

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)

12 January 2005^{*}

In Joined Cases T-367/02 to T-369/02,

Wieland-Werke AG, established at Ulm (Germany), represented by S. Gruber and F. Graf von Stosch, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by T.L. Eichenberg and G. Schneider, acting as Agents,

defendant,

APPLICATIONS for annulment of three decisions of the First Board of Appeal of the OHIM of 25 September 2002 (Cases R 338/2001-1, R 337/2001-1 and R 335/2001-1), concerning applications for registration of word marks SnTEM, SnPUR and SnMIX as Community trade marks,

^{*} Language of the case: German.

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

composed of: H. Legal, President, V. Tiili and M. Vilaras, Judges,

Registrar: D. Christensen, Administrator,

having regard to the applications lodged at the Registry of the Court of First Instance on 9 December 2002,

having regard to the joinder of these cases for the purposes of the written procedure, the oral procedure and the judgment, in accordance with Article 50 of the Rules of Procedure of the Court of First Instance,

having regard to the response lodged at the Registry of the Court of First Instance on 28 April 2003,

and further to the hearing on 17 June 2004,

gives the following

Judgment

Background to the dispute

- 1 On 14 December 1999 the applicant filed three applications for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), pursuant to 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 marks for which registration was sought were the word signs SnTEM, SnPUR and SnMIX.

- 3 The goods in respect of which registration was sought fall within Class 6 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 to the following description:

‘Metallic semi-finished products in the form of sheets, strips, wires, tubes, sections, rods or the like, especially in non-ferrous metals, such as copper or a copper alloy, having a metallic coating on one side or both sides especially of tin or a tin alloy.’

- 4 By letters of 10 February 2000 the examiner informed the applicant that in accordance with Article 7(1)(b), (c) and (g) of Regulation No 40/94 it was impossible to allow the signs in question to be registered, for they were descriptive of the goods for which registration was sought, devoid of any distinctive character and of such a nature as to deceive the public. According to the examiner, the element ‘Sn’ represents the chemical symbol for tin. The element ‘TEM’ is the abbreviation used in the scientific and technical sphere for the word ‘tempered’ in connection with alloys. Consequently, the trade mark SnTEM means ‘tempered tin’. The element ‘PUR’ means pure, so the trade mark SnPUR means ‘pure tin’. Last, according to the examiner, the element ‘MIX’ corresponds to the German for ‘mixture’ and the trade mark SnMIX therefore means ‘tin alloy’. The examiner also found that each of the trade marks sought was of such a nature as to deceive the public inasmuch as the products in respect of which the applications were made are not consistent with those indications.

5 By letter of 3 April 2000 the applicant submitted its observations on the examiner's objections. In addition, it limited the list of products covered by the applications for trade marks by deleting the second 'especially', the list of products thus becoming:

'Metallic semi-finished products in the form of sheets, strips, wires, tubes, sections, rods or the like, especially in non-ferrous metals, such as copper or a copper alloy, having a metallic coating on one side or both sides of tin or a tin alloy.'

6 By three decisions of 7 and 8 February 2001 the examiner refused the applications for registration on the basis of Article 7(1)(b) and (c) of Regulation No 40/94.

7 On 4 April 2001 the applicant lodged three appeals with the Office pursuant to Articles 57 to 62 of Regulation No 40/94.

8 By decisions of 25 September 2002 R 338/2001-1, R 337/2001-1 and R 335/2001-1 ('the contested decisions'), which were notified to the applicant on 10 October 2002, the First Board of Appeal dismissed the appeals. In substance, the Board of Appeal held that, since specialist circles would know the meaning of the chemical symbol 'Sn' and of the abbreviations 'TEM', 'PUR' and 'MIX', the trade marks sought indicate tempered tin, pure tin or a tin alloy, respectively. In consequence, according to the Board of Appeal, the trade marks at issue are descriptive of the goods covered by the applications for registration and are devoid of any distinctive character within the meaning of Article 7(1)(c) and (b) of Regulation No 40/94.

Forms of order sought

9 The applicant claims that the Court should:

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

10 The Office contends that the Court should:

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

Law

11 In support of its actions the applicant puts forward two pleas in law. The first alleges infringement of Article 7(1)(c) of Regulation No 40/94. The second alleges infringement of Article 7(1)(b) of that regulation.

- 12 It is appropriate to examine the first plea in law.
- 13 The applicant denies that the signs SnTEM, SnPUR and SnMIX are merely descriptive of the goods covered by the applications for registration and claims that those signs do not, in the relevant sectors, directly or physically designate the quality or other characteristics of the goods referred to.
- 14 The Office maintains that the Board of Appeal was right in finding in the contested decisions that the trade marks in question must be refused registration.
- 15 The Court notes that, under Article 7(1)(c) of Regulation No 40/94, '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 of rendering of the service, or other characteristics of the goods or service' may not be registered. In addition, Article 7 (2) provides that '[p]aragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community'.
- 16 Article 7(1)(c) of Regulation No 40/94 prevents the signs and indications to which it refers from being reserved to one undertaking alone because they have been registered as trade marks. That provision thus pursues an aim which is in the public interest, namely that such signs or indications may be freely used by all (Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 31).

- 17 The distinctiveness of a trade mark must be assessed, first, in relation to the goods or services in respect of which registration of the sign has been requested (Case T-135/99 *Taurus-Film v OHIM (Cine Action)* [2001] ECR II-379, paragraph 25, and Case T-136/99 *Taurus-Film v OHIM (Cine Comedy)* [2001] ECR II-397, paragraph 25) and, second, in relation to the perception of the section of the public targeted which is composed of the consumers of those products or services (Case T-219/00 *Ellos v OHIM (ELLOS)* [2002] ECR II-753, paragraph 29).
- 18 In the circumstances of the case, it is to be noted first of all that the goods covered by the applications for registration are metallic semi-finished products, especially in non-ferrous metals, in the form of sheets, strips, wires, tubes, sections, rods or the like, having a metallic coating on one side or both sides of tin or a tin alloy.
- 19 It has therefore to be considered that, given the nature of the goods in question, the targeted public consists of specialists in the sphere of metallurgy.
- 20 Moreover, inasmuch as those specialists are acquainted with the usual scientific terms and abbreviations in their sphere of activity, whatever the linguistic origin of those terms or abbreviations may be, the targeted public has to be considered to consist of specialists in metallurgy in various countries of the European Union.
- 21 Accordingly, for the purposes of Article 7(1)(c) of Regulation No 40/94, it is necessary only to consider, on the basis of a given meaning of the word signs in question, whether, from the point of view of the intended public, there is a sufficiently direct and specific association between the signs and the categories of goods and services in respect of which registration is sought (Case T-355/00 *DaimlerChrysler v OHIM (TELE AID)* [2002] ECR II-1939, paragraph 28).

- 22 With regard to the meaning of the trade marks in respect of which registration is sought, it is to be noted that each of the word signs SnTEM, SnPUR and SnMIX is composed of two distinct elements, namely, 'Sn' and 'TEM', 'PUR' and 'MIX', respectively.
- 23 First, it is established that the element 'Sn', common to the three word signs at issue, is the chemical symbol for tin. All the goods in respect of which the applicant seeks registration are covered in 'a metallic coating on one side or both sides of tin or a tin alloy'. In consequence, all the goods claimed by the applicant contain tin and the element 'Sn' is therefore descriptive of one of their characteristics.
- 24 Second, it is necessary to examine the meaning of the second element composing the three signs for which registration has been sought.
- 25 First of all, the element 'TEM' refers — and this has not been disputed — to the English verb 'temper', which relates to heat treatment which is a characteristic of the goods in question. The applicant's argument that the word 'temper' does not indicate the material qualities of a product but rather a manufacturing process has no relevance. Indeed, indicating the process by which a product is manufactured also concerns a characteristic of that product.
- 26 Accordingly, the element 'TEM' has to be regarded as descriptive of one of the characteristics of the goods for which registration is claimed.
- 27 Next, as regards the element 'PUR', that too must be regarded as being descriptive of one of the characteristics of the goods for which registration is claimed, namely, their 'purity'.

- 28 The element 'MIX' refers — and this is not disputed by the applicant — to a mixture.
- 29 That element is therefore descriptive of one of the characteristics of the goods for which registration is claimed, inasmuch as it indicates that those goods or some part of them are composed of an alloy of various metals.
- 30 Third, the meaning of each of the signs at issue as a whole must be examined.
- 31 It must be borne in mind that if a mark, such as that at issue in the main proceedings, which consists of a neologism produced by a combination of elements, is to be regarded as descriptive within the meaning of Article 7(1)(c) of Regulation No 40/94, it is not sufficient that each of its components may be found to be descriptive. The word or neologism itself must be found to be so (see, by analogy, Case C-265/00 *Campina Melkunie* [2004] ECR I-1699, paragraph 37, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 96).
- 32 A trade mark consisting of a neologism or a word composed of elements each of which is descriptive of characteristics of the goods or services in respect of which registration is sought is itself descriptive of the characteristics of those goods or services for the purposes of Article 7(1)(c) of Regulation No 40/94, unless there is a perceptible difference between the neologism or the word and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the neologism or word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts (see, by analogy, *Campina Melkunie*, paragraph 43, and *Koninklijke KPN Nederland*, paragraph 104).

- 33 In the circumstances, with regard to the signs SnTEM and SnPUR, it is clear from the annexes to the Office's response, which have not been challenged by the applicant, that in the sector of the metallic goods concerned in this case it is quite normal for the designation of the material in question to be followed by an explanatory addition when mention is made of the precise nature of the materials used for those goods. Accordingly, contrary to the applicant's submission, the signs SnTEM and SnPUR cannot be considered to be lexical inventions. Moreover, as the Office has correctly pointed out, the adjective 'pure' is often placed after the noun to which it relates in order to emphasise its purity.
- 34 Having regard to the nature of the goods referred to in the application for the trade mark, the relevant public will thus immediately understand the word sign SnPUR to designate products made of pure tin.
- 35 So far as the word sign SnTEM is concerned, having regard to the nature of the goods referred to in the application for the trade mark, the relevant public, that is to say, specialists in the field of metallurgy, will understand it to mean that the goods in question are made of tempered tin. In this connection the applicant itself admits that it is possible 'at the very most to see in the sign some vague allusion to the thermal treatment of tin ("tempered tin")', but it considers that the sign cannot be understood straight away in that sense before the chemical symbol 'Sn' has been translated as 'tin'. It has to be held that specialist sectors are capable of understanding immediately, having regard to the goods in question, that 'Sn' means tin. Indeed, as is clear from the internet sites to which the Office refers in its response, without being contradicted on that point by the applicant, chemical symbols are in widespread use in the sector concerned.
- 36 So far as concerns the word sign SnMIX, having regard to the nature of the goods referred to in the application for the trade mark, the relevant public will immediately understand it to designate products made of a tin alloy. The applicant cannot reasonably maintain that the connection between the sign SnMIX and the goods in respect of which it is claimed is too vague or uncertain for it to be possible for the sign in question to be considered to be a description of those goods. Indeed, the

mere indication that an alloy of tin is involved is enough to characterise the goods in question, and it is not necessary to know with what metal or other material the tin is mixed. The applicant's argument that the expression 'tin mixture' could refer to the manufacturing process is equally irrelevant, since that process forms part of the characteristics of a product.

- 37 Consequently, it must be considered that the word signs SnTEM, SnPUR and SnMIX are themselves descriptive of characteristics of the goods concerned, because there is no perceptible difference between those signs and the mere sum of their parts. In relation to the goods in question, the nature of the combinations SnTEM, SnPUR and SnMIX is not unusual (see, to that effect and by analogy, *Campina Melkunie*, paragraph 41).
- 38 With regard to the sign SnTEM the Board of Appeal found, in paragraph 23 of the decision challenged in Case T-367/02, that specialist circles know the meaning of the abbreviation 'Sn' and that 'TEM' is a common abbreviation in English, although the combination of the two elements into SnTEM cannot be vouched for from the lexical point of view. According to paragraph 24 of that decision, specialist circles will not see in the word sign SnTEM a 'neologism contrary to the rules of grammar' but rather an abbreviation clearly indicating that it referred to 'tempered tin'. The Board of Appeal therefore concluded in paragraph 25 of that decision that the trade mark applied for was merely descriptive of the goods in question. Similar reasoning is set out in paragraphs 24 to 26 of the decision challenged in Case T-368/02 and paragraphs 24 to 26 of the decision challenged in Case T-369/02.
- 39 Accordingly, the Board of Appeal in essence considered in the contested decisions that the signs at issue were not unusual. Consequently, the Board of Appeal did not, as the applicant alleges, misinterpret the principles laid down in Case C-383/99 P *Procter & Gamble v OHIM* [2001] ECR I-6251), concerning the word mark BABY-DRY, having regard to the fact that in the instant case it is not disputed that the trade marks applied for do not constitute lexical inventions.

- 40 Finally, so far as concerns the applicant's argument that the terms SnTEM, SnPUR and SnMIX are not used to designate the intermediary products themselves, or one of their essential characteristics or yet the quality following from the treatment they have undergone, it is enough to observe that it is not necessary that the signs and indications composing the mark that are referred to in Article 7(1)(c) of Regulation No 40/94 should actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient that those signs and indications could be used for such purposes (see, by analogy, *Campina Melkunie*, paragraph 38), which is made sufficiently plain in the documents submitted to the Court of First Instance by the Office and not challenged by the applicant. Nor can the latter rely on Case T-193/99 *Wrigley v OHIM (DOUBLEMINT)* [2001] ECR-II-417, set aside by the judgment in *OHIM v Wrigley*, since it is enough that the sign in question should designate, in at least one of its possible meanings, a characteristic of the goods or services concerned (see *OHIM v Wrigley*, paragraph 32 and, by analogy, *Campina Melkunie*, paragraph 38).
- 41 The applicant's argument that there are other terms for designating the same characteristics of its products is not persuasive. It is immaterial whether or not there are synonyms capable of designating the same characteristics of the goods or services mentioned in the application for registration. Although Article 7(1)(c) of Regulation 40/94 provides that, if the ground for refusal set out there is to apply, the mark must consist 'exclusively' of signs or indications which may serve to designate characteristics of the goods or services concerned, it does not require that those signs or indications should be the only way of designating such characteristics (see, by analogy, *Campina Melkunie*, paragraph 42, and *Koninklijke KPN Nederland*, paragraphs 57 and 101).
- 42 It follows from all the foregoing considerations that the word signs SnTEM, SnPUR and SnMIX may serve, within the meaning of Article 7(1)(c) of Regulation No 40/94, from the point of view of the targeted public, to designate essential characteristics of the goods falling within the categories covered by the applications for registration.

- 43 In consequence, the Board of Appeal did not infringe Article 7(1)(c) of Regulation 40/94 when it considered that the word signs SnTEM, SnPUR and SnMIX could not be registered as Community trade marks.
- 44 The applicant's first plea in law must therefore be rejected, without any need to hear the witness relied upon by the applicant.
- 45 With regard to the second plea in law, Article 7(1) of Regulation 40/94 makes it quite clear that it is sufficient that one of the absolute grounds for refusal listed in that provision applies for the sign at issue not to be registrable as a Community trade mark (Case C-104/00 P *DKV v OHIM* [2002] ECR I-7561, paragraph 29; Case T-331/99 *Mitsubishi HiTec Paper Bielefeld v OHIM (Giroform)* [2001] ECR II-433, paragraph 30, and Case T-348/02 *Quick v OHIM (Quick)* [2003] ECR II-5071, paragraph 37).
- 46 Furthermore, according to the case-law, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 7(1)(c) of Regulation No 40/94 is, on that account, necessarily devoid of any distinctive character in relation to those goods or services within the meaning of Article 7(1)(b) (see, by analogy, *Campina Melkunie*, paragraph 19, and *Koninklijke KPN Nederland*, paragraph 86).
- 47 In those circumstances, the applicant's second plea alleging infringement of Article 7(1)(b) of Regulation No 40/94 cannot be upheld.
- 48 In consequence the actions must be dismissed in their entirety.

Costs

- 49 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 Office's costs in accordance with the forms of order sought by the Office.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

- 1. Dismisses the actions in their entirety;**
- 2. Orders the applicant to pay the costs.**

Legal

Tiili

Vilaras

Delivered in open court in Luxembourg on 12 January 2005.

H. Jung

Registrar

H. Legal

President