JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)
20 November 2002 *

In Joined Cases T-79/01 and T-86/01,

Robert Bosch GmbH, established in Stuttgart (Germany), represented by S. Völker, lawyer, with an address for service in Luxembourg,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by G. Schneider, acting as Agent,

defendant,

* Language of the case: German.

ACTIONS brought against two decisions of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 31 January 2001 (Cases R 124/2000-1 and R 123/2000-1) on the registration of Kit Pro and Kit Super Pro respectively as Community trade marks,

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

composed of: M. Vilaras, President, V. Tiili and P. Mengozzi, Judges,

Registrar: D. Christensen, Administrator,

having regard to the written procedure and further to the hearing on 10 July 2002,

gives the following

Judgment

1 On 3 March 1998, the applicant filed two applications for Community word marks 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 marks of which registration was sought were Kit Pro and Kit Super Pro.

3 The goods in respect of which registration of the marks was sought come within Class 12 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 to the following description:

'Parts for repairing drum brakes in land vehicles'.

4 By decisions of 13 December 1999, the examiner refused the applications under Article 38 of Regulation No 40/94 on the ground that the trade marks applied for were descriptive of the goods in question and devoid of any distinctive character within the meaning of Article 7(1)(c) and (b) of Regulation No 40/94.

5 On 24 January 2000 the applicant filed appeals against the examiner's decisions at the Office, under Article 59 of Regulation No 40/94.

6 By decisions of 31 January 2001 ('the contested decisions'), which were notified to the applicant on 6 February 2001, the First Board of Appeal dismissed the appeals. Essentially, the Board of Appeal held in relation to 'Kit Pro' that, read as a whole, it expresses the idea of a professional set or of a set which is particularly reliable and of high quality. As for 'Kit Super Pro', the Board of Appeal took the view that, read as a whole, it expresses the idea of a professional set of exceptional quality or of a set which is particularly reliable and capable of satisfying exacting standards. Therefore, the Board of Appeal held that the trade marks applied for, since they designated the characteristics of the goods referred

to in the applications, had to be refused registration under Article 7(1)(c) of Regulation No 40/94. Moreover, it held that since the trade marks were descriptive of the goods referred to in the applications they were also caught by Article 7(1)(b) of that regulation.

Procedure and forms of order sought by the parties

7 By applications lodged at the Registry of the Court of First Instance on 5 and 11 April 2001, the applicant brought the present actions, registered under numbers T-79/01 and T-86/01 respectively.

8 By order of 4 June 2002, the President of the Fourth Chamber joined Cases T-79/01 and T-86/01 for the purposes of the oral procedure and of the judgment in accordance with Article 50 of the Rules of Procedure.

9 The applicant claims that the Court should:

— annul the contested decisions;

— order the Office to pay the costs.

10 The Office contends that the Court should:

— dismiss the applications;

— order the applicant to pay the costs.

Law

11 The applicant raises two pleas based on infringement of Article 7(1)(b) and Article 7(1)(c) of Regulation No 40/94.

Arguments of the parties

12 The applicant argues that it follows from the words 'devoid of any distinctive character' in Article 7(1)(b) of Regulation No 40/94 that any degree of distinctiveness, however slight, is sufficient to justify registration of a sign as a trade mark and that one must not take too strict an approach when assessing distinctiveness.

13 As far as the terms in question are concerned, the applicant claims that each of them is a neologism which, considered as a whole, has the minimum level of distinctiveness required.

14 As regards, more particularly, the component 'Kit', the applicant points out that the contested decisions do not contain anything to show that that component must be understood exactly in the sense of '(repair) sets'. According to the applicant that word can have very varied meanings in English (equipment, gear, soldier's equipment, set of tools, tools, tool bag, tub, basket, basin, bucket, thing, stuff, outfit, small three-stringed violin used by dancing masters, kitten). Moreover, the applicant states that 'Kit' is frequently used in the most diverse combinations as a component of a trade mark.

15 Finally, the applicant argues that registration of the trade marks applied for is justified in the light of the decision-making practice followed by the Boards of Appeal. In that regard, it relies on the decisions accepting the registrability of the word marks ProBank, Pro Care and PROLIPID, in connection with which the Boards of Appeal held that the component 'Pro' had several meanings. Additionally, it cites the decisions concerning the trade marks NETMEETING, CareService, Schülerhilfe, GLOBAL CARE, MEGATOURS, SAFETYTECH, STEAM TERMINAL, FIXIT, TOP-LOK, helpLine, HYPERLITE, Tensiontech, SAFEJAW, SURESEAL, FOILGUARD, OMNICARE, ZONEMESSAGE, BID-WATCH and Oilgear.

16 The Office argues that it follows from the descriptive nature of the trade marks applied for, in relation to the goods concerned, that they also lack distinctive character. In that regard, it submits that the way in which the components making up the terms in question are combined does not confer any distinctive character on the trade marks applied for. In that context, the Office notes that the components 'Pro' and 'Super' are very often used in the language of advertising.

17 As regards the decisions of the Boards of Appeal relied on by the applicant, the Office replies that in relation to the great majority of those decisions the applicant has not explained to what extent the trade marks covered by those decisions are comparable to those at issue in the present case or what constitutes the alleged decision-making practice. More particularly, as to the decisions concerning the trade marks ProBank, Pro Care and PROLIPID, the Office argues that those trade

marks are distinguishable from the trade marks applied for in that in the former cases 'Pro' precedes the dominant component. Moreover, according to the Office the mere fact that those three trade marks containing the component 'Pro' have been registered does not, in the absence of homogenous and standardised considerations underpinning those decisions, prove that there is a decision-making practice.

Findings of the Court

18 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. Moreover, Article 7(2) of Regulation No 40/94 states that '[p]aragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community'.

19 As is clear from the case-law, the trade marks covered by Article 7(1)(b) of Regulation No 40/94 are in particular those which, from the point of view of the relevant public, are commonly used in trade for the presentation of the goods or services concerned or in connection with which there exists, at the very least, concrete evidence justifying the conclusion that they are capable of being used in that manner (Case T-323/00 *SAT.1* v *OHIM (SAT.2)* [2002] ECR II-2839, paragraph 37). In addition, such trade marks do not enable the relevant public to repeat a purchasing experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (Case T-79/00 *Rewe Zentral* v *OHIM (LITE)* [2002] ECR II-704, paragraph 26).

20 Consequently, the distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (*LITE*, paragraph 27, and *SAT.2*, paragraph 37).

21 In that regard, the Office stated at the hearing, in answer to a question from the Court and without being contradicted on that point by the applicant, that the relevant public consists of independent repair workshops and private individuals wishing themselves to carry out repairs to their vehicles. Thus, it must be held that the relevant public is an informed public in relation to the goods concerned. Moreover, since the terms in question are made up of components taken from the English language, the relevant public is an English-speaking public.

22 Since this is a trade mark made up of several components (a compound mark), for the purposes of assessing its distinctive character it must be considered as a whole. However, that is not incompatible with an examination of each of the mark's individual components in turn (Case T-118/00 *Procter & Gamble* v *OHIM (square tablet, white with green speckles and pale green)* [2001] ECR II-2731, paragraph 59).

23 First, in relation to the component 'Kit', a sign which may serve to designate the characteristics of the goods or services concerned, which may be taken into account by the relevant public when making its choice, is generally likely to be commonly used in trade for the presentation of those goods or services. Therefore, such a sign is devoid of any distinctive character in relation to those goods or services (*SAT.2*, paragraph 40).

24 In the present case, as the Board of Appeal held in paragraphs 14 and 15 of the contested decisions and as the Office set out in its responses, 'Kit' means, *inter alia*, 'set of tools' and 'set of pieces of equipment ready to be assembled'. Thus, it designates a characteristic of the goods concerned which is likely to be taken into account by the relevant public when making its choice, that is, the fact that they are marketed as a set. In that connection, the applicant's argument that 'Kit' does not have a clear and specific meaning is without relevance. The meaning of a word mark and its components must be examined in the light of the goods or

services referred to in the trade mark application (see, to that effect, Case T-356/00 *DaimlerChrysler* v *OHIM (CARCARD)* [2002] ECR II-1963, paragraph 30). In the present case, taking account of the goods in respect of which registration is sought, the meaning adopted by the Board of Appeal, that is 'set', is the correct one.

25 Accordingly, 'Kit' is devoid of any distinctive character in relation to the goods referred to in the trade mark applications.

26 Second, as regards the components 'Pro' and 'Super', both are laudatory for the sake of advertising, the purpose being to highlight the positive qualities of the goods or services for the presentation of which those components are used. Moreover, the Office has appositely shown that those components are commonly used in trade for the presentation of all kinds of goods and services. Therefore, it is possible to conclude that they are also likely to be used in that way in relation to the goods designated by the trade marks applied for, even though actual use in relation to those goods has not been established.

27 Therefore, the components 'Pro' and 'Super' are devoid of any distinctive character as regards the goods in question in the present cases.

28 It follows that each of the trade marks applied for consists of a combination of components, each of which is devoid of distinctive character as regards those goods.

29 Next, the fact that a compound trade mark consists only of components devoid of distinctive character as regards the goods or services concerned is evidence which

generally justifies the conclusion that that trade mark, considered as a whole, is also devoid of distinctive character in relation to those goods or services. Such a conclusion can be dismissed only if concrete evidence, such as, for example, the way in which the various components are combined, indicates that the compound trade mark, considered as a whole, is greater than the sum of its parts (see, to that effect, *SAT.2*, paragraph 49, and the Opinion of Advocate General Ruiz-Jarabo Colomer in Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR, point 65).

30 In the present proceedings, contrary to the applicant's claim, such evidence does not appear to exist. The combination of a term designating a characteristic of the goods concerned, which is likely to be taken into account by the relevant public when making its choice, with one or more laudatory terms does not mean that the trade marks applied for, considered as a whole, are greater than the sum of their parts. In that connection, it must be observed that the structure of those trade marks, which is distinguished essentially by the fact that 'Pro' or 'Super Pro' appear after the substantive 'Kit', is normal in advertising language, as the Office established to the requisite legal standard in its responses and at the hearing, by reference to research conducted on the Internet.

31 Therefore, it must be held that the trade marks applied for, each considered as a whole, are likely to be commonly used in trade for the presentation of the goods referred to in the trade mark applications and therefore they are devoid of any distinctive character in relation to those goods.

32 As to the applicant's arguments relating to the decisions of the Boards of Appeal accepting the registrability of other trade marks, it is clear from the case-law that decisions concerning registration of a sign as a Community trade mark which the

Boards of Appeal are called on to take under Regulation No 40/94 are adopted in the exercise of circumscribed powers and are not a matter of discretion. Therefore, the registrability of a sign as a Community trade mark must be assessed solely on the basis of that regulation, as interpreted by the Community judicature, and not on the basis of a previous practice of the Boards of Appeal (see, to that effect, Case T-106/00 *Streamserve* v *OHIM (STREAMSERVE)* [2002] ECR II-723, paragraph 66).

33 In addition, factual or legal grounds contained in an earlier decision may, admittedly, constitute arguments to support a plea alleging infringement of a provision of Regulation No 40/94. Nevertheless, it must be pointed out that, in the present case, the applicant has not relied, in relation to those decisions — except those concerning ProBank, Pro Care and PROLIPID —, on grounds mentioned in them such as to call into question the assessment made above in relation to the plea based on infringement of Article 7(1)(b) of Regulation No 40/94. As regards the latter trade marks, the applicant's argument that the Boards of Appeal took the view in their regard that 'pro' has several meanings is without relevance in the context of assessing the distinctive character of the trade marks applied for. As has just been pointed out in paragraphs 26 and 27 above, the conclusion that 'pro' is devoid of distinctive character is based on the fact that it is laudatory and that it is, additionally, likely to be commonly used in trade for the presentation of the goods in question in the present cases. As the Office rightly states in its response, the trade marks ProBank, Pro Care and PROLIPID are not comparable to the trade marks applied for in the present case in that in the former cases the component 'Pro' precedes the dominant component. Furthermore, the trade marks ProBank, Pro Care and PROLIPID were registered in respect of goods or services other than those in question in the present cases.

34 Therefore, the applicant's arguments concerning decisions of the Boards of Appeal accepting the registrability of other trade marks must be rejected.

35 It follows that the plea alleging infringement of Article 7(1)(b) of Regulation No 40/94 must be rejected.

36 In those circumstances, there is no need to examine the plea alleging infringement of Article 7(1)(c) of Regulation No 40/94. According to established case-law, for a sign to be ineligible for registration as a Community trade mark, it is sufficient that one of the absolute grounds for refusal applies (Case T-345/99 *Harbinger* v *OHIM (TRUSTEDLINK)* [2000] ECR II-3525, paragraph 31; Case T-360/99 *Community Concepts* v *OHIM (Investorworld)* [2000] ECR II-3545, paragraph 26, and Case T-24/00 *Sunrider* v *OHIM (VITALITE)* [2001] ECR II-449, paragraph 28).

37 Consequently, the applications must be dismissed.

Costs

38 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 applicant has been unsuccessful, it must be ordered to pay the costs incurred by the Office in accordance with the form of order sought by the Office.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

1. **Dismisses the applications;**

2. **Orders the applicant to pay the costs.**

Vilaras Tiili Mengozzi

Delivered in open court in Luxembourg on 20 November 2002.

H. Jung
Registrar

M. Vilaras
President