence submitted on 1 October 2020, are also applicable here (see paragraph 92 above). On the one hand, the evidence is supplementary, there is a public interest, the contested mark concerns a registered mark, the appeal proceedings were not formally closed, and the cancellation applicant has been able to give its observations.
- 105 On the other hand, the stage of the proceedings at which that late submission takes place and the circumstances surrounding it cannot be disregarded (T-235/12, Grass in bottle (other), EU:T:2014:1058, § 62 and the case-law cited ) The market surveys were submitted almost four months outside the time limit to submit the statement of grounds. Moreover, as to the EUTM proprietor's COVID-19 argument, this is not very strong since, as also pointed out by the cancellation applicant, the participation of the survey was done online.
- 106 Although the cancellation applicant's counter arguments have to be attributed considerable weight, the Board considers that in balancing the interest of the parties, more weight has to be given to the arguments in favour of accepting the this evidence.

- 107 However, this evidence – on its own and in combination with the other evidence – is not capable of supplementing the main evidence to such extent that acquired distinctiveness can be found proven in Italy, Spain and Portugal.
- 108 As a general remark, as far as the probative value of surveys is concerned, this depends on the survey method used. Thus, the results of a survey may lack probative value in the case where the survey in question is not accompanied by sufficient evidence to ensure that it is reliable (09/09/2020, T-187/19, Colour Purple - 2587C (col.), EU:T:2020:405, § 95 and case-law cited).
- 109 Furthermore, it is apparent from the case-law that one of the criteria allowing the results of a survey to be recognised as having probative value is that the survey be carried out in the objective circumstances in which the mark at issue is present, or may be present, on the market (09/09/2020, T-187/19, Colour Purple - 2587C (col.), EU:T:2020:405, § 96 and case-law cited).
- 110 Similarly, the probative value of opinion surveys depends on, inter alia, whether the persons interviewed have been shown several images in order to be able spontaneously to associate one of those images with an undertaking, instead of being shown one image only (09/09/2020, T-187/19, Colour Purple - 2587C (col.), EU:T:2020:405, § 97 and case-law cited).
- 111 The so-called surveys contain several deficiencies. Firstly, the documents submitted do not consist of the survey itself but, to use the words of the EUTM proprietor itself, of a report based on the market research conducted by a company called Netquest, the information displayed by the brand on its own website (<http://es.casashops.com/es/>) and ‘the information outlined by the [EUTM] in the document n° 003017662’ [n° 003017662 being the registration number of the contested mark]. The survey itself was not submitted. Although it is not the task for the Office to search for the evidence, the Board used the hyperlink provided by the EUTM proprietor consisting of the five questions asks to the participants of the survey. [http://test.netquest.com/respondent/global\\_glacier/dfacf950-bd33-4e31-9cd7-5d879953e24d](http://test.netquest.com/respondent/global_glacier/dfacf950-bd33-4e31-9cd7-5d879953e24d) with the result that it was requested to become a participant in the survey of *Netquest*. Only by participating in the survey do the questions asked (in Spanish or Portuguese) became clear. However, the overall end results of the survey were not shown.
- 112 Furthermore, as mentioned above, the probative value of opinion surveys depends on, inter alia, whether the persons interviewed have been shown several images in order to be able spontaneously to associate one of those images with an undertaking, instead of being shown one image only (09/09/2020, T-187/19, Colour Purple - 2587C (col.), EU:T:2020:405, § 97 and case-law cited). In the case at hand, and as also pointed out by the cancellation applicant, it seems that the relevant public had only been shown the image of the contested mark.
- 113 Moreover, all participants, according to the report, were living in a town where a CASA-shop was located.
- 114 Also, as to the first question, when asked if they knew the contested mark (the image of the contested mark was apparently shown), it seems that the participants

could only answer 'yes' or 'no'. Another option, e.g. 'don't know', was apparently not given.

- 115 In addition, it seems that, when confronted with the question 'What type of product/s or business do you associate this logo with', the participant had to choose between five fixed groups, namely: 'Furniture mirrors and frames'; 'Household products (e.g. fabrics and textile products, blankets, home clothes)'; 'Decoration items (e.g. candles, candlesticks and candle holders, decorative fountains, clocks, etc.)'; 'Kitchenware or kitchen products (e.g. pans and bowls, pastry utensils, kitchen accessories)' and 'Trade in decoration, kitchen and home products'. As correctly pointed out by the cancellation applicant, these options are limited and strongly leading.
- 116 In light of the foregoing, the Board considers that the probative value of the surveys is rather limited.
- 117 However, even if the surveys for Spain and Portugal would have to be considered solid and objective evidence, the EUTM proprietor did not submit a survey for Italy nor did it provide any reasoning which would justify a finding that the results of the survey of Spain and Portugal should also be extended to Italy. The mere fact that the EUTM proprietor submitted similar evidence in the form of brochures and casa-shops for the three Member States Portugal, Spain and Italy is clearly insufficient for 'extrapolation' purposes.
- 118 It may very well be that the contested mark has acquired distinctive character for the goods and/or services at issue in Spain, Portugal and Italy. However, the Board can only legitimately reach such finding on the basis of objective and solid evidence on file. Such evidence is, however, lacking for these three Member States and in particular Italy.
- 119 In light of the foregoing, the EUTM proprietor has not shown that the mark has acquired distinctiveness among the relevant consumers for any of the goods or services in Italy or, even though there is more evidence in relation to these Member States, in Spain, Portugal. Thus, the claim under Article 7(3) EUTMR and Article 51(2) CTMR is rejected.
- 120 Bearing in mind all the above, the application for a declaration of invalidity is upheld pursuant to Article 51(1)(a) CTMR in conjunction with Articles 7(1)(b) and (c) CTMR for all the contested goods and services. Furthermore, the evidence submitted by the EUTM proprietor does not make it possible to establish that the mark applied for had acquired distinctive character in Italy as well as in Spain, Portugal within the meaning of Article 51(2) CTMR.
- 121 Insofar as the cancellation applicant requests the Board to also decide upon the distinctive character in the remaining Member States, in particular the Benelux countries, there is no obligation for the Office to do so (see, with respect to a possible conversion in the remaining Member States, 03/07/2013, T-236/12, Neo, EU:T:2013:343, § 57).
- 122 Consequently, the appeal is dismissed.

**Costs**

- 123 Pursuant to Article 109(1) EUTMR and Article 18 EUTMIR, the EUTM proprietor, as the losing party, must bear the cancellation applicant's costs of the cancellation and appeal proceedings
- 124 As to the appeal proceedings, these consist of the cancellation applicant's costs of professional representation of EUR 550.
- 125 As to the cancellation proceedings, the Cancellation Division ordered the EUTM proprietor to bear the cancellation applicant's representation costs which were fixed at EUR 450 and the cancellation fee of EUR 630. This decision remains unaffected. The total amount for both proceedings is, therefore, EUR 1 630.

**Order**

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the EUTM proprietor to bear the cancellation applicant's costs in the appeal proceedings, which are fixed at EUR 550. The total amount to be paid by the EUTM proprietor in the appeal and cancellation proceedings is EUR 1 630.**

Signed

S. Stürmann

Signed

H. Salmi

Signed

C. Negro

Registrar:

Signed

p.o. P. Nafz

