

Joined Cases T-367/02 to T-369/02

Wieland-Werke AG

v

**Office for Harmonisation in the Internal Market
(Trade Marks and Designs) (OHIM)**

(Community trade mark — Word marks SnTEM, SnPUR and SnMIX — Absolute grounds for refusal — Descriptive nature — Article 7(1)(c) of Regulation (EC) No 40/94)

Judgment of the Court of First Instance (Fourth Chamber), 12 January 2005 II - 50

Summary of the Judgment

1. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Marks composed exclusively of signs or indications which may serve to designate the characteristics of goods — Definition*
(Council Regulation No 40/94, Art. 7(1)(c))

2. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Marks composed exclusively of signs or indications which may serve to designate the characteristics of goods — Existence of synonyms designating the same characteristics — No effect*
(Council Regulation No 40/94, Art. 7(1)(c))
3. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Marks composed exclusively of signs or indications which may serve to designate the characteristics of goods — Word signs 'SnTEM', 'SnPUR' and 'SnMLX'*
(Council Regulation No 40/94, Art. 7(1)(c))
4. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Descriptive character of a sign — Circumstance necessarily implying the sign's want of any distinctive character*
(Council Regulation No 40/94, Art. 7(1)(b) and (c))

1. For an application for registration of a Community trade mark to be refused on the basis of Article 7(1)(c) of Regulation No 40/94 on the Community trade mark, it is not necessary that the signs and indications composing the mark that are referred to in that provision should actually be in use at the time of the application for registration in a way that is descriptive of goods such as those in relation to which the application is filed, or of characteristics of those goods. It is sufficient that those signs and indications could be used for such purposes.

teristic of the goods or services concerned.

(see para. 40)

2. For the purposes of determining whether a mark is caught by the ground of refusal to register set out in Article 7(1)(c) of Regulation No 40/94 on the Community trade mark, it is immaterial whether or not there are synonyms capable of designating the same characteristics of the goods or services mentioned in the application for registration. Although that provision states that, if the ground for refusal set out there is to apply, the mark must consist

Furthermore, it is enough that the sign in question should designate, in at least one of its possible meanings, a charac-

'exclusively' of signs or indications which may serve to designate characteristics of the goods or services concerned, it does not require that those signs or indications should be the only way of designating such characteristics.

(see para. 41)

3. The word signs SnTEM, SnPUR and SnMIX, registration of which is sought in respect of 'Metallic semi-finished products in the form of sheets, strips, wires, tubes, sections, rods or the like, especially in non-ferrous metals, such as copper or a copper alloy, having a metallic coating on one side or both sides especially of tin or a tin alloy' falling within Class 6 of the Nice Agreement, may serve, within the meaning of Article 7(1)(c) of Regulation No 40/94 on the Community trade mark, from the point of view of specialists in the sphere of metallurgy in various countries of the European Union, to designate essential characteristics of the goods concerned.

First, with regard to the element 'Sn', the chemical symbol for tin, since all the goods in respect of which registration is sought contain tin that element is

descriptive of one of their characteristics; the elements 'TEM', 'PUR' and 'MIX' are also, by connotation, descriptive of one of the characteristics of the goods for which registration is claimed.

Second, with regard to the meaning of each of the signs in question, they are themselves descriptive of characteristics of the goods concerned, because there is no perceptible difference between those signs and the mere sum of their parts. In relation to the goods in question, the combinations concerned are not of an unusual nature and do not constitute lexical inventions.

(see paras 23, 26-27, 29, 37, 39, 42)

4. A word Community trade 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 in relation to those goods or services within the meaning of Article 7(1)(b) of that regulation.

(see para. 46)