

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fifth Chamber)

12 June 2007*

In Case T-190/05,

The Sherwin-Williams Company, established in Cleveland, Ohio (United States),
represented by E. Armijo Chávarri and A. Castán Pérez-Gómez, lawyers,

applicant,

v

Office for Harmonization in the Internal Market (Trade marks and Designs)
(OHIM), represented by Ó. Mondéjar, acting as Agent,

defendant,

ACTION brought against the decision of the Second Board of Appeal of OHIM of
22 February 2005 (Case R 755/2004-2), relating to registration of the sign
TWIST & POUR as a Community trade mark,

* Language of the case: Spanish.

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

composed of M. Vilaras, President, M.E. Martins Ribeiro and K. Jürimäe, Judges,

Registrar: B. Pastor, Deputy Registrar,

having regard to the application lodged at the Registry of the Court of First Instance on 9 May 2005,

having regard to the response lodged at the Court Registry on 11 August 2005,

further to the hearing on 18 January 2007,

gives the following

Judgment

Background to the dispute

- ¹ On 25 February 2003, the applicant filed an application for the registration of a Community trade mark at the Office for Harmonization 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), as amended.

- 2 The mark for which registration was sought is the word sign TWIST & POUR.
- 3 The goods in respect of which registration was applied for are in Class 21 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: 'Hand held plastic containers sold as an integral part of a liquid paint containing, storage and pouring device'.
- 4 By letter of 10 March 2004, the examiner informed the applicant that the trade mark was not eligible for registration because it did not comply with Article 7(1)(b) of Regulation No 40/94, stating, in particular, that the mark would not be seen as an indicator of origin. The examiner invited the applicant to submit observations within a period of two months.
- 5 By letter of 10 May 2004 the applicant replied, in essence, that the mark applied for was sufficiently original to be registered and to function as a trademark, that the mark had to be considered overall and that a number of other marks containing the word 'twist' had previously been registered by OHIM.
- 6 By decision of 23 June 2004, the examiner refused the application, on the ground that the Community trade mark applied for was covered by the ground for refusal set out in Article 7(1)(b) of Regulation No 40/94: first, the mark was composed of two English verbs which were restricted to informing consumers of the characteristics of the goods in question; secondly, the message conveyed by the

mark was simple, clear and direct; thirdly, no single undertaking could be given the right to monopolise the use of ordinary words or adaptations of such words which describe the goods; and fourthly, the other marks referred to by the applicant were not comparable to the mark at issue in this action.

- 7 On 30 August 2004, the applicant filed an appeal at OHIM, under Articles 57 to 62 of Regulation No 40/94, against the examiner's decision.
- 8 By decision of 22 February 2005 ('the contested decision'), notified on 28 February 2005, the Second Board of Appeal in essence decided that the message conveyed by the mark applied for was simple, clear and direct, in that the word mark TWIST & POUR simply informed consumers that, in order to remove paint from the container, all they had to do was twist the lid and pour the contents out. Such being the case, taking the view that the word mark TWIST & POUR was descriptive of the goods to be covered by the registration applied for, the Board of Appeal dismissed the appeal. The Board of Appeal also stated that the applicant's argument that the examiner took into consideration matters that were relevant to Article 7(1)(c) rather than to Article 7(1)(b) of Regulation No 40/94 was misconceived, since the two provisions overlap. Moreover, the Board of Appeal held that, in accordance with the case-law of the Court of Justice, and in particular with Case C-265/00 *Campina Melkunie* [2004] ECR I-1699, the examiner was entitled to decide that the mark applied for was devoid of distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94 because it was descriptive of certain characteristics of the goods in question. The Board of Appeal took the view that the fact that the examiner did not expressly mention Article 7(1)(c) of Regulation No 40/94 and that he did not expressly base his decision on that provision was not of major importance, bearing in mind that the applicant had been fully aware of the nature of the objection and had been able to submit its arguments on the alleged distinctiveness of the mark applied for. As to OHIM's lack of consistency because similar marks had been registered, the Board of Appeal pointed out that there were procedures for cancelling registrations granted in error and that what mattered was that its own decision should be consistent.

Forms of order sought

9 The applicant claims that the Court of First Instance should:

- declare the action to be admissible;
- annul the contested decision;
- order OHIM to pay the costs.

10 OHIM contends that the Court of First Instance should:

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

Law

11 In support of its action, the applicant submits a single plea in law alleging an infringement of Article 7(1)(b) of Regulation No 40/94.

Arguments of the parties

- 12 The applicant points out that, as is clear from the case-law, the prohibition prescribed in Article 7(1)(b) of Regulation No 40/94 refers to signs which are not suitable for performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, such as marks commonly used in connection with the marketing of the goods or services covered by the mark or those which could be so used (Case T-281/02 *Norma Lebensmittelfilialbetrieb v OHIM (Mehr für Ihr Geld)* [2004] ECR II-1915, paragraphs 24 and 33). A mark's distinctiveness should, in accordance with that case-law, be assessed, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the perception of the mark by the relevant public (*Mehr für Ihr Geld*, paragraph 26).
- 13 In this case, since the goods concerned are containers of liquid paint which are intended for consumers in general, the relevant public is the average, reasonably well-informed, and reasonably observant and circumspect consumer. Furthermore, since the word mark consists of two English words, the relevant public consists of the English-speaking public (Case T-219/00 *Ellos v OHIM (ELLOS)* [2002] ECR II-753, paragraphs 30 and 31).
- 14 The applicant also draws attention to the case-law according to which, first, each of the grounds for refusal to register is independent of the others and requires separate examination, so that those grounds for refusal must be interpreted in the light of the general interest which underlies each of them (Case C-329/02 P *SAT.1 v OHIM*

[2004] ECR I-8317). Secondly, since the mark is a compound mark composed of two words, its distinctiveness must be assessed by examining it as a whole (Case T-323/00 *SAT.1 v OHIM (SAT.2)* [2002] ECR II-2839).

- 15 The word mark TWIST & POUR is, according to the applicant, distinctive, and consequently the Board of Appeal's decision confirming the alleged unsuitability of the mark to perform a distinctive function, is inadequate, unfounded and insufficiently rigorous.
- 16 The applicant submits, first, that the Board of Appeal found that the mark applied for lacked distinctiveness on the basis of the supposed descriptive character of the mark, since the Board stated, in paragraph 11 of the contested decision, that the word mark TWIST & POUR simply informed consumers of the fact that, in order to extract paint from the container, consumers only had to turn the lid and pour out the contents. That idea is moreover repeated in paragraph 12 of the decision, where it is stated that the mark applied for conveys information about how to use the product.
- 17 That criterion is relevant to Article 7(1)(c) of Regulation No 40/94, but not to Article 7(1)(b). The decision of the Board of Appeal is therefore vitiated by an error in law, as the Court of Justice held in *SAT.1 v OHIM*, cited in paragraph 14 above, and in Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031.
- 18 Secondly, it is incorrect to claim that, since the Community trade mark applied for refers to a characteristic of the product concerned, it must therefore be considered to be descriptive. A distinction should be made between marks which are descriptive and those which are only allusive or evocative. The Court of First Instance has held

that, while descriptive indications cannot be protected as trade marks, that rule does not apply to indications or signs which are allusive or evocative (Case T-135/99 *Taurus-Film v OHIM (Cine Action)* [2001] ECR II-379, and Case T-360/00 *Dart Industries v OHIM (UltraPlus)* [2002] ECR II-3867).

- 19 According to the applicant, there is no precise point beyond which an expression falls suddenly from one category into the other, rather there is a variable scale between two extremes — going from signs which are not descriptive, registration of which is possible, to signs which are purely descriptive, registration of which is impossible — and on that scale signs and their descriptiveness, evocativeness or allusiveness vary or are located in accordance with their intrinsic characteristics. In principle, the assessment of distinctive character depends, in part, on the subjective assessment of the examiner and, on appeal, on that of the Board of Appeal.
- 20 Advocate General Jacobs, in points 62 to 64 of his Opinion in Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, set out the appropriate objective criteria which allow descriptive marks to be differentiated from those which are merely evocative.
- 21 According to the applicant, if the word mark TWIST & POUR were to be judged against those criteria, it would be clear that this mark is far from the end of the scale where descriptive signs are located.
- 22 First, the word mark TWIST & POUR consists of a combination of two verbs which, individually or together, do not describe either the goods covered or any of the characteristics of the goods. The two verbs refer to actions which are not objectively identifiable with plastic paint containers.

- 23 Secondly, the relevant public will not perceive the word mark TWIST & POUR immediately, directly and without further reflection as an indication of a characteristic of the goods which it covers. According to the applicant, the relevant consumer who sees the sign will not automatically associate it with plastic paint containers.
- 24 Lastly, the word mark TWIST & POUR is said not to describe an essential or dominant characteristic of the product which is capable of having any particular significance when consumers come to choose products of that kind as against those offered by competitors. The reference to the manner of opening the product covered by the mark applied for does not contribute any substantial value to the product concerned.
- 25 Contrary to the impression given in paragraph 12 of the contested decision, the applicant states that it is not applying for registration of the sign EASY-TO-OPEN or EASY-TO-POUR, but the mark TWIST & POUR. Consequently, the argument to the effect that English-speaking consumers will interpret this mark as a message that ‘all they have to do is twist the lid and pour the contents out’ is misleading, since the word mark is autonomous and independent of the goods concerned. Further, it is incorrect to claim that the mark concerned conveys a message about the ease of use of the product which it covers (see, to that effect, *UltraPlus*, cited in paragraph 18 above, paragraph 52). The applicant considers therefore that the English-speaking public, faced with the sign, will very probably perceive it as fanciful and will not automatically and immediately think of plastic paint containers. Only subsequently will the public concerned think of the functioning of the product referred to, namely of the means of opening it. However, understanding how it works is not the result of automatic, unreflecting and direct perception, but rather derives from a prior cognitive process or effort on the part of the consumer which makes that perception mediated and indirect, and accordingly not descriptive.

- 26 Registration of a sign which refers in an indirect way or by evocation or suggestion to a characteristic of the product covered should not be refused. Such a refusal is contrary to the intention of the legislature, as expressed in Article 7(1)(c) of Regulation No 40/94 and the case-law referred to in paragraph 18 above.
- 27 Further, the criterion applied in the contested decision does not lead to an analysis of the distinctive character of the mark applied for which is 'a priori ... and without reference to any actual use of the sign' (Case T-88/00 *Mag Instrument v OHIM (Torch Shape)* [2002] ECR II-467, paragraph 34). The applicant notes, on that point, that the question whether, in a particular case, the manner in which the sign is used or is displayed on the goods, as a trade mark or for some other purpose, might cause the consumer not to perceive the sign as a distinctive sign of origin, but as mere marketing information, cannot be taken into account in the context of assessment of its registrability (*UltraPlus*, cited in paragraph 18 above, paragraph 52).
- 28 Thirdly, the applicant considers that the word mark TWIST & POUR has the minimal intrinsic capacity necessary to enable the relevant public to perceive it as indicating the commercial origin of the goods covered, since for the purposes of Article 7(1)(b) of Regulation No 40/94 registration can be obtained if the mark concerned is shown to have a minimum degree of distinctive character. This holds true for the word mark at issue, which is concise, direct and easily remembered by the relevant public.
- 29 Further, what is at issue is an original word mark which is composed of two English words the particularity of which lies in the effect produced by the juxtaposition of

the verbs 'twist' and 'pour'. The integration of those two words within a single sign has a certain effect of surprise on consumers, capturing and retaining, or at least being capable of retaining, their attention. The sign makes up a trade mark which is sufficiently different from that produced by the mere putting together of the two words it consists of.

30 The applicant points out that it demonstrated, in the proceedings before OHIM, that the verb 'twist' was frequently used in compound marks and that consumers were familiar with marks built upon that verb. Other signs suitable for distinguishing goods had moreover been registered by OHIM, inter alia TWIST & VAC, TWIST & DRINK, TWISTER TESTER, TWISTED TUBE and TWISTED DIPS. In that regard, the applicant infers from *SAT.1 v OHIM*, cited in paragraph 14 above, that the frequent use of trade marks consisting of words and associated grammatical constructions indicates that that type of combination cannot be considered to be devoid of distinctive character.

31 The fact that the mark applied for is composed of ordinary words, which are comprehensible to consumers, does not affect the mark's distinctive character. The Court of First Instance has held on this point that the mere fact that each of the components of the sign, considered separately, is devoid of distinctive character does not mean that in combination they cannot present a distinctive character. The onus was, to the contrary, on the Board of Appeal to show that the sign concerned, taken as a whole, did not enable the targeted public to distinguish the applicant's goods from those having a different commercial origin (Case T-260/03 *Celltech v OHIM (CELLTECH)* [2005] ECR II-1215, paragraphs 43 and 44). According to the applicant, it is not necessary for the sign applied for to convey any exact information as to the identity of the company which is marketing the product, rather it is sufficient for the mark in question to enable the relevant public to distinguish the goods covered by it from those which have a different commercial origin (Case T-173/00 *KWS Saat v OHIM (Shade of orange)* [2002] ECR II-3843, paragraph 44).

32 OHIM points out, first, that, according to the case-law, there is some degree of overlap between the ground for refusal relating to the absence of distinctive character and that which prevents the registration of marks which are purely descriptive. A sign which merely describes the characteristics of the goods or services is, similarly, incapable of performing the essential function of a trade mark and is simultaneously covered by both grounds of refusal (*Campina Melkunie*, cited in paragraph 8 above). Further, signs which are devoid of distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94 are incapable of performing the essential function of the trade mark, namely identifying the commercial origin of the goods or services (*UltraPlus*, cited in paragraph 18 above, paragraph 52). Lastly, marks referred to in Article 7(1)(b) are those which, from the point of view of the relevant public, are commonly used in trade for the presentation of the goods or services concerned or in connection with which there exists, at the very least, concrete evidence justifying the conclusion that they are capable of being used in that manner.

33 In the present case, OHIM contends that the goods concerned are tins of liquid paint, so that the relevant public is the average, reasonably well informed and reasonably observant and circumspect consumer. 'TWIST & POUR' is a concise expression the meaning of which is directly intelligible to everyone and it has no unusual characteristic. Its syntax is straightforward and normal in English, in particular for conveying information in the simplest and most direct way possible about two actions which must be performed consecutively in order to achieve the given objective. In association with the goods concerned, the immediate reaction of the relevant public will be to perceive the sign as a message as to method of use. Paint tins must first be opened before their contents can be used. It is sometimes necessary to shake them or to transfer the contents into another container before use. It is not uncommon for paint tins to be difficult to open and necessitating some sort of lever. It follows that 'TWIST & POUR' will produce no reaction in the mind of the relevant consumer other than immediately providing them with information as to how to use the tins, but not relating to the company which manufactures them.

34 OHIM adds that that conclusion does not, contrary to what is claimed by the applicant, rest on an assessment of the actual use of the mark in the market. More specifically, the conclusion that the sign is one which is devoid of distinctive character does not depend on the precise part of the product on which the mark is displayed or on the size of the letters in which it is printed on the surface of the tin. The Board of Appeal correctly decided, in principle, (Case T-360/03 *Frischpack v OHIM (Shape of a cheese box)* [2004] ECR II-4097, paragraph 29) that 'TWIST & POUR' will be perceived as instructions on the use of the goods, rather than as a sign capable of performing the essential function of a trade mark. That analysis is based on the way that consumers could reasonably be expected to perceive the sign, taking into account its characteristics as such and the characteristics of the goods concerned and leaving entirely out of consideration the actual ways that that mark is in fact used in the market.

35 OHIM contends that the applicant's premiss is false when it argues that the Board of Appeal has erred in law in inferring that the mark applied for lacks distinctiveness because it is descriptive. In fact, the Board of Appeal stated that it could not find any distinctive character in the expression TWIST & POUR, because relevant consumers would perceive the sign as an instruction linked to use of the goods, which accordingly prevents the sign being perceived at the same time as distinctive. The relevant public will therefore see in that expression a generic declaration of certain qualities of the goods. Because of that false premiss, the applicant commits the error of then analysing the descriptive character of the sign with regard to the goods concerned and concludes that, in the absence of such descriptive character, the sign is one which is distinctive and therefore capable of registration. On that point, OHIM states that the Board of Appeal based its decision on Article 7(1)(b) of Regulation No 40/94 and held that the fact that the examiner did not in his decision expressly mention Article 7(1)(c) was not of major importance, since the reasons for the refusal of the application were clearly set out.

36 OHIM adds that in the present case the Board of Appeal did not, in declaring that the mark applied for had no distinctive character, restrict itself to the argument that it was descriptive, but relied on a wider consideration, namely the fact that the word mark TWIST & POUR solely provided information on the characteristics of the goods, and consequently the relevant public was not able to see the mark as a sign which was distinctive. Accordingly, it was an interpretation which combines those two arguments that led the Board of Appeal to conclude that the mark applied for fell under the prohibition set out in Article 7(1)(b) of Regulation No 40/94. Since the first impression left by the mark applied for on the minds of consumers is that of an indication as to how to use the goods, OHIM infers that consumers would not see in this sign a means of identifying the origin of those goods and a means of distinguishing them from other goods. Further, the assessment carried out by the Board of Appeal is identical to that carried out by the Court of First Instance in various judgments in which it found various expressions to lack distinctive character (Case T-79/00 *Rewe-Zentral v OHIM (LITE)* [2002] ECR II-705, and Case T-270/02 *MLP Finanzdienstleistungen v OHIM (bestpartner)* [2004] ECR II-2837).

Findings of the Court

37 Article 7(1)(b) of Regulation No 40/94 provides that ‘trade marks which are devoid of any distinctive character’ are not to be registered and Article 7(1)(c) of that Regulation provides that ‘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’ are not to be registered. Article 7(2) of Regulation No 40/94 states in addition that ‘Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community’.

- 38 Each of the grounds for refusal to register listed in Article 7(1) of Regulation No 40/94 is independent of the others and calls for separate examination. Furthermore, the various grounds for refusal must be interpreted in the light of the general interest underlying each of them. The general interest taken into consideration when examining each of those grounds for refusal may, or even must, reflect different considerations, according to 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, *SAT.1 v OHIM*, cited in paragraph 14 above, paragraph 25, and Case C-37/03 P *BioID v OHIM* [2005] ECR I-7975, paragraph 59).
- 39 However, there is a clear overlap between the scope of the grounds for refusal set out in Article 7(1)(b) to (d) (see, by analogy, Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraphs 67 and 85, and *Campina Melkunie*, cited in paragraph 8 above, paragraph 18). In particular, it is clear from the case-law that a word mark which is descriptive of characteristics of goods or services within the meaning of Article 7(1)(c) of Regulation No 40/94 is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 7(1)(b) of the regulation. A mark can however be devoid of distinctive character for reasons other than its possible descriptive character (Case T-289/02 *Telepharmacy Solutions v OHIM (TELEPHARMACY SOLUTIONS)* [2004] ECR II-2851, paragraph 24; see also, to that effect, *bestpartner*, cited in paragraph 36 above, paragraph 25; see also, by analogy, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, cited in paragraph 8 above, paragraph 19).
- 40 In a case such as the present, where, by the contested decision, registration of the mark applied for is refused by reason of the absolute ground for refusal in Article 7(1)(b) of Regulation No 40/94, it is appropriate to examine whether OHIM has demonstrated that that mark was devoid of distinctive character.

- 41 On that point, it is useful to recall that the signs referred to in Article 7(1)(b) of Regulation No 40/94 are signs which are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (*LITE*, cited in paragraph 36 above, paragraph 26). That applies to, inter alia, signs which are commonly used in connection with the marketing of the goods or services concerned (Case T-122/01 *Best Buy Concepts v OHIM (BEST BUY)* [2003] ECR II-2235, paragraph 20, and *Mehr für Ihr Geld*, cited in paragraph 12 above, paragraph 24).
- 42 Moreover, the public interest underlying Article 7(1)(b) of the regulation is, manifestly, indissociable from the essential function of a trade mark which is to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (*SAT.1 v OHIM*, cited in paragraph 14 above, paragraphs 23 and 27, and *BioID v OHIM*, cited in paragraph 38 above, paragraph 60).
- 43 As regards a mark composed of words and a typographical sign, such as the mark which is the subject of these proceedings, the distinctiveness of each of its terms or elements, taken separately, may be assessed, in part, but must in any event depend on an appraisal of the composite whole. Indeed, the mere fact that each of those elements, considered separately, is devoid of distinctive character does not mean that in combination they cannot present a distinctive character (*SAT.1 v OHIM*, cited in paragraph 14 above, paragraph 28; see also, by analogy, *Campina Melkunie*, cited in paragraph 8 above, paragraphs 40 and 41, and *Koninklijke KPN Nederland*, cited in paragraph 39 above, paragraphs 99 and 100).

- 44 In accordance with settled case-law, the distinctiveness of a mark must be assessed, first, in relation to the goods or services for which registration of the sign has been requested and, second, in relation to the perception which the relevant public has of it (*LITE*, cited in paragraph 36 above, paragraph 27; *BEST BUY*, cited in paragraph 41 above, paragraph 22, and *Mehr für Ihr Geld*, cited in paragraph 12 above, paragraph 26).
- 45 In the present case, as was stated by the Board of Appeal and as was not contested by the applicant, since the goods covered by the mark applied for are pots of paint intended for all consumers, the public targeted is deemed to be the average, reasonably well informed and reasonably observant and circumspect consumer.
- 46 Further, in accordance with Article 7(2) of Regulation No 40/94, the targeted public by reference to whom the absolute ground of refusal must be assessed is an English-speaking public, since the word mark at issue is composed of elements coming from the English language, and this again is not contested by the applicant (see, to that effect, *ELLOS*, cited in paragraph 13 above, paragraph 31; Case T-295/01 *Nordmilch v OHIM (OLDENBURGER)* [2003] ECR II-4365, paragraph 35, and *Mehr für Ihr Geld*, cited in paragraph 12 above, paragraph 27).
- 47 Secondly, it is clear from paragraph 14 of the contested decision that the Board of Appeal considered that the sign for which registration was sought had no distinctive character since, in the market concerned, it could be understood only as a mere indication of a particular characteristic of the product, namely its method of use, and not as an indication of the commercial origin of the product. Accordingly, the Board of Appeal in essence considered that the word mark TWIST & POUR was not distinctive within the meaning of Article 7(1)(b) of Regulation No 40/94 on the ground that it would be perceived by the relevant public as being descriptive of the goods in question.

- 48 What has to be determined therefore is whether the association established by the Board of Appeal between the semantic content of the sign for which registration was sought, on the one hand, and the goods in question, on the other, is sufficiently concrete and direct to prove that that sign enables the relevant public to identify those goods immediately (see, to that effect, Case T-359/99 *DKV v OHIM (EuroHealth)* [2001] ECR II-1645, paragraphs 35 and 36).
- 49 The sign consists of two English words 'twist' and 'pour', which, as stated by the Board of Appeal in paragraph 12 of the contested decision, convey information about how to use the product. This has not, moreover, been challenged by the applicant.
- 50 The Board of Appeal further stated, at paragraph 12 of the contested decision, that the use of '&', meaning 'and', does not add anything in terms of the distinctiveness of the sign, since use of that typographical sign is commonplace in the English language.
- 51 Therefore, as OHIM has argued, the syntactic structure of the word mark TWIST & POUR must be regarded as straightforward and normal in the English language. It follows that the structure of that sign and the bringing together of the two words by linking them by means of the typographical sign '&' are not, as a whole, so perceptibly different from terms used in the ordinary language of the relevant public as to confer on the sign a distinctive character within the meaning of Case C-383/99 P *Procter & Gamble v OHIM* [2001] ECR I-6251, paragraph 40).

- 52 Consequently the Board of Appeal rightly held that the expression, taken as a whole, signified 'twist and pour', or, in other words, 'turn and pour'.
- 53 As regards the relationship between the semantic content of the sign TWIST & POUR and the goods concerned, it must be held that the Board of Appeal also rightly determined, at paragraph 11 of the contested decision, that the sign was composed of generic terms which merely designated a characteristic of the product, concerning in particular its method of use (see, to that effect, Case T-19/99 *DKV v OHIM (COMPANYLINE)* [2000] ECR II-1, paragraphs 26 and 27, confirmed on appeal in Case C-104/00 P *DKV v OHIM* [2002] ECR I-7561, and *bestpartner*, cited in paragraph 36 above, paragraph 24).
- 54 Taken as a whole, the word mark directly describes the action in particular of opening a container with a cap which has to be turned before the liquid contents can be poured. The words brought together in this way are accordingly limited to describing a characteristic of the product concerned, that is, its ease of use, in particular in relation to paint which normally, before it can be applied, has first to be stirred or its container shaken before its contents can be poured into another container. The use of the terms 'twist' and 'pour' therefore highlights a particularly important characteristic of the product concerned, namely its extremely straightforward method of use. As the Board of Appeal rightly stated, '[i]t would be difficult to think of a clearer, more direct way of telling consumers that all they have to do is twist the lid and pour the contents than by printing the words TWIST AND POUR on the side of the box'.
- 55 It follows from all of the foregoing that the word mark TWIST & POUR does not, contrary to the applicant's claim, merely evoke or allude to certain characteristics of

the product, but, on the contrary, directly describes a characteristic of the product concerned. The fact that the relevant public is directly informed of the ease of use of the product constitutes a sufficiently concrete and direct link between the mark applied for and the goods concerned.

56 At the hearing, the applicant stated that the word mark TWIST & POUR only described an incidental characteristic of the product concerned, and accordingly registration ought to have been authorised.

57 In that connection, it suffices to point out that the Court of Justice has already held that a word mark which is descriptive of characteristics of goods or services is, on that account, necessarily devoid of distinctive character and that it is irrelevant whether the characteristics of the goods or services which can be described are commercially essential or are incidental (see, by analogy, *Koninklijke KPN Nederland*, cited in paragraph 39 above, paragraphs 86 and 102).

58 The applicant also claims, first, that the Board of Appeal erred in inferring from its alleged descriptive character that the mark applied for lacked distinctiveness.

59 On that point, it should be noted, first, that, while it is correct that each of the grounds for refusal referred to in Article 3(1) of the 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) is independent of the others and requires separate examination, none the less, as was stated in paragraph 39 above, there is a clear overlap between the scope of the grounds for refusal set out under (b) to (d). Secondly, as has also already been stated in paragraph 39 above, a word mark which is descriptive of characteristics of goods or services is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services.

60 The applicant then complains that the Board of Appeal used a criterion, namely the public interest objective that signs may be freely used by all, which is relevant in the context of Article 7(1)(c) but not in that of Article 7(1)(b).

61 On that point, it is certainly true, as the Court of Justice has held in paragraph 36 of *SAT.1 v OHIM*, cited in paragraph 14 above, that Article 7(1)(b) of Regulation No 40/94 does not pursue an aim in the public interest to the effect that signs can be freely used by all.

62 It is clear from paragraph 26 of *SAT.1 v OHIM*, cited in paragraph 14 above, that the public interest underlying Article 3(1)(b) of Directive 89/104/EEC, a provision the scope of which is identical to that of Article 7(1)(b) of Regulation No 40/94, derives from the need not to restrict unduly the availability of elements which are devoid of distinctive character making up the sign at issue to other operators offering for sale goods or services of the same type as those in respect of which registration is sought.

- 63 The Board of Appeal held, in paragraph 13 of the contested decision, that registration of the word mark TWIST & POUR should not be authorised since it ‘belongs to a category of signs whose availability for other trades should not be unduly restricted’.
- 64 It must therefore be held that, in so ruling, the Board of Appeal applied the appropriate criterion against which Article 7(1)(b) should be interpreted and accordingly no objection can be taken on that point.
- 65 To address, finally, the applicant’s argument that OHIM has registered similar marks such as TWIST & VAC, TWIST & DRINK, TWISTER TESTER, TWISTED TUBE and TWISTED DIPS, it must be held that, even on the supposition that the relationship between those marks and the goods for which they were registered was closer than that between the sign TWIST & POUR and the goods in respect of which its registration is sought, it in no way follows that a uniform application of Regulation No 40/94 requires that that sign be registered for the goods concerned. It must be pointed out that, in accordance with settled case-law, 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 solely on the basis of that regulation, as interpreted by the Community judicature, and not on the basis of a previous practice of the Boards of Appeal (*BioID v OHIM*, cited in paragraph 38 above, paragraph 47; Case T-36/01 *Glaverbel v OHIM (Surface of a sheet of glass)* [2002] ECR II-3887, paragraph 35; Joined Cases T-79/01 and T-86/01 *Bosch v OHIM (Kit Pro and Kit Super Pro)* [2002] ECR II-4881, paragraph 32; Case T-346/04 *Sadas v OHIM — LTJ Diffusion (ARTHUR ET FELICIE)* [2005] ECR II-4891, paragraph 71).

66 In the light of all of the foregoing, it must be held that the Board of Appeal rightly decided that the mark TWIST & POUR was devoid of distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94, and accordingly the sole plea in law cannot be upheld.

67 It follows from all of the foregoing that the appeal must be dismissed.

Costs

68 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 asked 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 OHIM.

On those grounds,

THE COURT OF FIRST INSTANCE (Fifth Chamber)

hereby:

1. Dismisses the action;

2. Orders the Sherwin-Williams Company to pay the costs.

Vilaras

Martins Ribeiro

Jürimäe

Delivered in open court in Luxembourg on 12 June 2007.

E. Coulon

Registrar

M. Vilaras

President