

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)

11 December 2001 *

In Case T-138/00,

Erpo Möbelwerk GmbH, established in Ertingen (Germany), represented by S. von Petersdorff-Campen, lawyer, with an address for service in Luxembourg,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by F. López de Rego and G. Schneider, acting as Agents, with an address for service in Luxembourg,

defendant,

ACTION brought against the decision of the Third Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of

* Language of the case: German.

23 March 2000 (Case R 392/1999-3) concerning the registration of 'DAS PRINZIP DER BEQUEMLICHKEIT' as a Community trade mark,

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

composed of: P. Mengozzi, President, V. Tiili and R.M. Moura Ramos, Judges,

Registrar: J. Palacio González, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 23 May 2000,

having regard to the response lodged at the Registry of the Court of First Instance on 15 September 2000,

having regard to the documents lodged by the applicant after the end of the written procedure, on which the defendant had the opportunity to take a view at the hearing of 15 March 2001,

further to that hearing,

gives the following

Judgment

Background to the dispute

- 1 On 23 April 1998, the applicant filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('the Office') 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 was 'DAS PRINZIP DER BEQUEMLICHKEIT'.
- 3 The goods in respect of which the registration of the mark was sought come within Classes 8, 12 and 20 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, for each of those classes, to the following description:

— Class 8: 'Tools (hand-operated); cutlery',

- Class 12: ‘Land vehicles and parts therefor’,

- Class 20: ‘Household furniture, in particular upholstered furniture, seating, chairs, tables, unit furniture, as well as office furniture’.

4 By decision of 4 June 1999, the examiner refused the application under Article 38 of Regulation No 40/94 on the ground that the word combination in respect of which registration was sought designated a characteristic of the goods concerned and was devoid of any distinctive character.

5 On 7 July 1999, the applicant filed at the Office notice of appeal against the examiner’s decision, under Article 59 of Regulation No 40/94.

6 On 4 October 1999, the appeal was submitted to the examiner for interlocutory revision pursuant to Article 60 of Regulation No 40/94.

7 On 4 November 1999, the appeal was remitted to the Board of Appeal.

- 8 By decision of 23 March 2000 ('the contested decision'), the Third Board of Appeal annulled the examiner's decision in so far as the examiner had refused the application in respect of the goods in Class 8. As to the remainder, the Board of Appeal dismissed the appeal.
- 9 As regards the goods in Classes 12 and 20, the Board of Appeal essentially held that the word combination at issue was caught by Article 7(1)(b) and (c) and (2) of Regulation No 40/94.

Forms of order sought

- 10 The applicant claims that the Court should:

- annul the contested decision;

- order the Office to pay the costs.

- 11 The Office contends that the Court should:

- dismiss the action;

— order the applicant to pay the costs.

Law

- 12 The applicant relies on three pleas in law, alleging infringement of Article 7(1)(c) and of Article 7(1)(b) of Regulation No 40/94 and failure to take into account prior national registrations.

Infringement of Article 7(1)(c) of Regulation No 40/94

Arguments of the parties

- 13 The applicant asserts that the mark applied for is not in the nature of a specifically descriptive indication.
- 14 Moreover, the applicant submits that the refusal to register a Community trade mark on the basis of Article 7(1)(c) of Regulation No 40/94 is dependent on there being a specific 'need for availability'.

- 15 It asserts that, in this case, instead of demonstrating that the mark applied for is specifically used to describe the goods concerned or that there is a specific need to use it for that purpose, the Office merely presumed that there was a need for availability. According to the applicant, that argument also applies in respect of the word combination 'das Prinzip der...' ('the principle of...') on its own, linked to the indication of a characteristic.
- 16 Furthermore, the applicant states that the Board of Appeal did not take into account Article 12(b) of Regulation No 40/94 although the mark applied for must, in any event, be registered in the light of that provision. In that regard, the applicant claims that, if the mark at issue were registered, its competitors would retain the right under that provision to refer to the comfortable nature of their products by using indications or advertising messages to that effect.
- 17 In addition, the applicant relies on decisions of the boards of appeal which approved the registration of the word marks BLOODSTREAM (in respect of medical apparatus intended for use in connection with blood circulation in the human body; Case R 33/1998-2), TRANSEUROPA (in respect of travel services; Case R 125/1998-3) and ALLTRAVEL (also in respect of travel services; Case R 185/1998-3). It asserts that, in the contested decision, stricter criteria were applied than in the case of other word signs.
- 18 The Office submits that the word combination at issue is understood, by the class of persons targeted, immediately and without particular efforts of analysis, as meaning that the goods concerned have been designed in accordance with the rules and principles of comfort.

- 19 According to the Office, comfort constitutes, as much for the products in Class 12 (land vehicles and parts therefor) as for those in Class 20 (household and office furniture), an essential element in the decision to purchase.

- 20 The Office contends that the fact of combining the two words ‘Prinzip’ (‘principle’) and ‘Bequemlichkeit’ (‘comfort’) does not have the effect of changing the descriptive nature of the word combination at issue in relation to the goods concerned.

- 21 As regards Article 12(b) of Regulation No 40/94, the Office submits that the contested decision rightly contains no consideration of that provision. In that regard, the Office asserts that the refusal of an application under Article 7(1)(b) or (c) of Regulation No 40/94 is not based on a ‘need for availability’, but on the inappropriateness of the sign for the purpose of constituting a trade mark. Therefore, according to the Office, it is normal for Article 12(b) of Regulation No 40/94 not to be taken into account during the examination.

Findings of the Court

- 22 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.

- 23 The descriptiveness of a sign should be assessed in relation to the goods or services in respect of which registration is sought.
- 24 Furthermore, Article 7(2) of Regulation No 40/94 provides that Article 7(1) is to 'apply notwithstanding that the grounds of non-registrability obtain in only part of the Community'.
- 25 In the present case, even if, as the Office submits, 'Bequemlichkeit' means 'comfort' in the German language and it must therefore be considered that the word combination at issue means 'principle of comfort', the fact remains that it does more than refer to a characteristic of the goods concerned.
- 26 On that subject, the Board of Appeal observed, at paragraph 26 of the contested decision, that 'the potential customers targeted understand immediately and without particular efforts of analysis that the goods in respect of which the application is made... have a particular quality, namely that they have been designed in accordance with the rules and principles of comfort'. The Board of Appeal therefore essentially assessed the descriptiveness of the word combination at issue in relation to 'Bequemlichkeit' alone and not in relation to 'DAS PRINZIP DER BEQUEMLICHKEIT' as a whole. In the eyes of the class of persons targeted, the quality of the goods concerned, consisting of being 'designed in accordance with the rules and principles of comfort', is associated with the quality of being comfortable. In the present case, the class of persons targeted is deemed to be made up of average, reasonably well-informed and reasonably observant and circumspect German-speaking consumers (see, to that effect, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26; and Case T-359/99 *DKV v OHIM (EuroHealth)* [2001] ECR II-1645, paragraph 27).

- 27 In that regard, it should be recalled that, in order to be caught by Article 7(1)(c) of Regulation No 40/94, a mark must consist ‘exclusively’ of signs or indications which may serve to designate a characteristic of the goods or services concerned. As regards a word sign composed of several elements, it follows from that requirement that descriptiveness must be assessed on the basis of all the elements of which the word sign is composed and not on the basis of only one of those elements.
- 28 Consequently, even if the ‘Bequemlichkeit’ element designates, on its own, a quality of the goods concerned which may be relevant when the class of persons targeted makes the decision to purchase, ‘DAS PRINZIP DER BEQUEMLICHKEIT’, when considered on the basis of all its elements and read in its entirety, cannot be regarded as consisting exclusively of signs or indications which may serve to designate the quality of the goods concerned.
- 29 It follows that the plea of infringement of Article 7(1)(c) of Regulation No 40/94 is well founded.

Infringement of Article 7(1)(b) of Regulation No 40/94

Arguments of the parties

- 30 The applicant asserts, by reference to the Office’s practice, that a very weak distinctive character is sufficient to overcome the absolute ground for refusal referred to in Article 7(1)(b) of Regulation No 40/94.

- 31 As regards slogans, the applicant submits that their communicative function does not in any circumstances justify assessing them in accordance with criteria which are stricter than those applied to other word signs. According to the applicant, for the purposes of assessing the distinctiveness of a slogan, account must be taken of originality, concision and the need for interpretation owing to its incomprehensibility or ambiguity.
- 32 In that regard, the applicant claims that the sign at issue is original. More specifically, it submits that the use of the words ‘das Prinzip der..’, to reinforce and highlight the concept of ‘Bequemlichkeit’ (ease, convenience), is unusual. It points out that the contrast created by the combination of, on the one hand, the word ‘Prinzip’, meaning something orderly, fundamental and objective, and, on the other, the word ‘Bequemlichkeit’, expressing a feeling or a subjective assessment, produces surprise. It contends that the slogan makes original use of the ambivalence of the word ‘Bequemlichkeit’, meaning, on the one hand, ‘nonchalance, laziness, casualness’ and, on the other, ‘comfort, convenience’.
- 33 The applicant considers that the idea of any ‘fundamental rule of comfort’, arising from the general effect of the sign at issue, is devoid of any specific meaning. In that regard, it asserts that the opposing meanings of the idea of a ‘hard rule’, which is objectively established, on the one hand, and the idea of ‘comfort’ or ‘ease’, which is felt subjectively, on the other, clash. According to the applicant, the slogan — which is intended to convey a positive advertising message — is therefore perplexing, likely to catch people’s attention and, therefore, distinctive.
- 34 The applicant submits that the Board of Appeal has not demonstrated that the sign in question has a specifically descriptive meaning in relation to the goods in Classes 12 (land vehicles and parts therefor) and 20 (household and office furniture). In that regard, it claims that the distinction drawn by the Board of Appeal between those goods, on the one hand, and the goods in Class 8 (tools (hand-operated); cutlery), on the other, is not convincing. According to the

applicant, the Board of Appeal erred in basing that distinction on the fact that, in the case of the latter goods, qualities other than comfort predominate, such as safety, efficiency, ease of use or aesthetics, when such qualities are also of importance in relation to the goods in Classes 12 and 20.

- 35 The applicant asserts that the Office, by refusing to register the mark applied for, goes against its own previous decisions. Thus, the applicant relies on the fact that the Office has regarded as distinctive the term 'Leicht', because of its equivocal nature. According to the applicant, since the slogan 'DAS PRINZIP DER BEQUEMLICHKEIT' is at least as distinctive as the term 'Leicht', the erroneous approach adopted in the contested decision is tantamount to applying to slogans criteria which are stricter than those applied to other word signs. Furthermore, the applicant submits that the mark applied for is not less distinctive than the slogans 'BEAUTY ISN'T ABOUT LOOKING YOUNG BUT LOOKING GOOD' and 'Früher an Später denken' which have been accepted for registration. By contrast, according to the applicant, the mark applied for is not comparable to the slogans 'THE WORLD'S BEST WAY TO PAY', 'GREAT BOOKS OF THE WESTERN WORLD', 'THE WORLD LEADER IN TELEPHONE MARKETING SOLUTIONS', 'BOUQUET DE PROVENCE' or 'THE PROFESSIONAL FLASH LIGHT', which are referred to by the Board of Appeal. In that regard, the applicant states that all those slogans, which have been refused for registration, are not only unequivocal — so that there is no need to interpret them — but also devoid of originality and concision.
- 36 The Office contends that slogans, which generally have an advertising function and refer to characteristics of the goods or services or of the manufacturer or distributor, must, in order to be able to serve as marks, possess an additional element of originality.
- 37 According to the Office, the slogan 'DAS PRINZIP DER BEQUEMLICHKEIT' has no originality since it has only an advertising function and is purely descriptive in relation to the goods concerned. The Office asserts that the class of persons targeted thus understands the mark applied for as a reference to the kind and the quality of the goods concerned and not to their origin.

- 38 The Office contends that the contested decision is consistent with the previous decisions of the boards of appeal concerning slogans. In that regard, the Office cites, in particular, a decision of the Third Board of Appeal of 3 April 2000 dismissing, on the ground of a lack of distinctiveness, the appeal against the refusal to register the slogan 'THE ADVANTAGE OF INFORMATION' in respect of goods and services in Classes 9, 16 and 42. As to the decisions relied on by the applicant, the Office observes that the slogan 'BEAUTY ISN'T ABOUT LOOKING YOUNG BUT LOOKING GOOD' does not refer to the goods concerned and that the marks 'LEICHT' and 'Früher an Später denken' are not descriptive in relation to the goods and services concerned.

Findings of the Court

- 39 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.
- 40 The distinctive character of a sign must be assessed in relation to the goods or services in respect of which registration is sought.
- 41 In the present case, the Board of Appeal observed, in paragraph 30 of the contested decision, that the word combination at issue is devoid of any distinctive character 'since it is understood by the customers targeted only as a reference to the kind and the quality... of the goods in question and not as a mark referring to the origin characterising the company of production'. The Board of Appeal thus essentially deduced lack of distinctive character from the descriptiveness of the phrase claimed.

- 42 It was held above that the registration of 'DAS PRINZIP DER BEQUEMLICHKEIT' could not be refused on the basis of Article 7(1)(c) of Regulation No 40/94. Consequently, the Board of Appeal's substantive reasoning in relation to Article 7(1)(b) of Regulation No 40/94 must be rejected, in so far as it is based on the error found above.
- 43 Furthermore, the Board of Appeal again noted, in paragraph 30 of the contested decision, that 'DAS PRINZIP DER BEQUEMLICHKEIT' was characterised by the lack of 'any additional element of imagination'. In addition, the Office submitted in its response that, 'in order to be able to serve as marks, slogans must possess an additional element... of originality' and that the term at issue had no such originality.
- 44 In that regard, it is clear from the case-law of the Court of First Instance that lack of distinctiveness cannot be found because of lack of imagination or of an additional element of originality (Case T-135/99 *Taurus-Film v OHIM (Cine Action)* [2001] ECR II-379, paragraph 31; Case T-136/99 *Taurus-Film v OHIM (Cine Comedy)* [2001] ECR II-397, paragraph 31; and Case T-87/00 *Bank für Arbeit und Wirtschaft v OHIM (EASYBANK)* [2001] ECR II-1259, paragraphs 39 and 40). Furthermore, it is not appropriate to apply to slogans criteria which are stricter than those applicable to other types of sign.
- 45 To the extent that the Board of Appeal, in paragraph 31 of the contested decision, again points out the lack of any 'conceptual tension which would create surprise and so make a striking impression', it must be stated that that point is really only a paraphrase of the Board of Appeal's finding of no 'additional element of imagination'.

- 46 The dismissal, on the basis of Article 7(1)(b) of Regulation No 40/94, of the appeal brought before the Board of Appeal would have been justified only if it had been demonstrated that the combination of the words 'das Prinzip der...' ('the principle of...') alone with a term designating a characteristic of the goods or services concerned is commonly used in business communications and, in particular, in advertising. The contested decision does not contain any finding to that effect and neither in its written pleadings nor at the hearing has the Office asserted that such a usage exists.
- 47 The plea of infringement of Article 7(1)(b) of Regulation No 40/94 is therefore also well founded.
- 48 It follows from all the foregoing that the contested decision must be annulled and that it is not necessary to rule on the third plea in law raised by the applicant.

Costs

- 49 Under Article 87(2) of the Rules of Procedure, 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 Office has been unsuccessful and the applicant has asked for costs to be awarded against it, the Office must be ordered to bear its own costs and to pay those of the applicant.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber),

hereby:

1. **Annuls the decision of the Third Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 23 March 2000 (Case R 392/1999-3);**
2. **Orders the Office to bear its own costs and to pay those of the applicant.**

Mengozzi

Tiili

Moura Ramos

Delivered in open court in Luxembourg on 11 December 2001.

H. Jung

Registrar

P. Mengozzi

President