

DECISION
of the Fourth Board of Appeal
of 8 February 2023

In case R 1726/2019-4

S.C. Scio International S.R.L

Str. Andrei Muresanu, No. 15
417495 Sanmartin, judet Bihor
Romania

EUTM Proprietor/ Appellant

represented by Carmen-Augustina Neacsu, 12/3 Rozelor Street, 430293 Baia Mare,
Maramures, Romania

v

Mandelay Kft.

Gyártelep 12001/33 hrsz.
2310 Szigetszentmiklós
Hungary

Cancellation Applicant / Defendant

represented by Danubia Szabadalmi És Jogi Iroda KFT., Bajcsy-Zsilinszky út 16., 1051
Budapest, Hungary

APPEAL relating to Cancellation Proceedings No 15 253 C (European Union trade mark
registration No 11 122 256)

THE FOURTH BOARD OF APPEAL

composed of N. Korjus as a single Member having regard to Article 165(2) and (5) EUTMR,
Article 36 EUTMDR and Article 7 of the Decision of the Presidium on the organisation of
the Boards of Appeal as currently in force

Registrar: H. Dijkema

gives the following

Language of the case: English

Decision

Summary of the facts

- 1 By an application filed on 25 July 2012, S.C. Scio International S.R.L. ('the EUTM proprietor') sought to register the word mark

EDUCTOR SCIO

for the following list of goods and services:

Class 10: *Medical apparatus, instruments and articles.*

Class 35: *Marketing of medical apparatus, instruments and articles.*

Class 37: *Repair, maintenance and installation in the field of medical apparatus, instruments and articles.*

- 2 The mark was registered on 28 December 2012.
- 3 On 17 July 2017, Mandelay Kft. ('the cancellation applicant') filed a request for a declaration of invalidity of the registered mark in its entirety. The application was based on three grounds: Article 52(1)(b) of Regulation (EC) No 207/2009, as modified (ground 1), Article 53(1)(b) in conjunction with Article 8(3) of Regulation (EC) No 207/2009, as modified (ground 2), and Article 60(1)(c) in conjunction with Article 8(4) of Regulation (EC) No 207/2009, as modified, claiming a non-registered mark 'SCIO' in Hungary, Spain, Italy and the Netherlands (ground 3).
- 4 By decision of 7 June 2019 ('the contested decision'), the Cancellation Division upheld the request for a declaration of invalidity on the basis of its ground 1 and declared the contested EUTM invalid in its entirety. It ordered the EUTM proprietor to bear the costs.
- 5 On 6 August 2019, the EUTM proprietor filed an appeal against the contested decision, requesting that the decision be set aside in its entirety. The statement of grounds of the appeal was received on 2 September 2019.
- 6 In its response of 13 November 2019, the cancellation applicant requested that the appeal be dismissed.
- 7 On 20 and 27 April 2020, the parties were informed that the appeal proceedings had been suspended until the General Court judgments in Cases T-84/20 and T-85/20 are final.
- 8 On 8 September 2021, the General Court handed down its judgments (08/09/2021, T-84/20, Eductor / Eductor, EU:T:2021:555; 08/09/2021, T-85/20, Eductor / Eductor, EU:T:2021:556), which were not further appealed.
- 9 By decision of 17 January 2022, notified to the parties on 2 February 2022, the appeal was re-allocated from the Fifth Board of Appeal to the Fourth Board of Appeal with the reference number R 1726/2019-4.

- 10 On 3 August 2022, the EUTM proprietor informed the Office that it had decided not to renew the contested EUTM.
- 11 On 27 December 2022, the EUTM proprietor withdrew the appeal. The Registry of the Boards of Appeal acknowledged of receipt for the withdrawal of the appeal on 12 January 2023. On the same day, the cancellation applicant was notified of the withdrawal.

Reasons

- 12 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 13 Pursuant to Article 66 EUTMR, an appeal shall have suspensive effect. It follows that an appeal may be withdrawn at any moment before the decision on the appeal becomes final.
- 14 The EUTM proprietor has terminated the appeal proceedings by withdrawing the appeal. The Board declares the appeal proceedings closed. As a consequence, the contested decision has become final

Costs

- 15 Pursuant to Article 109(4) EUTMR, the party who terminates the proceedings by withdrawing the appeal, shall bear the fees and the costs incurred by the other party. Therefore, the EUTM proprietor must bear the cancellation applicant's costs of the cancellation and appeal proceedings.
- 16 As to the appeal proceedings, these consist of the cancellation applicant's costs of professional representation of EUR 550.
- 17 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.
- 18 The total amount for both proceedings is, therefore, EUR 1 630.

Order

On those grounds,

THE BOARD

hereby:

- 1. Takes note of the withdrawal of the appeal and declares the appeal proceedings closed;**
- 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

N. Korjus

Registrar:

Signed

H. Dijkema

