

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)

31 March 2004 *

In Case T-216/02,

Fieldturf Inc., established in Montreal (Canada), represented by P. Baronikians,
lawyer,

applicant,

v

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

defendant,

ACTION against the decision of the First Board of Appeal of OHIM of 15 May 2002 (Case R 462/2001-I) concerning registration of the word mark LOOKS LIKE GRASS... FEELS LIKE GRASS... PLAYS LIKE GRASS... 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: H. Jung,

having regard to the written procedure and further to the hearing on 17 December 2003,

gives the following

Judgment

Facts

- 1 On 19 June 2000, the applicant filed an application for a Community trade mark with 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 word mark in respect of which registration was sought is LOOKS LIKE GRASS... FEELS LIKE GRASS... PLAYS LIKE GRASS.

- 3 The goods and services in respect of which registration of the trade mark was sought are in Classes 27 and 37 within the meaning 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 in respect of each of those classes to the following description:
 - Class 27: ‘Synthetic surfacing consisting of ribbons of synthetic fibres standing upright on a backing and partially covered with an infill of mixed sand and resilient particles for the playing of soccer, football, lacrosse, field hockey, golf and other athletic activities;’

 - Class 37: ‘Installation of synthetic surfacing consisting of ribbons of synthetic fibres standing upright on a backing and partially covered with an infill of mixed sand and resilient particles for the playing of soccer, football, lacrosse, field hockey, golf and other athletic activities.’

- 4 By decision of 13 March 2001, the Examiner found that the trade mark applied for was not capable of registration pursuant to Article 7(1)(b) of Regulation No 40/94 in respect of the goods and services referred to in the application. The

Examiner found that the trade mark applied for was exclusively composed of a very simple slogan devoid of any distinctive character in respect of the goods and services referred to. According to the Examiner, the wording of the trade mark applied for could easily be perceived by the relevant public as directly and immediately referring to a desirable aspect of synthetic surfaces. The rhetorical flourish, emphatic sound and symmetrical form which were claimed were not sufficient to confer any distinctiveness on the trade mark applied for. The fact that that trade mark was registered in the United States was not a sufficient reason to conclude that that mark was distinctive.

- 5 On 3 May 2001, the applicant filed notice of appeal with OHIM against the Examiner's decision, pursuant to Article 59 of Regulation No 40/94. The written statement setting out the grounds of appeal was filed on 12 July 2001. Since the Examiner had not rectified the decision, the appeal was remitted to the First Board of Appeal on 20 July 2001 pursuant to Article 60(2) of Regulation No 40/94.
- 6 By decision of 15 May 2002 ('the contested decision'), notified to the applicant on 17 May 2002, the First Board of Appeal dismissed the appeal.
- 7 The Board of Appeal held, essentially, that the mark applied for delivers a clear and direct message informing the relevant consumer that the applicant's synthetic surfaces have properties very similar to those of grass and that the applicant installs synthetic surfaces having those properties. The Board of Appeal added that the relevant consumer would be unable to distinguish the applicant's goods and services from those of competitors who also wish to communicate, in plain language, the fact that their own synthetic surfaces resemble grass. The Board of Appeal considered that the inherent lack of distinctiveness of the trade mark applied for was borne out by the results of an internet search which showed that

other suppliers of similar products routinely use terms such as ‘looks like grass’, ‘feels like grass’ and ‘plays like grass’, either alone, or in combinations similar or identical to the trade mark applied for. Finally, having regard to the slogans which have been registered as trade marks by OHIM, the Board of Appeal pointed out that there is no particular line to be taken in assessing slogans, since each case must be assessed on its own merits in relation to the goods and services in question.

Procedure and forms of order sought

- 8 By application lodged at the Registry of the Court of First Instance on 17 July 2002, the applicant brought the present action.
- 9 Upon hearing the report of the Judge-Rapporteur, the Court of First Instance (Fourth Chamber) decided to open the oral procedure.
- 10 Informed that the applicant would not appear at the hearing on 17 December 2003, OHIM did not appear at that hearing either. The Court formally noted the absence of the parties in the minutes of the hearing.
- 11 The applicant claims that the Court should:

— annul the contested decision;

- order OHIM to register the trade mark applied for in respect of all the goods and services specified in the trade mark application;

- order OHIM to pay the costs.

12 OHIM contends that the Court should:

- dismiss the application as inadmissible in so far as it seeks an order to register the trade mark applied for;

- dismiss the remainder of the application as unfounded;

- order the applicant to pay the costs.

Admissibility of the claim for directions to be issued

Arguments of the parties

- 13 The applicant claims that OHIM should be directed to register the trade mark applied for in respect of all the goods and services specified in the trade mark application.

- 14 OHIM submits that the Court is not entitled to issue such directions to it.

Findings of the Court

- 15 According to settled case-law, in an action brought before the Community courts against the decision of a Board of Appeal of OHIM, under Article 63(6) of Regulation No 40/94 OHIM is to be required to take the measures necessary to comply with the judgments of those courts. Accordingly, the Court of First Instance is not entitled to issue directions to OHIM (Case T-331/99 *Mitsubishi HiTec Paper Bielefeld v OHIM (Giroform)* [2001] ECR II-433, paragraph 33, and Case T-388/00 *Institut für Lernsysteme v OHIM — Educational Services (ELS)* [2002] ECR II-4301, paragraph 19).
- 16 The applicant's second head of claim that the Court should direct OHIM to register the trade mark applied for must therefore be rejected as inadmissible.

Substance

- 17 The applicant essentially advances two pleas in law alleging infringement of Article 7(1)(b) of Regulation No 40/94 and infringement of Article 73 of that regulation.

First plea in law: infringement of Article 7(1)(b) of Regulation No 40/94

Arguments of the parties

- 18 The applicant submits that the trade mark applied for possesses the minimum of distinctiveness required to justify its registration and adds that, at least in respect of the services referred to in the trade mark application, that mark is not descriptive.
- 19 The trade mark applied for has an unusual grammatical and rhythmical structure. The multiple use of the words ‘like grass’ gives the mark applied for a poetic character and a rhetorical flourish and its symmetrical three-part form creates an emphatic sound. Those effects enable the consumer to recognise and memorise the mark as an indication of the origin of the applicant’s goods and services. The trade mark applied for is imaginative and visual because of the repetition of one and the same sequence made up of a monosyllabic verb, ‘like’, ‘grass’ and ‘...’. The mark applied for has a vague, multiple meaning since the words ‘look’, ‘feel’ and ‘play’ may be understood both transitively and intransitively. ‘Plays like grass’, in particular, is not a common construction and suggests the following unusual meaning: something plays in the same way that grass plays.
- 20 Moreover, the contested decision is contrary to the judgment in Case T-138/00 *Erpo Möbelwerk v OHIM (DAS PRINZIP DER BEQUEMLICHKEIT)* [2001] ECR II-3739, in which the Court held that refusal to register on the basis of Article 7(1)(b) of Regulation No 40/94 is justified only if it is demonstrated that the combination of words in question is commonly used in business communications and, in particular, in advertising for the goods and services specified. In that regard, the advertisements quoted by the Board of Appeal in a footnote to

paragraph 12 of the contested decision are irrelevant because they relate exclusively to the American market. Indeed, one of those advertisements results from authorised use of the United States trade mark LOOKS LIKE GRASS... FEELS LIKE GRASS... PLAYS LIKE GRASS of which the applicant is the proprietor.

- 21 OHIM maintains that the Board of Appeal was justified in finding that the trade mark applied for is not distinctive for the goods and services specified in respect of the relevant public.

Findings of the Court

- 22 Under Article 7(1)(b) of Regulation No 40/94 ‘trade marks which are devoid of any distinctive character’ are not to be registered.
- 23 The signs devoid of any distinctive character within the meaning of that provision are those which are 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; Joined Cases T-79/01 and T-86/01 *Bosch v OHIM (Kit Pro and Kit Super Pro)* [2002] ECR II-4881, paragraph 19; Case T-130/01 *Sykes Enterprises v OHIM (REAL PEOPLE, REAL SOLUTIONS)* [2002] ECR II-5179, paragraph 18, and Joined Cases T-324/01 and T-110/02 *Axions and Belce v OHIM (Brown cigar shape and gold ingot shape)* [2003] ECR II-1897, paragraph 29).

24 The trade marks 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, for the presentation of the goods or services concerned or in connection with which there exists, at the very least, concrete evidence justifying the conclusion that they are capable of being used in that manner (*Kit Pro and Kit Super Pro*, cited above, paragraph 19, and *Brown cigar shape and gold ingot shape*, cited above, paragraphs 44 and 45).

25 Registration of a trade mark which consists of signs or indications which are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by that mark is not excluded as such by virtue of such use. However, a sign which, like an advertising slogan, fulfils functions other than that of a trade mark is distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 only if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin (*REAL PEOPLE, REAL SOLUTIONS*, cited above, paragraphs 19 and 20).

26 Finally, the distinctiveness of a mark may be assessed only, first, in relation to the goods or services for which registration of the sign has been requested and, second, in relation to the perception which the relevant public has of it (*LITE*, cited above, paragraph 27; *Kit Pro and Kit Super Pro*, cited above, paragraph 20, and *Brown cigar shape and gold ingot shape*, cited above, paragraph 30).

27 The goods and services covered are synthetic surfacing and installation services for that product.

- 28 As regards the relevant public, this consists not only of sports clubs, sports federations and organisers of sporting events but, more generally, of reasonably well-informed and circumspect final consumers who may be induced to use the applicants' goods and services for their personal needs. Moreover, since the mark applied for is in English, the relevant public is an English-speaking one (see, to that effect, *Kit Pro and Kit Super Pro*, cited above, paragraph 21).
- 29 In respect of the mark applied for, the applicant's main argument is that, having regard to its allegedly unusual grammatical and rhythmical structure, the mark LOOKS LIKE GRASS... FEELS LIKE GRASS... PLAYS LIKE GRASS possesses the minimum of distinctiveness required to justify its registration. The applicant points to the symmetrical structure of that mark and claims that it has a poetic character, rhythm and rhetorical 'flourish'.
- 30 As regards the goods specified in the trade mark application, there is no reason to challenge the finding of the Board of Appeal to the effect that the mark applied for does not of itself contain any element which would endow it with distinctive character. As OHIM rightly pointed out, the mark applied for is merely the concatenation, which is commonplace, of three unambiguous statements concerning the properties of the goods. Contrary to the applicant's assertion, the expression 'plays like grass' does not in the slightest suggest the unusual meaning of 'something plays in the same way that grass plays'. On the contrary, the mark LOOKS LIKE GRASS... FEELS LIKE GRASS... PLAYS LIKE GRASS suggests the following clear and direct meaning: 'Has the same appearance as grass... Produces the same sensation as grass... Is as suitable for playing on as grass'. That mark therefore directly informs the relevant public that the goods covered by the trade mark application (synthetic grass surfaces) have qualities similar to those of natural grass.

- 31 The Court further finds, like OHIM, that the mark applied for has no particular rhetorical ‘flourish’, poetic character or rhythm such as to confer distinctiveness upon it. Even if it were admitted that the mark produces such effects, they would in any event be very diffuse and would not induce the relevant consumer to see in the mark anything other than a promotional formula applicable to synthetic surfaces in general, and not therefore capable of designating the origin of those goods.
- 32 As regards the services specified in the trade mark application, the Board of Appeal and OHIM applied the same reasoning to them as to the goods. Thus, in paragraph 11 of the contested decision, after finding that the mark applied for is clearly intended to inform consumers that the goods specified in the trade mark application have qualities similar to those of natural grass, the Board of Appeal adds that, ‘[b]y the same token, [that mark] informs consumers that the [applicant] installs (Class 37 services) synthetic surfaces with those properties’.
- 33 It cannot be ruled out that, with regard to services for the installation of synthetic surfaces, the mark applied for may be distinctive. However, it must be stated that the applicant applied for registration of that mark in respect of both synthetic surfaces and the installation services for that product, without distinction and, in particular, without applying to restrict its trade mark application to the services alone should that application be rejected in respect of the goods. That situation is comparable to cases in which the trade mark application applies to a whole class within the meaning of the Nice Agreement, without restriction on the part of the trade mark applicant (Case T-106/00 *Streamserve v OHIM (STREAMSERVE)* [2002] ECR II-723, paragraph 46; Case T-355/00 *DaimlerChrysler v OHIM (TELE AID)* [2002] ECR II-1939, paragraph 40, and Case T-222/02 *HERON Robotunits v OHIM (ROBOTUNITS)* [2003] ECR II-4995, paragraph 46). That situation also, and above all, takes account of the fact that the services and goods specified in the applicant’s trade mark application are inseparably linked since the purpose of those services can only be the installation of those goods (for an example in which the connection between the goods and services was taken into

account, see the judgment in *TELE AID*, cited above, paragraph 35). In that context, the Board of Appeal correctly applied a solution which was common to the goods and services specified in the trade mark application by finding that, in respect of both, the mark applied for was not capable of being perceived immediately as an indication of origin, but merely as a promotional slogan informing the consumer that the surface marketed and installed by the applicant has properties similar to those of natural grass.

- 34 As regards the applicant's claim that, in not citing evidence that the trade mark applied for is commonly used, the contested decision is contrary to the judgment in *DAS PRINZIP DER BEQUEMLICHKEIT*, cited above, it is sufficient to state that, according to 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 commonly used in trade for the presentation of the goods or services concerned but also those which are merely capable of being used in that manner (see, to that effect, *Kit Pro and Kit Super Pro*, cited above, paragraph 19, and the case-law cited therein). In finding essentially that the trade mark applied for informs consumers in plain language of the nature and advantages or qualities of the goods and services concerned, the Board of Appeal showed to the requisite standard of proof, in paragraph 11 of the contested decision, that that mark is capable of being commonly used in trade for the presentation of those goods and services.
- 35 It is apparent from all the circumstances that the trade mark applied for is not such as to be perceived immediately as an indication of the commercial origin of the goods or services in question, but as a mere promotional slogan (see, to that effect, *REAL PEOPLE, REAL SOLUTIONS*, cited above, paragraphs 20 and 28).
- 36 In those circumstances, the present plea in law must be rejected as unfounded.

The second plea in law: infringement of Article 73 of Regulation No 40/94

Arguments of the parties

- 37 The applicant alleges that OHIM infringed Article 73 of Regulation No 40/94, in that it was not given any opportunity to submit observations on the results of an internet search made by the Board of Appeal and referred to by it in a footnote to paragraph 12 of the contested decision.
- 38 OHIM denies that the Board of Appeal infringed Article 73 of Regulation No 40/94.

Findings of the Court

- 39 According to Article 73 of Regulation No 40/94, decisions of OHIM are to be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.
- 40 It is not in dispute that the internet search referred to in the contested decision was not communicated to the applicant.

- 41 However, that fact is not such as to lead to the annulment of the contested decision. It was as a result of reasoning independent of that reference to an internet search, reasoning which was, moreover, already known to the applicant since it had been adopted by the Examiner, that the Board of Appeal arrived at the conclusion, in the contested decision, that the mark applied for is intrinsically devoid of distinctive character. The reference in question to the internet search was made only to confirm the accuracy of that finding.
- 42 In those circumstances, the plea in law alleging infringement of Article 73 of Regulation No 40/94 must be rejected.
- 43 In the light of all the foregoing considerations, the present action must be dismissed as unfounded.

Costs

- 44 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 OHIM 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 action;
2. Orders the applicant to pay the costs.

Legal

Tiili

Vilaras

Delivered in open court in Luxembourg on 31 March 2004.

H. Jung

Registrar

H. Legal

President