

	<p>TRIBUNAL DE PRIMERA INSTANCIA DE LAS COMUNIDADES EUROPEAS Soud prvního stupně Evropských společenství DE EUROPÆISKE FÆLLESSKABERS RET I FØRSTE INSTANS GERICHT ERSTER INSTANZ DER EUROPÄISCHEN GEMEINSCHAFTEN EUROOPA ÜHENDUSTE ESIMESE ASTME KOHUS ΠΡΩΤΟΔΙΚΕΙΟ ΤΩΝ ΕΥΡΩΠΑΪΚΩΝ ΚΟΙΝΟΤΗΤΩΝ COURT OF FIRST INSTANCE OF THE EUROPEAN COMMUNITIES TRIBUNAL DE PREMIÈRE INSTANCE DES COMMUNAUTÉS EUROPÉENNES CÚIRT CHÉADCHÉIMENA GCOMHPHOBAL EORPACH TRIBUNALE DI PRIMO GRADO DELLE COMUNITÀ EUROPEE EIROPAS KOPIENU PIRMĀS INSTANCES TIESA</p>	<p>EUROPOS BENDRIJŲ PIRMOSIOS INSTANCIJOS TEISMAS EURÓPAI KÖZÖSSÉGEK ELŐFOKÚ BÍRÓSÁGA IL-QORT TAL-PRIMI INSTANZA TAL-KOMUNITAJIET EWROPEJ GERECHT VAN EERSTE AANLEG VAN DE EUROPESE GEMEENSCHAPPEN SĄD PIERWSZEJ INSTANCIJ WSPÓLNOT EUROPEJSKICH TRIBUNAL DE PRIMEIRA INSTÂNCIA DAS COMUNIDADES EUROPEIAS SÚD PRVÉHO STUPŇA EURÓPSKÝCH SPOLOČENSTEV SODIŠČE PRVE STOPNJE EVROPSKIH SKUPNOSTI EUROOPAN YHTEISÖJEN ENSIMMÄISEN OIKEUSASTEEN TUOMIOISTUIN EUROPEISKA GEMENSKAPERNAS FÖRSTAINSTANSRÄTT</p>
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Press and Information

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16 March 2006

Judgment of the Court of First Instance in Case T-322/03

Telefon & Buch Verlagsgesellschaft mbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) – Herold Business Data GmbH & Co. KG

THE COURT OF FIRST INSTANCE UPHOLDS THE DECISION OF OHIM TO CANCEL THE COMMUNITY WORD MARK ‘WEISSE SEITEN’ FOR CERTAIN GOODS

The term ‘weiße Seiten’ has become a synonym, in the German language, for telephone directories for private individuals

In 1996, the company Telefon & Buch Verlagsgesellschaft filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) in respect of the word sign WEISSE SEITEN to cover various goods, including IT goods and printed matter, reference works and classified directories.

Subsequent to the registration of that Community trade mark in 1999, the company Herold Business Data sought cancellation of the registration.

In 2003 the Board of Appeal of OHIM cancelled the mark WEISSE SEITEN for IT goods, discs, CD-ROMs, printed matter, reference works and classified directories because ‘weiße Seiten’ was a customary term signifying telephone directories for private individuals. It also cancelled the mark for stationery, office requisites, publishing services and editing of written texts on the ground that the sign was descriptive and devoid of any distinctive character.

Telefon & Buch Verlagsgesellschaft challenged OHIM’s decision before the Court of First Instance of the European Communities. It submitted that the Board of Appeal’s assessment that the term ‘weiße Seiten’ had become part of the German language as a synonym for ‘alphabetisches Teilnehmerverzeichnis’ (telephone directories for private individuals) before the date of application for registration is incorrect.

The Court, first, pointed out that the documents produced by the applicant for cancellation of the regulation, such as the various documents from the Austrian postal service for example, show that 'weiße Seiten' was a term which, on the date of application for registration of the mark WEISSE SEITEN, had already become generic in Germany for telephone directories for private individuals. Given that Telefon & Buch Verlagsgesellschaft did not draw any distinction within the generic category 'printed matter, reference works, classified directories', to which telephone directories in paper form belong, the mark had to be declared invalid for the whole of that category.

Next, the Court noted that telephone directories for private individuals are available not only on paper, but also in electronic form, on the internet or on CD-ROM. Therefore, the term 'weiße Seiten' must also be considered to be a customary term for electronic directories, as was also apparent from the internet research carried out during the administrative procedure before OHIM. Given that Telefon & Buch Verlagsgesellschaft did not draw any distinction between the goods within the category 'magnetic data carriers and recorded storage media for data processing installations and equipment, in particular tapes, discs, CD-ROMs', the mark had to be cancelled in respect of all those goods.

In addition, since the term has become a synonym, in the German language, for telephone directories for private individuals, it may also be considered to be descriptive of the products for which it is regarded as being a customary term. Given that publishing services and editing of written texts concern the creation and drawing-up of those products, the term 'weiße Seiten' may also be regarded as descriptive of those services, since it describes their intended purpose.

As regards the other goods, such as stationery and office requisites, the term in question can be understood in the sense of 'weißfarbige Seiten' (white-coloured pages) and can be used as a synonym of 'weißfarbige Blätter' (white-coloured sheets). Therefore, since Telefon & Buch Verlagsgesellschaft did not draw any distinction within the various categories, the mark is also descriptive of all those goods.

The Court concluded that the link between the mark WEISSE SEITEN and the characteristics of all the goods and services in dispute is so close that the mark, being descriptive, should not have been registered.

Consequently, the Court dismissed the action brought by Telefon & Buch Verlagsgesellschaft.

REMINDER: An appeal, limited to points of law only, may be brought before the Court of Justice of the European Communities against a decision of the Court of First Instance, within two months of its notification.

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Languages available: DE, EN, FR, PL

*The full text of the judgment may be found on the Court's internet site
<http://curia.eu.int/jurisp/cgi-bin/form.pl?lang=EN&Submit=rechercher&numaff=T-322/03>
It can usually be consulted after midday (CET) on the day judgment is delivered.*

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