

JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)
30 November 2004^{*}

In Case T-173/03,

Anne Geddes, residing at Auckland (New Zealand), represented by G. Farrington,
Solicitor;

applicant,

v

**Office for Harmonisation in the Internal Market (Trade Marks and Designs)
(OHIM)**, represented by E. Dijkema and A. Folliard-Monguiral, acting as Agents,

defendant,

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 13 February 2003 (Case R 839/2001-4) regarding an application for registration of the Community word mark 'NURSERYROOM',

^{*} Language of the case: English.

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

composed of: J. Pirrung, President, N.J. Forwood and S. Papasavvas, Judges,
Registrar: J. Plingers, Administrator,

having regard to the application lodged at the Court Registry on 19 May 2003,

having regard to the response lodged at the Court Registry on 8 August 2003,

further to the hearing on 22 September 2004,

gives the following

Judgment

Background to the dispute

- ¹ On 21 September 2000, the applicant filed an application 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 mark in respect of which registration was sought is the word sign 'NURSERYROOM'.

3 The products in respect of which registration of the trade mark was sought are in the following classes 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:

— Class 16: 'books, stationery, cards';

— Class 18: 'diaper bags';

— Class 21: 'plates and cups';

— Class 25: 'hats, booties, baby clothing, shoes, layettes';

— Class 28: 'plush toys, mobiles'.

4 By decision of 26 July 2001, the examiner, relying on Article 7(1)(b) and (c) of Regulation No 40/94, rejected the application in accordance with Article 38 thereof, on the ground that the mark applied for is descriptive of the intended purpose of the goods covered.

- 5 On 19 September 2001, the applicant filed a notice of appeal at OHIM against the examiner's decision.
- 6 By decision of 13 February 2003 (Case R 839/2001-4, hereinafter 'the contested decision'), the Fourth Board of Appeal dismissed the appeal on the ground that the mark applied for is descriptive of the intended purpose of the goods covered and the segment of population for which they are intended, contrary to 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 case to be remitted to the examiner.
- 8 OHIM contends that the Court should:
- dismiss the application;
 - order the applicant to pay the costs.

Law

Arguments of the parties

- 9 According to the applicant, the Board of Appeal infringed Article 7(1)(c) of Regulation 40/94 in holding that the sign applied for designated the intended purpose of the goods covered, or, alternatively, that it designated a characteristic of the goods, namely that they were for use in a nursery room.
- 10 A simple analysis of the words 'nursery' and 'room' making up the mark applied for shows that that mark, considered in its entirety, contains no direct reference to the goods in question, does not connote their purpose and does not necessarily mean that they are for use in a nursery room. The term 'nurseryroom' has no unequivocal meaning. At most it might suggest that those goods were suitable for young children. The term is clearly a suggestive term rather than a descriptive one. The mark applied for has a distinctive character separate and apart from the nature of the goods.
- 11 The applicant takes the view that the Board of Appeal failed to take sufficient account of the issues raised by her.
- 12 OHIM pleads that, in the ground of challenge set out in the preceding paragraph, the applicant is merely putting in issue the Board of Appeal's assessment of the merits of the appeal before it. Should the Court interpret it as a plea in law alleging infringement of Article 73 of Regulation No 40/94, OHIM submits that the contested decision was properly reasoned.

- 13 OHIM takes the view that the applicant is mistaken in identifying in the contested decision two separate reasons justifying the application of Article 7(1)(c) of Regulation No 40/94.
- 14 OHIM argues that the words comprising the sign 'NURSERYROOM' permit the relevant public to perceive, without any further reflection, the intended purpose of those goods. The combination of those words is frequently used to designate unequivocally a room for use by children. It is indisputable that some of the goods in question are specifically intended for babies or young children and that, for the other goods, the applicant did not exclude that use. According to OHIM, there is nothing arbitrary or inventive about the term 'nurseryroom'. Its structure follows the normal grammatical rules and the mere coupling of the words is not sufficient to render the term non-descriptive. OHIM takes the view that the implicit designation of the end users of the goods in question, namely babies and young children, is an essential characteristic of the goods. That consideration explains why the goods, although of a different nature, are sold in the same place. The term 'nurseryroom' therefore becomes crucial when deciding whether to purchase the goods. At the hearing, OHIM submitted that the refusal to register the mark sought was all the more justified since the Court, in its judgment of 12 February 2004 in Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 102, held that it did not matter that the characteristic described by the mark is commercially essential.
- 15 OHIM submits that the applicant's second head of claim is inadmissible because it is not for the Court of First Instance to issue it with directions.

Findings of the Court

- 16 Article 7(1)(c) of Regulation No 40/94 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.

- 17 A trade mark's distinctiveness must be assessed, first, by reference to the goods and services for which registration is sought and, second, by reference to the relevant public's perception.
- 18 In this case, the Board of Appeal did not expressly define the relevant public in the contested decision. However, the mark sought is made up of English words, examined in that language by the Board of Appeal, and in the absence of any other suggestion by the applicant in that regard, it must be held that the Board of Appeal impliedly but certainly found the relevant public to be average English-speaking consumers.
- 19 According to the Court's judgment of 23 October 2003 in Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, a word sign must be refused registration, under Article 7(1)(c) of Regulation No 40/94, if at least one of its possible meanings designates a characteristic of the goods or services concerned (paragraph 32).
- 20 It must therefore be determined whether there is, for the relevant public, a direct and specific relationship between the word sign in question and the products covered (see, most recently, the judgment of 20 July 2004 in Case T-311/02 *Lissotschenko and Hentze v OHIM (LIMO)* [2004] ECR II-2957, paragraph 30, and the case-law cited therein).

- 21 It is not disputed that the words ‘nursery room’ designate a place for use by babies or young children. It must be held, moreover, that the sign in question, in coupling those two words in the grammatically correct order in English, does not create an impression sufficiently removed from that produced by the mere juxtaposition of the words to change their meaning or scope (see, by analogy, *Koninklijke KPN Nederland*, cited in paragraph 14 above, paragraphs 98 and 99).
- 22 Of the goods covered, some are exclusively for babies or young children. Thus it is for diaper bags, booties, baby clothing, layettes and soft toys. As regards the other goods, namely books, stationery, cards, plates, cups, hats, shoes and mobiles, all those categories of goods include those which, because of their shape, their size, or their look, are specifically intended for use by babies or young children.
- 23 Admittedly, the immediate meaning of the sign in question designates a place in which that category of persons may be. However, that meaning must be analysed in relation to the goods covered in the trade mark application (see paragraph 17 above). In that perspective, the word sign in question is perfectly appropriate to designate goods capable of being used in a nursery and, therefore, for use by babies or young children. Since the goods in question are all capable of being intended, exclusively or potentially, for those users, the relevant public will easily establish a direct and specific link between the sign and the goods in question. The fact, relied upon by the applicant, that the goods covered can obviously be used outside a nursery does not undermine that conclusion, since, for the average consumer, that possibility does not affect his understanding of the intended purpose of the goods in question.
- 24 It must also be said that the applicant’s arguments, that the Board of Appeal ‘failed to take sufficient account of the issues raised by her’ and that there are two different reasons in the contested decision, are not specifically evidenced either in law or in

fact. They cannot, therefore, be regarded as independent grounds of appeal and therefore cannot change that conclusion.

25 It follows from the foregoing that the Board of Appeal correctly held that the sign in question is descriptive of the intended purpose of the goods, and, by extension, of the category of end users, namely babies and young children (paragraph 10 of the contested decision).

26 Consequently, the applicant's single plea in law alleging infringement of Article 7(1)(c) of Regulation No 40/94 must be rejected.

27 Accordingly, the applicant's claim for an order that the case be remitted to the examiner must also be rejected.

28 The action must therefore be dismissed in its entirety.

Costs

29 Under Article 87(2) of the Rules of Procedure, 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 and OHIM has asked for costs, the applicant must be ordered to pay the costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby:

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

Pirrung

Forwood

Papasavvas

Delivered in open court in Luxembourg on 30 November 2004.

H. Jung

Registrar

J. Pirrung

President