

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)

30 June 2004^{*}

In Case T-281/02,

Norma Lebensmittelfilialbetrieb GmbH & Co. KG, established in Nuremberg (Germany), represented by S. Rojahn and S. Freytag, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by D. Schennen, acting as Agent,

defendant,

ACTION brought against the decision of the Third Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 3 July 2002 (Case R 239/2002-3), concerning the registration of the word mark 'Mehr für Ihr Geld' as a Community trade mark,

^{*} Language of the case: German.

THE COURT OF FIRST INSTANCE OF THE EUROPEAN COMMUNITIES
(Fourth Chamber),

composed of: H. Legal, President, V. Tiili and M. Vilaras, Judges,
Registrar: J. Plingers, Administrator,

having regard to the application lodged at the Court Registry on 18 September 2002,

having regard to the response lodged at the Court Registry on 16 December 2002,

further to the hearing on 3 March 2004,

gives the following

Judgment

Background to the dispute

- ¹ On 19 May 2000 the applicant filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) ('the Office') under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.

2 The trade mark in respect of which registration was sought is the sign 'Mehr für Ihr Geld'.

3 The goods and services in respect of which registration of the trade mark was sought were in Classes 3, 29, 30 and 35 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following descriptions for each class:

- Class 3: 'Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, toilet preparations (included in Class 3); hair lotions, hair care preparations; deodorising preparations for personal use; dentifrices';

- Class 29: 'Meat, sausage, fish (including processed shellfish, crustaceans and molluscs), poultry and game; meat, sausage, poultry, game and fish products; meat extracts; fruit, vegetables, herbs and potatoes in preserved, dried, cooked, frozen or processed form, including peanut kernels, nuts, almonds and cashew nut kernels, including being snacks; potato products, namely French fries, potato croquettes, potato fritters, potato rissoles, fried potatoes; meat, sausage, fish, fruit and vegetable jellies; marmalades and jams; eggs; milk, in particular buttermilk, sour milk, curds, milk preserves and condensed milk; butter, clarified butter, cheese, in particular quark, cheese preserves, kefir, cream, yoghurt (including yoghurt with added fruit), powdered milk for food; desserts, mainly of milk, yoghurt, quark, gelatine, starch and/or cream; non-alcoholic milk and mixed milk beverages; edible oils and fats, including margarine and lard; spreads of edible fats and edible fat mixtures; cooking oils, cooking fats, separating oils and separating fats for cooking; meat, sausage, fish, fruit and vegetable preserves; delicatessen salads as well as frozen food, mixed, semi-prepared (including with fillings) and prepared meals, including preserved meals, mainly consisting of meat, sausage, fish, poultry, game, prepared fruits

and vegetables, pulses, cheese, eggs, potatoes, pasta, rice, maize, farinaceous foods and/or potato products (including potato flour), including the aforesaid goods with added spices and sauces (including salad dressings) and/or combined with bread or bread rolls (for example hamburgers or sandwiches); pies, namely meat pies, pies mainly filled with meat, fish, fruit or vegetables and empty pie cases; mixed pickles; bouillon extracts, meat stock cubes and other meat stock preparations, in particular meat stock cubes, vegetable stock cubes; instant soups, soup concentrates and soup seasonings in liquid, concentrated and dried form, stock paste preparations, vegetable extracts being additives for foodstuffs and meat’;

- Class 30: ‘Coffee, tea, cocoa, sugar (including vanillin and vanilla sugar and glucose for food), rice, tapioca, sago, artificial coffee, coffee and tea extracts; cocoa powder; non-alcoholic coffee, tea, cocoa and chocolate-based beverages including instant drinks; blancmanges, blancmange powders and blancmange desserts; flour and preparations made from cereals (except animal feed); popcorn, corn flakes for food; cereals for human consumption, in particular oat flakes or other cereal flakes, in particular being breakfast foodstuffs, including the aforesaid goods mixed with dried fruits (including nuts), sugar and/or honey; potato flour, semolina; pasta, prepared pasta meals and pasta preserves; bread, cookies, cakes and other pastries; sweet and/or savoury snacks mainly consisting of cereals, cocoa, cake, chocolate, sugar, honey, dried fruit, nuts, potato products (including potato flour), peanut kernels, almonds, cashew nut kernels and/or pastries; long life cakes and pastries (including with sweet or spicy fillings), in particular crispbread, gingerbread and biscuits; pizzas, including preserved pizzas; chocolate; confectionery, in particular chocolate products and pralines, including confectionery with a filling of fruit, coffee, non-alcoholic drinks, wine and/or spirits, and of milk or milk products, in particular yoghurt; ices and powder for ices; confectionery, in particular sweetmeats (candy) and chewing gum, not for medical purposes; marzipan; honey, invert

sugar cream, fruit syrup, treacle; spreadable cocoa substances, spreads, mainly consisting of sugar, cocoa, nougat, milk and/or fats; yeast, baking powder, essences for baking (except essential oils); salt for food, mustard, pepper, vinegar, sauces (including salad dressings), powdered sauces and sauce extracts (including the aforesaid goods for salad dressings), salad dressings; mayonnaise; ketchup, spices and condiments; ice’;

— Class 35: ‘Marketing, sales promotion, sales and purchasing consultancy, market research and market analysis; business, organisation, personnel and professional business consultancy; advertising; advertising documents; consultancy on interior decoration of business premises and shops for advertising purposes, shop window dressing; providing of information and know-how in the commercial and professional business sector; in particular in the retail food sector; accountancy, negotiating and concluding commercial transactions, arranging contracts for the buying and selling of goods; distribution of goods for advertising purposes’.

4 By decision of 18 January 2002, the examiner refused the trade mark application on the ground that the mark applied for was descriptive and not distinctive within the meaning of Article 7(1)(b) and (c) of Regulation No 40/94.

5 On 15 March 2002 the applicant filed at the Office notice of appeal against the examiner’s decision, under Article 59 of Regulation No 40/94.

6 By decision of 3 July 2002 (‘the contested decision’), the Third Board of Appeal annulled the examiner’s decision in so far as it refused the trade mark application in respect of the services in Class 35. The Board of Appeal dismissed the remainder of the appeal.

- 7 As regards the goods in Classes 3, 29 and 30, the Board of Appeal held, in essence, that the mark applied for, first, consisted exclusively of descriptive indications and, second, was devoid of any distinctive character.

Forms of order sought by the parties

- 8 The applicant claims that the Court should:

- annul the contested decision in so far as it upholds the refusal of the registration application in respect of Classes 3, 29 and 30;

- order the Office to pay the costs.

- 9 The Office contends that the Court should:

- dismiss the application;

- order the applicant to pay the costs.

Law

- 10 The applicant advances two pleas in law alleging, respectively, infringement of Article 7(1)(c) of Regulation No 40/94 and infringement of Article 7(1)(b) of that regulation. It is appropriate to consider the second plea first.

Arguments of the parties

- 11 The applicant submits that the trade mark applied for, 'Mehr für Ihr Geld', possesses the minimum of distinctiveness required for the purposes of Article 7(1)(b) of Regulation No 40/94.
- 12 The consumer regards the sign 'Mehr für Ihr Geld' as a whole and as an indication of the particular undertaking which is the origin of the goods and services to which it applies. It is precisely because that sign takes the form of a direct statement meaning 'if you buy this from us, you will get more for your money!', that the average consumer sees it as an indication not so much as to a product's quality as to the advantages of making his purchases from the user of that slogan.
- 13 Furthermore, according to the applicant, since the mark applied for, 'Mehr für Ihr Geld', is short and striking, the consumer is curious to find out what 'more' it involves, so that the slogan sticks in his memory and acts as an indication of origin. The slogan makes use, in an original way, of the ambivalence between the word 'mehr' ('more'), which is uncertain, and whose meaning therefore remains obscure, and the words 'Ihr Geld' ('your money'), which, for the consumer, is more understandable and has a more personal meaning.

- 14 The fact that the slogan in question consists of common understandable elements which have already been used on numerous occasions in trade is irrelevant to the assessment of the distinctiveness of the mark applied for, since trade mark law does not protect the separate elements of trade marks and a trade mark must always be considered as a whole. In the applicant's submission the fact that some of the words in the slogan 'Mehr für Ihr Geld' are occasionally used descriptively in advertisements of the goods and services covered does not justify the refusal of the trade mark application on the basis of lack of distinctive character. In the actual combination of those words which are directly addressed to the consumer courted by the advertising the sign is understood, in the same way as a house mark, as an indication of the commercial origin of the goods and not only as an indication of a particular quality of those goods.
- 15 The applicant adds that, because the mark applied for is short, striking and ambivalent, the consumer will find in it, not that this is necessary to overcome the ground for refusal, a conceptual whole which provokes an effect of surprise and, therefore, of identification. The interpretation of the element 'mehr' ('more'), which arouses curiosity, together with the indication 'Ihr Geld' ('your money') produces an effect of astonishment and strangeness for the consumer in the context of a slogan communicating a positive advertising statement, with the result that the mark applied for must, as a whole, be regarded as distinctive within the meaning of the case-law (Case T-138/00 *Erpo Möbelwerk v OHIM (DAS PRINZIP DER BEQUEMLICHKEIT)* [2001] ECR II-3739).
- 16 According to the applicant, it is because of the mark's short and striking character, of its formulation, which constitutes a direct and personal appeal, and of its vague meaning that the mark applied for will be perceived as a house mark and that it will enable the consumer to discern the extra value of the product purchased in the applicant's shops. The applicant contests the examiner's assertion that the mark applied for does not involve any element of imagination. That assessment does not permit the conclusion that it lacks distinctive character.

- 17 In addition, the applicant points out that all the examples of the use of the sign in question or of its elements, relied upon by the examiner, reveal descriptive use of elements of the mark applied for or of variations of it. However, undertakings competing with the applicant would be free to use the mark descriptively even after registration.
- 18 Furthermore, the applicant cites a decision of the Bundesgerichtshof (Federal Court of Justice), *Partner with the best* (Markenrecht 2000, pp. 50 and 51), according to which the repeated presence of various words from an advertising slogan or a similar advertising slogan, for example on internet pages, cannot lead to a contrary assessment since, as a matter of principle, the mark applied for must be assessed as a whole and, consequently, searching for documents in which the various words appear in descriptive indications cannot give rise to any conclusion as to the frequency of that mark's use. The same goes for a Community trade mark.
- 19 As a result, the mark applied for, 'Mehr für Ihr Geld', cannot be regarded, in respect of Classes 3, 29 and 30, as a sign devoid of any distinctive character.
- 20 The Office maintains that the Board of Appeal was justified in finding that the mark applied for was not distinctive in respect of the goods it designates with regard to the relevant public.
- 21 The Office points out that any trade mark for which registration is sought must not only possess a distinctive character, but also be suited to performing a function as an indication of origin. The Office states that it has always considered that the fact that a trade mark is an advertising slogan does not prevent it from being accorded protection as such, just as it does not justify the application of stricter assessment criteria to the examination of the absolute grounds for refusal (see, to that effect, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 40, and Case T-130/01

Sykes Enterprises v OHIM (REAL PEOPLE, REAL SOLUTIONS) [2002] ECR II-5179, paragraph 19). That approach does not mean, however, that the effect of the mark applied for on the consumer concerned must be ignored. On the contrary, according to the Office, that effect must be taken into account since it is a matter of establishing whether the mark whose registration is sought, on the assumption that it is actually used, will or will not be perceived by the public concerned as an indication of origin.

- 22 The Office disputes the applicant's assertion that the mark applied for, 'Mehr für Ihr Geld' ('More for your money'), can perform a role as an indication of origin. According to the Office, that mark is simple, banal and directly accessible. The tenor of its message coincides exactly with the information which the consumer can draw from it, namely that the customer will be able to obtain 'more' in exchange for his money. The mark applied for therefore merely draws attention to a particularly advantageous offer.

Findings of the Court

- 23 According to Article 7(1)(b) of Regulation No 40/94, 'trade marks which are devoid of any distinctive character' are not to be registered. In addition, Article 7(2) of Regulation No 40/94 states that '[p]aragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community'.
- 24 The signs devoid of any distinctive character referred to in Article 7(1)(b) of Regulation No 40/94 are signs which are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them 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 (Case T-79/00 *Rewe-Zentral v OHIM (LITE)* [2002] ECR II-705, paragraph 26). Such is the case for inter alia signs which are commonly used in connection with the marketing of the goods or services concerned (Case T-122/01 *Best Buy Concepts v OHIM (BEST BUY)* [2003] ECR II-2235, paragraph 20).

- 25 However, 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 (see, by analogy, *Merz & Krell*, cited above, paragraph 40). A sign which fulfils functions other than that of a trade mark in the traditional sense of the term is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 however 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 (*BEST BUY*, cited above, paragraph 21).
- 26 A sign's distinctiveness can be assessed only, firstly, by reference to the goods or services in respect of which registration is sought and, secondly, on the basis of the perception of that sign by the relevant public (*BEST BUY*, paragraph 22).
- 27 In the present case it must be stated, first of all, that the goods designated by the mark applied for are cleaning and cosmetic materials and foods for everyday consumption by consumers as a whole. Consequently, the target public is deemed to be the average consumer who is reasonably well-informed and reasonably observant and circumspect. In addition, under Article 7(2) of Regulation No 40/94, the target public by reference to which the absolute ground for refusal must be assessed is German-speaking, since the sign in question is composed of elements of the German language (see, to that effect, Case T-219/00 *Ellos v OHIM (ELLOS)* [2002] ECR II-753, paragraphs 30 and 31, and Case T-295/01 *Nordmilch v OHIM (OLDENBURGER)* [2003] ECR II-4365, paragraph 35).

- 28 As regards, next, the distinctive character of the mark applied for, the Board of Appeal held, at paragraph 36 of the contested decision, that the slogan claimed was devoid of the minimum distinctive character required, since it would be understood by the commercial circles concerned as a mere indication of the particular quality of the goods offered and not as a mark indicating the undertaking from which they come. That is because, as a common and customary slogan devoid of distinctive additional elements, that sign has no distinctive character.
- 29 It must be stated that the Board of Appeal correctly analysed the mark applied for. That mark will be perceived immediately by the target public as a mere promotional formula or a slogan which indicates that the goods in question offer consumers an advantage in terms of quantity and/or quality as against competing goods (see, to that effect, *BEST BUY*, paragraph 29). In that regard, the element 'Mehr' ('more') is laudatory for the sake of advertising, the purpose being to highlight the positive qualities of the goods or services for the presentation of which that element is used (see, to that effect, Joined Cases T-79/01 and T-86/01 *Bosch v OHIM (Kit Pro and Kit Super Pro)* [2002] ECR II-4881, paragraph 26).
- 30 Furthermore, the applicant itself stated that the mark applied for gives the consumer the general idea that, if he buys the goods designated by that mark, he gets 'more for his money'.
- 31 In that regard, the applicant's argument that the consumer is told nothing about the content or nature of the goods offered under that mark is irrelevant, because he does not know to what the word 'more' relates. For a finding that there is no distinctive character, it is sufficient to note that the semantic content of the word mark in question indicates to the consumer a characteristic of the product relating to its market value which, whilst not specific, comes from promotional or advertising information which the relevant public will perceive first and foremost as such, rather than as an indication of the commercial origin of the goods (see, to that effect, *REAL*

PEOPLE, REAL SOLUTIONS, paragraphs 29 and 30). In addition, the mere fact that the word mark 'Mehr für Ihr Geld' does not convey any information about the nature of the goods concerned is not sufficient to make that sign distinctive (see, to that effect, *BEST BUY*, paragraph 30).

32 Furthermore, there is nothing about the mark applied for, 'Mehr für Ihr Geld', that might, beyond its obvious promotional meaning, enable the relevant public to memorise it easily and instantly as a distinctive trade mark for the goods designated. Even if the mark applied for were used alone, without any other sign or trade mark, the relevant public could not, in the absence of prior knowledge, perceive it otherwise than in its promotional sense (*REAL PEOPLE, REAL SOLUTIONS*, paragraph 28).

33 As regards the argument based by the applicant on the judgment in *DAS PRINZIP DER BEQUEMLICHKEIT*, cited above, that a mark such as that applied for must be regarded as distinctive, it is sufficient to state that, under the case-law subsequent to that judgment, the trade marks covered by Article 7(1)(b) of Regulation No 40/94 are not only those which are commonly used in trade for the presentation of the goods or services concerned, but also those which are merely capable of such use (see, to that effect, *Kit Pro and Kit Super Pro*, cited above, paragraph 19, and the case-law there cited). In finding essentially that, 'with its few pithy words, combined very simply' the mark applied for indicates to consumers that the goods concerned offer an advantage in terms of quantity and/or quality, the Board of Appeal, in paragraph 31 of the contested decision, showed sufficiently in law that such mark is capable of being commonly used in trade for the presentation of the goods concerned.

34 In those circumstances, it must be held that the trade mark applied for will be perceived first and foremost by the relevant public as a promotional slogan, because of its meaning, rather than as a trade mark, and that it is therefore devoid of any distinctive character.

- 35 As to the registration of the slogan 'Partner with the best' in Germany, cited by the applicant, it must be borne in mind that it is settled case-law, first, that the Community trade mark system is autonomous and, second, that the legality of decisions of the Boards of Appeal is to be assessed purely by reference to Regulation No 40/94, and not the Office's practice in earlier decisions (judgments in Cases T-122/99 *Procter & Gamble v OHIM (soap bar shape)* [2000] ECR II-265, paragraphs 60 and 61; T-32/00 *Messe München v OHIM (electronica)* [2000] ECR II-3829, paragraphs 46 and 47; T-106/00 *Streamserve v OHIM (STREAMSERVE)* [2002] ECR II-723, paragraph 66, and *REAL PEOPLE, REAL SOLUTIONS*, paragraph 31). Accordingly, the Office is bound neither by national registrations nor by its own previous decisions.
- 36 Consequently, the applicant's second plea in law must be rejected.
- 37 As is apparent from Article 7(1) of Regulation No 40/94, for a sign to be ineligible for registration as a Community trade mark, it is sufficient that one of the absolute grounds for refusal listed should apply (Case C-104/00 P *DKV v OHIM* [2002] ECR I-7561, paragraph 29; Case T-331/99 *Mitsubishi HiTec Paper Bielefeld v OHIM (Giroform)* [2001] ECR II-433, paragraph 30, and Case T-348/02 *Quick v OHIM (Quick)* [2003] ECR II-5071, paragraph 37). In those circumstances, it is unnecessary to consider the plea in law alleging infringement of Article 7(1)(c) of Regulation No 40/94.
- 38 Accordingly, the application must be dismissed.

Costs

- 39 Under Article 87(2) of the Rules of Procedure of the Court of First Instance, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, and the Office has applied for costs, the applicant must be ordered to pay the costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

- 1. Dismisses the application;**
- 2. Orders the applicant to pay the costs.**

Legal

Tiili

Vilaras

Delivered in open court in Luxembourg on 30 June 2004.

H. Jung

Registrar

H. Legal

President