



## **AN EXCLAMATION MARK CANNOT BE REGISTERED AS A COMMUNITY TRADE MARK**

*The figurative signs in question have no distinctive character and JOOP! has not demonstrated that they have acquired such character through their use in the Community*

According to the Community Trade Mark Regulation<sup>1</sup>, a trade mark which is devoid of distinctive character cannot, in principle, be registered. Such a mark may, however, be registered if it has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it.

On 7 September 2006, JOOP! GmbH filed two applications for registration of trade marks at OHIM, the Community trade mark office. The marks for which registration was sought are the following figurative signs:



The OHIM examiner rejected the applications for registration on the ground that the marks applied for were devoid of distinctive character. The appeals filed by JOOP! at OHIM against the examiner's decisions were also rejected, as OHIM found, inter alia, that, regard being had to the goods in question (jewellery, clothes and related goods), the relevant public would perceive the signs at issue as mere laudatory advertising, or as an eye-catching gimmick, and not as an indication of the commercial origin of those goods.

JOOP! challenged OHIM's decisions before the Court of First Instance.

The Court of First Instance recalls, first, that registration of a trade mark which consists of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by that mark is not excluded as such by virtue of such use. However, a sign which fulfils functions other than that of a trade mark in the traditional sense of the term will be distinctive only if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin.

In the present cases, the marks applied for cannot be considered capable of identifying the commercial origin of the goods which they designate. The lack of distinctive character arises, inter alia, from the fact that the consumer, including a consumer having a high degree of attention, will not be in a position to infer the origin of the goods designated by relying on a mere exclamation mark, which – as it does not have a graphical design which is peculiar to it and which differs from

<sup>1</sup> Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), now Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

the standard graphical design – will be perceived rather as mere laudatory advertising or as an eye-catching gimmick.

Nor can the rectangular frame which surrounds the exclamation mark in the second trade mark applied for be regarded as a sufficiently distinctive element. The rectangular frame which surrounds the exclamation mark is a secondary element, which gives the mark in question the appearance of a label. Moreover, by reason of the fact that the designated goods are often sold with an accompanying label, placing the mark inside a label-like rectangle is a very common practice in the relevant commercial sector.

Next, the Court of First Instance notes that the acquisition by a trade mark of distinctive character through use requires that, because of that mark, at least a significant proportion of the relevant public identifies the products or services concerned as originating from a specific undertaking. Furthermore, the mark must have become distinctive through use before the application for registration was filed.

The Court also points out – in reply to the applicant's argument that the relevant public are accustomed to its principal trade mark and to its insignia JOOP! – that it is possible that the mark applied for may have acquired distinctive character in the course of its use as a part of the applicant's principal trade mark.

However, the Court finds that the documents submitted by JOOP!, through which it seeks to demonstrate that the marks applied for have acquired distinctive character through use in the Community, refer only to the German market. Moreover, the only evidence submitted consists of three photos of jeans to which a piece of cloth, or a label, is attached showing an exclamation mark. That evidence is clearly incapable of providing proof of the relevant consumers' knowledge of the mark applied for before the date on which the application for registration was filed.

The Court of First Instance accordingly dismisses the actions.

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**NOTE:** An appeal, limited to points of law only, may be brought before the Court of Justice against the decision of the Court of First Instance within two months of notification of the decision.

**NOTE:** An action for annulment seeks the annulment of acts of the Community institutions that are contrary to Community law. The Member States, the European institutions and individuals may, under certain conditions, bring an action for annulment before the Court of Justice or the Court of First Instance. If the action is well founded, the act is annulled. The institution concerned must fill any legal vacuum created by the annulment of the act.

**NOTE:** Community trade marks are valid throughout the European Union and co-exist with national trade marks. Applications for registration of a Community trade mark must be sent to OHIM. Actions against its decisions may be brought before the Court of First Instance.

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*The [full text](#) of the judgment is published on the CURIA website on the day of delivery*

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