

JUDGMENT OF THE COURT (Third Chamber)
15 September 2005 *

In Case C-37/03 P,

APPEAL under Article 56 of the Statute of the Court of Justice lodged at the Court on 3 February 2003,

BioID AG, established in Berlin (Germany), in judicial liquidation, represented by A. Nordemann, Rechtsanwalt,

appellant,

the other party to the proceedings being

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by A. von Mühlendahl and G. Schneider, acting as Agents,

defendant at first instance,

* Language of the case: German.

THE COURT (Third Chamber),

composed of A. Rosas, President of the Chamber, J.-P. Puissechet, S. von Bahr, J. Malenovský and A. Ó Caoimh (Rapporteur), Judges,

Advocate General: P. Léger,

Registrar: M. Ferreira, Principal Administrator,

having regard to the written procedure and further to the hearing on 13 January 2005,

after hearing the Opinion of the Advocate General at the sitting on 2 June 2005,

gives the following

Judgment

- 1 By its appeal, BioID AG requests the Court to set aside the judgment of the Court of First Instance of the European Communities of 5 December 2002 in Case T-91/01 *BioID v OHIM (BioID)* [2002] ECR II-5159, 'the judgment under appeal', dismissing the action brought against the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('OHIM') of 20 February 2001 (Case R 538/1999-2) ('the contested decision'), refusing registration as a Community trade mark of the compound mark containing the abbreviation 'BioID'.

Legal framework

- 2 Under Article 4 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1):

‘A Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.’

- 3 Article 7 of that regulation states:

‘1. The following shall not be registered:

...

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;

- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;

...'

Background to the dispute

- 4 On 8 July 1998, the appellant, acting under its former name, D.C.S. Dialog Communication Systems AG, filed an application with OHIM for a Community trade mark in respect of a compound mark ('the trade mark applied for'), made up of the sign reproduced below:

BioID[®].

- 5 The goods and services in respect of which registration of the said mark is sought fall under Classes 9, 38 and 42 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. They correspond to the following descriptions, which were set out in the application for registration of the mark:

- computer software, computer hardware and parts therefor, optical, acoustic and electronic apparatus and parts therefor, all the aforesaid goods in particular for and in connection with the monitoring of user passwords, for computer intercommunication and for the computer-aided identification and/or verification of live organisms based on one or more specific biometric characteristics, in Class 9;

- telecommunications; security services in connection with computer communications, access to databases, electronic payment transactions, the checking of user passwords and the computer-aided identification and/or verification of live organisms based on one or more specific biometric characteristics, in Class 38;

- providing of software on the internet and other communications networks, on-line maintenance of computer programs, computer programming, all the aforesaid services in particular for and in connection with the monitoring of user passwords, computer intercommunication and the computer-aided identification and/or verification of live organisms based on one or more specific biometric characteristics; technical development of systems for monitoring user passwords, for computer intercommunication, and of systems for the computer-aided identification and/or verification of live organisms based on one or more specific biometric characteristics, in Class 42.

6 By decision of 25 June 1999 the examiner refused the application, on the ground that the mark applied for was descriptive of the goods concerned and devoid of any distinctive character within the meaning of Article 7(1)(b) and (c) of Regulation No 40/94. The appellant appealed against that decision.

7 By the contested decision, the Second Board of Appeal of OHIM dismissed the appeal on the ground that Article 7(1)(b) and (c) of Regulation No 40/94 precluded registration of the trade mark applied for, since the latter, read as a whole, constitutes a shortened form of the words 'biometric identification' and thus described characteristics of the goods and services claimed. It also concluded that the graphic elements could not endow the mark with any distinctive character within the meaning of Article 7(1)(b).

The procedure before the Court of First Instance and the judgment under appeal

8 By application lodged at the Registry of the Court of First Instance on 25 April 2001, the appellant sought annulment of the contested decision. It put forward two pleas in law alleging infringement of Article 7(1)(b) and of Article 7(1)(c) of Regulation No 40/94.

9 In rejecting the action before it, the Court considered first of all, in paragraph 23 of the judgment under appeal, that:

'As is clear from the case-law, the signs referred to in Article 7(1)(b) of Regulation No 40/94 are, in particular, those which, from the point of view of the relevant public, are commonly used in trade in connection with the presentation of the goods

or services concerned or in respect of which there is, at least, evidence that they could be used in that way. Such signs do not enable the relevant public to repeat the experience of a purchase, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition of the goods or services concerned (see, to that effect, Case T-79/00 *Rewe-Zentral v OHIM (LITE)* [2002] ECR II-705, paragraph 26).’

- 10 Accordingly, the Court of First Instance considered, in paragraph 25 of the judgment under appeal, that the relevant public is, in any event, one with experience in the sector of the goods and services in question.
- 11 Next, the Court of First Instance held, in paragraph 27 of that judgment, in particular, that a trade mark composed of several elements must, for the purposes of assessing its distinctive character, be considered as a whole and that that is not inconsistent with a successive examination of the different composite elements of the mark.
- 12 Firstly, as regards the trade mark applied for, the Court of First Instance found in paragraph 28 of that judgment that, in English, the element ‘ID’ is a standard abbreviation of the noun ‘identification’, and that the prefix ‘Bio’ may constitute either an abbreviation of an adjective (‘biological’ or ‘biometrical’) or the abbreviation of a noun (‘biology’). It found in paragraph 29 of that judgment that, in the light of the goods and services claimed, the relevant public understands BioID as meaning ‘biometrical identification.’
- 13 Secondly, in respect of all of the goods and services covered by the trade mark applied for, the Court held, in paragraphs 30 to 32 of the judgment under appeal, first, as regards the goods and services in Class 9, that the biometric identification of

live organisms involves or even requires the use of the said goods, and second, as regards the goods and services in Classes 38 and 42, that, since those services are provided by means of biometric identification or relate to the development of systems for such identification, the abbreviation BioID directly refers to one of the qualities of those services, which may be taken into account by the relevant public when choosing such services.

- 14 According to the Court of First Instance, in paragraph 34 of its judgment, from the point of view of the relevant public, the abbreviation BioID was likely to be commonly used, in trade, for the presentation of the goods and services in the categories referred to in the application for registration. Accordingly, it is devoid of distinctive character as regards those categories of goods and services.
- 15 In paragraph 37 of the judgment under appeal, the Court of First Instance observed that the figurative elements of the trade mark applied for, consisting of 'Arial' typeface and characters of different boldness, are commonly used, in trade, for the presentation of all types of goods and services and are thus devoid of distinctive character in relation to the categories of goods and services concerned.
- 16 Next, in paragraphs 38 to 40 of the aforesaid judgment, and in relation to the graphic elements of the trade mark applied for, the Court held that, as regards the full stop '■', the appellant itself had declared that that element is commonly used as the last of several elements in a word mark, indicating that the mark is an abbreviation, and that, as regards the sign '®', its function is limited to indicating that the mark has been registered for a specific territory and that, in the absence of such registration, the use of that graphic element would be misleading for the public. The Court of First Instance therefore concluded that the aforementioned graphic elements are likely to be used, in trade, to present all types of goods and services and are therefore devoid of distinctive character in respect of those goods and services.

- 17 Moreover, in paragraph 41 of that judgment, having considered each of the elements of the trade mark applied for, the Court found the trade mark applied for to be composed of a combination of elements, each of which is likely to be used, in trade, to present goods and services in the categories claimed by that trade mark and is therefore devoid of distinctive character in respect of those goods and services.
- 18 The Court of First Instance thus held, in paragraphs 42 to 44 of the judgment under appeal, that, since there was no concrete evidence, such as, for example, the way in which the various elements are combined, to indicate that the compound trade mark applied for, taken as a whole, was greater than the sum of its parts, that trade mark is therefore devoid of distinctive character in respect of the categories of goods and services concerned.
- 19 Furthermore, in relation to the appellant's arguments based on the existence of other registered Community trade marks, the Court of First Instance, pointing out, in paragraph 47 of the said judgment, that factual or legal grounds contained in a previous OHIM decision may constitute arguments supporting a plea alleging infringement of a provision of Regulation No 40/94, nevertheless found that, in the present case, the appellant did not rely on grounds contained in other decisions which might call into question the above findings as to the distinctive character of the trade mark applied for.
- 20 The Court of First Instance thus concluded, in paragraphs 49 and 50 of that judgment, that the plea alleging infringement of Article 7(1)(b) of Regulation No 40/94 therefore had to be rejected and that it was unnecessary to consider the plea alleging infringement of Article 7(1)(c) of that regulation.

The appeal

- 21 By its appeal, the appellant claims that the Court should set aside the judgment under appeal, annul the contested decision and order OHIM to pay the costs.
- 22 OHIM contends that the Court should dismiss the appeal and order the appellant to pay the costs.
- 23 In support of its appeal, the appellant puts forward two grounds of appeal. In the first it alleges that the Court of First Instance interpreted incorrectly and too broadly the absolute ground for refusal to register trade marks which are devoid of any distinctive character, laid down in Article 7(1)(b) of Regulation No 40/94. In its second ground of appeal it claims that, if the Court of First Instance interpreted the latter provision of the regulation correctly, it erred in law in not dealing with the second plea submitted at first instance, alleging infringement of that regulation.

First ground of appeal, alleging infringement of Article 7(1)(b) of Regulation No 40/94

- 24 This ground of appeal can be divided into four heads of claim.

First head of claim, concerning the account to be taken of the overall impression produced by the trade mark applied for

- 25 With this head of claim, the appellant complains that the Court of First Instance did not take as a basis for its assessment as to whether the trade mark applied for is capable of having distinctive character the criterion of the impression produced by that trade mark as a whole on the relevant public. The appellant submits that, although the Court of First Instance examined each of the different figurative and graphic elements of that trade mark in detail and based its conclusions on that examination, it did not really analyse the overall impression.
- 26 In the view of OHIM, the Court of First Instance examined the trade mark applied for as a whole, even though it rightly asserted that that approach does not preclude starting with a separate analysis of each of its individual components. OHIM, which itself carried out such an analysis, concluded that the overall impression produced by each of the elements of the trade mark applied for was of a sign that is not distinctive.
- 27 First, the essential function of a trade mark is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see, in particular, Case 102/77 *Hoffmann-La Roche* [1978] ECR 1139, paragraph 7, and Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 30). Article 7(1)(b) of Regulation No 40/94 is thus intended to preclude registration of trade marks which are devoid of distinctive character which alone renders them capable of fulfilling that essential function (see Case C-329/02 P *SAT.1 v OHIM* [2004] ECR I-8317, paragraph 23).
- 28 Secondly, in order to determine whether a sign is of a character such as to render it registrable as a trade mark, it is appropriate to take the viewpoint of the relevant public.

- 29 Thirdly, as regards a compound mark, such as that which forms the subject-matter of the present dispute, any distinctive character may be assessed, in part, in respect of each of the terms or elements, taken separately, but that assessment must, in any event, be based on the overall perception of that trade mark by the relevant public and not on the presumption that elements individually devoid of distinctive character cannot, on being combined, present such character (see *SAT.1 v OHIM*, cited above, paragraph 35). The mere fact that each of those elements, considered separately, is devoid of distinctive character does not mean that their combination cannot present such character (see, by way of analogy, Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraphs 99 and 100, Case C-265/00 *Campina Melkunie* [2004] ECR I-1699, paragraphs 40 and 41, as well as *SAT.1 v OHIM*, cited above, paragraph 28).
- 30 In *SAT.1 v OHIM*, cited above, concerning an application for a Community trade mark in respect of the term SAT.2, the Court set aside the judgment of the Court of First Instance in Case T-323/00 *SAT.1 v OHIM (SAT.2)* [2002] ECR II-2839, on the ground that, in order to justify refusal of registration of that term, that Court had based itself on the presumption that elements individually devoid of distinctive character cannot, on being combined, present such a character. The Court of First Instance had thus examined the impression as a whole produced by that term only as a secondary matter, refusing to attribute any relevance to aspects such as the existence of a fanciful element, which ought to be taken into account in such an analysis.
- 31 In paragraph 27 of the judgment under appeal, the Court of First Instance rightly held that, for the purposes of assessing the distinctive character of a compound mark, it is not inconsistent with a successive examination of the different composite elements of the mark to consider that mark as a whole.
- 32 Admittedly, in paragraph 42 of the judgment under appeal, having taken the view that the different elements of the trade mark applied for were devoid of distinctive character, the Court of First Instance found that the trade mark itself should also be presumed to be devoid of such character.

- 33 However, contrary to the situation in *SAT.1 v OHIM (SAT.2)*, cited above, that finding did not, in this case, affect the Court of First Instance's analysis on that point since it did not restrict itself to examining the overall impression produced by the trade mark applied for as a secondary matter, but directed part of its reasoning to considering, in relation to a compound mark, the sign's distinctiveness as a whole.
- 34 In paragraph 42 of the judgment under appeal, the Court of First Instance noted that, where it does not appear that there is concrete evidence, such as, for example, the way in which the various elements are combined, to indicate that a compound trade mark, taken as a whole, is greater than the sum of its parts, such a trade mark is devoid of distinctive character in respect of the goods and services concerned.
- 35 In addition, in paragraphs 43 and 44 of the aforesaid judgment, the Court of First Instance referred to its detailed analysis, first, of the typographical elements described in paragraph 37 of that judgment, and second, of the graphic elements referred to in paragraphs 38 and 39 of the judgment. In doing so, the Court of First Instance integrated the analysis in those paragraphs of the judgment into its examination of the impression produced by the trade mark applied for as a whole, with a view to determining whether the mark is of a character such as to render it registrable as a trade mark.
- 36 Finally, the Court of First Instance found that the structure of the trade mark applied for did not alter the conclusion that the trade mark, taken as a whole, was devoid of distinctive character.
- 37 That reasoning is not vitiated by any error of law, since the Court of First Instance ascertained whether the said mark, taken as a whole, had distinctive character.

38 It follows from this that the first head of claim of the first ground of appeal must be rejected as unfounded.

Second head of claim, concerning the evidence that the trade mark applied for was actually used by the public or by competitors

39 With this head of claim, the appellant submits that, in considering that the trade mark applied for was devoid of distinctive character, the Court of First Instance did not take into account the fact that it could not be proved that the trade mark applied for was actually used by the public or by competitors, that it did not appear in dictionaries and that, although an internet search of the terms 'biometric identification' gave more than 19 075 results, the trade mark applied for has only been used in publications on 'biometric identification' originating from the appellant.

40 OHIM contends that the specific evaluation of the impact of a trade mark on consumers, clearly defined in relation to the goods and services for which registration of the sign is requested, amounts to a finding of fact which cannot be examined by the Court unless the Court of First Instance is alleged to have distorted the facts. Since the appellant has not put forward any factor capable of undermining the Court of First Instance's findings of fact on that point, this ground of appeal is inadmissible.

41 As regards the question of proof that the trade mark applied for was commonly used in a descriptive way by the public or by competitors, it is sufficient to point out, first, that the fact that it has been shown that the trade mark applied for is commonly used by the public or by competitors is a relevant factor under Article 7(1)(d) of Regulation No 40/94, but not under Article 7(1)(b) (see, to that effect, Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraphs 40 and 46).

- 42 Secondly, the specific evaluation of the impact of a trade mark on consumers, clearly defined in relation to the goods and services for which registration of the sign is requested, amounts to a finding of fact. The appellant is thus effectively requesting the Court to substitute its own assessment of the facts for that carried out by the Court of First Instance.
- 43 It is clear from Article 225 EC and the first paragraph of Article 58 of the Statute of the Court of Justice that an appeal lies on points of law only. The Court of First Instance thus has exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence. The appraisal of those facts and the assessment of that evidence thus does not, save where they distort the evidence, constitute a point of law which is subject, as such, to review by the Court of Justice on appeal (see, to that effect, Case C-104/00 P *DKV v OHIM* [2002] ECR I-7561, paragraph 22; Case C-194/99 P *Thyssen Stahl v Commission* [2003] ECR I-10821, paragraph 20; and Case C-136/02 P *Mag Instrument v OHIM* [2004] ECR I-9165, paragraph 39).
- 44 In those circumstances, the second head of claim of the first ground of appeal must accordingly be rejected as being partly unfounded and partly inadmissible.

Third head of claim, concerning the account to be taken of other trade marks registered as Community trade marks

- 45 With this head of claim, the appellant claims that the Court of First Instance should have considered that other marks registered by OHIM as Community trade marks, including not only other marks containing the prefix 'Bio' and another descriptive term, but also the word mark Bioid, were indications of the distinctive character of the trade mark applied for.

- 46 OHIM contends that, since the decisions of the Boards of Appeal are not decisions which involve discretion, but rather the exercise of circumscribed powers, earlier decisions cannot be used as criteria of comparison. The list of word marks containing the element 'Bio' and refused by OHIM is just as long as the list of trade marks registered that include that element. Comparable registrations have to be examined on a case by case basis, taking into account, in particular, the goods and services for which registration of the sign is requested. Furthermore, OHIM points out that the word mark 'BioID' cannot be compared with the figurative mark BioID. The figurative separation, also shown graphically, of 'Bio' on the one hand, and 'ID' on the other hand, clearly illustrates that those are two elements of one mark. In the case of the word mark BioID, those elements of separation are completely lacking.
- 47 In that regard, it is necessary to point out, first of all, that decisions concerning registration of a sign as a Community trade mark which the Boards of Appeal are called on to take under Regulation No 40/94 are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the legality of the decisions of Boards of Appeal must be assessed solely on the basis of that regulation, as interpreted by the Community judicature, and not on the basis of a previous decision-making practice of those boards (see Case T-19/04 *Metso Paper Automation v OHIM (PAPERLAB)* [2005] ECR II-2383, paragraph 39).
- 48 In addition, the distinctiveness of a mark must be assessed, first, in relation to the goods or services in respect of which registration has been applied for and, second, in relation to the perception of them by the relevant public.
- 49 It follows that the identity or similarity of the trade mark applied for in relation to another Community trade mark is irrelevant where, as in this case, elements of fact or of law which have been put forward in support of the application for that other mark are not put forward by the appellant for the purpose of showing the distinctive character of the trade mark applied for.

- 50 In any event, contrary to the appellant's submissions, the Court of First Instance did not in any way refuse to examine the evidence deriving from OHIM's decision-making practice.
- 51 The Court of First Instance thus held, in paragraph 47 of the judgment under appeal, that factual or legal grounds contained in a previous decision may constitute arguments supporting a plea alleging infringement of a provision of Regulation No 40/94. However, in the same paragraph of that judgment it expressly stated that, in relation to the trade mark applied for, the appellant had not relied on grounds contained in earlier decisions of the Boards of Appeal recognising the registrability of other marks containing the element 'Bio' which might call into question the findings in the contested decision as to its distinctive character.
- 52 Moreover, having noted at the hearing that the appellant also relied on the registration by OHIM of the word mark BioID for the categories of goods and services described as 'printing products', 'telecommunications' and 'computer programming', the Court of First Instance concluded that, contrary to the appellant's submission, the trade mark applied for and the word mark 'BioID' are not interchangeable, and the fact that in the said word mark the letters 'id' are in lower case distinguishes it, in terms of its semantic content, from the abbreviation BioID.
- 53 Finally, as has already been pointed out in paragraph 43 of this judgment, it is clear from Article 225 EC and the first paragraph of Article 58 of the Statute of the Court of Justice, that an appeal lies on points of law only. The Court of First Instance thus has exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence. The appraisal of those facts and the assessment of that evidence thus does not, save where they distort the evidence, constitute a point of law which is subject, as such, to review by the Court of Justice on appeal.

- 54 However, in calling into question the Court of First Instance's assessment of the similarity and identity of the registered trade marks, and accordingly the relevance of earlier decisions of OHIM, the appellant is in reality merely challenging the appraisal of the facts carried out by the Court of First Instance, without mentioning or alleging any such distortion.
- 55 The third head of claim of the first ground of appeal must accordingly be rejected as being partly unfounded and partly inadmissible.

Fourth head of claim, concerning the criterion for refusal of registration

- 56 With this final head of claim of the first ground of appeal, which the appellant raised for the first time at the hearing, it claims that the Court of First Instance interpreted Article 7(1)(b) of the regulation erroneously in finding that the trade marks referred to in that provision are, in particular, those which, from the point of view of the relevant public, are commonly used in trade in connection with the presentation of the goods or services concerned or in respect of which there is, at least, evidence that they could be used in that way.
- 57 OHIM contends that the Court of First Instance did not commit any error in considering that the trade mark applied for can be commonly used. In its opinion, that trade mark would not readily be perceived as a mark of origin by the limited public targeted by the application in this case. Furthermore, at the hearing, OHIM raised by implication the question of the admissibility of this head of claim which had not been raised in the appeal.

58 In that connection, and as the Advocate General indicates in point 25 of his Opinion, it should be noted that this head of claim was submitted in support of the first ground of appeal put forward by the appellant to the Court, according to which the Court of First Instance erroneously interpreted the absolute ground for refusal to register trade marks which are devoid of any distinctive character, laid down in Article 7(1)(b) of Regulation No 40/94. Consequently, it is not a new plea within the meaning of Article 42(2) of the Rules of Procedure.

59 As regards the validity of the head of claim, it must be pointed out that each of the grounds for refusal to register listed in Article 7(1) of Regulation No 40/94 is independent of the others and calls for separate examination (see *OHIM v Erpo Möbelwerk*, cited above, paragraph 39). Furthermore, the various grounds for refusal must be interpreted in the light of the general interest underlying each of them. The general interest taken into consideration when examining each of those grounds for refusal may, or even must, reflect different considerations, according to the ground for refusal in question (see Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraphs 45 and 46, and *SAT.1 v OHIM*, cited above, paragraph 25).

60 In addition, it must be pointed out that the notion of general interest underlying Article 7(1)(b) of Regulation No 40/94 is, manifestly, indissociable from the essential function of a trade mark, which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see, *SAT.1 v OHIM*, cited above, paragraphs 23 and 27).

61 In paragraphs 23, 34, 41 and 43 of the judgment under appeal, the Court of First Instance primarily accepted the fact that the trade mark applied for is likely to be commonly used in trade, in order to establish that it fell within Article 7(1)(b) of the regulation.

62 It must, however, be stated that, as the Court of Justice held in paragraph 36 of *SAT.1 v OHIM*, cited above, that criterion, although relevant in relation to Article 7(1)(c) of Regulation No 40/94, is not the yardstick by which Article 7(1)(b) must be interpreted.

63 Consequently, it must be held that the head of claim alleging that the Court of First Instance applied a criterion relevant in the context of Article 7(1)(c) of the regulation rather than in that of Article 7(1)(b) is well founded.

64 Therefore, the first ground of appeal, alleging erroneous interpretation of Article 7(1)(b) of Regulation No 40/94, must be accepted.

65 It follows from the foregoing, without there being any need to examine the second ground of appeal, that the judgment under appeal must be set aside in so far as the Court of First instance erred in law in its interpretation of Article 7(1)(b) of Regulation No 40/94.

Substance of the action at first instance

66 Under the second sentence of the first paragraph of Article 61 of the Statute of the Court of Justice, the latter may, where the decision of the Court of First Instance is quashed, itself give final judgment in the matter, where the state of the proceedings so permits. That is the case here.

- 67 In that regard, and as is clear from paragraphs 27 and 28 of this judgment, in order to ascertain whether the trade mark applied for guarantees the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin, it is appropriate to take the viewpoint of the relevant public.
- 68 Thus, bearing in mind the goods and services covered by the trade mark application described in paragraph 5 of this judgment, it appears that the relevant public is one with experience in the sector of the goods and services in question, reasonably well-informed and reasonably observant and circumspect.
- 69 The trade mark applied for contains the abbreviation BioID and figurative elements, namely the typographical characteristics of that abbreviation, and two graphic elements placed after the abbreviation BioID, namely a full stop (■) and a sign (®).
- 70 As regards the said abbreviation, and as OHIM rightly found in the contested decision, the relevant public will understand BioID, in the light of the goods and services claimed in the trade mark application, as being made up of the abbreviation of an adjective 'biometrical' and of a noun ('identification'), and thus, as a whole, as meaning 'biometrical identification'. Therefore, that abbreviation, which is indistinguishable from the goods and services covered by the trade mark application, is not of a character which can guarantee the identity of the origin of the marked product or service to the consumer or end-user from the viewpoint of the relevant public.
- 71 In addition, in the light of the recurrent nature of the typographical features of the abbreviation BioID and the absence of any particular distinctive element, the

characters in 'Arial' typeface and characters of different boldness do not enable the trade mark applied for to guarantee, to the relevant public, the identity of the origin of the goods and services covered by the trade mark application.

- 72 Furthermore, the two graphic elements placed after the abbreviation BioID, namely a full stop (■) and a sign (®), do nothing to enable the relevant public to distinguish, without any possibility of confusion, the products or services covered by the trade mark application from others which have another origin. It follows that those graphic elements are not capable of fulfilling the essential function of a trade mark, as described in paragraph 25 of the present judgment, in relation to the relevant goods and services.
- 73 As pointed out by the Advocate General in point 105 of his Opinion, when the overall impression conveyed by the trade mark applied for to the relevant public is examined, the abbreviation BioID, which is devoid of any distinctive character, is the dominant element of that mark.
- 74 Moreover, as OHIM observed in paragraph 21 of the contested decision, the figurative and graphic elements are so minimal in nature that they do not endow the trade mark applied for as a whole with any distinctive character. Those elements do not possess any feature, in particular in terms of fancifulness or as regards the way in which they are combined, allowing that mark to fulfil its essential function in relation to the goods and services covered by the trade mark application.
- 75 Accordingly, the trade mark applied for is devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94. In those circumstances, the appellant's action against the contested decision must be dismissed.

Costs

- 76 Under Article 122 of the Rules of Procedure of the Court of Justice, where the appeal is well founded and the Court of Justice itself gives final judgment in the case, the Court is to make a decision as to costs. Under Article 69(2) of the Rules of Procedure of the Court of Justice, which applies to appeals by virtue of Article 118, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since OHIM has applied for costs against the appellant and the appellant has been unsuccessful, the latter must be ordered to pay the costs of the proceedings at first instance and on appeal.

On those grounds, the Court (Third Chamber) hereby:

- 1. Sets aside the judgment of the Court of First Instance of the European Communities of 5 December 2002 in Case T-91/01 *BioID v OHIM (BioID)* [2002] ECR II-5159;**
- 2. Dismisses the action against the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 20 February 2001;**
- 3. Orders the appellant to pay the costs of the proceedings at first instance and on appeal.**

[Signatures]