

JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)

31 January 2001 \*

In Case T-24/00,

**The Sunrider Corporation**, having its registered office in Torrance, California (United States of America), represented by A. Kockläuner, lawyer, with an address for service in Luxembourg,

applicant,

v

**Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)**, represented by C. Rusconi and G. Humphreys, acting as Agents, with an address for service in Luxembourg,

defendant,

APPLICATION brought against the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs)

\* Language of the case: English.

of 26 November 1999 (Case R 137/1999-2) concerning the registration of the term VITALITE as a Community trade mark,

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

composed of: J. Pirrung, President, A. Potocki and A.W.H. Meij, Judges,

Registrar: J. Palacio González, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 9 February 2000,

having regard to the response lodged at the Registry of the Court of First Instance on 9 June 2000,

further to the hearing on 27 September 2000,

gives the following

## Judgment

### Background to the dispute

- 1 On 1 April 1996, the applicant filed, under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, an application for a Community word mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) ('the Office').
- 2 The trade mark in respect of which registration was sought is VITALITE.
- 3 The goods in respect of which registration was sought come within Classes 5, 29 and 32 for the purpose 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.
- 4 By decision of 19 January 1999, the examiner refused the application under Article 38 of Regulation No 40/94.

- 5 On 17 March 1999, the applicant appealed to the Office, under Article 59 of Regulation No 40/94, against the examiner's decision.
- 6 The appeal was submitted to the examiner for interlocutory revision under Article 60 of Regulation No 40/94.
- 7 It was subsequently remitted to the Board of Appeal.
- 8 By decision of 26 November 1999 ('the decision'), the Board of Appeal partially annulled the examiner's decision. It dismissed the appeal in so far as the application for a trade mark related to the following goods: 'medicaments, pharmaceutical preparations; dietetic substances and nutritional replacement adapted for medical use; food for babies; preparations on the basis of vitamins, trace elements and/or minerals for dietetic purposes or as nutritional supplementation; nutritional concentrates or nutritional supplements on the basis of herbs, herbal teas, all for health care purposes', in Class 5; 'non-medical nutritional concentrates or nutritional supplements on herbal basis, herbal food, also in form of snack bars', in Class 29; 'herbal and vitamin beverages'; 'mineral and aerated waters and other non-alcoholic drinks', in Class 32. In substance, the Board of Appeal found that, since capital letters do not usually carry accents in French, the sign VITALITE could, in that language, be read as 'vitalité'. Having drawn attention to the meaning of that term, it inferred that Article 7(1)(b) and (c) of Regulation No 40/94 precluded its registration as a Community trade mark.

Forms of order sought by the parties

9 The applicant claims that the Court should:

- annul the decision in so far as it dismissed the applicant's appeal;
  
- order the defendant to pay the costs.

10 At the hearing, the applicant also claimed that the Court should, in the alternative, alter the decision, and sought application of Article 38(2) of Regulation No 40/94. Finally, it introduced some documentary evidence intended to prove its assertions in the application.

11 The Office contends that the Court should:

- dismiss the application;
  
- order the applicant to pay the costs.

## Admissibility

- 12 Under Article 19 of the EC Statute of the Court of Justice and Article 44(1)(c) and (d) of the Rules of Procedure of the Court of First Instance, the application must state the subject-matter of the proceedings and the forms of order sought by the applicant. It follows that claims put forward at the hearing, even if they are characterised as alternative to those mentioned in the application, must be rejected as inadmissible (Case T-398/94 *Kahn Scheepvaart v Commission* [1996] ECR II-477, paragraph 20).
- 13 In addition, under Article 135(4) of the Rules of Procedure, the parties' pleadings lodged before the Court of First Instance may not change the subject-matter of the proceedings before the Board of Appeal. It is not clear from the documents before the Court that the applicant submitted a similar claim to the Board of Appeal. It is therefore inadmissible also on that ground.
- 14 As regards the evidence which the applicant wished to introduce at the hearing, the Court finds that, as evidence which was intended to support the assertions put forward in the application, it was submitted out of time, without any reason being given. When the applicant had in fact offered no evidence in its application, that belated introduction of evidence is in breach of the principle of *audi alteram partem* and the rights of the defence (see Articles 44(1)(e) and 48(1) of the Rules of Procedure). The evidence in question must consequently be rejected as inadmissible.

## Substance

### *Preliminary observations*

- 15 Assessment of the absolute grounds for refusal listed in Article 7(1)(b) and (c) of Regulation No 40/94 involves taking account of a range of elements, in particular

the general impression made by the mark examined as a whole and the perception which the average consumer is likely to have of the goods or services in respect of which registration is sought, in each of the languages of the European Union and for each of the goods or services in question.

*The plea of infringement of Article 7(1)(c) of Regulation No 40/94*

Arguments of the applicant

- 16 The applicant claims that the basis of the prohibition on registering as a trade mark words which are exclusively descriptive is that such terms must remain freely available to all. However, that must be understood in the light of Article 12(b) of Regulation No 40/94. In those circumstances, it is for the Office to establish, in each case, the existence of an actual, ascertainable use of the word in question by competitors to describe the goods in respect of which registration is sought, or the existence of a need to use that term.
- 17 Furthermore, the applicant submits that the average consumer is reluctant to scrutinise trade marks or to analyse their meaning. In reality, that consumer does not easily associate the word VITALITE with, for example, the intended purpose of the goods in question. That word does not really describe an essential characteristic of the goods. Moreover, the word VITALITE, which does not have an accent, is not the same as the French word 'vitalité'.

## Findings of the Court

- 18 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 ... intended purpose ... of the goods’ are not to be registered.
- 19 Furthermore, Article 7(2) of Regulation No 40/94 states that Article 7(1) ‘shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community’.
- 20 In the present case, it should be noted, first of all, that there is no grammatical or typographical rule requiring accents on capital letters in French. Many writers regret the fact that accents are not commonly used in such cases (for example, A. Jouette, *Dictionnaire d’Orthographe et d’Expression Écrite*, Le Robert, Paris, 1993, p. 404). It has thus not been shown that the Board of Appeal was wrong in pointing out that capital letters do not usually carry accents and in finding, accordingly, that the term VITALITE could be understood by a French-speaking consumer as the word ‘vitalité’.
- 21 On the other hand, it seems that the term VITALITE, even if it is read in French as ‘vitalité’, cannot be regarded as being able to serve to designate the intended purpose of ‘food for babies’ or ‘mineral and aerated waters’.

- 22 In its response, the Office explained that food for babies is often ‘preservative free or contain[s] added vitamins and trace elements’. That argument cannot be accepted. The sign VITALITE cannot be regarded as designating those characteristics, but only, at best, as being indirectly evocative of them. The Office none the less added that ‘such food can give “life force” or “vitality” to babies’. However, it must be pointed out that although food for babies may certainly be designed to promote the growth of babies, the sign VITALITE does not, in this respect, go beyond the acceptable limits of suggestion.
- 23 The Office further stated in its response that mineral and aerated waters are ‘often advertised as promoting a healthy, sporty image and as contributing to a general sense of well being’. Those explanations are not decisive. On the contrary, they show that what is at issue in this case is not the designation of a characteristic of the goods, but the mere suggestion of an image which, for promotional purposes, has been given to those goods. It should be noted, moreover, that the Board of Appeal did not regard the term VITALITE as designating the characteristics of ‘milk products’ or ‘drinks [mainly] of milk’ although the marketing of those products is often accompanied by comparable advertising messages.
- 24 Accordingly, the word ‘vitalité’ does not directly and immediately inform the consumer of one of the characteristics of ‘food for babies’ or ‘mineral and aerated waters’. Consequently, the link between the meaning of the word ‘vitalité’, on the one hand, and the goods in question, on the other, does not seem to be sufficiently close to be caught by the prohibition laid down in Article 7(1)(c) of Regulation No 40/94. In fact it is a case of evocation and not designation for the purposes of that provision.
- 25 On the other hand, as regards all the other goods, which all have a specific medical, nutritional or dietetic purpose, it has not been established that the Board

of Appeal was wrong in concluding that the sign could serve, in trade, to designate the intended purpose of those goods. Nor has the applicant presented any specific argument in order to show that gaining renewed vitality is not one of the intended purposes of those goods.

- 26 Accordingly, the Board of Appeal infringed Article 7(1)(c) of Regulation No 40/94 in respect of ‘food for babies’ and ‘mineral and aerated waters’. The decision must therefore be annulled to that extent.

*The plea of infringement of Article 7(1)(b) of Regulation No 40/94*

- 27 The applicant claims that only signs devoid of distinctive character cannot be registered under Article 7(1)(b) of Regulation No 40/94. In the light of the arguments outlined above in respect of descriptiveness, the term VITALITE is not devoid of distinctive character.
- 28 The Court observes that, as is clear from Article 7(1) of Regulation No 40/94, it is sufficient for one of the absolute grounds of refusal listed to apply for the sign not to be able to be registered as a Community trade mark. In those circumstances, the sign VITALITE cannot in any event be registered for the goods in respect of which it has not been shown that the Board of Appeal infringed Article 7(1)(c) of Regulation No 40/94.
- 29 As regards ‘food for babies’ and ‘mineral and aerated waters’, it is sufficient to state, in this case, that the Board of Appeal inferred the incompatibility of the sign

VITALITE with Article 7(1)(b) of Regulation No 40/94 from the fact that it was incompatible with Article 7(1)(c) thereof. However, it was held above that the term VITALITE, even if read as 'vitalité', is evocative of the intended purpose of the goods in question, without designating it for the purposes of Article 7(1)(c) of Regulation No 40/94.

- 30 Accordingly, the decision must also be annulled on the ground of infringement of Article 7(1)(b) of Regulation No 40/94 as regards 'food for babies' and 'mineral and aerated waters'.

*The plea of prior registration of the mark*

Arguments of the applicant

- 31 The applicant claims that the Board of Appeal should have taken account of the fact that the word VITALITE has been registered as a trade mark in 15 European States, 12 of which are members of the European Union and some of which have, *inter alia*, French as an official language in their national office for the registration of trade marks.
- 32 In refusing to register a mark which has been accepted in 12 of the 15 Member States, the Office, the only body responsible for issuing trade marks which are valid throughout the Community, adversely affects the free movement of goods. It thereby contravenes the spirit 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), as evidenced by the seventh and eighth recitals in the preamble thereto.

## Findings of the Court

- 33 Registrations already made in the Member States are only one factor which, without being given decisive weight, may merely be taken into consideration for the purposes of registering a Community trade mark (Case T-122/99 *Procter & Gamble v OHIM* (soap bar shape) [2000] ECR II-265, paragraph 61). Accordingly, the Board of Appeal did not err in law merely because it refused to register a sign although that sign had been previously registered in a number of European States.
- 34 Moreover, most of the registrations in French-speaking countries on which the applicant relies relate to a figurative mark in which the word ‘vitalite’ is written in lower case, in a special font and with the first letter in a particular form (Benelux, Monaco and Switzerland), which distinguishes it from the sign at issue in this case. Furthermore, such registrations relate to goods which are totally (France, Monaco and Benelux) or essentially (Switzerland) different from those referred to in the applicant’s application. In addition, a number of those registrations were made in non-Member States of the European Union (Switzerland, Monaco) or at a time when there was no examination prior to registration on the basis of absolute grounds of refusal (Benelux).
- 35 Finally, the argument based on the infringement of the recitals in the preamble to Directive 89/104 is unfounded. The validity of the Board’s decision must be examined only in the light of the relevant provisions, namely, in this case, Article 7(1)(b) and (c) of Regulation No 40/94.

36 It follows that this plea must be rejected.

### Costs

37 Under Article 87(3) of the Rules of Procedure of the Court of First Instance, the Court may order that the costs be shared where each party succeeds on some and fails on other heads. In the present case, since the applicant's application has been granted only in respect of a limited number of goods, the applicant must be ordered to bear its own costs and to pay one half of the defendant's costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby:

1. Annuls the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 26 November 1999 (Case R 137/1999-2) in respect of the following goods: 'food for babies' and 'mineral and aerated waters';

2. Dismisses the application as to the remainder;
  
3. Orders the applicant to bear its own costs and to pay one half of the defendant's costs; orders the defendant to bear the other half of its own costs.

Pirrung

Potocki

Meij

Delivered in open court in Luxembourg on 31 January 2001.

H. Jung

Registrar

A.W.H. Meij

President