

Case T-247/01

eCopy, Inc

v

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

(Community Trade Mark — ECOPY — Misuse of powers — Distinctive  
character acquired through use after the date of filing —  
Article 7(3) of Regulation (EC) No 40/94)

Judgment of the Court of First Instance (Fourth Chamber), 12 December  
2002 . . . . . II-5304

Summary of the Judgment

1. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Marks devoid of any distinctive character — Exception — Acquisition through use — Requirement of acquisition before the date of filing of the trade mark application*  
(Council Regulation No 40/94, Art. 7(3))

2. *Community trade mark — Appeals procedure — Appeals before the Community judicature — Legality of decisions of the Boards of Appeal — Challenged by adducing new facts — Condition of admissibility*  
(Council Regulation No 40/94, Art. 63(2) and (3))
3. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Marks devoid of any distinctive character — Exception — Acquisition through use — Examination by the Office — Limited to the facts and evidence relied on by the trade mark applicant*  
(Council Regulation No 40/94, Arts 7(3) and 74(1))

1. Article 7(3) of Regulation No 40/94 on the Community trade mark must be interpreted as meaning that a mark must have become distinctive through use before the application was filed. Accordingly, it is irrelevant that the mark may have acquired distinctiveness through use after the application was filed but before the Office for Harmonisation in the Internal Market (Trade Marks and Designs) in the person of the examiner or, where appropriate, the Board of Appeal, has determined whether there are any absolute grounds for refusing registration of the mark. It follows that the Office may not have regard to evidence of use that occurred after the date of filing.
2. The legality of a decision of the Board of Appeal of the Office of Harmonisation in the Internal Market (Trade Marks and Designs) cannot be called into question by pleading new facts before the Court of First Instance unless it is proved that the Board of Appeal should have taken those facts into account of its own motion during the administrative procedure before adopting any decision in the matter.

(see para. 36)

First of all, it is clear from a combined reading of subparagraphs (2) and (3) of Article 63 of Regulation No 40/94 on the Community trade mark that decisions of the Boards of Appeal may be annulled or altered only where they contain a substantive or procedural irregularity and, secondly, the legality

of a Community measure falls to be assessed on the basis of the elements of fact and of law existing at the time when the measure was adopted.

(see para. 46)

3. When assessing the distinctiveness of a Community trade mark acquired through use within the meaning of Article 7(3) of Regulation No 40/94, the Office for Harmonisation in the Internal Market (Trade Marks and Designs) is not bound to examine facts showing that the mark claimed has so become distinctive unless the applicant has pleaded them.

Whilst with regard to Article 7(3) of Regulation No 40/94 it is true that there is no rule stipulating that the examination by the Office (that is, by the examiner or, if appropriate, the

Board of Appeal) must be limited to the facts relied on by the parties, contrary to what is stated at the end of Article 74(1) of the regulation with regard to the relative grounds for refusal, if the applicant for the mark does not plead distinctiveness acquired through use, the Office is in practical terms unable to take account of the fact that the mark claimed may have become distinctive.

Similarly, the Office is required to take account of evidence establishing that the mark claimed has become distinctive through use only if the applicant for the mark produced that evidence during the administrative procedure before the Office because there is no material difference between claiming that the mark sought has become distinctive through use on the one hand, and adducing evidence in support of such a claim on the other.

(see paras 47-48)