

Case T-19/04

Metso Paper Automation Oy

v

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

(Community trade mark — Word mark PAPERLAB — Absolute ground for refusal of registration — Article 7(1)(c) of Regulation (EC) No 40/94 — Descriptive sign)

Judgment of the Court of First Instance (Fourth Chamber), 22 June 2005 . . II - 2386

Summary of the Judgment

- 1. Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Marks composed exclusively of signs or indications which may serve to designate the characteristics of goods — Word mark PAPERLAB (Council Regulation No 40/94, Art. 7(1)(c))*

2. *Community trade mark — Definition and acquisition of the Community trade mark — Assessment of the registrability of a sign — Account to be taken only of Community legislation — Earlier registration of the mark in certain Member States or third countries — Decisions not binding Community bodies*
(Council Regulation No 40/94; Council Directive 89/104)
3. *Community trade mark — Decisions of the Office — Lawfulness — Examination by the Community judicature — Criteria*
(Council Regulation No 40/94)

1. The word sign PAPERLAB, in respect of which registration is sought for 'computer equipment and measuring installations for surveying and testing of paper' in class 9 within the meaning of the Nice Agreement, may serve to designate, from the viewpoint of a public which consists of professionals and consumers experienced in the sector of computer equipment and measuring installations for surveying and testing of paper and has a command of English, the characteristics or functions of the goods referred to in the trade mark application, since that sign describes in English in a simple and straightforward manner the intended function of the goods for which registration of the mark is sought.

tively. Moreover, the 'paperlab' sign could also be perceived as denoting one of the technical characteristics of the goods in question, since this is a question of computer equipment and measuring installations which have been designed to work like a real mobile laboratory in order to obtain, on the spot, services usually performed in a laboratory.

(see paras 28, 30, 33)

The word sign PAPERLAB does not create an impression sufficiently removed from that produced by merely joining the words 'paper' and 'lab', which refer to paper and a laboratory respec-

2. The Community trade mark regime is an autonomous system with its own set of objectives and rules peculiar to it; it applies independently of any national system. The registrability of a sign as a Community trade mark must therefore be assessed by reference only to the relevant Community rules. The Office for Harmonisation in the Internal Market (Trade Marks and Designs) and, if

appropriate, the Community judicature are not bound by a decision given in a Member State, or a third country, that the sign in question is registrable as a national mark. That is so even if such a decision was adopted under national legislation harmonised with First Directive 89/104 on trade marks or in a country belonging to the linguistic area in which the word sign in question originated.

3. 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 registrability of a sign as a Community trade mark must be assessed only on the basis of the relevant Community legislation, as interpreted by the Community judicature, and not on the basis of a different approach taken in the past by the Boards of Appeal in their decisions.

(see para. 37)

(see para. 39)