

Case T-289/02

Telepharmacy Solutions, Inc.

v

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

(Community trade mark — Word mark TELEPHARMACY SOLUTIONS —
Absolute grounds for refusal — Article 7(1)(c) of Regulation (EC) No 40/94 —
Observance of the rights of defence)

Judgment of the Court of First Instance (Fourth Chamber), 8 July 2004 . . . II - 2856

Summary of the Judgment

- 1. Community trade mark — Appeals procedure — Appeals before the Community judicature — Refusal of application made in the application initiating proceedings to restrict the list of goods and services contained in the trade-mark application — Interpreted as partial abandonment*

(Rules of Procedure of the Court of First Instance, Art. 135(4); Council Regulation No 40/94, Art. 44; Commission Regulation No 2868/95, Art. 1, Rule 13)

2. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Overlap between the scope of the grounds for refusal set out in subparagraphs (b), (c) and (d) of Article 7(1) of Regulation No 40/94*
(Council Regulation No 40/94, Art. 7(1))
 3. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Interpretation in the light of the public interest underlying each of them — Article 7(1)(c) of Regulation No 40/94 — Aim — Need to preserve availability*
(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 — Marks composed exclusively of signs or indications which may serve to designate the characteristics of goods or services — Neologism consisting of elements descriptive of characteristics of the goods or services concerned — Whether included where the nature of the combination is not unusual*
(Council Regulation No 40/94, Art. 7(1)(c))
 5. *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 sign 'TELEPHARMACY SOLUTIONS'*
(Council Regulation No 40/94, Art. 7(1)(c))
 6. *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 or services — Assessment of registrability by the Office — Production of evidence — Not required*
(Council Regulation No 40/94, Art. 7(1)(c))
 7. *Community trade mark — Decisions of the Office — Error of law as to the registrability of a sign — Not possible for the applicant to rely in support of its claims on an unlawful act committed in a similar case*
-
1. Where, in an appeal brought against the decision of a Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) confirming the rejection of an application for a Community trade mark, a request is made in the application initiating proceedings for the list of goods or services referred to in that request to be restricted, such a request cannot be considered to be an application for amendment within the meaning of Article 44 of Regulation No 40/94 and Rule 13 of Regulation No 2868/95 implementing Regulation No 40/94, since it does not comply with the rules specifically laid down by those provisions. Rather, such a request may be

interpreted as meaning that the applicant is merely seeking partial annulment of the contested decision. Such a request is not, as such, contrary to the prohibition in Article 135(4) of the Rules of Procedure of the Court of First Instance on changing, before the Court of First Instance, the subject-matter of the proceedings before the Board of Appeal.

same goods or services for the purposes of Article 7(1)(b) of the regulation.

(see paras 23, 24)

(see paras 13, 14)

2. Although it is clear from Article 7(1) of Regulation No 40/94 on the Community trade mark that each of the grounds for refusal to register listed in that provision is independent of the others and calls for separate examination, 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). 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

(see paras 41, 42)

3. The various grounds for refusing registration in Article 7 of Regulation No 40/94 on the Community trade mark must be interpreted in the light of the public interest underlying each of them. 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.

4. Article 7(1)(c) of Regulation No 40/94 on the Community trade mark must be interpreted as meaning that 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.

sign 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.

(see paras 52, 53)

(see para. 49)

5. The word sign TELEPHARMACY SOLUTIONS may serve, for the purposes of Article 7(1)(c) of Regulation No 40/94 on the Community trade mark, to designate an essential characteristic of the goods covered by the application for trade-mark registration; registration of that sign as a Community trade mark is sought for a '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 of the Nice Agreement. Taken as a whole, that

6. Where registration of a sign as a Community trade mark is refused under Article 7(1)(c) of Regulation No 40/94, 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, it is sufficient that the Office for Harmonisation in the Internal Market (Trade Marks and Designs) applies the descriptiveness test, as interpreted by the case-law, in order to reach a decision and it is not obliged to justify its action by the production of evidence.

(see para. 54)

7. If, by accepting in a decision given in a particular case that a sign is eligible for registration as a Community trade mark, the Office for Harmonisation in the Internal Market (Trade Marks and Designs) 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. 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 para. 59)