

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)

8 July 2004 *

In Case T-289/02,

Telepharmacy Solutions Inc., established in North Billerica, Massachusetts (United States), represented by R. Davis, barrister, and M. Medycky, solicitor,

applicant,

v

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

defendant,

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 28 June 2002 (Case R 108/2001-4), concerning registration of the word sign TELEPHARMACY SOLUTIONS as a Community trade mark,

* Language of the case : English.

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

composed of: H. Legal, President, V. Tiili and M. Vilaras, Judges,
Registrar: B. Pastor, Deputy Registrar,

having regard to the written procedure and following the hearing on 10 March 2004,

gives the following

Judgment

Facts

- 1 On 26 November 1999, the applicant, formerly Adds Inc., filed an application for a Community word mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to 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 for which registration was sought was the word sign TELEPHARMACY SOLUTIONS.

3 The goods and services in respect of which registration was sought are in Classes 9, 10, 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, and correspond, for each of those classes, to the following description:

- ‘Computers, computer peripherals, computer cabinets, printers, labellers, computer furniture and computer software; data carriers; also all the aforesaid goods comprising parts of a dispensing system and/or being for use in pharmaceutical, pharmacy or medical services; dispensing systems comprising software and hardware’, within Class 9;

- ‘Dispensing systems; dispensing systems for packaged pharmaceutical and/or packaged medical products; dispensing systems comprising cabinets; parts and fittings for all the aforesaid goods’, within Class 10;

- ‘Transmission of information, data and dispensing instructions, electronic and/or radio transmission of information, data and dispensing instructions’, within Class 38;

- ‘Patient consulting services; forwarding of dispensing instructions to remote dispensing system; medical and pharmacy services’, within Class 42.

- 4 By decision of 21 November 2000, the examiner rejected the application for registration on the basis of Article 7(1)(b) of Regulation No 40/94. The examiner took the view that the sign concerned was directly descriptive of the goods and services referred to in the trade-mark application, since the term 'telepharmacy' was commonly used in relation to the distribution of medicinal products from a distance. The examiner considered that, read as a whole, the mark TELEPHARMACY SOLUTIONS merely told the consumer that the applicant, by providing the goods and services in respect of which registration was sought, was offering solutions to undertakings or individuals who wished to set up telepharmacy businesses. The trade mark was therefore considered to be devoid of any distinctive character in respect of all the goods and services applied for.
- 5 On 22 January 2001, the applicant filed a notice of appeal at OHIM under Article 59 of Regulation No 40/94 against the examiner's decision. It provided a statement of grounds of appeal by letter of 21 March 2001.
- 6 By decision of 28 June 2002 ('the contested decision') the Fourth Board of Appeal of OHIM dismissed the appeal on the ground that Article 7(1)(c) of Regulation No 40/94 precluded the registration of the word mark TELEPHARMACY SOLUTIONS because the latter was likely to be perceived by consumers as an indication of the intended purpose of the goods and services applied for, namely that they were intended for the distribution of pharmaceutical products from a distance. In the Board's view, the mark applied for described the equipment and services employed in the distribution of pharmaceutical products from a distance, since the term 'telepharmacy' was commonly used in that area.

Procedure and forms of order sought

- 7 By application lodged at the Registry of the Court of First Instance on 20 September 2002, the applicant brought the present action.

8 In its application initiating proceedings, the applicant indicated that this action concerned only the following goods: 'a system for remote control electronic dispensing of packaged pharmaceuticals comprising a storage housing from which the packaged pharmaceuticals products are stored and dispensed, a computer connected to the dispenser, and a communications network connecting the computer to a remote computer', within Class 9.

9 The applicant claims that the Court should:

- annul the contested decision in so far as it applies to the goods referred to in paragraph 8 above;

- order OHIM to pay the costs.

10 OHIM contends that the Court should:

- dismiss the action;

- order the applicant to pay the costs.

Law

11 The applicant relies on three pleas in law in support of its action. They allege (i), in essence, infringement of its rights of defence, (ii) infringement of Article 7(1)(b) and (c) of Regulation No 40/94 and (iii) infringement of the principle of legitimate expectations.

The subject-matter of the proceedings

- 12 It is necessary to consider, as a preliminary point, whether the applicant's request in the application initiating proceedings, which seeks to restrict the list of goods and services covered by the trade-mark application (see paragraph 8 above), is admissible.
- 13 It is appropriate to bear in mind in that regard that an applicant for a Community trade mark may at any time apply to OHIM for the list of goods or services to be restricted, in accordance with Article 44 of Regulation No 40/94 and Rule 13 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1). It is clear from those provisions that the list of goods or services specified in a Community trade mark application may be restricted only in accordance with certain detailed rules. Since the request made by the applicant in the application initiating proceedings does not comply with those rules, it cannot be considered to be an application for amendment within the meaning of those provisions (see, to that effect, Case T-194/01 *Unilever v OHIM (Ovoid tablet)* [2003] ECR II-383, paragraph 13).
- 14 Rather, that request may be interpreted as meaning that the applicant is merely seeking partial annulment of the contested decision (see, to that effect, the *Ovoid tablet* judgment, cited in paragraph 13 above, paragraph 14). Such a request is not, as such, contrary to the prohibition in Article 135(4) of the Rules of Procedure on changing, before the Court of First Instance, the subject-matter of the proceedings before the Board of Appeal (see, to that effect, the *Ovoid tablet* judgment, cited in paragraph 13 above, paragraph 15).
- 15 In this instance, as both the applicant and OHIM confirm in their answers to a written question asked by the Court, what is involved is a request for partial annulment of the contested decision, which does not change the subject-matter of the proceedings for the purposes of Article 135(4) of the Rules of Procedure. Therefore, the request is admissible.

First plea: infringement of the rights of defence

Arguments of the parties

- 16 The applicant submits that whilst the examiner's decision of 21 November 2000 is based solely on Article 7(1)(b) of Regulation No 40/94, the contested decision is founded on Article 7(1)(c) of that regulation. The Board of Appeal put forward a new absolute ground for refusal to register without the applicant having the opportunity to state its opinion thereon or submit evidence in that regard. In acting in that way, the Board of Appeal infringed Article 73 of Regulation No 40/94.
- 17 OHIM contends that this plea should be rejected, given that the reasons for refusal to register in this case, on the basis of Article 7(1)(b) and Article 7(1)(c) of Regulation No 40/94, were the same. Only the legal basis for the refusal to register was changed. The Boards of Appeal are entitled to proceed in that way, by virtue of Article 62 of Regulation No 40/94, which provides that the Board of Appeal may exercise any power within the competence of the department which was responsible for the decision.
- 18 OHIM submits that it has not infringed Article 73 of Regulation No 40/94 because it has consistently stated that the reason for the refusal to register the trade mark applied for was that the sign concerned was descriptive of all the goods and services referred to, namely that the latter were offering solutions in relation to the preparation and distribution of medicinal products from a distance. The notice of grounds for refusal of the application for a Community trade mark sent by the examiner on 16 May 2000 already stated that the mark was objectionable under Article 7(1)(b) of Regulation No 40/94, since it was descriptive of all the goods and services referred to in the application for registration. Accordingly, the applicant had two opportunities to comment on the reasons giving rise to the finding that the mark applied for was descriptive: once before the examiner and once before the Board of Appeal.

Findings of the Court

- 19 It must be stated that in the present case it is not in dispute that the examiner rejected the trade-mark application in respect of TELEPHARMACY SOLUTIONS because the latter was devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94 in relation to the goods and services referred to in the application. The Board of Appeal, for its part, argued that the word sign in question was objectionable under the absolute ground for refusal laid down by Article 7(1)(c) of Regulation No 40/94.
- 20 It should be recalled at the outset that the principle of the protection of the rights of defence is laid down in Article 73 of Regulation No 40/94, which provides that decisions of OHIM are to be based only on reasons on which the parties have had an opportunity to present their comments (Case T-122/99 *Procter & Gamble v OHIM (Soap shape)* [2000] ECR II-265, paragraph 40, Case T-34/00 *Eurocool Logistik v OHIM (EUROCOOL)* [2002] ECR II-683, paragraph 20, and Case T-79/00 *Rewe-Zentral v OHIM (LITE)* [2002] ECR II-705, paragraph 13).
- 21 Furthermore, observance of the rights of defence is a general principle of Community law which requires that addressees of decisions of public authorities which appreciably affect their interests must be given the opportunity to express their views effectively (*Soap shape*, cited in paragraph 20 above, paragraph 42, *EUROCOOL*, cited in paragraph 20 above, paragraph 21, and *LITE*, cited in paragraph 20 above, paragraph 14).
- 22 In that regard, it is clear from the case-law of the Court of First Instance that the Board of Appeal, by failing to accord an applicant for a trade mark an opportunity to express its views on the application of the absolute grounds for refusal to register which the Board applies of its own motion, infringes the applicant's rights of defence (judgments in *Soap shape*, cited in paragraph 20 above, paragraph 47, *EUROCOOL*, cited in paragraph 20 above, paragraph 22, and *LITE*, cited in paragraph 20 above, paragraph 15).

- 23 However, it must also be borne in mind that, although it is clear from Article 7(1) of Regulation No 40/94 that each of the grounds for refusal to register listed in that provision is independent of the others and calls for separate examination (see by analogy, as regards the identical provisions of Article 3(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 67), there is a clear overlap between the scope of the grounds for refusal set out in subparagraphs (b), (c) and (d) of Article 7 (1) (see, by analogy, as regards the identical provisions of Article 3(1) of Directive 89/104, Case C-265/00 *Campina Melkunie* [2004] ECR I-1699, paragraph 18).
- 24 In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 7(1)(c) of Regulation No 40/94 is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services for the purposes of Article 7(1)(b) of the regulation (see by analogy as regards the identical provisions of Article 3(1) of Directive 89/104, *Campina Melkunie*, cited in paragraph 23 above, paragraph 19, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 86).
- 25 In this case, the reasoning which the Board of Appeal advanced in the contested decision to support its applying Article 7(1)(c) of Regulation No 40/94 and the reasons given by the examiner for his decision were similar. Referring to the dictionary definitions of the English terms ‘tele’, ‘pharmacy’ and ‘solutions’, the examiner stated that the trade mark applied for could not be registered because of Article 7(1)(b) of Regulation No 40/94 as it was devoid of any distinctive character, since it described goods and services which offered solutions to and pertained to the preparation and dispensing of medicinal products from a distance.

26 The Board of Appeal upheld that assessment, stating as follows in paragraphs 8 and 9 of the contested decision:

‘... The mark is composed of an expression that may be used by consumers to designate the claimed goods or the destination of the claimed services. It is, therefore, objectionable under Article 7(1)(c) [of Regulation No 40/94]. ... The [examiner’s] decision objected to the mark under Article 7(1)(b) [of Regulation No 40/94] because it is “devoid of distinctive character, as it is descriptive of the goods and services....” The Board assumes, therefore, that the examiner refused the application, in fact, on descriptiveness grounds and had no distinctiveness objections, distinct from those based on descriptive character. The Board agrees that the mark is only objectionable under Article 7(1)(c) [of Regulation No 40/94].’

27 It is apparent from those decisions that the circumstances of this case are different from those in the cases to which the decisions mentioned in paragraph 20 above relate. In those cases, the Board of Appeal had applied of its own motion new absolute grounds for refusal, without affording the applicants an opportunity to express their views on whether those absolute grounds for refusal applied or on the reasoning put forward in support of their application (judgments in *Soap shape*, cited in paragraph 20 above, paragraphs 43 to 46, *ELIROCOOL*, cited in paragraph 20 above, paragraphs 23 and 24, and *LITE*, cited in paragraph 20 above, paragraphs 16 to 19).

28 In this case, by contrast, the Board of Appeal rightly found that, although the examiner’s decision specifically referred to only Article 7(1)(b) of Regulation No 40/94, it clearly followed from the reasons in his decision that it was founded on Article 7(1)(c) of the regulation. Therefore, in taking Article 7(1)(c) as the basis for its own decision, the Board of Appeal did not apply of its own motion a new absolute ground of refusal on which it would have been required first to accord the applicant an opportunity to express its views.

- 29 Moreover, since the examiner justified the refusal to register on the basis of Article 7(1)(b) of Regulation No 40/94 by reasons pertaining solely to the descriptive character of the trade mark applied for, the applicant was given the opportunity to express its view on the reasoning which led the Board of Appeal to uphold the refusal to register. Its statement of the grounds of appeal, dated 21 March 2001, in fact addresses the issue of the allegedly descriptive character of the mark at issue.
- 30 It follows that the first plea in law must be rejected.

Second plea: infringement of Article 7(1)(b) and (c) of Regulation No 40/94

Arguments of the parties

- 31 Referring to the judgment of the Court of Justice in Case C-383/99 P *Procter & Gamble v OHIM* [2001] ECR I-6251, the applicant maintains, first, that the trade mark applied for is not objectionable under Article 7(1)(c) of Regulation No 40/94, since it does not consist exclusively of signs or indications designating the intended purpose of the goods or services concerned. The applicant accepts that the word 'pharmacy' may be used in trade as an indication of the intended purpose of those goods. Furthermore, it accepts that 'tele' may be used as a prefix meaning 'from a distance'. However, in its submission, it does not follow from either of those statements that the word-combination is an expression in everyday parlance. Nor does the fact that the term 'telepharmacy' is found in a dictionary provide evidence of this.

- 32 Furthermore, OHIM failed to examine the mark in its entirety, namely the addition of the term 'solutions', which cannot be regarded as a term in everyday parlance for goods as distinct from services.
- 33 For the applicant, the trade mark applied for constitutes an elliptical indication, which has an unusual grammatical structure and which forms a phrase the meaning of which is not immediately clear. In addition, the mere fact that the mark alludes to particular goods or services must not be equated with it being descriptive of those goods or services.
- 34 It adds that, although, for OHIM, the mark applied for was purely descriptive of the offering of solutions to firms or individuals who want to set up 'telepharmacy' businesses, namely the distribution of medicinal products involving the use of telecommunications, it is not descriptive of the goods covered by the application, as the latter is defined for the purposes of these proceedings.
- 35 The applicant submits, second, that the Board of Appeal, which was confined to the evidence produced before the examiner, had no evidence, or alternatively no reasonable evidence, to support its finding that the mark applied for was objectionable on the basis of Article 7(1)(c) of Regulation No 40/94. The examiner's refusal was based on a single internet reference to a conference mentioned on the website of an educational establishment outside the European Community. Moreover, the applicant has been unable to verify whether that internet reference exists.
- 36 Third, the applicant claims that nor can the mark applied for be refused on the basis of Article 7(1)(b) of Regulation No 40/94, given that it is not descriptive and that OHIM has put forward no other evidence to support a finding that the mark is devoid of any distinctive character.

- 37 OHIM contends that the mark applied for, taken as a whole, refers to a pharmacy which can be consulted from a distance over the internet. From the point of view of the target public, which is a specialised public of people from the medical sector, the mark is descriptive. That public may be English-speaking or be familiar with the language of medical science, which is English.
- 38 As regards the applicant's assertion that the Board of Appeal had no evidence to support its finding that the mark had to be refused on the basis of Article 7(1)(c) of Regulation No 40/94, OHIM observes that the Board of Appeal applied the descriptiveness test alone, in accordance with the case-law, in order to arrive at its decision.
- 39 As to the lack of distinctiveness of the trade mark, OHIM maintains that even though the contested decision is based on Article 7(1)(c) of Regulation No 40/94, the mark is also devoid of any distinctive character. In this connection, it points out that an internet search under 'telepharmacy and solutions' gives a list of 245 internet sites on which the mark applied for is used as a generic term.

Findings of the Court

- 40 Under Article 7(1)(c) of Regulation No 40/94, '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' are not to be registered. Moreover, Article 7(2) of Regulation No 40/94 provides that '[p]aragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community'.

- 41 The various grounds for refusing registration in Article 7 of Regulation No 40/94 must be interpreted in the light of the public interest underlying each of them (see by analogy as regards Article 3 of Directive 89/104, Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 77, *Linde and Others*, cited in paragraph 23 above, paragraph 71, Case C-104/01 *Libertel* [2003] ECR I-3793, paragraph 51, and *Campina Melkunie*, cited in paragraph 23 above, paragraph 34).
- 42 By prohibiting the registration as Community trade marks of the signs and indications to which it refers, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 31, and the case-law cited).
- 43 In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark, to which that provision refers, actually be in use at the time of the

application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of the characteristics of those goods or services. It is sufficient, as the very wording of that provision itself indicates, that those signs and indications could be used for such purposes. A word sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned (*OHIM v Wrigley*, cited in paragraph 42 above, paragraph 32).

- 44 Therefore, for the purpose of applying Article 7(1)(c) of Regulation No 40/94, consideration must be given to whether at least one of the possible meanings of the sign at issue designates a characteristic of the goods or services concerned.
- 45 When considering the possible meanings of a sign, it is necessary to ascertain whether, in normal usage from the relevant public's point of view, that sign may serve to designate, either directly or by reference to one of their essential characteristics, the goods or services in respect of which registration is sought (see, to that effect, *Procter & Gamble v OHIM*, cited in paragraph 31 above, paragraph 39). Accordingly, whether a sign is descriptive may be assessed only, first, in relation to the goods or services concerned and, second, in relation to the understanding which the relevant public has of it (*EUROCOOL*, cited in paragraph 20 above, paragraph 38).
- 46 As a preliminary point, it must be borne in mind that, of the goods mentioned in the trade-mark application, this action covers only the following: 'a system for remote control electronic dispensing of packaged pharmaceuticals comprising a storage housing from which the packaged pharmaceuticals products are stored and dispensed, a computer connected to the dispenser, and a communications network connecting the computer to a remote computer', within Class 9.

47 As a consequence, it must be held that the relevant public is an English-speaking, specialised public, consisting of people from the medical sector, as OHIM maintained without challenge from the applicant.

48 As regards the meaning of the word sign TELEPHARMACY SOLUTIONS in the English language, the Court finds, as the applicant in fact accepts, that 'pharmacy' may be used in trade as an indication of the intended purpose of the goods covered by the trade-mark application, whilst 'tele' may be used as a prefix meaning 'from a distance'. Consequently, the Court concludes that the term 'telepharmacy' refers to the distribution of medicinal products from a distance.

49 In that regard, it is irrelevant whether or not the term 'telepharmacy' is a neologism. As the Court of Justice has stated, a trade mark consisting of a neologism composed of word elements each of which is descriptive of characteristics of the goods or services in respect of which registration is sought is itself descriptive of those characteristics unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the neologism creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts (see, by analogy as regards the identical provisions of Article 3(1)(c) of Directive 89/104, *Campina Melkunie*, cited in paragraph 23 above, paragraph 43).

50 In this instance, the mere combination of the components 'tele' and 'pharmacy', each of which is descriptive of characteristics of the goods in respect of which registration was sought, itself remains descriptive of those characteristics. Merely bringing such elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods concerned.

- 51 As to the term 'solutions', it concerns particularly actions intended to resolve a problem of a theoretical or practical nature. Thus, read together, the terms 'telepharmacy' and 'solutions' must be regarded as descriptive of the intended purpose of the goods covered by the application for registration and, therefore, as designating an essential characteristic thereof.
- 52 Accordingly, the Court must find, as OHIM did, that, taken as a whole, the word sign TELEPHARMACY SOLUTIONS merely tells the relevant public, which is composed of English-speaking people from the medical sector, that the applicant, in providing the goods to which the application for registration refers, is offering equipment which may be used to distribute pharmaceutical products from a distance.
- 53 It follows that the word sign TELEPHARMACY SOLUTIONS may serve, for the purposes of Article 7(1)(c) of Regulation No 40/94, to designate an essential characteristic of the goods covered by the application for registration.
- 54 As regards the applicant's assertion that the Board of Appeal had no evidence in support of its finding that the trade mark had to be refused registration under Article 7(1)(c) of Regulation No 40/94, suffice it to state that the registrability of a sign as a Community trade mark must be assessed only on the basis of the relevant Community legislation as interpreted by the Community Courts. Therefore, as OHIM correctly maintains, it is sufficient that the Board of Appeal applied the descriptiveness test, as interpreted by the case-law, in order to reach a decision and it was not obliged to justify its action by the production of evidence.

55 Finally, so far as the applicant's arguments relating to Article 7(1)(b) of Regulation No 40/94 are concerned, it must be borne in mind that, by virtue of Article 7(1) of Regulation No 40/94, it is sufficient that one of the absolute grounds for refusal listed applies for a sign not to be registrable as a Community trade mark (Case C-104/00 P *DKV v OHIM* [2002] ECR I-7561, paragraph 29, and Case T-19/99 *DKV v OHIM (COMPANYLINE)* [2000] ECR II-1, paragraph 30). Therefore, there is no need to examine the applicant's arguments alleging infringement of Article 7(1)(b) of Regulation No 40/94.

56 In view of the foregoing, the second plea in law must be rejected.

Third plea: infringement of the principle of legitimate expectations

Arguments of the parties

57 The applicant points out that its application to register the word sign TELEPHARMACY, which is currently pending, was filed on the same date as the application to register the sign TELEPHARMACY SOLUTIONS and, following the restriction effected in this action, covers the same list of goods. Following amendment of the list of goods and services in respect of which registration of the mark TELEPHARMACY had been sought, the examiner withdrew his objections based on Article 7(1)(b) and (c) of Regulation No 40/94. Moreover, the application for registration of the sign TELEPHARMACY has already been published in the

Communities Trade Mark Bulletin, on 27 August 2001. The applicant submits that the sign TELEPHARMACY SOLUTIONS should be regarded as more rather than less distinctive than TELEPHARMACY. It is illogical and contrary to the principle of legitimate expectations to refuse to register the former sign whilst registering the latter.

- 58 OHIM points out that the sign TELEPHARMACY has not yet been registered, since opposition proceedings are pending. Moreover, as long as a trade mark has not been registered, OHIM may still re-examine *ex officio* a trade mark on absolute grounds for refusal in order to rectify mistakes. In any event, a party cannot rely, to its advantage, on a decision which is wrong in law.

Findings of the Court

- 59 It is sufficient to state in relation to this plea that, in view of the foregoing and given OHIM's acknowledgement to such effect at the hearing, the examiner's decision not to raise any objections to registering the sign TELEPHARMACY was wrong. If, by accepting in a decision given in a particular case that a sign is eligible for registration as a Community trade mark, OHIM has erred in law, that decision cannot be successfully relied on to support an application for the annulment of a later contrary decision adopted in a similar case. It is clear from the case-law of the Court of Justice that observance of the principle of equal treatment must be reconciled with observance of the principle of legality, according to which no person may rely, in support of his claim, on unlawful acts committed in favour of another (see, to that effect, Case 188/83 *Witte v Parliament* [1984] ECR 3465, paragraph 15, and Case 134/84 *Williams v Court of Auditors* [1985] ECR 2225, paragraph 14).

60 In any event, it must be observed that publication of a trade-mark application is no guarantee that the mark concerned will be registered. It is clear from Article 40(2) of Regulation No 40/94 that, following its publication, the trade-mark application may still be refused under Articles 37 and 38 of the regulation. In that regard, it must be noted that Article 38 of the regulation provides for an examination as to absolute grounds for refusal. Moreover, a trade-mark application may also be rejected following, inter alia, observations by third parties, in accordance with Article 41 of Regulation No 40/94, which provides that: '[f]ollowing the publication of the Community trade mark application, any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers may submit to [OHIM] written observations, explaining on which grounds under Article 7, in particular, the trade mark shall not be registered *ex officio ...*', or following opposition under Article 42 of the regulation.

61 In those circumstances the plea alleging infringement of the principle of legitimate expectations is unfounded.

62 It follows that the third plea must also be rejected and, accordingly, the action must be dismissed in its entirety.

Costs

63 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they were applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it must be ordered to pay the costs, as applied for by OHIM.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

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

Legal

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Vilaras

Delivered in open court in Luxembourg on 8 July 2004.

H. Jung

H. Legal

Registrar

President