

JUDGMENT OF THE COURT OF FIRST INSTANCE (Third Chamber)

15 September 2005<sup>\*</sup>

In Case T-320/03,

**Citicorp**, established in New York (United States), represented by V. von Bomhard, A. Renck and A. Pohlmann, lawyers,

applicant,

v

**Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)**, represented by S. Laitinen, P. Bullock and A. von Mühlendahl, acting as Agents,

defendant,

ACTION for the annulment of the Third Board of Appeal of OHIM of 25 June 2003 (Case R 85/2002-3), concerning an application to register the word mark LIVE RICHLIY as a Community trade mark,

<sup>\*</sup> Language of the case: English.

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

composed of M. Jaeger, President, J. Azizi and E. Cremona, Judges,

Registrar: C. Kristensen, Administrator,

having regard to the written procedure and further to the hearing on 9 December 2004,

gives the following

## **Judgment**

### **Background to the dispute**

- 1 On 2 March 2001 the applicant filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('OHIM') under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1).
- 2 The trade mark sought to be registered was the word sign LIVE RICHLY.

- 3 The services in respect of which registration of the mark was sought are within Class 36 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 are described as follows:

‘Financial and monetary services and real estate affairs; in particular, banking; credit card; commercial and consumer lending and financing; real estate and mortgage brokerage; trust, estate and fiduciary management, planning and consulting; investment and investment advisory and consulting; securities brokerage and trading services facilitating secure financial transactions; insurance services; in particular, underwriting and sales of property, casualty and life insurance policies and annuity contracts’.

- 4 By a letter dated 3 July 2001 the examiner objected to the registration of the LIVE RICHLIY mark on the ground of its lack of distinctive character. The applicant challenged the examiner’s view and, in its letter of 8 August 2001, asked her to approve its application for registration. By decision of 4 December 2001 (‘the examiner’s decision’) the examiner maintained her rejection of the application to register the LIVE RICHLIY mark.
- 5 On 22 January 2002 the applicant filed an appeal against the examiner’s decision at OHIM under Articles 57 to 62 of Regulation No 40/94.
- 6 By decision of 25 June 2003 (‘the contested decision’), the Third Board of Appeal dismissed that appeal, thereby upholding the decision of the examiner to refuse registration. The Board of Appeal found essentially that the LIVE RICHLIY mark did

not satisfy the requirements of Article 7(1)(b) of Regulation No 40/94 in that it would be perceived by the relevant public as a simple laudatory formula and not as an indication of the commercial origin of the services in question.

### **Procedure and forms of order sought by the parties**

- 7 On 15 September 2003 the applicant lodged an action against the contested decision at the Court Registry under Article 63 of Regulation No 40/94. After the defendant had lodged its response — in which it stated that the LIVE RICHLY mark had been accepted by the examiner in respect of insurance and real estate services — the applicant applied under Article 135(2) of the Rules of Procedure of the Court of First Instance to be allowed to lodge a reply. By decision of the President of the Third Chamber of 19 February 2004, the applicant was granted permission to submit a reply.
- 8 Upon hearing the report of the Judge-Rapporteur, the Court of First Instance (Third Chamber) decided to put questions to the parties in writing and to open the oral procedure. The parties replied to those questions within the prescribed time-limits.
- 9 At the hearing on 9 December 2004 the parties presented oral argument and replied to the questions put to them by the Court. The defendant confirmed on that occasion that the LIVE RICHLY mark could be registered in respect of insurance and real estate services. After that was confirmed, the applicant conceded that those services were no longer part of the subject-matter of the dispute before the Court, that being confined, as far as the substance was concerned, to financial and monetary services. Lastly, the applicant declared that after the ruling of the Court of Justice in Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, it was no longer claiming that, in order for a Community trade mark to be devoid of

distinctive character, it must be proven to have been commonly used. Those statements by the parties were recorded in the minutes of the hearing.

10 The applicant claims that the Court should:

- annul the contested decision;
- order the defendant to pay the costs.

11 The defendant contends that the Court should:

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

## Law

### *The admissibility of certain evidence adduced by the applicant*

#### Arguments of the parties

12 In support of its argument as to the distinctive character of the LIVE RICHLY sign, the applicant adduces copies of excerpts from trade mark databases and internet pages which are intended to show that it is the only entity to use the sign applied for in respect of the services concerned.

- 13 The defendant contends that those documents are inadmissible, given that they were produced for the first time before the Court (see, to that effect, Case T-128/01 *DaimlerChrysler v OHIM (vehicle grille)* [2003] ECR II-701, paragraph 18).

### Findings of the Court

- 14 The purpose of an action before the Court of First Instance is to review the legality of decisions of the Boards of Appeal of OHIM within the meaning of Article 63 of Regulation No 40/94, and in proceedings for annulment the legality of the contested measure must be assessed on the basis of the elements of fact and of law existing at the time when the measure was adopted (Joined Cases 15/76 and 16/76 *France v Commission* [1979] ECR 321, paragraph 7; and Joined Cases T-177/94 and T-377/94 *Altmann and Others v Commission* [1996] ECR II-2041, paragraph 119). It is thus not the Court's function to re-evaluate the factual circumstances in the light of evidence adduced for the first time before it. Evidence produced for the first time before the Court of First Instance is therefore inadmissible (see, to that effect, the *vehicle grille* case cited in paragraph 13 above, paragraph 18).
- 15 In the present case, it appears, and is not disputed by the applicant, that the new documents upon which it relies in support of the exclusive use of the LIVE RICHLIY mark were adduced for the first time before the Court of First Instance. Therefore those documents adduced by the applicant must be declared inadmissible.
- 16 That conclusion is not affected by the arguments which the applicant put forward at the hearing, according to which, first, the documents being relied upon merely support the matters previously raised; second, those matters should have been examined by OHIM of its own motion; and third, those matters do not alter the subject-matter of the dispute before the Board of Appeal. As stated in paragraph 14 above, the Court's task is to review the legality of the Board of Appeal's decision. It follows that that review must be carried out in the light of the factual and legal

context of the dispute as it was brought before the Board of Appeal, and that a party cannot alter the matters of fact and law on the basis of which the legality of the Board of Appeal's decision is examined (Case T-194/01 *Unilever v OHIM (Ovoid tablet)* [2003] ECR II-383, paragraph 16). As stated in paragraph 15 above, the matters of fact relied upon are new matters of fact which were not put before the Board of Appeal. They do not, therefore, form part of the factual and legal context of the dispute as it was before the Board of Appeal when it took its decision. That finding is not affected by the fact that those matters of fact simply support the matters already raised or that they do not alter the subject-matter of the dispute in this case. Accordingly, having regard to the Court's review of legality, it is not for the Court to express a view on those matters. Furthermore, as regards the argument that those matters should have been raised by OHIM of its own motion, it must be borne in mind that under Article 74(2) of Regulation No 40/94, it is for the parties to supply in due time the evidence upon which they intend to rely. It follows that OHIM cannot be accused of any illegality with regard to evidence which the applicant failed to submit to it in due time.

*Plea relating to infringements of the right to be heard*

Arguments of the parties

- 17 The applicant alleges that its right to be heard, as enshrined in the second sentence of Article 73 of Regulation No 40/94, was infringed in two respects.
- 18 First, whilst the examiner gave as her reason for refusing registration the purely economic meaning of the term 'richly', the Board of Appeal based its decision on another, more elaborate definition put forward by the applicant itself, according to which that term means 'in a rich or elaborate manner; fully and appropriately'. That more elaborate definition of the term 'richly' had, however, been put forward by the

applicant as an argument in favour of the registration of the mark in question. The applicant considers that in refusing to register the mark in question on the basis of an argument of the applicant in favour of that registration, the Board of Appeal relied on a completely new point. The Board of Appeal's failure to provide the applicant with an opportunity to comment on that new point infringed its right to be heard as recognised by the second sentence of Article 73 of Regulation No 40/94. The applicant refers in that respect to Case 136/79 *National Panasonic v Commission* [1980] ECR 2033, paragraph 21, and to the decisions of the Boards of Appeal of 10 April 2002, *Bébé v BEBÉ* (R 1112/2000-3), and of 27 February 2003, *MYKO VITAL v Miko* (R 476/2002-3).

19 Second, the applicant submits that the Board of Appeal also infringed its right to be heard by finding that the level of attentiveness of consumers in relation to services covered by the LIVE RICHLIY sign was low, without inviting the applicant to comment in that regard.

20 The defendant submits that the Board of Appeal did not introduce a new meaning for the term 'richly' in order to confirm the examiner's rejection. Consequently, the Board of Appeal did not infringe the applicant's right to be heard in that regard. The defendant does not comment specifically on the second allegation of infringement of the right to be heard.

## Findings of the Court

### — Preliminary comments

21 According to the second sentence of Article 73 of Regulation No 40/94, OHIM's decisions are to be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments. The general principle of protection of the right to defend oneself is enshrined in the law of Community trade marks by that provision.



22 According to that general principle of Community law, a person whose interests are appreciably affected by a decision taken by a public authority must be given the opportunity to make his point of view known (Case 17/74 *Transocean Marine Paint v Commission* [1974] ECR 1063, paragraph 15; and Case T-34/00 *Eurocool Logistik v OHIM (EUROCOOL)* [2002] ECR II-683, paragraph 21).

23 In the present case, it is necessary to ascertain whether the Board of Appeal's reasoning — which differs from that of the applicant — based on a certain meaning of the words 'live richly', and whether the Board of Appeal's view that the relevant public is not very attentive, constitute reasons or evidence on which the applicant did not have an opportunity to present its comments.

24 In that regard, it is necessary first to consider the differences between the examiner's decision and the contested decision as regards the matters put forward by the applicant, since the lack of any difference between those decisions will preclude any infringement of the applicant's right to defend itself. If the Board of Appeal's decision merely reproduces the examiner's decision so far as those matters are concerned, the applicant must be regarded as having had an opportunity to present its comments on those matters when it appealed against the examiner's decision.

— Meanings of 'live richly'

25 So far as the meaning of 'live richly' is concerned, it must be observed as a preliminary that the applicant stated in its action before the Board of Appeal that the first definition of the term 'rich' in the *Collins Dictionary* was 'well supplied with

wealth, property, etc., owning much', and that the term 'richly' was defined in the same dictionary as 'in a rich or elaborate manner'; 'fully and appropriately'.

- 26 As regards the alleged infringement of the rights of the defence in relation to the absence of comment by the applicant on the Board of Appeal's reasoning based on the meaning of the terms 'live richly' as held by the examiner, it must be noted that the examiner challenges the distinctive character of the applicant's mark in her decision as follows:

'Any investor, professional or amateur, is looking for growth and any successful bank makes its customers rich or offers them at least the possibility of living rich lives; all the applicant's competitors intend to appeal [to] customers with similar slogans that only highlight their financial achievements.

... More rich people are made through investing than any other way; namely, hard work or heritage. What do the consumers of those services desire? If not to become wealthy at least to lead a rich life.

The words "live" and "richly" are both common; the term "rich" has a positive economic connotation ...'

- 27 Following the examiner's decision, the applicant emphasised in its action before the Board of Appeal that the terms 'live richly' should be understood not in the purely economic sense but in a broader, vaguer sense, meaning a fulfilling life or one that is full of experiences.

28 In the contested decision the Board of Appeal upheld the examiner's refusal to register the mark for, inter alia, the following reasons:

'10 ... According to the *Collins English Dictionary*, the word "richly" means "in a rich or elaborate manner; fully and appropriately".

11 Taking into account the above definition, the combined use of the word "live" and the word "richly" in the context of the services applied for conveys a clear informative message with a laudatory connotation. It informs the relevant consumers that the services in question are offering them the possibility of leading a rich life.

...

14 As regards the applicant's argument that the word "richly" has various connotations, it must be observed that a sign's distinctiveness can only be assessed by reference to the goods and services applied for. Therefore, the examiner rightly took into consideration the meaning of the term "richly", which applies to the services covered by the application.'

29 It is thus apparent from the examiner's decision, first, that the term 'richly' was considered in the sense of 'having money, wealth', that is to say, in the economic sense.

30 Second, it follows from the contested decision that the definition of the word 'richly' which was applied by the Board of Appeal is, inter alia, 'in a rich manner'. As the defendant states, the first definition of the term 'rich' is 'well supplied with wealth, property etc., owning much'. That view is not challenged by the applicant, which put forward the same definition in the proceedings before the Board of Appeal, and acknowledged in its application that the term 'rich' means, above all, 'prosperous or wealthy'. Therefore the Board of Appeal's definition includes the economic sense of the term 'richly' which was also accepted by the examiner.

31 Moreover, it is apparent from paragraph 14 of the contested decision that the Board of Appeal approved the fact that the examiner took the meaning of the term 'richly' into consideration in relation to the specific services for which registration of the mark had been sought. It follows that the Board of Appeal did not overlook the economic sense of the term 'richly'.

32 Therefore the meanings of the word 'richly' which were accepted by the Board of Appeal are not genuinely distinguishable from those which the examiner took into consideration.

33 That conclusion is not affected by the fact that the Board of Appeal stated that it had taken into consideration the definition of 'richly', which has several connotations. A definition which embraces several meanings must be regarded as having been taken into consideration if just one of those meanings has been taken into account. The Board of Appeal's confirmation, in the present case, that the examiner correctly took into consideration the meaning of the word 'richly' clarifies which meaning was taken into account in the definition of that term.

- 34 Lastly, as regards the use of the expression ‘to lead a rich life or to live a rich life’, that expression is used in the examiner’s decision as well as in that of the Board of Appeal. As that expression is based on the word ‘rich’ which, as stated above, has an economic sense, the above remarks are not affected by the fact that that expression was used in the contested decision.
- 35 As regards the applicant’s reference to earlier decisions by OHIM, it is sufficient to point out that the legality of the decisions of Boards of Appeal must be assessed solely on the basis of Regulation No 40/94, as interpreted by the Community judicature, and not OHIM’s practice in earlier decisions (see Case T-129/01 *Alejandro v OHIM — Anheuser-Busch (BUDMEN)* [2003] ECR II-2251, paragraph 61, and the case-law cited therein).
- 36 Above all and in any event, it must be borne in mind that the Court of First Instance has already decided that the Boards of Appeal must be able to base their decisions on arguments not presented before the examiner provided that the party concerned has been able to comment on the matters affecting the application of the legal provision in question. As there is in principle a continuity of function between the examiner and the Boards of Appeal, the latter may re-examine the application without being limited by the examiner’s reasoning (Case T-122/99 *Procter & Gamble v OHIM (Soap bar shape)* [2000] ECR II-265, paragraph 27, and Case T-198/00 *Hershey Foods v OHIM (Kiss Device with plume)* [2002] ECR II-2567, paragraph 25).
- 37 In the present case, even if the Board of Appeal had departed from the approach taken by the examiner, it is apparent, first, that the Board of Appeal did not rely on the new matters of fact on which the applicant had been unable to comment. Given that the applicant itself put forward the broader interpretation of the meaning of the word ‘richly’, it cannot argue that it was unable to present its comments on that

point. Second, it is apparent that the Board of Appeal confined itself exclusively to a reasoning that was different from that which was argued by the applicant. Therefore, in the light of the case-law cited in paragraph 36 above, that, of itself, cannot result in an infringement of the applicant's right to defend itself.

— Attentiveness of the relevant public

38 As regards infringement of the applicant's right to defend itself in relation to the absence of comment by it on the level of attentiveness of the relevant public as held by the Board of Appeal, it is again necessary to begin by analysing the differences in that regard between the decision of the Board of Appeal and that of the examiner.

39 The second sentence of the examiner's decision is worded as follows:

'As to your argument that the message of the mark is vague and undefined, it should first of all be noted that the message ... is addressed [to] the broad public, [which] is reasonably well informed and reasonably observant and circumspect ...'

40 In paragraphs 13 and 15 of the contested decision, the Board of Appeal states:

'13 As regards the perception of the sign LIVE RICHLIY by the relevant public, the Board finds, as the examiner did, that this slogan is composed of commonplace words, which, when applied to the services covered by the application, are

understood by that public as a simple laudatory formula and not as an indication of the commercial origin of the services in question.

...

15 Furthermore, there is nothing about the term LIVE RICHLI that might, beyond its obvious promotional meaning, enable the relevant public to memorise the sign easily and instantly as a distinctive trade mark for the services designated. In the absence of prior knowledge, the relevant public could not perceive it other than in its promotional sense. Since the relevant consumer is not very attentive, if a sign does not immediately indicate to him the origin of the object of his intended purchase, but just gives him purely promotional, abstract information, he will not take the time either to enquire into the sign's various possible functions or mentally to register it as a trade mark.'

41 The applicant inferred from paragraph 15 of the contested decision, which states that the relevant consumer is not very attentive, that the relevant consumer's attentiveness is low.

42 The statement that a consumer is not very attentive does not necessarily imply that that consumer's attentiveness is low, however. It can also mean that although the relevant consumer does not pay a great deal of attention to the trade mark in question, he nevertheless pays reasonable attention to it.

- 43 In the present case it must be observed that, in paragraph 13 of the contested decision, the Board of Appeal confirms the examiner's analysis of the relevant public's perception of the LIVE RICHLIY sign. In the second sentence of her decision, the examiner states that the message of the mark is addressed to the broad public, which is not only reasonably well informed and circumspect, but also reasonably attentive.
- 44 In stating that the relevant consumer was not very attentive, therefore, the Board of Appeal in fact took the view that the relevant consumer was reasonably attentive. The Board of Appeal merely expressed in different terms the view stated by the examiner in the second sentence of her decision.
- 45 As the Board of Appeal merely paraphrased the examiner's view, the applicant is wrong to consider that the Board of Appeal took into account the low level of attentiveness of the relevant public without the applicant having had the opportunity to present its comments on that aspect.
- 46 For the abovementioned reasons, the complaints relating to the infringement of the applicant's rights of defence must be dismissed.

*Plea relating to infringement of the duty to state reasons*

- 47 In substance the applicant submits that the contested decision was not sufficiently reasoned, in that registration of the mark sought was refused in respect of all the services for which registration was sought, without any reasons being specified for



the refusal of the application in relation to insurance and real estate services. The defendant contests that plea, submitting that registration in respect of insurance and real estate services had been approved by OHIM ab initio.

- 48 The Court notes that after the defendant declared at the hearing that the LIVE RICHLIY mark could be registered in respect of insurance and real estate services, the applicant expressly acknowledged that the subject-matter of the dispute was limited to financial and monetary services. The applicant therefore withdrew its plea relating to the failure to state reasons which concerned only insurance and real estate services. The Court of First Instance is therefore no longer required to give a ruling on that plea.

*Plea relating to infringement of Article 7(1)(b) of Regulation No 40/94*

Arguments of the parties

- 49 The applicant submits that the contested decision must also be annulled because in it the Board of Appeal interprets Article 7(1)(b) of Regulation No 40/94 incorrectly so far as concerns the absolute ground for refusal of registration of a Community trade mark based on its lack of distinctive character.

- 50 The applicant emphasises, first of all, that the case-law of the Court of First Instance as well as the practice of the Boards of Appeal confirm that slogans are subject to the same criteria as any other type of mark (Case T-138/00 *Erpo Möbelwerk v OHIM (DAS PRINZIP DER BEQUEMLICHKEIT)* [2001] ECR II-3739, paragraph 44; and the Board of Appeal's decision of 11 February 1999, BEAUTY ISN'T ABOUT

LOOKING YOUNG BUT LOOKING GOOD (R 73/1998-2)). In the present case, the applicant submits, the Board of Appeal refused registration of the word sign simply because it was a laudatory slogan, without ruling on whether it is capable of distinguishing the services in question.

51 Next, the applicant states that the Board of Appeal acknowledged that the terms 'live richly' are not descriptive. That acknowledgement implies, according to the applicant, that the Board of Appeal cannot simply rely, as it does in the present case, on the laudatory character of the formula in order to demonstrate that the mark in question lacks distinctiveness. The applicant refers in that regard to various Board of Appeal decisions.

52 The applicant challenges the Board of Appeal's (unsubstantiated) view that the terms 'live richly' are a simple laudatory formula with a clear meaning, and maintains that their vague, indeterminate and ambiguous meaning makes them open to a number of interpretations, particularly as far as financial and monetary services are concerned. According to the applicant, the mark applied for, LIVE RICHLY, is a play on words which as such does not make much sense, since there are probably as many ways to live richly as there are human beings, and every consumer will interpret that slogan in his own way. Furthermore, consumers confronted with the slogan in question will be surprised, irritated or confused because they would not expect a bank to offer financial services with the invitation to 'live richly', which demonstrates the distinctive character of the LIVE RICHLY mark. In support of its arguments, the applicant refers to the definition of the term 'rich' in *Collins English Dictionary* (1995 edition), the different interpretations of the term 'richly' by the Board of Appeal and the examiner, the decision of the Board of Appeal of 1 October 2001, ES GIBT SIE NOCH, DIE GUTEN DINGE (R 393/2000-1), advertising in the United States and the comments which that generated on the internet. It submits, in particular, that those comments demonstrate that consumers' perception of that mark is far from being simple and straightforward.

53 The applicant submits furthermore that the contested decision is based on the mistaken presumption that the level of attentiveness of the relevant public is low, whereas it is in fact high. According to the applicant, the average consumer of financial services is particularly careful and attentive, given that those services are not bought 'off the shelf' like milk or a pair of jeans and because of their major importance in the life of that consumer. Consequently, the average consumer will spend more time looking for the meanings of that slogan and will memorise it more easily in relation to financial services.

54 The case-law of the Court of First Instance in relation to slogans as well as the practice of the Boards of Appeal in their decisions confirm, according to the applicant, that the slogan LIVE RICHLY is registrable. In the judgment on DAS PRINZIP DER BEQUEMLICHKEIT, cited in paragraph 50 above, and in Case T-130/01 *Sykes Enterprises v OHIM (REAL PEOPLE, REAL SOLUTIONS)* [2002] ECR II-5179, the Court acknowledged that, contrary to the examiner's statement in her letter of 3 July 2001, lack of distinctiveness cannot be founded on either lack of imagination or lack of an additional element of originality. It also considered that the use of the same sign or of similar signs on the market plays a decisive part in the assessment of the intrinsically distinctive character of a mark. In particular, the Court stated in the judgment on DAS PRINZIP DER BEQUEMLICHKEIT, cited in paragraph 50 above, that lack of distinctiveness can be justified only if it has been demonstrated that the word mark at issue is commonly used. In the present case, the applicant emphasises, first, that the defendant has not demonstrated usage of the terms 'live richly' and, second, that those terms have never been used to market or sell financial or monetary services. Given the unique and fanciful character of its slogan, the applicant submits that its mark has distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94.

55 The registrability of the LIVE RICHLY mark is also confirmed by the standing practice of the Boards of Appeal. The applicant mentions in that respect the decision of 7 November 2001, WE GET IT DONE (R 1090/2000-4). It claims that it can be concluded from that decision, first, that the threshold of applicability for Article 7(1)

(b) of Regulation No 40/94 is low and, second, that it is for OHIM to prove that a mark is not capable of being registered under that article, given that it is not enough to state that a slogan is banal or constitutes a simple laudatory formula in order to establish lack of distinctiveness. The applicant submits that in relying on that decision the Board of Appeal failed to explain why, in the present case, the promotional and laudatory characteristics of the terms 'live richly' should prevent the average consumer of financial and monetary services from establishing a link between that sign and the applicant and, accordingly, from perceiving the slogan to be a trade mark. The applicant argues that the slogan is open to several interpretations, that the relevant public would immediately memorise it because it would not expect a financial institution to promote its services with such a slogan, and that it is the only one to use that slogan.

56 The applicant infers from the current practice of the Boards of Appeal that the vagueness of a slogan can be taken into account in establishing the distinctive character of a sign (WE GET IT DONE, cited above; decision of 25 February 2002, 'Taking care of the world's water ... and yours' (R 135/2000-2); and TEAM POWER (R 222/2001-1, decision of 18 September 2001)). It also infers from that practice that the lack of usage on the relevant market of the slogan in question or of a variation thereof is a strong indication of its intrinsic distinctiveness ('Taking care of the world's water ... and yours', cited above; TEAM POWER, cited above; decisions of 4 May 1999, 'Früher an Später denken!' (R 153/1998-2), of 5 July 2000, UNLOCK THE POTENTIAL (R 689/1999-3), and of 5 June 2002, WHATEVER WHENEVER (R 58/2001-4)).

57 Next, the applicant mentions the registration by OHIM, in respect of services within Class 36 of the Nice Agreement and corresponding to the description 'financial and monetary services and real estate affairs', of a number of slogans containing the terms 'live' or 'life', including 'make more of life', 'WHERE MONEY LIVES' and 'SO YOU CAN ENJOY LIFE!' It suggests that it would be contradictory to refuse to register the LIVE RICHLY mark in respect of the same services.

- 58 It also refers to a number of slogans registered by national offices of certain Member States, showing that registration has been granted for slogans less distinctive than that at issue.
- 59 The applicant points out that the LIVE RICHLY mark has been registered in respect of the same services within Class 36 of the Nice Agreement by the trade mark authorities of several third countries, including the Commonwealth of Australia and the United States of America. Although the applicant recognises that the United States of America and the Commonwealth of Australia are not Member States, it considers those registrations of the LIVE RICHLY mark to be a strong indication of the registrability of that mark in English-speaking countries in general.
- 60 Lastly, in so far as the dispute now relates only to registration of the LIVE RICHLY mark for financial and monetary services, the applicant submits that the defendant's argument that that term is not distinctive for those services (given that the clear message of the terms 'live richly' is to live a materially richer life), but that it is distinctive for insurance and real estate services, is arbitrary, illogical, paradoxical and contradictory.
- 61 According to the applicant, that conclusion is based on the fact that financial and insurance services are very closely related, if not identical, as are financial and property services, as the defendant has underlined in earlier decisions (decision of the Board of Appeal of 27 November 2002, *Travel Card v AIR TRAVEL CARD* (R 498/2001-3); decisions of the Opposition Division of 21 July 2003, *LLOYD v LLOYDS TSB* (1454-2003), and of 11 November 2003, *ADIGSA v ADIG GRUPPE GUT FÜR IHR GELD* (2451-2003)).

- 62 However, according to the applicant, it is the ultimate paradox for the defendant to justify the non-distinctive character of the mark for financial and monetary services on the ground that the message conveyed by that mark is that the services in question offer the relevant public, at the very least, the possibility of increasing their financial assets and thus of living a materially richer life. The applicant maintains that even if, contrary to its view, that perception of the slogan must be regarded as accurate, from the point of view of the consumer insurance and real estate services also have the ultimate goal of potential individual enrichment. The applicant therefore submits that the Board of Appeal has thus failed to demonstrate the lack of distinctive character of the terms 'live richly' as it is required to do in order to reject the application for registration of that mark under Article 7(1)(b) of Regulation No 40/94. The decision partly to refuse registration of the LIVE RICHLIY mark for the services in question should therefore be annulled.
- 63 The defendant refutes the applicant's arguments and submits that none of them calls into question the lack of distinctive character of the mark which is sought to be registered.

## Findings of the Court

### — Preliminary comments

- 64 Under Article 7(1)(b) of Regulation No 40/94, 'trade marks which are devoid of any distinctive character' are not to be registered. In addition, Article 7(2) of Regulation

No 40/94 states that ‘paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community’.

65 As the Court of First Instance has already held, the marks referred to in Article 7(1)(b) of Regulation No 40/94 are, in particular, those which do not enable the relevant public to repeat the experience of a purchase if it proves to be positive, or to avoid it if it proves to be negative, on the occasion of a subsequent acquisition of the goods or services in question (Case T-79/00 *Rewe-Zentral v OHIM (LITE)* [2002] ECR II-705, paragraph 26; and *EUROCOOL*, cited in paragraph 22 above, paragraph 37). That is true, in particular, for signs which are commonly used in the marketing of the goods or services concerned.

66 However, registration of a trade mark which consists of signs or indications that 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 (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 40). A sign which fulfils functions other than that of a trade mark in the traditional sense of the term is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94, however, 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 (Case T-122/01 *Best Buy Concepts v OHIM (BEST BUY)* [2003] ECR II-2235, paragraphs 20 and 21).

67 Distinctiveness must be assessed, first, in relation to the goods or services for which registration has been requested and, second, in relation to the perception of the relevant section of the public, which is composed of consumers of those goods or services (*EUROCOOL*, cited in paragraph 22 above, paragraph 38; and *LITE*, cited in paragraph 65 above, paragraph 27).

68 Finally, it is clear from the wording of Article 7(1)(b) of Regulation No 40/94 that a minimum degree of distinctive character is sufficient to render inapplicable the ground for refusal set out in that article (*LITE*, cited in paragraph 65 above, paragraph 28).

— The relevant public and its level of attentiveness

69 As far as the relevant public is concerned, it must be borne in mind, first of all, that the designated services are financial and monetary services within Class 36 of the Nice Agreement. The relevant public for those services is made up of all consumers. The distinctive character of the mark sought must therefore be assessed taking into account the presumed expectations of an average consumer who is reasonably well-informed and reasonably observant and circumspect (see, by analogy, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31).

70 Next, it must be borne in mind that the way in which the relevant public, in this case the average consumer, perceives a trade mark is influenced by the consumer's level of attention, which is likely to vary according to the category of goods or services in question (see, in relation to 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), Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26; and, in relation to Regulation No 40/94, *Ovoid tablet*, cited in paragraph 16 above, paragraph 42).



71 In that connection, the applicant submits that, contrary to the view of the Board of Appeal, the relevant public is clearly very attentive as far as financial services are concerned, given that those services are not bought 'off the shelf' like milk or a pair of jeans, and that they are vitally important for the consumer's future.

72 The Court of First Instance observes first that, contrary to the applicant's interpretation according to which the Board of Appeal regarded the relevant public's attentiveness as low, the Board of Appeal in fact considered the relevant public to be reasonably attentive (see paragraph 42 et seq. above).

73 Next, given the nature of certain financial and monetary services at issue, some of those consumers may constitute a very attentive public since the commitments taken on by consumers can be relatively significant and those services can appear to be relatively technical.

74 However, that awareness can be relatively low when it comes to promotional indications, which well-informed consumers do not see as decisive (see, to that effect, *REAL PEOPLE, REAL SOLUTIONS*, cited in paragraph 54 above, paragraph 24; and *BEST BUY*, cited in paragraph 66 above, paragraph 25).

75 Accordingly, the public should be taken to be normally well-informed and aware for all the services covered.

- 76 Furthermore, as the word sign LIVE RICHLIY is made up of English terms, the relevant public is an English-speaking public, or even one which is not so but which has sufficient knowledge of the English language.

— The relevant public's perception

- 77 It is necessary to assess the relevant public's perception of the sign LIVE RICHLIY as a trade mark for financial and monetary services.

- 78 The Board of Appeal considered the LIVE RICHLIY sign to be a slogan made up of two ordinary English words which are understood by the relevant public as a simple laudatory formula meaning that the applicant's services enable consumers to live richly. In addition, the Board of Appeal considered that, beyond its obvious promotional meaning, the LIVE RICHLIY sign did not enable the relevant public to memorise it easily and instantly as a trade mark for the services designated. Since the average consumer is not very attentive, if the sign does not immediately indicate to him the origin of the designated goods or service, but just gives him purely promotional, abstract information, he will not take the time either to enquire into the sign's various possible functions or mentally to register it as a trade mark. For those reasons, the Board of Appeal concluded that the sign could not be a trade mark.

- 79 In the light of those considerations, the applicant is wrong to claim that the Board of Appeal considered the sign at issue to be unregistrable solely because it was a promotional, laudatory formula. Furthermore, those considerations serve to refute the applicant's argument that the Board of Appeal failed to comment on the ability of the LIVE RICHLY sign to distinguish the services of the applicant from those of its competitors.
- 80 In considering in paragraph 15 of the contested decision that the relevant public would be unable to memorise the sign easily and instantly as a trade mark for the services at issue, the Board of Appeal did not confine itself to inferring a lack of distinctiveness of the sign in question from the promotional character of the terms 'live richly', but took into consideration the ability of that sign to distinguish the applicant's goods from those of a competitor, so far as the relevant public is concerned.
- 81 In addition, a trade mark composed of several elements (a compound trade mark) must, for the purposes of assessing its distinctive character, be considered as a whole (Joined Cases T-79/01 and T-86/01 *Bosch v OHIM (Kit Pro and Kit Super Pro)* [2002] ECR II-4881, paragraph 22).
- 82 In that connection, it must be stated that whilst, as the parties acknowledge, the sign LIVE RICHLY is not exclusively and directly descriptive of a service or of goods, it is composed of two current English words which, taken together, have an independent meaning. That sign is easily understood as meaning that the applicant's services enable consumers of those services to live richly.

83 Whilst the expression ‘to live richly’ can indeed be understood in various ways and thus may be vague, the meaning of a word mark must be examined in the light of the services designated in the trade mark application (see *Kit Pro and Kit Super Pro*, cited in paragraph 81 above, paragraph 24 and the case-law cited therein). In so far as the word mark in question is associated with financial and monetary services, it will include, first and foremost, its material or economic sense. The Board of Appeal could therefore legitimately take the view that the sign LIVE RICHLY conveys a clear informative message with a laudatory connotation in the context of financial and monetary services.

84 Furthermore, the fact that the non-descriptive sign LIVE RICHLY can have several meanings, that it can be a play on words and that it can be perceived as ironic, surprising and unexpected, does not suffice to make it distinctive. Those various elements only make that sign distinctive in so far as it is immediately perceived by the relevant public as an indication of the commercial origin of the applicant’s services, and so as to enable the relevant public to distinguish, without any possibility of confusion, the applicant’s services from those of a different commercial origin (*BEST BUY*, cited in paragraph 66 above, paragraph 21; *REAL PEOPLE, REAL SOLUTIONS*, cited in paragraph 54 above, paragraph 20; and Joined Cases T-146/02 to T-153/02 *Deutsche SiSi-Werke v OHIM (Stand-up pouch)* [2004] ECR II-447, paragraph 38).

85 In the present case, as the Board of Appeal points out, the relevant public will, in the context of financial and monetary services, effectively perceive that sign primarily as a promotional formula and not as an indication of the commercial origin of the services in question. There is nothing about the sign LIVE RICHLY that might, beyond its obvious promotional meaning, enable the relevant public to memorise the sign easily and instantly as a distinctive trade mark for the services designated. Even if the sign were used alone, without any other sign or trade mark, the relevant public could not, in the absence of prior knowledge, perceive it other than in its promotional sense (*REAL PEOPLE, REAL SOLUTIONS*, cited in paragraph 54 above, paragraph 28).

86 As regards the paradoxical nature of that argument in relation to OHIM's acceptance of the LIVE RICHLIY mark for insurance and real estate services, it must be emphasised that the Court's jurisdiction is limited to the application of Regulation No 40/94 to the dispute before it. Whilst it is indeed necessary, so far as possible, to maintain consistency in accepting trade marks, it is not for the Court to rule on trade marks beyond the confines of the dispute before the Court.

— The applicant's exclusive use of the trade mark

87 As regards the argument relating to the failure to take into account the non-use of the mark sought, the applicant declared at the hearing that, following the judgment in *OHIM v Erpo Möbelwerk*, cited in paragraph 9 above, it was withdrawing the allegation that in order for a Community trade mark to be devoid of distinctive character, OHIM had to prove that it was commonly used. That declaration was recorded in the minutes of the hearing. The applicant nevertheless argues that the lack of use of a trade mark can be an indication that competitors cannot use that term to designate their own services.

88 The Court of First Instance points out in that regard that the distinctive character of a trade mark is determined on the basis of the fact that that mark can be immediately perceived by the relevant public as designating the commercial origin of the goods or service in question (see paragraph 66 above). The lack of prior use cannot automatically indicate such a perception.

89 In the present case, in the light of the above points, the perception of the services in question is not affected by lack of use, even if established. The applicant's argument must therefore be dismissed.

— The lack of imaginativeness of the mark

90 The applicant submits that the examiner wrongly took into consideration, in her letter of 3 July 2001, the lack of imaginativeness of the mark in refusing the application for registration.

91 In that regard, the Court points out that, according to case-law, a trade mark's lack of distinctive character cannot arise from the lack of an additional element of imagination (Case T-87/00 *Bank für Arbeit und Wirtschaft v OHIM (EASYBANK)* [2001] ECR II-1259, paragraph 39) or of a minimum amount of imagination (Case T-135/99 *Taurus-Film v OHIM (Cine Action)* [2001] ECR II-379, paragraph 31, and Case T-136/99 *Taurus-Film v OHIM (Cine Comedy)* [2001] ECR II-397, paragraph 31), as a Community mark is not necessarily a work of invention and is founded not on any element of originality or imagination, but on its ability to distinguish goods or services on the market from goods or services of the same type offered by competitors (*LITE*, cited in paragraph 65 above, paragraph 30).

92 In the present case, it does not follow from the contested decision that the Board of Appeal based its assessment on the need for a trade mark to be original and imaginative in order for it to have distinctive character.

- 93 According to Article 63 of Regulation No 40/94, only a decision of the Board of Appeal may be the subject of an action before the Court of First Instance. The applicant's complaint is based on the fact that the examiner took the criteria of originality and imagination into account in her letter of 3 July 2001; however they were not taken into account in the contested decision.
- 94 Therefore, even supposing that it is appropriate to take the view that the examiner erroneously took those criteria into account in her decision, in the absence of any such indication in the contested decision, that argument must be dismissed.

— OHIM precedents and other authorities

- 95 As regards the applicant's arguments relating to earlier OHIM decisions and slogans registered by OHIM and in Member States, as well as the fact that the LIVE RICHLIY mark has been accepted in third countries, it is sufficient to point out, first, that the Community trade mark regime is an autonomous system (Case T-32/00 *Messe München v OHIM (electronica)* [2000] ECR II-3829, paragraph 47) and, second, that the legality of the Boards of Appeal's decisions must be assessed solely on the basis of Regulation No 40/94, as interpreted by the Community judicature, and not on the basis of previous practice of those Boards in their decisions (*BUDMEN*, cited in paragraph 35 above, paragraph 61, and Case T-106/00 *Streamserve v OHIM (STREAMSERVE)* [2002] ECR II-723, paragraph 66).
- 96 Therefore the applicant's arguments relating to earlier OHIM decisions and other slogans registered by OHIM or in Member States, as well as the registration of the LIVE RICHLIY mark in third countries, are irrelevant and must be dismissed.

## Costs

### *Arguments of the parties*

- 97 The applicant submits that it could not be inferred from the contested decision that registration of the mark was refused solely in respect of financial and monetary services. It observes that it was only during the proceedings that the defendant admitted that the LIVE RICHLY mark could be registered for insurance and real estate services. Accordingly, it submits that the defendant should be ordered to pay at least two thirds of the costs of the present proceedings.
- 98 At the hearing, the defendant contended that its statements concerning the registration of the mark in respect of insurance and real estate services should not affect the apportionment of costs.

### *Findings of the Court*

- 99 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Furthermore, under Article 87(6) of the Rules of Procedure, where a case does not proceed to judgment the costs are in the discretion of the Court of First Instance.



100 In the present case, the defendant applied for the applicant to be ordered to pay the costs. The applicant's pleas are all dismissed, save for the plea relating to the failure to state reasons, on which it is not necessary to give judgment in view of the applicant's clarification of the subject-matter of the dispute (see paragraph 48 above). However, that clarification by the applicant was given after the defendant's declarations — made for the first time during the action — concerning registration of the mark sought in respect of insurance and real estate services; the contested decision did not make it sufficiently clear that registration of those services was not refused.

101 Accordingly, the applicant must be ordered to bear its own costs as well as one half of the costs incurred by the defendant.

On those grounds,

THE COURT OF FIRST INSTANCE (Third Chamber)

hereby:

**1. Dismisses the application;**

2. **Orders the applicant to bear its own costs, in addition to one half of the costs incurred by the defendant;**
  
3. **Orders the defendant to bear one half of its own costs.**

Jaeger

Azizi

Cremona

Delivered in open court in Luxembourg on 15 September 2005.

H. Jung

Registrar

M. Jaeger

President