

JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)

31 January 2001 *

In Case T-193/99,

Wm. Wrigley Jr. Company, established in Chicago, Illinois (United States of America), represented by M. Kinkeldey, lawyer,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by V. Melgar and S. Laitinen, acting as Agents, with an address for service in Luxembourg,

defendant,

APPLICATION for annulment of the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of

* Language of the case: English.

16 June 1999 (Case R 216/1998-1) concerning the registration of the term DOUBLEMINT as a Community trade mark,

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

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

Registrar: B. Pastor, Principal Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 1 September 1999,

having regard to the response lodged at the Registry of the Court of First Instance on 6 December 1999,

further to the hearing on 14 September 2000,

gives the following

Judgment

Background to the dispute

- 1 On 29 March 1996, the applicant filed, under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, an application for a Community word mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('the Office').
- 2 The trade mark in respect of which registration was sought is the term **DOUBLEMINT**.
- 3 The goods in respect of which registration was sought come within, in particular, Classes 3, 5 and 30 for the purpose of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and are, more specifically:

'Cosmetics, dentifrices, including chewing gum for cosmetic purposes' (Class 3);

'Pharmaceutical, veterinary and sanitary preparations, including chewing gum for medical purposes, chewing gum with medicinal additives' (Class 5);

'Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, coffee substitutes, flour and preparations made from cereals, bread, biscuits, cakes, pastry and confectionery, caramels, ices; honey; treacle, yeast, baking-powder, salt, mustard; pepper, vinegar, sauces (condiments), spices; ice; confectionery and chewing gum without medicinal additives, confectionery including chewing gum; sugar-coated chewing gum, chewing gum plain, non-medicated confectionery, chocolate, sugars, candy' (Class 30).

4 By decision of 13 October 1998, the examiner refused the application under Article 38 of Regulation No 40/94, on the ground that the term for which registration was sought was purely descriptive and therefore fell within the ambit of Article 7(1)(c) of Regulation No 40/94.

5 On 8 December 1998, the applicant lodged an appeal at the Office, under Article 59 of Regulation No 40/94, against the examiner's decision. It submitted that, taken in its entirety, the term must be regarded as a new word creation. Consumers would not understand the words 'double' and 'mint' as each having one single meaning, but would have to take several mental steps in order to reach a final understanding of their meaning.

6 The appeal was dismissed by decision of 16 June 1999 ('the contested decision'). In substance, the Board of Appeal found that the term at issue, which is a combination of two English words with no additional fanciful or imaginative

element, was descriptive of certain characteristics of the goods in question. It could not, therefore, be registered as a Community trade mark.

Forms of order sought by the parties

7 The applicant claims that the Court should:

— annul the contested decision;

— order the Office to pay the costs.

8 The Office contends that the Court should:

— dismiss the application;

— order the applicant to pay the costs.

9 At the hearing, the Office stated, without being contradicted by the applicant on that point, that, according to its research, each of the goods referred to in the

application for registration and listed in paragraph 3 above might contain mint. The applicant stated that its business activities were currently focused on chewing gum. None the less, its application for registration refers to all the goods mentioned in paragraph 3 above; it is possible that its activities will be diversified to cover goods other than chewing gum.

Law

- 10 In support of its application, the applicant puts forward a single plea based on infringement of Article 7(1)(c) of Regulation No 40/94.

Arguments of the parties

- 11 The applicant submits that the term DOUBLEMINT does not fall within the scope of the provision in question. That provision covers only marks which consist 'exclusively' of descriptive indications. Once a mental effort, even a small one, is necessary clearly to discern a trade mark's possible meaning, the mark becomes suggestive. The expression DOUBLEMINT includes inventive elements.
- 12 In the applicant's submission, the Board of Appeal was wrong in stating that DOUBLEMINT means 'twice the usual amount of mint'; consumers cannot know what is the 'usual amount of mint' in the goods in question, since there is no definition of such a thing. Consequently, there is no taste which is 'twice as strong as usual'. The term DOUBLEMINT thus does not describe any definable characteristic of the goods in question but gives a highly fanciful and vague

impression of the nature of the goods. Such trade marks are the best because they stick in consumers' minds.

13 In any event, the word DOUBLEMINT must be considered in its entirety. It is an expression which is uncommon and fanciful. Furthermore, the fact that the word DOUBLEMINT does not appear in any dictionary strongly indicates that it is a coined and fanciful term.

14 The Office submits that descriptive indications, for the purposes of the provision in question, are not, by their nature, capable of performing the function of a trade mark. Where invented words are involved and they do not appear in the dictionary, the practice of the Office is to look at how they are perceived by the average person. In the case of word marks composed of several words, assessment must be based in each case on the normal and spontaneous understanding of the average person.

15 As regards the present case, the Office states that the compound term DOUBLEMINT consists of two common words of the English language. A consumer who sees that expression on a packet of chewing gum or in an advertisement for chewing gum assumes that the product contains a great deal of mint or an addition of the flavour of mint. Since the message is limited to an immediate description of characteristics, the word is not registrable.

16 The Office adds that the fact that the term DOUBLEMINT has two meanings — namely 'twice the usual amount of mint' and 'flavoured with two varieties of mint' — does not give the term at issue a suggestive meaning, since each of the two meanings is purely descriptive.

Findings of the Court

- 17 Under Article 4 of Regulation No 40/94, the decisive factor if a sign capable of being represented graphically is to be eligible for registration as a Community trade mark is its capacity to distinguish the goods of one undertaking from those of another.
- 18 One of the implications of this is that the absolute grounds for refusal listed in Article 7(1) of Regulation No 40/94 can be assessed only in relation to the goods in respect of which registration of the sign is applied for (see Case T-163/98 *Procter & Gamble v OHIM* ('*Baby-Dry*') [1999] ECR II-2383, paragraphs 20 and 21).
- 19 Under Article 7(1)(c) of Regulation No 40/94 — the only provision in question in this case —, 'trade marks which 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 other characteristics of the goods...' are not to be registered.
- 20 It was thus the intention of the legislature that — subject to Article 7(3) of Regulation No 40/94 — such signs should, by their purely descriptive nature, be regarded as incapable of distinguishing the goods of one undertaking from those of another. By contrast, signs or indications whose meaning goes beyond the merely descriptive are capable of being registered as Community trade marks.
- 21 In this case, the Board of Appeal states in the contested decision that the term DOUBLEMINT is a combination of two English words, namely the word 'double' — which means 'consisting of two members, things, layers, sets' and 'of two or more times the usual size, value, strength' — and the word 'mint' —

which means, *inter alia*, ‘any of various aromatic... plants of the genus *Mentha*, which bear lilac flowers and include spearmint, peppermint, and other culinary herbs’ and ‘a sweet or chocolate flavoured with an extract of such a plant, especially peppermint’. According to the Board of Appeal, that term immediately indicates to potential consumers that the goods in question contain ‘twice the usual amount of mint’ or that they are ‘flavoured with two varieties of mint’.

- 22 The Board of Appeal does not find it at all relevant that both the word ‘double’ and the word ‘mint’ have alternative meanings, on the ground that a consumer who sees the term at issue assumes, in the Board of Appeal’s view, that the product in question contains ‘a great deal of mint’ or ‘the flavour of mint’. It concludes that the term at issue is purely descriptive and cannot therefore be registered as a Community trade mark.
- 23 The Board of Appeal was wrong in regarding the term DOUBLEMINT as exclusively descriptive.
- 24 First of all, when it is used as a term of praise designed to refer to a given product, the adjective ‘double’ is unusual when compared with more straightforward and commonplace complimentary words such as ‘much’, ‘strong’, ‘extra’, ‘best’ or ‘finest’, and this is all the more true in the present case in which that adjective makes no comparative allusion to the ‘single’ state of the same, or a competitive product.
- 25 Next, the Board of Appeal itself stated that the word ‘double’, more particularly when combined with the word ‘mint’, has two distinct meanings for the potential consumer: ‘twice the usual amount of mint’ or ‘flavoured with two varieties of mint’.

- 26 On the basis of that finding, it is not possible to infer from the mere term DOUBLEMINT whether the product referred to contains twice as much mint, for example peppermint, or whether it is flavoured with two different varieties of mint, for example peppermint and spearmint.
- 27 Finally, as regards solely the case of a combination of two sorts of mint, it is possible, furthermore, that the flavour of spearmint or that of another culinary herb is much stronger than that of peppermint, so that the consumer must expect a product containing two sorts of mint to have a taste which is very different from that of a product containing only peppermint in double quantity.
- 28 Still on the subject of a combination of two sorts of mint, it is important to bear in mind, finally, that ‘mint’ is a generic term which includes, according to the Board of Appeal’s findings, spearmint, peppermint and other culinary herbs. Consequently, there are several possible ways of combining two sorts of mint and, in addition, various strengths of flavour are possible in the case of each combination.
- 29 Therefore, the numerous meanings of the composite term DOUBLEMINT — each element of which is a common word of the English language — are immediately apparent, at least by association or allusion, to an average English-speaking consumer and thus deprive that sign of any descriptive function, for the purposes of Article 7(1)(c) of Regulation No 40/94, whereas for a consumer who does not have a sufficient mastery of the English language the term at issue will, by its very nature, have a vague and fanciful meaning.
- 30 It follows from all the foregoing considerations that the term DOUBLEMINT, when applied to the goods referred to in the application for registration, has an

ambiguous and suggestive meaning which is open to various interpretations. The multiplicity of possible semantic combinations therefore precludes the consumer from remembering one of them in particular. Accordingly, the term at issue does not enable the public concerned immediately and without further reflection to detect the description of a characteristic of the goods in question.

31 Consequently, that term cannot be characterised as exclusively descriptive.

32 It follows that the contested decision must be annulled.

Costs

33 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.

34 In this case, the Office has been unsuccessful. Consequently, it must be ordered to pay the costs, in accordance with the form of order sought by the applicant.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby:

1. Annuls the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade marks and Designs) of 16 June 1999 (Case R 216/1998-1);
2. Orders the defendant to pay the costs.

Pirrung

Potocki

Meij

Delivered in open court in Luxembourg on 31 January 2001.

H. Jung

Registrar

A.W.H. Meij

President