

**DECISION  
of the Second Board of Appeal  
of 25 August 2016**

In Case R 366/2016-2

**Daltrey Funding LP**

48 Wall Street, 27th Floor  
New York, NY 10005  
United States of America

EUTM proprietor / Appellant

represented by Casalonga Alicante, S.L., Avenida Maisonnave, 41-6C, 03003  
Alicante, Spain

v

**MEGA Spielgeräte Entwicklungs- und Vertriebsgesellschaft mbH & Co. KG**

Im Dachsstück 15  
65549 Limburg  
Germany

Cancellation Applicant / Respondent

represented by Wolfgang Schröder, Paul-Gauselmann-Straße 8, 32312, Lübbecke,  
Germany

APPEAL relating to Cancellation Proceedings No 9 983 C (European Union trade  
mark registration No 4 177 218)

THE SECOND BOARD OF APPEAL

composed of T. de las Heras (Chairperson), C. Negro (Rapporteur) and C. Govers  
(Member)

Registrar: H. Dijkema

gives the following

## Decision

### Summary of the facts

- 1 By an application filed on 7 December 2004, Daltrey Funding LP ('the EUTM proprietor') sought to register the figurative declared the invalidity of

**CSI=NY**

for the following list of goods and services:

Class 9 – Video recordings; audio recordings; cinematographic films; compact discs; DVDs; semi-conductor devices containing recorded sound and/or video and/or images; music, sound, images, text, signals, software and information, all accessible via telecommunications networks online or by way of the Internet; electronic amusement apparatus; measuring, detecting and forensic apparatus and instruments; arcade games; video games; multimedia apparatus and instruments; computer software, including game software; non-printed publications; electronic, magnetic and optical credit, identity and/or membership cards;

Class 14 – Precious metals and their alloys and goods in precious metals or coated therewith; horological and chronometric apparatus and instruments; watches; clocks; chains, bands and bracelets for watches; jewellery; cufflinks; precious and semi-precious stones; presentation cases adapted for all the aforesaid goods; parts and fittings for all the aforesaid goods;

Class 16 – Printed matter; printed publications; books; magazines; flyers; photographs; prints; posters; iron-on transfers; stickers; decalcomanias; stationery; albums; badges; calendars; diaries; personal organisers; maps; book markers; pencils; pens; markers; postcards, greeting cards; fact sheets; paper-weights;

Class 18 – Articles of leather or of imitation leather; purses; wallets; credit card holders; hand bags; beach bags; sports bags; tote bags; backpacks; luggage; suitcases; briefcases; key holders;

Class 21 – Household or kitchen utensils and vessels; glassware; glass cases; vases; drinking-cups; goblets; bottles; carafes; decanters; jugs; pitchers; liqueur-sets; dinner-services; bowls; basins; candlesticks; plates and glasses; combs; sponges; brushes; shot glasses; beverage glassware; cocktail picks; cocktail shakers; cocktail stirrers; coasters; serving trays;

Class 25 – Clothing; footwear; headgear;

Class 28 – Toys, games and playthings; gymnastic and sporting articles and equipment; decorations for Christmas trees; playing cards; board games and detective games; toy and novelty face masks; computer games, electronic games and video games, all being hand-held;

Class 41 – Entertainment; education; production, presentation, exhibition and rental of radio or television programmes, motion pictures, films, sound recordings, video recordings, interactive compact discs, CD-ROMs and of games cartridges for use with electronic games; amusement arcade services; amusement park services; organisation of competitions; organisation, production and presentation of shows and live performances; concert services; organisation of exhibitions for cultural, entertainment and educational purposes; organisation of musical events; reservation of tickets for entertainment, sports events and exhibitions; provision of cinema and theatre facilities; film, sound and video recording, modifying and editing services; publishing; publication of printed matter, books and periodical publications; publication and provision of entertainment for access by computer; theatrical agency services; management and agency services for performing artists; fan club services;

Class 42 – Licensing of intellectual property and copyright works, including television programmes; website design, maintenance and operation services; hosting of websites; computer database leasing; website portal services; technical support services for computer hardware and software problems; consultancy, design, testing, engineering, research and advisory services, all relating to computers, computer networks, computer software and computer programming; research and development of computer hardware and software; maintenance and upgrading of computer software; computer help-line services; information technology consulting; information, consultancy and advisory services relating to all the aforesaid services including such services provided online or via the Internet or extranets.

2 The application was published on 3 July 2006 and the mark was registered on 19 January 2007.

3 On 24 October 2014, MEGA Spielgeräte Entwicklungs- und Vertriebsgesellschaft mbH & Co. KG ('the cancellation applicant') filed a request for a declaration for revocation of the registered mark for declared the invalidity of goods and services, namely:

Class 9 – Electronic amusement apparatus; arcade games; video games; computer software, including game software;

Class 28 – Computer games, electronic games and video games, all being hand-held;

Class 41 – Entertainment; production, presentation, exhibition and rental of games cartridges for use with electronic games; amusement arcade services.

4 The grounds of the request for revocation were those laid down in Article 51(1) (a) EUTMR.

5 By decision of 17 December 2015 ('the contested decision'), the Cancellation Division partially upheld the request for a declaration of revocation, namely for:

Class 9 – Video games except for PC video games; computer software, except for PC game software;

Class 28 – Computer games, electronic games and video games, all being hand-held;

Class 41 – Entertainment, except for television entertainment services; production, presentation, exhibition and rental of games cartridges for use with electronic games; amusement arcade services.

The EUTM remains registered for all the remaining goods and services, namely:

Class 9 – Electronic amusement apparatus; arcade games; PC video games; PC game software;

Class 41 – Television entertainment services.

Each party bears its own costs.

It gave, in particular, the following grounds for its decision:

– In the present case the EUTM was registered on 19 January 2007. The revocation request was filed on 24 October 2014. Therefore, the EUTM had been registered for more than five years at the date of the filing of the request. The EUTM proprietor had to prove genuine use of the contested

CTM during the five-year period preceding the date of the revocation request, that is, from 24 October 2009 to 23 October 2014 inclusive, for the following contested goods and services:

Class 9 – Electronic amusement apparatus; arcade games; video games; computer software, including game software;

Class 28 – Computer games, electronic games and video games, all being hand-held;

Class 41 – Entertainment; production, presentation, exhibition and rental of games cartridges for use with electronic games; amusement arcade services.

- On 7 April 2015 the EUTM proprietor submitted evidence as proof of use. The evidence consists of the following documents:
  - A number of screenshots from the websites amazon.co.uk (the United Kingdom), amazon.de (Germany) and amazon.es (Spain), demonstrating DVDs with ‘CSI:NY’ and ‘CSI: New York’ TV series, as well as PC games, such as ‘CSI:NY – The Game’, available for sale, displaying the marks  and  some of them demonstrating release dates between 2009-2014 (Exhibit 1);
  - Photographs of the packaging and DVD disc with ‘CSI:NY’ PC game, displaying the mark  and the game description in German and English, undated (Exhibit 2);
  - Screenshot from the website gameloft.de, offering ‘CSI:NY’ mobile phone game for sale, undated, showing users’ reviews from 03/2009 (Exhibit 3);
  - Chart demonstrating various products sold by licensees in the EU Member States between 2009 and 2014, according to which ‘CSI NYC PC’ was sold in, inter alia, the Benelux countries, Bulgaria, Estonia, France, Germany and Austria, Greece, Hungary, Ireland, Italy, Poland, Portugal, Slovenia, Spain and the United Kingdom between 31/03/2009 and 31/12/2013 (Exhibit 4);
  - Merchandising License Agreement with the company IGT, dated 30/06/2010, referring to ‘gaming machines and other electronic and/or mechanical devices’, such as ‘slot machines’, which according to the agreement incorporate elements from the TV series ‘CSI: NEW YORK’, ‘CSI: MIAMI’ and ‘CSI: CRIME SCENE INVESTIGATION’ (Exhibit 5);
  - Licensing agreement with the company Stern Pinball, Inc., dated 15/05/2007, referring to ‘CSI: CRIME SCENE INVESTIGATION’ ‘pinball machine and replacement parts’, establishing the territorial scope of the agreement as ‘worldwide’ (Exhibits 5 and 9);
  - Four information leaflets, three of them originating from the company IGT and dated between 2012 and 2013, showing gaming machines displaying the mark  (next to two other marks referring to ‘CSI: MIAMI’ and ‘CSI: CRIME SCENE INVESTIGATION’ TV series). One of the machines is described in the leaflet as ‘three games in one: players can

swipe to change the entire base game to play CSI: Crime Scene Investigation, CSI: Miami or CSI: New York' (Exhibit 6);

- 'Royalty Fee Summary' reports, issued by the company IGT, dated 28/09/2013, 28/12/2013, 29/03/2014 and 28/06/2014, showing royalties earned in, inter alia, Italy, Sweden, Finland and France, accompanied by the letter from the said company. The reports refer to 'CSI – IGT', which as explained by the EUTM proprietor denotes gaming machines, which permit players to choose between three games 'CSI: NEW YORK', 'CSI: MIAMI' and 'CSI: CRIME SCENE INVESTIGATION' (Exhibit 7);
- Affidavit by Reena Patel, Brand Licensing Executive Director of IGT, dated 26/03/2015, stating that IGT has distributed gaming machines and/or mechanical devices under the  and 'CSI: MIAMI' marks in, inter alia, Finland, France, Italy and Sweden between 07/2013 and 07/2014 (Exhibit 8);
- Five License Agreements with the company Ubisoft Entertainment SA, of which two (dated 14/09/2007 and 16/02/2011) refer to 'CSI: NEW YORK' mark with respect to licensing software games in various formats (Exhibit 10);
- 'Royalty Statement' reports, dated between 07/2009 and 12/2012, showing royalties earned in, inter alia, France, Germany, Ireland, Italy, Sweden, the United Kingdom and Spain, with respect to 'CSI NYC PC' (Exhibit 11);
- Affidavit by Yves Guillemot, President of Ubisoft Entertainment SA, dated 01/04/2015, stating that Ubisoft Entertainment SA has distributed interactive software games in PC format (including downloadable games) under the mark  from 2007 in countries such as Austria, Belgium, Bulgaria, Cyprus, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Netherlands, Portugal, Slovenia, Spain, Sweden and the United Kingdom (Exhibit 12);
- A document containing information on 'CSI: CRIME SCENE INVESTIGATION' and 'CSI: MIAMI' TV series, referring to their positions in international ratings, awards and critical acclaim (Exhibit 13);
- A table containing 'CSI: NEW YORK', 'CSI: MIAMI' and 'CSI: CRIME SCENE INVESTIGATION' TV series broadcasting information, namely the broadcasting TV channel, territory and date. The table shows that the TV series 'CSI: NEW YORK' was broadcasted in, inter alia, Austria, Sweden, Denmark, the Netherlands, the United Kingdom, Czech Republic, Italy, Spain, Portugal, Bulgaria, Hungary, Poland, Romania, Slovakia, Slovenia, Cyprus, Finland, France, Greece, Latvia, Lithuania, Estonia, between 15/12/2004 and 01/12/2014 (Exhibit 14);
- Great number of video screenshots, posters, press clippings and articles, photographs and other promotional materials referring to the CSI: NEW

YORK' (or 'CSI:NY'), 'CSI: MIAMI' and 'CSI: CRIME SCENE INVESTIAGTION' TV series, written in, inter alia, Danish, French, Italian, Swedish, English, some of them dated in 2010 and 2012 (Exhibits 15 and 16).

*Time of use*

- Most of the evidence is dated within the relevant period. Therefore, the evidence of use filed by the EUTM proprietor contains sufficient indications concerning the time of use.

*Place of use*

- The submitted evidence shows that the EUTM was used in numerous European Union countries, such as Germany, Spain and the United Kingdom. This can be inferred in particular from the language of the documents (German, Spanish, English) and the currency mentioned (Euros and Pounds). The evidence also refers to TV channels, websites and press originating from or directed at public from Germany, Spain and the United Kingdom. These countries alone must be regarded as representing a substantial part of the relevant market in the European Union. Therefore, the Cancellation Division considers that the evidence relates to the relevant territory.

*Nature of use: use as a trade mark*

- In the present case the Cancellation Division considers that the evidence sufficiently shows that the contested EUTM was used as a trade mark, as it appears directly on the goods in question, as well as in various business papers relating to these goods. With regards to the services in question, the Cancellation Division notes that marks cannot be directly used 'on' services. Therefore, as regards marks registered for services, their use will generally be found on business papers, in advertising, or in any other direct or indirect relation to the services. Where the use on such items demonstrates genuine use, such use will be sufficient. It stems from the evidence provided, in particular the video screenshots, posters, press clippings and articles, photographs and other promotional materials that the services in question were identified by the contested EUTM.

*Nature of use: use of the mark as registered*

- The EUTM is registered for the figurative mark **'CSI:NY'**. In the evidence it frequently appears depicted in different colours and/or on different background.
- As regards the use of the EUTM in different colours and/or on different background, the Cancellation Division considers that such use does not alter the distinctive character of the contested mark and, therefore, does not constitute unacceptable variation of the EUTM as registered. Regardless of the use of different colours of typeface and/or background, the distinctive verbal elements 'CSI:NY', are clearly perceptible in the mark. The

Cancellation Division considers the black colour of the EUTM to be rather immaterial for the distinctive character of the mark.

- Consequently, it is considered that the use of the abovementioned variations of the sign in question shows use of the mark as registered or in a form essentially equivalent to that registered and, therefore, constitutes use of the contested EUTM under Article 15 EUTMR.

*Extent of use*

- The evidence filed, in particular the sales chart, license agreements, affidavits and royalties reports, containing information on revenue figures, as well as broadcasting information and numerous press clippings, articles and other promotional materials, provides the Cancellation Division with sufficient information concerning the commercial volume, the territorial scope, the duration, and the frequency of use. The evidence demonstrates that the goods and services in question were offered under the trade mark continuously during the entire relevant period and show sufficient commercial volume for it to be concluded that the use of the mark is genuine.

*Use in relation to the registered goods and services*

- However, the evidence filed by the EUTM proprietor does not show genuine use of the trade mark for all the goods and services for which it is registered.
- First of all, the Cancellation Division considers that the evidence submitted sufficiently shows the use of the EUTM for electronic amusement apparatus; arcade games in Class 9. The documents provided, in particular license agreements, royalties reports, affidavit of the director of IGT, as well as information leaflets showing gaming machines, all demonstrate that the EUTM was used for entertainment machines, such as video slots machines.
- With regards to the contested video games; computer software, including game software in Class 9 and computer games, electronic games and video games, all being hand-held in Class 28, the Cancellation Division notes that the EUTM proprietor did not provide sufficient evidence indicating that the contested mark was used for all of these goods. The evidence provided with regards to games software, namely sales chart, license agreements, royalties reports, affidavit of the president of Ubisoft Entertainment SA, as well as Amazon website screenshots and photographs of a ‘CSI:NY’ PC game DVD and packaging, all demonstrate the use of the EUTM only in relation to a PC game (and a downloadable PC game). PC game involves a player interacting with a personal computer (PC) and is not intended for a hand-held gaming device. Even though the license agreements with Ubisoft (exhibit 10) mention software games not only in PC format, but also in ‘console formats’ or ‘disc based or cartridge based hand-held formats’, there is no sufficient evidence that any game in such formats was eventually produced and marketed under the contested EUTM. In particular, the EUTM proprietor did not file a single piece of evidence showing actual commercial transactions or turnover figures with regard to console or hand-held games. An undated printout from a German webpage gameloft.de, offering ‘CSI:NY’ mobile phone game for sale is not sufficient to establish such use, especially taking

into account that the sales chart, royalties reports and the affidavit do not show the use of the contested mark for any game in a non-PC format. Moreover, it must be noted that the EUTM proprietor did not provide any piece of evidence for other types of computer software. Therefore the use of the EUTM is established only in relation to video PC games; PC game software in Class 9.

- The Cancellation Division further notes that the EUTM proprietor did not provide any evidence as to production, presentation, exhibition and rental of games cartridges for use with electronic games; amusement arcade services in Class 41. None of the documents submitted refers to the use of the EUTM for these services. In particular, the mere fact that the evidence demonstrates the EUTM affixed on arcade game machines is clearly not sufficient to conclude that the EUTM proprietor renders amusement arcade services in Class 41.
  - With regard to the remaining broad category of entertainment in Class 41, the evidence submitted, in particular broadcasting information table, video screenshots, posters, press clippings and articles, photographs and other promotional materials, as well as Amazon website screenshots, has shown that the EUTM is used for a popular TV series of the so-called ‘CSI franchise’. Therefore, it is considered that the evidence provided shows use of the EUTM for television entertainment services.
  - Taking everything into account, the Cancellation Division considers that the EUTM proprietor has shown genuine use of the contested trade mark for electronic amusement apparatus; arcade games; PC video games; PC game software in Class 9 and television entertainment services in Class 41.
  - In the present case, the Cancellation Division considers that genuine use of the contested mark has been sufficiently demonstrated for the relevant factors of time, place, extent and nature of use in relation to some of the contested goods and services, namely electronic amusement apparatus; arcade games; PC video games; PC game software in Class 9 and television entertainment services in Class 41. However, the EUTM must be revoked for the remaining goods and services.
- 6 On 17 February 2016, EUTM proprietor filed an appeal against the contested decision, requesting that the decision be partially set aside. The statement of grounds of the appeal was received on 15 April 2016.
- 7 In its observations in reply received on 7 June 2016, the cancellation applicant requests that the appeal be dismissed.

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

- 8 The arguments raised in the statement of grounds may be summarised as follows:

*The contested goods in Class 9: ‘Video games except for PC video games; computer software, except for PC game software’*

- According to the definition of Wikipedia, a video game encompasses a broad category of games that are used on a variety of devices, notably small hand-held computing devices, such as smartphones; video game consoles/home video game devices; arcade games. The evidence filed clearly demonstrates use in relation to video games.
- Exhibit 3 clearly shows the CSI:NY mobile games available since 2009 on the website [www.gameloft.de](http://www.gameloft.de), and therefore shows use of the EUTM in connection with video games other than PC video games.
- Exhibit 12, which consists of an affidavit of Mr Yves Guillemot, co-founder and president of Ubisoft Entertainment SA, confirms that the EUTM has been used in connection with ‘format and online games (Facebook)’ in the EU since 2007. The CSI video games developed on Facebook by Ubisoft are available on mobile devices such as smartphones.
- Exhibit 6 also demonstrates use of the EUTM in connection with video games other than PC video games. Furthermore, the license agreement provided in Exhibit 5, the brochure for gaming machines (Exhibit 6), the redacted royalty reports provided in Exhibit 7, which provide the royalties earned in the European Union Member States Italy, Sweden, Finland and France in connection with the EUTM, as well as the IGT’s Brand Licensing Executive Director’s affidavit (Exhibit 8), a sworn statement confirming the use of the EUTM, together form a set of evidence that — when analysed together — confirm the genuine use of the EUTM in the EU within the relevant time period for arcade video games. Once again, this evidence demonstrates the use of the EUTM for the category of video games in general and not simply for PC video games.
- As to the new additional evidence filed on appeal, it can be seen from Exhibit 17, the affidavit of Jerome Sibade, Associate General Counsel of Gameloft (French video game developer which entered into a licensing agreement with the EUTM proprietor of license of the contested mark for mobile games) that the mark has been used in connection with wireless games, i.e. available for download on wireless devices in the EU during the relevant period from 2008 to 2014.
- Pursuant to this agreement, Gameloft SE has distributed CSI:NY – the Mobile Game, displaying the EUTM, which is typical of games for download and use on wireless devices.
- Yves Guillemot’s affidavit, co-founder and president of Ubisoft Entertainment SA (Exhibit 18), confirms that the contested mark has been used in connection with games within the relevant period beginning as early as 2007.

*The contested goods in Class 28: ‘computer games, electronic games and video games, all being hand-held’*

- It can be seen from the Wikipedia definition that hand-held video games now include mobile games played, notably, on mobile phones. Exhibits 3 and 12 clearly provide sufficient evidence of use in relation to these contested goods.

Similarly, the newly filed evidence, Exhibits 17 and 18, also provide use of the contested mark in relation to these contested goods.

*The contested services in Class 41: 'entertainment, except for television entertainment services; amusement arcade services.'*

- Contrary to the contested decision, the evidence already submitted during the first instance clearly shows proof of genuine use of the contested mark for the services in question, especially with regards to 'entertainment and amusement arcade services' as can be seen from Exhibits 6 (licence agreement together with brochures for gaming machines), 7 (redacted royalty reports), 8 (IGT's Brand licensing executive director's affidavit), and 9 (sworn statement confirming the use of the mark together with licence agreement with Stern Pinball Inc. for the use of the contested mark in connection with 'pinball machine, and replacement parts').
  - The EUTM appears clearly on the gaming machines as shown in the documents filed and from the and in Exhibits 5 and 6.
  - The affidavit of Ms Reena Patel, as Brand Licensing Executive Director of IGT, confirms that the EUTM has been used in connection with gaming machines and other electronic and/or mechanical devices for use in legal jurisdictions on which a wage is placed that incorporates elements from the Series in the EU, beginning as early as June 2013 through June 2014.
  - The licence agreements with IGT and Stern Pinball Inc. clearly show use of the contested mark in connection with gaming machines and other electronic and/or mechanical devices. This constitutes sufficient evidence to demonstrate that the contested mark is used in connection with amusement arcade services, provided through the gaming machines under the contested mark.
  - The evidence filed, together with the additional new evidence on appeal, clearly shows that the EUTM proprietor is using its EUTM in connection to numerous goods and related services including within the general category of 'entertainment services'. Games are played for entertainment and over the years the number of video games has increased enormously, providing a wide variety of entertainment to players around the world (Wikipedia extract filed). The EUTM proprietor has demonstrated extensive evidence of use of the EUTM in connection with video games, computer games and electronic games.
  - This constitutes sufficient evidence to demonstrate that the EUTM is used not only in connection with Classes 9 and 28 goods, but also with entertainment services as these services are performed through the great variety of games and sold under the EUTM.
- 9 The cancellation applicant refers to its arguments filed during the first instance and adds the following arguments:
- The additional evidence filed (Exhibits 17 and 18) are not presented in a structured, comprehensible and descriptive way. Exhibits 1-3 of the affidavit

under Exhibit 17 are missing the time and the extent of use of the contested mark. Items 1-4 of Exhibit 18 do not show the time or the extent of use of the contested mark.

## **Reasons**

### *Preliminary remark on the applicable Regulations*

- 10 The revocation request was filed before the entering into force (on 23 March 2016) of the new European Trade Mark Regulation (EUTMR) which was introduced by Amending Regulation (EU) No 2015/2424. Therefore, the former Community Trade Mark Regulation (EC) No 207/2009 (CTMR) is applicable to this appeal. However, for easy reference the Board will refer to 'EUTMR' and the new terminology introduced by the amending Regulation, bearing in mind that the material changes introduced by the latter Regulation will not apply to the case at hand.
- 11 On the other hand, since the new European Union Trade Mark Implementing Regulation (EUTMIR) will not enter into force until 1 October 2017, the Board will keep on referring to the current Community Trade Mark Implementing Regulation (EC) No 2868/95 (CTMIR).

### *Admissibility*

- 12 The appeal complies with Articles 58, 59 and 60 EUTMR and Rule 48 CTMIR. It is, therefore, admissible.

### *Scope of the appeal*

- 13 The EUTM proprietor appealed the contested decision in part, namely in respect of all the goods and services for which the application for revocation was upheld.
- 14 Since the cancellation applicant did not file an appeal or a response seeking a decision annulling or altering the contested decision on a point not raised in the appeal in the sense of Article 8(3) BoA-RP, the contested decision has become final to the extent that it rejected the application for revocation for:

Class 9 – Electronic amusement apparatus; arcade games; PC video games; PC game software;

Class 41 – Television entertainment services.

- 15 Therefore, the scope of the appeal solely concerns the goods and services for which the EUTMR was revoked:

Class 9 – Video games except for PC video games; computer software, except for PC game software;

Class 28 – Computer games, electronic games and video games, all being hand-held;

Class 41 – Entertainment, except for television entertainment services; production, presentation, exhibition and rental of games cartridges for use with electronic games; amusement arcade services.

*Article 51(1)(a) EUTMR*

- 16 Pursuant to Article 51(1)(a) EUTMR, the rights of the proprietor of the EU trade mark shall be declared revoked on application to the Office, if, within a continuous period of five years, the trade mark has not been put to genuine use in the Union in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use; however, no person may claim that the proprietor's rights in an EU trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application, genuine use of the trade mark has been started or resumed; the commencement or resumption of use within a period of three months preceding the filing of the application which began at the earliest on expiry of the continuous period of five years of non-use shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application may be filed.
- 17 According to Rule 40(5) CTMIR, if the proprietor of the EU trade mark does not provide proof of genuine use of the contested mark within the time-limit set by the Office, the EU trade mark shall be revoked.
- 18 Pursuant to Article 51(2) EUTMR, where the grounds for revocation of rights exist in respect of only some of the goods or services for which the EU trade mark is registered, the rights of the proprietor shall be declared to be revoked in respect of those goods or services only.
- 19 There is genuine use of a trade mark where the mark is used in accordance with its essential function as a trade mark, which is to guarantee the identity of the origin of goods or services for which it is registered, in order to create or preserve an outlet for those goods and services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 43). Moreover, the condition relating to genuine use of the trade mark requires that the mark, as protected on the relevant territory, be used publicly and outwardly (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 37; 30/04/2008, T-131/06, *Sonia Sonia Rykiel*, EU:T:2008:135, § 38; 18/01/2011, T-382/08, *Vogue*, EU:T:2011:9, § 27).
- 20 Genuine use of a trade mark in the sense of Article 51(1)(a) EUTMR in conjunction with Article 15 EUTMR must be understood to denote real use that is not merely token, serving solely to preserve the rights conferred by the mark (fictitious use). Genuine use of the mark entails use of the mark on the relevant market and not just internal use by the undertaking concerned (27/09/2007, T-418/03, *La Mer*, EU:T:2007:299, § 54; 11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 36-37). Genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (12/12/2002, T-39/01, *Hiwatt*, EU:T:2002:316, § 47).
- 21 As to the criteria for assessing genuine use, under Rule 40(5) CTMIR, account must be taken of the facts and circumstances of each case, regard being had to the wording of Rule 22(3) CTMIR which states that the indications and evidence for furnishing proof of use are to consist of indications concerning the place, time, extent and nature of use.

- 22 It is not disputed by the parties that the request for revocation is admissible, given that the contested EUTM had been registered for more than five years at the date of filing the request. In the present case, the contested EUTM was registered on 19 May 2014 and the request for revocation was filed on 24 October 2014. The relevant period for assessing use of the contested EUTM is between 24 October 2009 and 23 October 2014, inclusive.

*Admissibility of documents filed for the first time on appeal*

- 23 Together with the statement of grounds, the EUTM proprietor submitted new evidence of genuine use before the Board and further arguments concerning the applicability of Article 51(1)(a) EUTMR.
- 24 Article 76(2) EUTMR provides that the Office may disregard facts or evidence which are not submitted in due time by the parties concerned. The Board finds that these facts and supplementary documents should be admitted in accordance with Article 76(2) CTMR for the reasons that are explained hereunder.
- 25 Article 76(2) EUTMR, also referred to in Rule 50(1) CTMR (applicable to cancellation proceedings *mutatis mutandis*), grants the Board wide discretion to decide, while giving reasons for its decision in that regard, whether or not to take new evidence into account. The criteria of this discretionary power have been defined in several judgments (03/10/2013, C-120/12 P, *Proti Snack*, EU:C:2013:638; 26/09/2013, C-610/11 P, *Centrotherm*, EU:C:2013:912; 18/07/2013, C-621/11 P, *Fishbone*, EU:C:2013:484 and 13/03/2007, C-29/05 P, *Arcol*, EU:C:2007:162).
- 26 Taking such facts or evidence into account is particularly likely to be justified where the Board considers, first, that such evidence is, on the face of it, likely to be relevant to the outcome of the proceedings and, second, that the stage of the proceedings at which the submission of new evidence takes place and the circumstances surround it do not argue against such matters being taken into account (03/10/2013, C-120/12 P, *Proti Snack*, EU:C:2013:638, § 38; 26/09/2013, C-610/11 P, *Centrotherm*, EU:C:2013:912, § 112; 13/03/2007, C-29/05 P, *Arcol*, EU:C:2007:162, § 44).
- 27 The Board may take into account additional evidence which merely supplements other evidence submitted within the time-limit, where the initial evidence was not irrelevant, but was held to be insufficient. In the present case, the conditions for the further facts and belated evidence being taken into consideration have been met. The belated evidence is additional and corroborates the main evidence submitted in due time before the Cancellation Division. The Board notes that upon a preliminary examination, the further facts and additional evidence submitted by the EUTM proprietor for the first time in the appeal proceedings are, on the face of it, likely to be relevant to the outcome of the cancellation action. Indeed, such further facts and additional evidence corroborate claims and information which had already been provided in the observations and other documents provided by the EUTM proprietor.
- 28 The Board notes, secondly, that the circumstances surrounding the belated filing of such further facts and additional evidence, for the first time in the appeal proceedings, plead for this belated material to be admitted into the proceedings.

- 29 Indeed, the EUTM proprietor had filed in due time before the Cancellation Division, a considerable quantity of relevant documents and given relevant arguments, which it could reasonably have believed to be sufficient to prove genuine use at least for some of the goods in question. The documents filed with the statement of grounds of appeal, are therefore, as stated above, additional facts and evidence, within the meaning of Rule 50(1) CTMIR, which merely support and confirm the veracity of the information provided before the Cancellation Division.
- 30 With a view to the above, the Board deems it appropriate to admit the additional facts and evidence filed with the appeal's statement of the grounds, by exercising its discretionary power, under Article 76(2) EUTMR. The Board stresses that the *prima facie* relevance of the evidence does not imply that it is conclusive for the outcome of the present case.
- 31 The Board will, therefore, proceed accordingly to analyse the list of documents provided by the EUTM proprietor cited in paragraph 5 above and the newly filed evidence on appeal, which consists of:
- Affidavit of Jerome Sibade, Associate General Counsel of Gameloft (French video game developer which entered into a licensing agreement with the EUTM proprietor of license of the contested mark for mobile games) (Exhibit 17) together with exemplary Exhibits 1-3.
  - Affidavit of Yves Guillemot's, co-founder and president of UBISOFT Entertainment SA (Exhibit 18) regarding the use of the contested mark on games designed for mobile devices and for online formats in the EU during the relevant period together with exemplary Exhibits 1-4.

*On the time of use*

- 32 As regards the period of use, as is clear from Article 10(1) of the Trade Mark Directive 2008/95/EC, only national trade marks genuine use of which has been suspended during an uninterrupted period of five years are subject to the sanctions provided by the Directive. Accordingly, it is sufficient that a trade mark was put to genuine use during a part of the relevant period for it not to be subject to the sanctions (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 45, confirmed by judgement of 11/05/2006, C-416/04 P, Vitafruit, EU:C:2006:310).
- 33 Admittedly, as the cancellation applicant argues, some of the documents are undated or originate before the relevant period, e.g. some of the licence agreements are dated prior to the relevant period. Nevertheless, the dates on the majority of the documents correspondent to the relevant period. For instance, the frequency and regularity of use during the relevant period is demonstrated by the remaining licence and merchandise agreements (most dated within the relevant period, e.g. 2010 and 2012), the leaflets dated 2012 and 2013 and the promotional materials, press clippings and articles dated 2010 and 2012.
- 34 Moreover, although the probative value of an item of evidence is limited to the extent that, individually, it does not show with certainty whether, and

how/when, the goods concerned were placed on the market, and although that item of evidence is therefore not in itself decisive, it may nevertheless be taken into account in the overall assessment as to whether the use is genuine. That is also the case, for example, where that evidence corroborates the other relevant factors of the case (06/03/2014, T-71/13, Annapurna, EU:T:2014:105, § 45), which is, in the Board's opinion, what had occurred in the present case.

*On the place of use*

- 35 As stated in the contested decision, the evidence shows that the EUTM was used in various European Union countries, such as Germany, Spain and the United Kingdom. This can be inferred in particular from the language of the documents (German, Spanish and English) and the currency mentioned (Euros and Pounds). The evidence also refers to TV channels, websites and press originating from or directed at the public from Germany, Spain and the United Kingdom, representing a substantial part of the relevant market in the European Union. This was not disputed by the parties.

*On the use of the mark as registered*

- 36 The contested decision's findings as to the use of the mark as registered, which are endorsed by the Board, were not challenged by the parties. Reference is made to the contested decision in this regard.

*On the extent of use*

- 37 As to the extent of use to which the trade mark has been put, account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 41, and 08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 35).
- 38 The evaluation of whether there has been genuine use of a mark neither involves assessing the commercial success of undertaking nor monitoring its economic strategy. When assessing whether use of a trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (30/04/2008, T-131/06, Sonia Sonia Rykiel, EU:T:2008:135, § 37 to 39 and the case-law cited therein).
- 39 The requirement for the extent of use does not mean that the EUTM proprietor has to reveal the entire volume of sales or turnover figures. It is sufficient to submit evidence which proves that the minimum threshold for a finding of genuine use has been passed (11/05/2006, C-416/04 P, Vitafruit, EU:C:2006:310, § 72).
- 40 It follows that it is not possible to determine *a priori*, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would not allow the Office or, on

appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (27/01/2004, C-259/02, *Laboratoire de la mer*, EU:C:2004:50, § 25). Thus, when it serves a real commercial purpose, in the circumstances referred to in paragraph 70 of the ‘LABORATOIRE DE LA MER’ judgment, even minimal use of the trade mark can be sufficient to establish genuine use (27/01/2004, C-259/02, *Laboratoire de la mer*, EU:C:2004:50, § 27). Also, the characteristics of the market in question must be taken into account (08/07/2004, T-334/01, *Hipoviton*, EU:T:2004:223, § 51).

- 41 The various license and merchandising agreements dated between 2007 to 2014 with different multinational and major well-known players in the field of computer, video, mobile and arcade gaming and software companies, such as Ubisoft, Stern Pinball Inc., IGT, GTECH, and Gameloft SE, show that the use of the contested mark has been made by these licensees during the relevant period throughout various countries within the European Union.
- 42 The EUTM proprietor has clearly given its consent to the use of its mark which can also be deduced by the fact that the EUTM proprietor has submitted sworn statements of the licensees and royalty reports, albeit redacted for confidential purposes, from the licensees, such as IGT and Ubisoft, and the press clippings. Therefore, the use by the licensees is valid and acceptable evidence, showing the public and outward use of the contested mark with the consent of the EUTM proprietor.
- 43 The EUTM proprietor has shown that it (or, more concretely, its licensees/distributors) has traded with a certain frequency during the relevant period throughout the European Union, which indicates genuine and not merely token use.
- 44 The sworn statements and declarations filed during the first instance and on appeal, although not sufficient on their own, provide information as to the commercial activities of the (licensees of the) EUTM proprietor. Even if the declaration is drawn up by the licensee itself, this does not mean that such solemn declarations would be totally devoid of all probative value (see, by analogy, 28/03/2012, T-214/08, *Outburst*, EU:T:2012:161, § 30).
- 45 As to the redacted royalties’ reports, it is perfectly understandable for confidential purposes that all personal information can be redacted, blanking out the name and addresses, the total amount of costs etc., whilst leaving, for example, the town/city and itemised amounts – in other words, thereby providing some evidence showing actual purchases/distributions/sale from these establishments by consumers. In the view of the Board, the quantities shown, even if done so by way of example, must make it credible that the amounts referred to in affidavit evidence would be sufficient to ‘maintain or create a share in the market’. The Board believes that it has been done in this case.
- 46 Moreover, case-law is clear that each piece of evidence is not to be analysed separately, but rather together – in order to determine the most likely and coherent meaning. In the course of such an analysis, it cannot be excluded that a body of evidence will enable proof of the facts to be established, even though each of those items of evidence, taken in isolation, would not be capable of

proving those facts (15/12/2010, T-132/09, Epcos, EU:T:2010:518, § 28 and 29; 29/02/2012, T-77/10 & T-78/10, L112, EU:T:2012:95, § 57).

- 47 Considering the evidence in its entirety, the evidence shows that the EUTM proprietor has seriously tried, in particular via its licensees and distributors within the EU and promotional materials, to acquire and maintain a commercial position on the relevant market.
- 48 As such, in line with the contested decision, it is deemed that the required extent of genuine use is shown.

*Use in relation to the registered contested goods and services*

- 49 As to the use of the contested goods and services, the Board recalls the ‘partial use’ principle, which implies that if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection only for the subcategory or subcategories to which the goods or services for which the trade mark has actually been used belong (14/07/2005, T-126/03, Aladin, EU:T:2005:288, § 45; 13/02/2007, T-256/04, Respicur, EU:T:2007:46, § 23).
- 50 In this sense, although the principle of ‘partial use’ operates to ensure that trade marks which have not been used for a given category of goods/services are not rendered unavailable, it must not, however, result in the proprietor of that mark being stripped of all protection for goods/services which, although not strictly identical to those in respect of which it has succeeded in proving genuine use, are not in essence different from them and belong to a single category which cannot be divided other than in an arbitrary manner. In fact, in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods/services concerned by the registration.
- 51 Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or subcategories (14/07/2005, T-126/03, Aladin, EU:T:2005:288, § 46; 06/03/2014, T-71/13, Annapurna, EU:T:2014:105, § 53).
- 52 In the case at hand, bearing in mind the said case-law, the contested trade mark is registered for the following contested goods and services:
- Class 9 – Electronic amusement apparatus; arcade games; video games; computer software, including game software;
- Class 28 – Computer games, electronic games and video games, all being hand-held;
- Class 41 – Entertainment; production, presentation, exhibition and rental of games cartridges for use with electronic games; amusement arcade services.

- 53 However, genuine use of the mark was found to be proven only for:

Class 9 – Electronic amusement apparatus; arcade games; PC video games; PC game software;

Class 41 – Television entertainment services.

*'Computer software' in Class 9*

- 54 Picking up on specific issues raised by the EUTM proprietor, firstly, looking at the contested registered goods in Class 9, it must be noted that the term 'computer software' has an extremely broad and undefined scope of application, with all kinds of specific types of different applications (10/02/2010, R 340/2009-2, *Inferno / Inferno*, § 28, 31-33; 06/06/2013, R 387/2012-2, *ER / STUDIO*, § 45).
- 55 It therefore seems appropriate to build sub-categories capable of being viewed independently and which however do not result in the proprietor of the trade mark being stripped of all protection for goods which are not strictly identical to those in respect of which it has succeeded in proving genuine use (14/07/2005, T-126/03, *Aladin*, EU:T:2005:288, § 46).
- 56 The evidence provided, notably the licence agreements with well-known multinational video game developers/publishers or gaming companies such as Ubisoft and IGT, GTECH, etc. regarding the use of the contested mark's video games, coupled with the royalties reports, Amazon (online retailer) screenshots of the EUTM proprietor's products, i.e. the 'CSI:NY: The Game' DVD-ROM disc (Exhibit 2), and the remaining promotional and press clippings shows that the mark is being used for 'game software' and not just 'PC game software' as the contested decision states.
- 57 PC games, also known as computer or personal computer games, are video games played on a personal computer rather than a dedicated video game console or arcade machine. However, it can be seen from the evidence that the 'CSI:NY' video game is not only a game with a PC format but can also be played online, e.g. via Facebook, can be downloaded, and is available through mobile devices. The game is also designed to be played on WII, XBOX, DS (Nintendo DS) and PS (PlayStation), all being either home or hand-held game consoles, as confirmed from the licensee agreements and sworn statements (e.g. affidavit of Jerome Siba of Gameloft SE and its exemplary Exhibit 1 release of the CSI ranges of games including CSI:NY game). Thus, the game can be found for PC and Macintosh format, as can be seen from the license agreement of 2003 with Ubisoft, but also, from the other license agreements and remaining evidence filed, it can be seen that the game can be found in non-PC format, dedicated for hand-held games, mobile or wireless games (exemplary exhibits of the affidavit of Jerome Siba of Gameloft SE for mobile gaming of the CSI:NY video game).
- 58 For the sake of clarity, as mentioned above, the Board points out that the cancellation applicant's claim concerning lack of independent evidence is unfounded. All the documents filed by the opponent represent valid means of proof, and they include not only internal documents, but also external and/or public ones as mentioned above, such as extracts from third parties' websites, press clippings and videos articles. The combined examination of all the documents submitted supports of the reliability of the evidence.

- 59 As the evidence given does not show use of the trade mark other than for game software, it is appropriate to limit the protection of the trade mark to the sub-category of ‘game software’ in Class 9, that take into account the legitimate interest of the proprietor to extend its range of goods in the future, within the confines of the terms describing the goods for which the trade mark is registered. None of the evidence provided shows genuine use of goods which would fall outside of this specific area of computer software.
- 60 In the present case, in the Board’s opinion, the category of ‘computer software’ is sufficiently broad for it to be possible to identify within it various sub-categories capable of being viewed independently. The concept of ‘computer software’ covers goods which are sufficiently different in their intended purpose, method of use, usual origin and in their channels of distribution and end consumers, for it to be possible to identify within it various sub-categories. In addition, the criterion of the purpose or intended use of the product or service in question is of fundamental importance in the definition of a sub-category of goods or services (23/09/2009, T-493/07, T-26/08 & T-27/08, Famoxin, EU:T:2009:355, § 37 and the case-law therein cited, judgment confirmed by 09/07/2010, C-461/09 P, Famoxin, EU:C:2010:421).
- 61 Indeed, in certain circumstances, it is not necessary to prove the use for all goods within a same category or subcategory (08/10/2014, T-300/12, Fairglobe, EU:T:2014:864, § 46). However, in this case, the evidence provided is so clearly limited to the single product ‘game software’, that no proof of a broader coverage of the contested mark has been provided. Moreover, these specific goods cannot justify by themselves coverage for the entire category of ‘computer software’.
- 62 In those circumstances, the Board finds that proof of genuine use of the contested mark has been proved only in respect of the subcategory of goods ‘game software’, which is however broader than the subcategory of ‘PC game software’ identified in the contested decision.

*‘Video games’ in Class 9*

- 63 As to the term ‘video games’ in Class 9, the EUTM proprietor also argues that the Cancellation Division delimited too narrowly the sub-category of the EUTM proprietor’s goods, finding that the contested mark was only used for ‘PC video games’ and not ‘video games’.
- 64 ‘Video games’ is a fairly broad term that can encompass any of various interactive games played using a specialised electronic gaming device or a computer or mobile device and television or other display screen.
- 65 According to the evidence given by the EUTM proprietor, Exhibit 1 shows that computer video games bearing the contested mark are being sold on Amazon and it can be seen from the various licence agreements and merchandising agreements that the EUTM proprietor’s CSI:NY video game can be played on PC, WII, XBOX, DS and PS, all of which are either being personal/home computer gaming or video game consoles .

- 66 Exhibit 3 also shows that the ‘CSI:NY’ mobile games have been tested on a third party’s website, German website [www.testberichte.de](http://www.testberichte.de) and since 24 May 2010 can be downloaded from the website [www.mob.org](http://www.mob.org), and, therefore, played on wireless devices, including smartphones. Exhibit 4 shows that ‘CSI:NY’ (depicted as CSI:NYC – both abbreviations NY and NYC making the same reference to New York (City)) PC game DVDs and CDS were sold by the EUTM proprietor’s licensees during the relevant period, in particular during 2010-2012 in, for example, amongst others, the Benelux, Scandinavia, Spain, and the United Kingdom.
- 67 Exhibit 12, which consists of an affidavit of Mr Yves Guillemot, co-founder and president of Ubisoft Entertainment SA, confirms that the EUTM has been used in connection with ‘format and online games (Facebook)’ in the EU since 2007, which are available on mobile devices such as smartphones. Similarly, Exhibit 17, which consists of an affidavit of Jerome Sibade, Associate General Counsel of Gameloft (French video game developer which entered into a licensing agreement with the EUTM proprietor of the license of the contested mark for mobile games) also confirms that the mark has been used in connection with wireless games, i.e. available for download on wireless devices in the EU during the relevant period from 2007 to 2014.
- 68 Thus, contrary to the contested decision, the Board considers that use of the contested mark has been proven in relation to ‘video games’, and not just ‘PC video games’.
- 69 Although it may be true that most of the video games seem to be PC or computer based video games, the borderline between such PC video games being specifically in a PC format only and video games downloadable on tablets, mobile devices, etc. in a non-PC format is not well defined.
- 70 As stated in 14/07/2005, T-126/03, Aladin, EU:T:2005:288, § 46, ‘Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner’.
- 71 Also, in 14/07/2005, T-126/03, Aladin, EU:T:2005:288 § 47 to 50, the General Court found that proof of use for ‘a product for polishing metals consisting of cotton impregnated with a polishing agent’ was not limited to that specific product but fulfilled the requirement for the broader product category ‘polish for metals’. Thus, when annulling the Board’s decision for giving the EUTM proprietor a too narrow protection, the General Court referred to the proprietor’s interest of being able to extend its range of goods by using the protection which registration of the trade mark confers on it, also for sale to a different public. This seems to be justified in relation to ‘video games’ in this case.
- 72 The conclusion must be that, especially taking into consideration the broad use in respect of different types of video games shown by the EUTM proprietor, the goods for which the EUTM has been registered form a sufficiently narrowly-

defined category in which the use requirement can be considered to be fulfilled. Under the present circumstances the specification cannot be divided other than in an arbitrary manner. Furthermore, to limit the specification of goods to ‘PC video games’, and thereby not giving the EUTM proprietor the option to extend its range of goods more generally to video games, within the confines of the terms describing the goods for which the EUTM is presently registered, would be an unjustified limitation on the scope of protection conferred by the European Union Trade Mark registration.

- 73 The Board, therefore, considers that it is fair to conclude, without prejudice to the further discussions on extent of use set out infra, that there is sufficient proof of use of the sign on ‘video games’.

*‘Computer games, electronic games and video games, all being hand-held’ in Class 28*

- 74 The Board considers that the same applies to the contested goods in Class 28.

- 75 Hand-held computer, electronic and video games are essentially video games designed for a hand-held device. In the past, as the EUTM proprietor states, this primarily meant hand-held game consoles, such as the Nintendo Game Boy line. Nowadays, with the increasing sophistication of hand-held consoles, these include Nintendo 3DS and PlayStation to name but a few. However, with rapid growth in technology over the years, mobile games have increasingly become popular in mobile phones, MP3 players, tablets, and other similar portable gadgets.

- 76 As already shown above, the evidence as a whole shows that the CSI:NY video game is used and designed for playing on PC, WII, XBOX, DS and PS and that it can be downloaded and played on mobile phones and tablets, being hand-held consoles or devices. Thus, the Board considers, contrary to the contested decision, that use of the mark has been proven for the contested goods in Class 28.

*‘Entertainment, except for television entertainment services; production, presentation, exhibition and rental of games cartridges for use with electronic games; amusement arcade services’ in Class 41*

- 77 As far as the relevant services in Class 41 are concerned, the Board agrees with the contested decision’s findings that the evidence submitted by the EUTM proprietor does not show that the contested mark was used for those services in Class 41. There is a fundamental difference between proving use of the contested mark for goods such as arcade game machines on the one hand, and providing a service such as an amusement arcade services on the other. Similarly, no evidence was filed to show that the EUTM proprietor provides ‘production, presentation, exhibition and rental of games cartridges for use with electronic games’ or any other type of ‘entertainment services, except for television entertainment services’.

- 78 It is therefore confirmed that the evidence does not demonstrate that the contested mark has been subjected to genuine commercial use for the above-mentioned Class 41 services for which it is registered.

### *Conclusion*

- 79 In conclusion, the Board finds that the EUTM proprietor failed to demonstrate genuine use of its EUTM, in respect of the following contested services :

Class 41 – Entertainment, except for television entertainment services; production, presentation, exhibition and rental of games cartridges for use with electronic games; amusement arcade services.

- 80 Genuine use was proven in respect of the following contested goods:

Class 9 – Video games; game software.

Class 28 – Computer games, electronic games and video games, all being hand-held.

- 81 In light of the above, the contested decision must be partially annulled to the extent that it declared the EUTM registration revoked in respect of ‘computer games, electronic games and video games, all being hand-held’ in Class 28 as well as to the extent that it limited the use of the contested mark for the contested goods ‘video games’ and ‘computer software, including game software’ in Class 9 to ‘PC video games’ and ‘PC game software’.

- 82 The EUTM proprietor’s appeal is partially upheld to the extent the EUTM remains registered for the above-contested goods in Class 28, and in respect of the broad category ‘video games’ in Class 9 and broader sub-category ‘game software’ also in Class 9. It is dismissed for the remainder.

### **Costs**

- 83 For reasons of equity, each party must bear its own costs in the appeal proceedings, in accordance with Article 85(2) EUTMR.

**Order**

On those grounds,

THE BOARD

hereby:

**1. Partially annuls the contested decision to the extent it declared the EUTM registration revoked in respect of ‘computer games, electronic games and video games, all being hand-held’ in Class 28, as well as to the extent that it declared that the mark remains registered for only ‘electronic amusement apparatus; arcade games; PC video games; PC game software’ in Class 9.**

**2. Declares the EUTM proprietor’s rights, in respect of its EUTM, to be revoked as from 24 October 2014 for part of the contested goods and services, namely:**

**Class 41 – Entertainment, except for television entertainment services; production, presentation, exhibition and rental of games cartridges for use with electronic games; amusement arcade services.**

**3. Declares that the EUTM remains registered in respect of the uncontested goods and services and the following contested goods:**

**Class 9 – Electronic amusement apparatus; arcade games; video games; game software;**

**Class 28 – Computer games, electronic games and video games, all being hand-held;**

**Class 41 – Television entertainment services.**

**4. Orders each party to bear its own costs in the revocation and appeal proceedings.**

Signed

T. de las Heras

Signed

C. Negro

Signed

C. Govers

Registrar:

Signed

H.Dijkema

