

JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)

10 October 2006 \*

In Case T-302/03,

**PTV Planung Transport Verkehr AG**, established in Karlsruhe (Germany),  
represented by F. Nielsen, lawyer,

applicant,

v

**Office for Harmonization in the Internal Market (Trade Marks and Designs)**,  
represented by B. Müller and G. Schneider, acting as Agents,

defendant,

**ACTION** against the decision of the Second Board of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) of 1 July 2003 (Case R 1046/2001-2), concerning an application for registration of the word mark map&guide as a Community trade mark,

\* Language of the case: German.

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

composed of J. Pirrung, President, A.W.H. Meij and I. Pelikánová, judges,

Registrar: I. Natsinas, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 4 September 2003,

having regard to the response lodged at the Registry of the Court of First Instance on 26 November 2003,

further to the hearing on 7 December 2005,

gives the following

## **Judgment**

### **Background to the dispute**

- <sup>1</sup> On 15 February 2001, the applicant filed an application for a Community trade mark at the Office for Harmonization in the Internal Market (Trade Marks and Designs) ('the Office') under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.

- 2 The trade mark applied for is the word mark map&guide.
  
  
  
  
  
  
  
  
  
  
- 3 The goods and services in respect of which registration was sought are in Classes 9, 41 and 42 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 correspond, for each of those classes, to the following description:
  - ‘computer software’, in Class 9;
  
  
  
  
  
  
  
  
  
  
  - ‘conducting training events for computer software’, in Class 41;
  
  
  
  
  
  
  
  
  
  
  - ‘computer programming’, in Class 42.
  
  
  
  
  
  
  
  
  
  
- 4 By a decision of 19 October 2001, the examiner refused the application for registration as a Community trade mark for ‘computer software’ and ‘computer programming’ services pursuant to Article 38 of Regulation No 40/94, on the ground that the trade mark applied for was descriptive of those goods and services within the meaning of Article 7(1)(c) of Regulation No 40/94 and devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94. Contrary to his initial intention, the examiner did not refuse the application for registration for the services of ‘conducting training events for computer software’.

- 5 On 19 December 2001, the applicant lodged an appeal with the Office under Articles 57 to 62 of Regulation No 40/94 against the examiner's decision.
- 6 By decision of 1 July 2003 ('the contested decision'), notified to the applicant on 4 July 2003, the Second Board of Appeal dismissed that appeal on the ground that the trade mark applied for was devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94, adding that it was not necessary to determine whether there was an absolute ground for refusal under Article 7(1)(c) of Regulation No 40/94.

### **Forms of order sought**

- 7 The applicant claims that the Court should:

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

- 8 The Office claims that the court should:

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

## Law

### *Arguments of the parties*

- 9 The applicant relies on a single plea, alleging infringement of Article 7(1)(b) of Regulation No 40/94.
- 10 In support of its claim, the applicant argues, firstly, that it is clear from the wording of Article 7(1)(b) of Regulation No 40/94, which refers to ‘trade marks which are devoid of any distinctive character’, that a slight element of distinctiveness suffices to remove the absolute ground for refusal under that provision.
- 11 It submits, secondly, that according to the judgment in Case T-122/01 *Best Buy Concepts v OHIM (BEST BUY)* [2003] ECR II-2235, paragraph 21, a trade mark is distinctive for the purposes Article 7(1)(b) of Regulation No 40/94 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 the goods or services of the owner of the mark from those of a different commercial origin. In the present case, the sign map&guide fulfils that function because it serves to indicate the commercial origin of the ‘computer software’ and of the ‘computer programming’ services.
- 12 In this respect, firstly, the applicant argues that the Office wrongly decided that the sign map&guide was directly and specifically related to the ‘computer software’ and the ‘computer programming’ services.

13 According to the applicant, the Office did not take sufficient account of the fact that the goods and services referred to in the application for a Community trade mark are not city maps or travel guides but 'computer software' and 'computer programming' services, which may cover any subject-matter. The relationship between these goods and services and the sign map&guide is thus necessarily general and hypothetical. Unlike a travel guide in the form of a book, which everyone would agree to describe as a travel guide, no-one would use the term 'map&guide' to designate a 'computer software' programme. The sign map&guide provides just as little direct information as to the 'computer programming' service. Thus, the relevant public will perceive the sign map&guide as a fanciful expression giving information as to commercial origin. No relationship therefore exists between the sign map&guide and the actual services and goods concerned. The relationship between the semantic content of the sign map&guide, on the one hand, and the 'computer software' and the 'computer programming' services, on the other, might perhaps be inferred by deductive reasoning. Consequently, the prior condition for denying the sign map&guide any entitlement to protection on the basis of lack of distinctiveness is not satisfied.

14 The applicant also argues that on the approach adopted in the contested decision no mark consisting of a 'concrete term' could be attached to 'computer software' or to 'computer programming' services, because it would always be possible to establish a relationship between the semantic content conveyed by that term — for example 'lion' or 'eagle' — and the subject-matter or the field of application of the good or service in question.

15 Secondly, the applicant submits that the sign in question, seen in its entirety and in relation to the goods and services claimed, must be considered to be distinctive.

- 16 Thirdly, the applicant argues that the sign map&guide must have a certain distinctiveness, since the examiner who had initially proposed to refuse the application for a trade mark for the service of 'conducting training events for computer software' subsequently allowed registration of the sign in question for that service. If the sign map&guide had no distinctive character, the examiner would not have been able to alter his initial assessment.
- 17 Fourthly, it submits that even if each case must be assessed individually and earlier registrations of other trade marks are not relevant for the purpose of determining whether a trade mark may be protected, the Office must nevertheless ensure uniformity in its application of the law. It follows that, in essence, there is no justification for the contested decision as long as it has been possible for certain trade marks to be registered for goods and services with which they have a closer relationship than the one that exists between the sign map&guide, on the one hand, and the 'computer software' and the 'computer programming' services, on the other. As examples, the applicant cites the registration of the marks LEICHT (easy) for fitted kitchen furniture, PRO CARE for bodycare and beauty care products, POLY COLOR for hair products, shampoo and hair colouring, GOLDEN CARE for insurance and financial affairs, Safetytech for installations for the packing industry, or again RAPID for drills.
- 18 Finally, the applicant referred generally in the application to the documents it submitted in the proceedings before the Office. However, at the hearing it indicated that it did not wish to rely on those documents in the present proceedings.
- 19 The Office argues that the sign map&guide is devoid of any distinctive character, and rejects the applicant's arguments.

20 Firstly, it submits in substance that the distinctiveness of a trade mark applied for, within the meaning of Article 7(1)(b) of Regulation No 40/94, lies in the actual capacity of the mark to distinguish, as an indication of commercial origin, the goods and services specified in the trade mark application. In this respect, it is settled case-law that the decisive factor to be taken into consideration lies in the presumed perception of an average consumer, who is reasonably well-informed and reasonably observant and circumspect and who is a member of the relevant public (Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26).

21 In the present case, it is the point of view of an English-speaking consumer that it is appropriate to take account of in order to determine the distinctiveness of the trade mark applied for. The sign map&guide consists of words in the English language, and it follows from Article 7(2) of Regulation No 40/94 that registration of a sign as a Community mark must be refused if the sign is devoid of any distinctive character in one of the languages used by the public in the territory of the Community (Case T-91/99 *Ford Motor v OHIM (OPTIONS)* [2000] ECR II-1925, paragraph 25 et seq.).

22 Secondly, the Office argues that, contrary to what the applicant maintains, there is a direct and specific relationship between the sign map&guide and the goods and services in respect of which registration of the sign was applied for, which deprives the sign of distinctive character as regards the goods and services in question.

23 In this respect, the Office submits that, as decided by the Board of Appeal, the words 'map' and 'guide', with their respective meanings in English, are both devoid of any

distinctive character, in as far as they designate solely the actual subject-matter of the product described as 'computer software' and the service described as 'computer programming'. As emphasised in the contested decision, the average consumer of the category of goods or products concerned would buy the computer programmes with the intention of using the data they contain and would understand, without any mental process or deduction, that the computer programme or related service generates geographical maps, city maps or travel guides.

24 Furthermore, as noted in the contested decision the simple combination of the words 'map' and 'guide' to become 'map&guide' does not portray more than the sum of those two elements which are devoid of any distinctive character. The link between these two terms by the typographical sign '&', which means 'and', is not at all grammatically unusual. The construction of the sign map&guide thus reveals no perceptible difference in relation to the terms used in current language, which might confer on it distinctive character within the meaning of Case C-383/99 P *Procter & Gamble v OHIM* [2001] ECR I-6251. Seeing the sign map&guide in the context of software programmes and computer programming, the consumer would understand the meaning immediately and would establish without mental effort a direct and specific relationship between that sign and the goods and services it is supposed to cover.

25 Furthermore, the examiner established sufficiently what the point of view of the relevant public would be, with examples. He also observed that software programmes presented in the form of a geographical map with a guide, which offer more possibilities, such as planning an individual itinerary, than a guide printed on paper are widely available on the market, in particular in the form of CD-ROMs. The applicant does not dispute those factual observations.

26 As regards the applicant's argument that nobody uses the expression 'map&guide' to describe a software programme whereas a travel guide in the form of a book will be described as a 'travel guide', the Office contends in substance that a software programme may replace a book, inasmuch as in the English-speaking regions of the Community there are works of reference which appear in the form of books as well as CD-ROMs. It adds that a consumer seeing the words 'map&guide' on a book thinks immediately of a travel guide with geographical maps or city maps, and that consequently the terms 'travel guide', 'map', 'guide' or even 'map&guide' for publications included in Class 16 are not eligible for protection. The same must therefore be true of the corresponding software.

27 As regards the applicant's objection that if the approach taken in the contested decision is followed no proper noun, such as 'lion' or 'eagle', for computer software or related services would be eligible for protection, the Office replies, in substance, that it is the point of view of the consumer that prevails and that that point of view will be influenced largely by specific practice in the sector in question. The general public, which in this case is the relevant public, is aware that geographical or city maps with a guide are available on the market in the form of software. That being so, and as the Board of Appeal remarked, the average consumer, seeing the words 'map&guide' on software packaging or in the context of a related service, and given the practice on the market, will think of a software programme in the form of an electronic travel guide with a city or geographical map. On the other hand, the Office considers that, when seeing computer software with the name 'lion' or 'eagle' (or 'apple'), the relevant public will not consider that to be the description of the content of the software, but will perceive the name as a trade mark.

28 The Office adds further that if the applicant wished to market under the trade mark map&guide software which did not have as its subject-matter geographical maps and guides, it was open to it to restrict the list of goods and services in respect of which registration was applied for, as permitted by Article 44(1) of Regulation

No 40/94. In this case, the application for registration covered all of the non-differentiated category of goods 'computer software' and the non-differentiated category of services called 'computer programming'. In those circumstances, it is appropriate to confirm the assessment of the Board of Appeal in respect of those categories as a whole (Case T-359/99 *DKV v OHIM (EuroHealth)* [2001] ECR II-1645, paragraph 33, and Case T-219/00 *Ellos v OHIM (ELLOS)* [2002] ECR II-753, paragraph 36).

29 Thirdly, the Office submits that the fact that the examiner abandoned the objections that he had initially raised to the trade mark sought in so far as it concerned the service of 'conducting training events for computer software' falling within Class 41 is not relevant here.

30 Fourthly, the Office argues that the claim that in the past it had allowed registration of trade marks with a significantly closer relationship with the goods and services they cover than the one which exists between the sign map&guide and the disputed goods and services is not relevant. In this respect, it submits that, following the judgment in Case T-106/00 *Streamserve v OHIM (STREAMSERVE)* [2002] ECR II-723, paragraphs 66 and 67, the applicant cannot rely on any error the Office might have made by registering comparable trade marks in other cases.

31 It follows from all the above that the sign map&guide is incapable of serving as an indication of origin of 'computer software' and of 'computer programming' services.

*Findings of the Court*

- 32 As provided in Article 7(1) of Regulation No 40/94, trade marks are not to be registered, under subparagraph (b) of this provision, if they are devoid of any distinctive character, and, under subparagraph (c) of the same provision, if they consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods.
- 33 Each of the grounds for refusal to register listed in Article 7(1) of Regulation No 40/94 is independent of the others and requires separate examination. Moreover, it is necessary to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may, or even must, reflect different considerations, depending on the ground for refusal in question (see Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraphs 45 and 46; Case C-329/02 P *SAT.1 v OHIM* [2004] ECR I-8317, paragraph 25; and Case C-37/03 P *BioID v OHIM* [2005] ECR I-7975, paragraph 59).
- 34 However, there is a clear overlap in scope between the grounds for refusal set out in subparagraphs (b) to (d) of that provision (Case C-265/00 *Campina Melkunie* [2004] ECR I-1699, paragraph 18, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 67). In particular, it is clear from the case-law that a word mark which is descriptive of the 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 the same regulation (see *Campina Melkunie*, paragraph 19, and *Koninklijke KPN Nederland*, paragraph 86).

- 35 In a case like the present one, in which the contested decision refuses registration of the trade mark applied for on the basis of an absolute ground for refusal provided for in Article 7(1)(b) of Regulation No 40/94, it is necessary to examine whether the Office has shown that that mark is devoid of any distinctive character.
- 36 In this respect, it must be noted that the notion of general interest underlying Article 7(1)(b) of Regulation No 40/94 is manifestly indissociable from the essential function of a trade mark, which is to guarantee to the consumer or end-user the identity of the origin of the product or service bearing the mark by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see *SAT.1 v OHIM*, paragraphs 23 and 27, and *BioID v OHIM*, paragraph 60).
- 37 As regards a mark comprised of words and a typographical sign, such as that which forms the subject-matter of this case, distinctiveness may be assessed partly in relation to each of those terms or elements separately, but must, in any event, depend on an appraisal of the whole which they comprise. That is because the mere fact that each of those elements, taken separately, is devoid of distinctive character does not mean that their combination cannot have distinctive character (*Campina Melkunie*, paragraphs 40 and 41; *Koninklijke KPN Nederland*, paragraphs 99 and 100, and *SAT.1 v OHIM*, paragraph 28).
- 38 It is clear from the contested decision that the Board of Appeal rejected the appeal on the ground, inter alia, that in relation to ‘computer software’ and ‘computer

programming' the sign map&guide will certainly be perceived by consumers solely as an indication as to the goods and services themselves, and not as an indication of origin enabling the goods and services of one business to be distinguished from those of another.

39 It follows that although the Board of Appeal indicated that it was not necessary to examine the absolute ground for refusal based on the descriptive character of the sign in question, it considered, in essence, that the sign map&guide was not distinctive within the meaning of Article 7(1)(b) of Regulation No 40/94 because it would be perceived by the relevant public as being descriptive of the goods and services in question.

40 It is necessary, therefore, to determine whether the association established by the Board of Appeal between the semantic content of the sign for which registration is sought, on the one hand, and the goods and services in question, on the other, is sufficiently specific and direct to show that that sign enables the relevant public to identify those goods and services immediately and that it is therefore descriptive (see to that effect *EuroHealth*, paragraphs 35 and 36).

41 In this respect it should be borne in mind that, according to settled case-law, the descriptiveness of a sign, like its distinctiveness, must be assessed, first, in relation to the goods or services in respect of which registration is applied for, and secondly in relation to the perception of it by the relevant public (*Procter & Gamble v OHIM*, paragraph 39, and Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 43).

- 42 The applicant does not dispute the assessment of the Board of Appeal according to which the relevant public for the goods and services in respect of which registration of the mark is applied for consists of the average consumer from the general public. Furthermore, as the Office submits, under Article 7(2) of Regulation No 40/94, the relevant target public in relation to which the absolute ground for refusal must be considered is the average English-speaking consumer, as the sign in question consists of elements of the English language.
- 43 In this respect, the Board of Appeal stated, without being contradicted by the applicant, that the sign in question consisted notably of two nouns in the English language, 'map' and 'guide', with their respective English meanings.
- 44 It also found expressly that the mere combination of the words 'map' and 'guide' by the typographical sign '&', meaning 'and', was not at all grammatically original and that, consequently, the meaning of the terms thus combined remained unchanged. It concluded that the sign for which registration was applied for, taken as a whole, did not represent more than the sum of the elements it is composed of.
- 45 Furthermore, as submitted by the Office, it is necessary to consider that the construction of the sign map&guide, taken as a whole, does not differ perceptibly from the terminology used in the common parlance of the relevant public which might make it distinctive in accordance with the judgment in *Procter & Gamble v OHIM*, paragraph 40.

46 The Board of Appeal therefore rightly decided, in essence, that the sign taken as a whole means ‘map and guide’, that is to say (city) map and (travel) guide.

47 As regards the relationship between the semantic content of the sign map&guide and the goods and services concerned, the Board of Appeal properly decided that that sign merely described the actual subject-matter of certain goods (‘computer software’) and of certain services (‘computer programming’). In the English-speaking zone of the Community, that sign may serve to designate computer software and computer programming services the function of which is to provide (city) maps and (travel) guides. It follows that the semantic content of the sign map&guide enables the relevant public to establish immediately, and without reflection, a specific and direct relationship with the computer software and the computer programming services for computers providing the function of (city) maps and (travel) guides.

48 Since the application sought registration for the non-differentiated category ‘computer software’ as well as the non-differentiated category ‘computer programming’ services, the assessment of the Board of Appeal must be upheld in so far as it relates to all those goods and services (see, to that effect, *EuroHealth*, paragraph 33).

49 Contrary to what the applicant argues, the fact that ‘computer software’ and ‘computer programming’ services may cover any theme does not preclude the finding that the semantic content of the sign in question describes the actual subject-matter of some of the goods and services covered by the application for registration. By claiming that the goods and services concerned by that application cover any theme, the applicant implicitly accepts that the ‘computer software’ and

the 'computer programming' services may include some which have the function of providing (city) maps and (travel) guides.

- 50 Furthermore, an approach such as that upheld by the Board of Appeal does not have the consequence, as argued by the applicant, of no longer permitting the registration of trade marks consisting of a 'specific term' for 'computer software' or for 'computer programming' services on the ground that it would always be possible to establish a relationship between the semantic content of the sign and the goods and services concerned. It is only in as far as that relationship is specific and direct that Article 7(1)(c) of Regulation No 40/94 prevents registration of such a sign.
- 51 It follows from the above that the Board of Appeal rightly decided that, for the relevant public consisting of average consumers from the English-speaking general public, the sign map&guide was descriptive of the goods and services covered by the application for registration. Therefore, in accordance with the case-law to the effect that every descriptive sign is necessarily devoid of any distinctive character (*Campina Melkunie*, paragraph 19, and *Koninklijke KPN Nederland*, paragraph 86), the Board of Appeal rightly decided that the sign map&guide was not distinctive.
- 52 Moreover, in so far as the Board of Appeal also decided to base the contested decision on the finding that the sign, taken as a whole, is likely to be commonly used in business for the presentation of the goods and services concerned (paragraphs 15 and 16 of that decision), it must be observed that it follows from the case-law of the Court that that criterion is not the yardstick against which Article 7(1)(b) of Regulation No 40/94 is to be interpreted and that the public interest underlying that

provision does not require that the signs it refers to may be freely used by all (*SAT.1 v OHIM*, paragraph 36).

53 Nevertheless, as the contested decision is based on the accurate assessment to the effect that the sign map&guide is not distinctive because there is a specific and direct link between its semantic content and the goods and services concerned, the Board of Appeal did not err in stating that there was an absolute ground for refusing registration of the sign map&guide.

54 It is clear from the decisions cited above in paragraph 41 that the distinctive character of a trade mark must be determined in relation to the goods and services in respect of which registration is applied for. Consequently, contrary to what the applicant argues, the fact that the examiner accepted the distinctive character of the sign map&guide in respect of the services of 'conducting training events for computer software' is not relevant in determining whether that sign is distinctive in relation to the various goods and services which constitute the 'computer software' and 'computer programming' services.

55 Finally, contrary to what the applicant argues, even if the Office had, as is alleged, allowed registration of trade marks for goods and services more closely related to those trade marks than is the sign map&guide to the goods and services in respect of which registration of that trade mark was applied for, that certainly does not mean that uniform application of Regulation No 40/94 requires that that sign be registered as a Community trade mark for the goods and services concerned. Decisions concerning registration of a sign as a Community trade mark which the Boards of Appeal are called on to take under Regulation No 40/94 are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the legality of the decisions of Boards of Appeal must be assessed solely on the basis of that regulation, as interpreted by the Community judicature, and not on the basis of

previous practice in the decisions of those boards (see *BioID v OHIM*, paragraph 47). Furthermore, the trade marks invoked and the goods and services with which they are associated are not similar to either the sign in question or the goods and services concerned in the present case. Consequently, in the light of the case-law set out above in paragraph 41, the registration of the trade marks relied on by the applicant is not relevant in determining whether the sign map&guide is distinctive for the goods and services in question in the present case.

56 In view of all the above, it must be held that the Board of Appeal correctly considered the sign map&guide to be devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94.

57 Consequently, the action must be dismissed.

## Costs

58 Under Article 87(2) of the Rules of Procedure of the Court of First Instance, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by the defendant.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders the applicant to pay the costs.**

Pirrung

Meij

Pelikánová

Delivered in open court in Luxembourg on 10 October 2006.

E. Coulon

Registrar

J. Pirrung

President