

Case T-91/01

BioID AG

v

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

(Community trade mark — Figurative mark containing the abbreviation
BioID — Absolute grounds for refusal — Article 7(1)(b)
of Regulation (EC) No 40/94)

Judgment of the Court of First Instance (Second Chamber), 5 December
2002 II-5161

Summary of the Judgment

1. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Marks devoid of any distinctive character — Examination in the case of a compound mark — Need to examine each of the elements independently of their relative importance*
(Council Regulation No 40/94, Art. 7(1)(b))

2. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Marks devoid of any distinctive character — Figurative abbreviation ‘BioID’*
(Council Regulation No 40/94, Art. 7(1)(b))

1. The absence of distinctive character, within the meaning of Article 7(1)(b) of Regulation No 40/94 on the Community trade mark, of a compound mark — that is to say, a mark composed of several elements — cannot be determined solely by reference to the relative importance of certain elements of which it is composed as compared with that of other elements of the mark, in respect of which an absence of distinctive character has been established. A compound mark cannot fall under the abovementioned article if one of its composite elements is distinctive in respect of the goods and services concerned. That is true even if the sole distinctive element of the compound mark is not dominant in relation to the other composite elements of the mark.
2. According to Article 7(1)(b) of Regulation No 40/94 on the Community trade mark, ‘trade marks which are devoid of any distinctive character’ are not to be registered. As regards registration of the figurative mark containing the abbreviation ‘BioID’, which was applied for in respect of goods and services in Classes 9, 38 and 42 of the Nice Agreement, including goods the use of which is required for the biometric identification of live organisms and services provided by means of such identification, that mark is devoid of distinctive character in so far as it is composed of a combination of elements each of which is likely to be used, in trade, to present the goods and services claimed and is therefore devoid of distinctive character in respect of those goods and services.

Accordingly, the distinctive character of a compound mark must be assessed in the light of all the elements of which it is composed.

(see para. 36)

(see paras 22, 30-31, 41)