

Case T-295/01

Nordmilch eG

v

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

(Community trade mark — Regulation (EC) No 40/94 — OLDENBURGER —
Absolute ground for refusal — Descriptive character — Geographical origin —
Articles 7(1)(c) and 7(2) — Limitation of the right conferred — Article 12(b) —
Statement as to the scope of protection — Article 38(2))

Judgment of the Court of First Instance (Fourth Chamber), 15 October
2003 II-4368

Summary of the Judgment

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

2. *Community trade mark — Effects of a Community trade mark — Limitations — Article 12(b) of Regulation No 40/94 — Purpose — Conditions of application — Existence of a validly registered trade mark*
(Council Regulation No 40/94, Arts 7(1)(c) and 12(b))
3. *Community trade mark — Registration procedure — Examination of the application — Trade mark containing an element which is devoid of distinctive character — Option for the Office to request a statement relating to that element — Scope*
(Council Regulation No 40/94, Art. 38(2))

1. The word OLDENBURGER, whose registration is sought in respect of certain foods for everyday consumption by consumers as a whole falling within Classes 29, 30 and 32 of the Nice Agreement, consists exclusively of a sign which indicates or is capable of indicating to the relevant persons the geographical origin of the designated goods within the meaning of Article 7(1)(c) of Regulation No 40/94 on the Community trade mark.

an indication of the geographical origin of those goods.

(see paras 36, 38, 45)

Given that that word derives directly, in its adjectival form, from the name of the German town Oldenburg, which is the principal town in the administrative district of Weser-Ems in Niedersachsen, and that the geographical area which is directly evoked by the sign is known as a region that produces the goods in question, the German public may perceive the geographical name as

2. The purpose of Article 12(b) of Regulation No 40/94 on the Community trade mark relating to the limitations of effects of trade marks, in the context of its relationship with Article 7(1)(c), in particular for trade marks which do not fall within the scope of that provision because they are not exclusively descriptive, is to ensure, inter alia, that use of an indication relating to geographical origin, which also forms part of a complex trade mark, does not fall within a prohibition that the proprietor of such a mark is entitled to enforce under Article 9 of the regulation, where that indication is used in accordance with honest practices in industrial and commercial matters. If it is to apply,

therefore, there must be a prior finding that a trade mark has been validly registered and that the proprietor thereof is enforcing his rights. The alleged infringer may then rely on Article 12 of the regulation as a defence to resist a claim of infringement of the proprietor's rights.

vides that the Office for Harmonisation in the Internal Market (Trade Marks and Designs) may request, where the trade mark applied for contains an element that is devoid of distinctive character, a statement as a condition for registration in which the applicant states that he disclaims any exclusive right to such element.

Consequently, application of that provision may not be taken into account during the registration procedure.

First, in that respect, those provisions do not imply that the Office is bound to request a disclaimer. Second, such a disclaimer cannot be required if there is no element to which it could relate, which is the case where the one element of which a trade mark is composed is not in itself eligible for protection.

(see paras 55-57)

3. Article 38(2) of Regulation No 40/94 on the Community trade mark pro-

(see paras 62, 64)