

JUDGMENT OF THE COURT OF FIRST INSTANCE (Third Chamber)

19 January 2005*

In Case T-387/03,

Proteome Inc., established at Beverly, Massachusetts (United States), represented by M. Edenborough, Barrister, C. Jones, A. Brodie and C. Loweth, Solicitors,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by P. Bullock and S. Laitinen, acting as Agents,

defendant,

ACTION brought against the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market of 25 August 2003 (Case R 0707/2002-4), and the examiner's decision of 21 June 2002 refusing registration of the word mark BIOKNOWLEDGE,

* Language of the case: English.

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

composed of J. Azizi, President, M. Jaeger and F. Dehousse, Judges,
Registrar: H. Jung,

having regard to the application lodged at the Registry of the Court of First Instance
on 25 November 2003,

having regard to the response lodged at the Registry of the Court of First Instance on
13 February 2004,

and further to the hearing on 9 September 2004,

gives the following

Judgment

Background to the dispute

- 1 On 2 March 2000 the company Proteome Inc. ('the applicant') filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) ('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 registration of which has been applied for is the term BIOKNOWLEDGE.
- 3 The goods and services in respect of which registration has been sought fall within Classes 9, 16 and 42 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 9: ‘Databases, in physical and electronic form, providing information relating to organisms, and computer software for use in searching, retrieving, compiling, organising, managing, analysing, communicating and/or integrating data in and among repositories of information in electronic form, including computer databases’;
 - Class 16: ‘Printed material, including guides and manuals, concerning repositories of information relating to organisms’;
 - Class 42: ‘Information and computer services, namely developing and/or providing access to databases containing information relating to organisms, and computer software related thereto’.
- 4 By letter of 6 July 2001 the Office’s examiner notified the applicant that she was of the view that the mark applied for did not comply with Article 7(1)(b) and (c) of Regulation No 40/94. The examiner also informed the applicant that it had a period of two months in which to submit observations in that regard.

- 5 The applicant submitted its observations on 31 August 2001.

- 6 By decision of 21 June 2002 the examiner refused the application for registration of the mark pursuant to Article 38 of Regulation No 40/94, on the basis of Article 7(1) (b) and (c) of Regulation No 40/94.

- 7 The applicant accordingly filed a notice of appeal with the Office under Article 59 of Regulation No 40/94.

- 8 By decision of 25 August 2003, notified to the applicant on 15 September 2003 ('the contested decision'), the Fourth Board of Appeal of the Office dismissed that appeal on the grounds that the word BIOKNOWLEDGE is descriptive of the goods and services concerned and is devoid of any distinctive character.

Forms of order sought

- 9 The applicant claims that the Court should:
 - allow the action;

 - annul the decision of the Fourth Board of Appeal;

- annul the examiner's decision of 21 June 2002;

- remit to the Office the application for a Community trade mark to allow the application to proceed to publication thereof;

- order the Office to pay the applicant's costs incurred in this action, the appeal before the Board of Appeal and the proceedings before the examiner.

10 The Office contends that the Court should:

- dismiss the action;

- order the applicant to pay the costs.

Law

11 First of all, it has in the circumstances of this case to be considered that the objective of the forms of order sought by the applicant is in point of fact that the contested decision should be annulled and that the Court of First Instance should give due effect to all the legal consequences of such annulment. It is, moreover, to be pointed out that the Office stated at the hearing that it no longer challenged the admissibility of the applicant's claim for annulment of the examiner's decision.

- 12 As to the substance of the action, the applicant relies on three grounds of challenge, which can be reformulated as two pleas in law. The first plea seeks to establish infringement of Article 7(1)(c) of Regulation No 40/94. The second alleges infringement of Article 7(1)(b) of Regulation No 40/94.

Concerning the first plea in law, alleging infringement of Article 7(1)(c) of Regulation No 40/94

- 13 The first plea advanced by the applicant falls into two parts. In the first, the applicant argues that the trade mark BIOKNOWLEDGE is too vague and indeterminate to confer on that term a descriptive character in relation to the goods and services in question. In the second, the applicant submits that the Board of Appeal used its knowledge of the goods and services concerned improperly in assessing the descriptive character of the mark.

Concerning the vague and indeterminate nature of the term BIOKNOWLEDGE

— Arguments of the parties

- 14 In the applicant's view, the Board of Appeal committed an error similar to that found by the Court in its judgment relating to the term EASYBANK (Case T-87/00 *Bank für Arbeit und Wirtschaft v OHIM (EASYBANK)* [2001] ECR II-1259, paragraphs 26 to 33). As was held in that judgment, the term BIOKNOWLEDGE is too vague and indeterminate to confer on that term a descriptive character in relation to the goods and services concerned.

- 15 Furthermore, the term ‘Bioknowledge’ is newly invented and has no clear, commonly defined and accepted meaning. The applicant infers from that that the term in question is not descriptive, in particular, of the goods and services concerned.
- 16 The applicant adds that, in any event, the word ‘knowledge’ cannot form a descriptive element or component of the term BIOKNOWLEDGE. The word ‘knowledge’ means in English awareness or familiarity gained by experience, but also a person’s range of information or even theoretical or practical understanding of a subject, a language, etc. Those different meanings indicate that the word ‘knowledge’ has a different meaning from ‘information’ and, a fortiori, from the medium in which that information might be stored or the means whereby that information might be imparted to a user.
- 17 Relying on the judgment given by the Court in Case T-34/00 *Eurocool Logistik v OHIM (EUROCOOL)* [2002] ECR II-683, paragraph 38, the Office submits that the assessment of whether a trade mark is descriptive can be made only, first, in relation to the goods or services concerned and, second, in relation to the understanding which the public has of them.
- 18 In the circumstances, having regard to the goods and services in respect of which registration has been applied for, the Office maintains that the target public comprises specialists in the medical, pharmaceutical or other life-science fields and the care business sector throughout the European Union.
- 19 According to the Office, if that public were to be confronted with the term BIOKNOWLEDGE used in relation to the goods and services concerned, it would draw the conclusion that they were intended to provide, or merely relate to, biological information.

- 20 Furthermore, the word ‘knowledge’ also means specific information about a subject. To the extent that the applicant’s goods and services are, or provide, sources of biological information, the Office submits that there exists a clear and direct connection between the mark applied for and the goods and services concerned.
- 21 In that regard the Office stresses the structure of the word mark at issue, which is composed of the prefix ‘bio’, often used in the formation of compound words in the field of science and technology, and the ordinary English word ‘knowledge’. It adds that such a structure will not be perceived as unusual by the consumers concerned, since it complies with the English rules of word composition.
- 22 As regards the applicant’s argument that the term ‘Bioknowledge’ is a newly invented word, the Office states that it is clear from case-law that the fact that a term does not appear in dictionaries is not decisive, since what matters is how that term would be perceived by the target public.

— Findings of the Court

- 23 It follows from Article 7(1)(c) of Regulation No 40/94 that signs and indications which may serve in trade to designate the characteristics of the goods or services in respect of which registration is sought are deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under Article 7(3) of that regulation. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications

from being reserved to one undertaking alone because they have been registered as trade marks (Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraphs 30 and 31).

24 From that viewpoint, the signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought (Case C-383/99 P *Procter & Gamble v OHIM* [2001] ECR I-6251, paragraph 39). Therefore, the descriptiveness of a sign can be assessed only in relation to the goods or services concerned and the relevant public's understanding of that sign (Case T-16/02 *Audi v OHIM (TDI)* [2003] ECR II-5167, paragraph 27).

25 It must first of all be stated that the applicant misunderstands the *EASYBANK* judgment (paragraph 14 above) when it considers that, in the instant case and in the same way as was held in that judgment, the trade mark BIOKNOWLEDGE is 'too vague and indeterminate' to confer on that term a descriptive character in relation to the goods and services concerned.

26 In the *EASYBANK* judgment, the Court used the words 'vague' and 'indeterminate' merely to clarify the connection between the meaning of the term concerned and the services in question. On that basis, it indicated that 'the link between the meaning of the term EASYBANK on the one hand and the services capable of being provided by an online bank on the other appears to be too vague and indeterminate to confer a descriptive character on that term in relation to those services' (paragraph 31). In that judgment the Court did not therefore characterise the trade mark at issue as 'too vague and indeterminate', as the applicant maintains.

- 27 Next, the first part of the first plea in law is based, principally, on the fact that the Board of Appeal wrongly concluded that the trade mark registration of which was sought was descriptive, in particular, of the goods and services concerned. The applicant's ground of challenge in this respect must therefore be examined.
- 28 In the present case it is not disputed that, as the Board of Appeal noted in paragraph 11 of the contested decision, the goods and services concerned are intended for a specialist public in the medical, pharmaceutical or other life-science fields and the care business sector.
- 29 The term BIOKNOWLEDGE is composed of the prefix 'bio' and the word 'knowledge'.
- 30 The prefix 'bio' comes from the Greek 'bios', meaning life, as the Board of Appeal correctly observed in paragraph 9 of the contested decision. That element is found in the composition of many words that are connected to 'life'. Set in the context of the relevant public in the instant case, the element 'bio' is used in the composition of words that relate to living organisms (for example, 'biology').
- 31 As regards the word 'knowledge', one of its definitions corresponds, as the Office has correctly noted, to specific information about a subject. The applicant has not challenged that definition as such, only the conclusion that the Office has drawn from it.
- 32 Accordingly, having regard to the definition of the relevant public in this case, juxtaposition of the terms 'bio' and 'knowledge' to form the word BIOKNOWLEDGE prompts the conclusion that that word has at least one possible meaning, namely, specific information about living organisms, that is to say, information particular to those organisms. It is to be borne in mind here that a word sign must,

pursuant to Article 7(1)(c) of Regulation No 40/94, be refused registration if at least one of its possible meanings designates a characteristic of the goods or services concerned (*OHIM v Wrigley*, cited in paragraph 23 above, paragraph 32).

- 33 Furthermore, the Court has earlier stated, in connection with a term including the element 'bio', that 'since the abbreviation BioID is composed of abbreviations which are part of the vocabulary of the reference language [namely, English], it does not represent an exception to the lexical rules of that language and is therefore not unusual in its structure' (Case T-91/01 *BioID v OHIM (BioID)* [2002] ECR II-5159, paragraph 28). In the circumstances, the fact that the term BIOKNOWLEDGE appears as a single word does not therefore alter the perception that the relevant public may have of it. It must be observed in this regard that, in addition to the relevant English-speaking public, scientific circles often use English.
- 34 So far as the descriptions of the classes of goods and services covered by the registration are concerned, they all refer to 'organisms', that is to say, to one of the components of the term at issue ('bio'). Moreover, the goods and services in respect of which registration is sought are either the means by which information may be stored or goods or services that make it possible to gain access to such information. It follows that the goods and services in question contain, or make possible access to, information about organisms.
- 35 Inasmuch as the relevant public consists of specialists in the life-science and care business fields, it has to be concluded that the link between the possible meaning of the term BIOKNOWLEDGE, set out in paragraph 32 above, on the one hand, and the goods and services in question, on the other, is not too vague or indeterminate. Rather, there exists, from the point of view of the relevant public, a sufficiently direct and concrete connection between the meaning of that term and the characteristics of the goods and services concerned.

- 36 Furthermore, in so far as the word ‘knowledge’, according to the definition given in paragraph 31 above, cannot be clearly distinguished from the word ‘information’, still less can it be distinguished, as the applicant would have it, from the medium in which the information is kept.
- 37 Finally, the term BIOKNOWLEDGE, as put forward for registration, contains no other elements or other indications that might invalidate that conclusion. The same holds good for the presentation or arrangement of the elements which make up that term.
- 38 The applicant’s argument that the term BIOKNOWLEDGE is a newly invented word and has, therefore, no clear, commonly defined and accepted meaning must in this respect be rejected.
- 39 Indeed, with regard to the distinctive nature of a term, the circumstance of coupling together two elements without any graphic or semantic modification does not imbue them with any additional characteristic such as to render the sign, taken as a whole, capable of distinguishing the applicant’s services from those of other undertakings. Moreover, the fact that the term does not appear in dictionaries as such — whether as one word or otherwise — does not in any way alter that finding (Case T-19/99 *DKV v OHIM (COMPANYLINE)* [2000] ECR II-1, paragraph 26, and Case T-345/99 *Harbinger v OHIM (TRUSTEDLINK)* [2000] ECR II-3525, paragraph 37).
- 40 Furthermore, as already indicated (paragraph 33 above), the Court has stated, in relation to the abbreviation BioID, that that term composed of several elements did not represent an exception to the lexical rules of the English language and was therefore not unusual in its structure.

41 In the instant case, as the Office has rightly observed, the structure of the term BIOKNOWLEDGE cannot be perceived as unusual by the consumers concerned, since it complies with the English rules of word composition. That is all the more true because the relevant public includes specialists accustomed to using the two elements that make up the term BIOKNOWLEDGE. Thus, even if that term is newly invented, as the applicant would have it, it has a sufficiently clear possible meaning for the relevant public and makes it possible to designate the essential characteristics of the goods and services concerned.

42 In the light of all those considerations it is to be concluded that the term BIOKNOWLEDGE is descriptive of the goods and services in respect of which registration has been applied for. The Board of Appeal therefore committed no error of law in considering that that term might serve to designate, for the purposes of Article 7(1)(c) of Regulation No 40/94, from the point of view of the relevant public, the essential characteristics of the goods and services covered by the trade mark application.

43 The first part of the first plea in law must therefore be rejected as unfounded.

Concerning the improper use by the Board of Appeal of its knowledge of the goods and services

— Arguments of the parties

44 The applicant states that the Board of Appeal used its knowledge of the proposed goods and services in assessing whether the term BIOKNOWLEDGE fell within the ambit of Article 7(1)(c) of Regulation No 40/94.

45 According to the applicant, such post factum assessment was impermissible, for that knowledge supplemented the information contained in the word mark. Without that knowledge, however, the Board could not have concluded that the term comprised descriptive signs or indications.

46 The applicant adds that, in any case, if the test applied by the Board of Appeal was correct, the sign BLOKNOWLEDGE did not give clear and unambiguous information about essential characteristics of the goods and services offered (contrary to what is stated in paragraph 13 of the contested decision).

47 The Office counters that the applicant is oblivious to the basic principle that assessment of whether a sign is descriptive can be made only in relation to the goods and services concerned. Therefore, far from abusing its knowledge of the specification of the goods and services to reach a biased conclusion, the Board of Appeal applied the correct test in assessing the descriptiveness of the term in the context of the goods and services concerned.

— Findings of the Court

48 As has been observed above, with regard to the application of Article 7(1)(c) of Regulation No 40/94, the descriptiveness of a sign can be assessed only in relation to the goods or services concerned and the relevant public's understanding of that sign (*TDI*, cited in paragraph 24 above, paragraph 27).

49 Contrary to what the applicant maintains, therefore, the Board of Appeal was right in referring, in the circumstances of this case, to the goods and services concerned in order to ascertain whether the term BIOKNOWLEDGE had to be refused registration pursuant to Article 7(1)(c) of Regulation No 40/94.

50 As regards the applicant's argument that the sign BIOKNOWLEDGE does not give clear and unambiguous information about essential characteristics of the goods and services offered, the considerations relating to the first part of the first plea in law have supported the conclusion that, on the contrary, there existed, from the relevant public's point of view, a sufficiently direct and concrete connection between the meaning of the term BIOKNOWLEDGE and the characteristics of the goods and services concerned. The argument put forward by the applicant in that respect must therefore also be rejected here.

51 For those reasons, the second part of the first plea in law must be rejected as unfounded and, therefore, the first plea must be rejected in its entirety.

Concerning the second plea in law, alleging infringement of Article 7(1)(b) of Regulation No 40/94

52 The first plea in law having been rejected, and in so far as it is sufficient that one of the absolute grounds for refusal listed in Article 7(1) of Regulation No 40/94 applies for the sign at issue not to be registrable as a Community trade mark (Case C-104/00 P *DKV v OHIM* [2002] ECR I-7561, paragraph 29), there is no need to consider the second plea in law raised by the applicant, alleging infringement of Article 7(1)(b) of Regulation No 40/94.

53 Having regard to all the foregoing, the action must be dismissed.

Costs

- 54 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 applied for in the successful party's pleadings. The applicant having been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by the Office.

On those grounds,

THE COURT OF FIRST INSTANCE (Third Chamber)

hereby:

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

Azizi

Jaeger

Dehousse

Delivered in open court in Luxembourg on 19 January 2005.

H. Jung

J. Azizi

Registrar

President