Reports of Cases

OPINION OF ADVOCATE GENERAL
JÄÄSKINEN
delivered on 26 January 2012 [1]

Joined Cases C-90/11 and C-91/11

Alfred Strigl
v
Deutsches Patent- und Markenamt
and
Securvita — Gesellschaft zur Entwicklung alternativer Versicherungskonzepte mbH
v
Öko-Invest Verlagsgesellschaft mbH

(References for a preliminary ruling from the Bundespatentgericht (Germany))

(Trade marks — Directive 2008/95/EC — Grounds for refusal or invalidity provided for in Article 3(1)(b) and (c) — Regulation (EC) No 207/2009 — Absolute grounds for refusal provided for in Article 7(1)(b) and (c) — Word mark composed of a descriptive word combination and a letter sequence non-descriptive in itself, corresponding to the initial letters of the words composing that word combination — Descriptive character — Distinctive character — Criteria for assessment — Requirement of availability — Distinctive function of the trade mark)

I – Introduction

1. The two references for a preliminary ruling from the Bundespatentgericht (Federal Patent Court, Germany) forming the subject-matter of this Opinion concern the interpretation of Article 3(1)(b) and (c) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to harmonise the laws of the Member States relating to trade marks. [2]

2. In the main proceedings, the word marks at issue are composed of a number of elements. Those marks, in this instance Multi Markets Fund MMF and NAI — Der Nature-Aktien-Index, are both composed of a descriptive word combination preceded or followed, as the case may be, by a sequence of letters (abbreviation) which is not descriptive in itself, corresponding to the initial letters of the words composing the word combination.

3. In these cases, the Court is called upon to supplement its case-law on trade marks and, more specifically, to rule on the scope of the two grounds for refusal or invalidity set out in Article 3(1)(b) and (c) of Directive 2008/95, namely, first, the absence of distinctive nature and, second, the composition exclusively of signs or indications which may serve, in trade, to designate the characteristics of the goods or services to which the trade mark relates.

1 — Original language: French.
2 — OJ 2008 L 299, p. 25.

4. In this area, the balancing of the protection of the interests of the applicant for or holder of a trade mark, on the one hand, and the need to take account of general interests, on the other, continues to raise questions. Those general interests consist, inter alia, in not unduly restricting the availability of descriptive signs (the requirement of availability) and in enabling the consumer or final user of the goods or services in question to distinguish those goods or services from other goods or services having a different origin (the distinctive function). The questions referred by the Bundespatentgericht seek, in substance, to identify the relevant elements in order to clarify the relationship between those two categories of objectives that govern trade mark law.

II – Legal framework

A – *European Union law*

5. Article 3(1) of Directive 2008/95,[3] under the heading 'Grounds for refusal or invalidity', provides:

'The following shall not be registered or, if registered, shall be liable to be declared invalid:

…

(b) trade marks which are devoid of any distinctive character;

(c) 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 services.

…'

B – *National law*

6. The provisions of Paragraph 3(1)(b) and (c) of Directive 2008/95 correspond, in substance, to the provisions of Article 8(2)(1) and (2) of the Law on the protection of trade marks (Gesetz über den Schutz von Marken und sonstigen Kennzeichen, 'the MarkenGesetz'). Those provisions are worded as follows:

'(2) The following trade marks shall be refused registration:

1. trade marks which are devoid of any distinctive character for the goods or services concerned;

2. 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 services, or other characteristics of the goods or services. …'.

3 — In that regard, it should be noted that the wording of Article 3(1)(b) and (c) of Directive 2008/95 corresponds to the wording of Article 7(1)(b) and (c) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community Trade Mark (OJ 2009 L 78. p. 1).

III – Main proceedings, questions referred and procedure before the Court

A – *Strigl (Case C-90/11)*

7. Mr Strigl filed an application with the Deutsches Patent- und Markenamt (the German patents and trade marks office) in 2008 to register the word mark Multi Markets Fund MMF to designate services coming under Class 36 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 ('the Nice Agreement').

8. Those services are described as follows: 'insurance (insurance consultancy, sales and brokerage); consultancy in insurance matters; financial affairs (services of banks and credit institutions, financial consultancy, investments, trustee transactions, monetary affairs); real estate affairs (real estate and house management, real estate brokerage); investment and financial consultancy'.

9. By two decisions of 23 May and 11 September 2008 the Deutsches Patent- und Markenamt rejected the application to register, relying on Paragraph 8(2)(1) and (2) of the MarkenGesetz. In that regard, it considered, in substance, that the expression 'Multi Markets Fund' designated a fund which invested in a number of different markets. It also considered that it could readily be imagined that the public would understand the letters 'MMF' as the obvious abbreviation of the first verbal elements of the sign, owing to the fact that that abbreviation immediately follows those three elements and uses their respective initial letters.

10. The Deutsches Patent- und Markenamt inferred that, taken as a whole, the sign did not prevail over the sum of its component elements. While accepting that it was possible to attribute various meanings to the letter sequence 'MMF' when it was considered in isolation, the Deutsches Patent- und Markenamt none the less considered that the choice was clearly less when the other elements of the trade mark and the services in respect of which the sign was applied for were taken into account.

11. Mr Strigl lodged an appeal with the Bundespatentgericht, seeking annulment of the decisions of the Deutsches Patent- und Markenamt refusing to register that word mark. He maintained that the word mark had a number of meanings. The fact that the element 'MMF' might correspond to a whole series of abbreviations was, in his submission, sufficient to reject the argument that the sign may be used descriptively.

12. Taking the view that the outcome of the action depends on the interpretation of Directive 2008/95, the Bundespatentgericht decided to stay proceedings and to refer the following question to the Court of Justice for a preliminary ruling:

'Is the ground for refusal under Article 3(1)(b) and/or (c) of [Directive 2008/95] also applicable to a word sign which consists of a descriptive word combination and a non-descriptive letter sequence, if the trade perceives the letter sequence as an abbreviation of the descriptive words because it reproduces their initial letters, and the trade mark as a whole can thus be construed as a combination of mutually explanatory descriptive indications or abbreviations?'

B – *Securvita (Case C-91/11)*

13. The word mark NAI — Der Natur-Aktien-Index was registered with the Deutsches Patent- und Markenamt in 2001 on behalf of Securvita — Gesellschaft zur Entwicklung alternativer Versicherungskonzepte mbH ('Securvita') for the following services in Class 36 of the Nice arrangement: 'Insurance; financial affairs; monetary affairs; real estate affairs'.

14. In 2007 Öko Invest Verlagsgesellschaft mbH ('Öko Invest') applied for cancellation of that trade mark, claiming that the letter sequence 'NAI' was used in financial affairs as an abbreviation for the word combination 'Natur-Aktien-Index'. In support of its action, Öko-Invest claimed that since that word combination, coming immediately after the letter sequence 'NAI', constituted a descriptive indication, the letter sequence, seen as a mere abbreviation of the word combination, could also be considered only to be a descriptive indication.

15. By decision of 28 May 2008 the Deutsches Patent- und Markenamt granted Öko-Invest's application and annulled the trade mark, taking the view that the ground for refusal provided for in Paragraph 8(2)(1) of the MarkenGesetz precluded it. According to the Deutsches Patent- und Markenamt, the trade mark, considered as a whole, was reduced to a combination of purely descriptive indications preceded by an abbreviation, namely the letter sequence 'NAI', perceived as such by the public.

16. In support of the appeal which it lodged against that decision before the Bundespatentgericht, Securvita claimed that no ground for refusal could be raised against that trade mark. In particular, it referred to the fact that the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) had accepted its application for a Community Trade Mark NAI — Der Natur-Aktien-Index, by decision of 15 October 2009 in Case R 1630/2008-4 and had taken the view that that trade mark constituted a sign that was distinctive and non-descriptive. [4]

17. In those circumstances the Bundespatentgericht decided to stay proceedings and to refer the following question to the Court for a preliminary ruling:

'Is the ground for refusal under Article 3(1)(b) and/or (c) of Directive 2008/95 also applicable to a word sign which consists of a letter sequence which is non-descriptive — when considered on its own — and a descriptive word combination, if the trade perceives the letter sequence as an abbreviation of the descriptive words because it reproduces their initial letters, and the trade mark as a whole can thus be construed as a combination of mutually explanatory descriptive indications or abbreviations?'

18. The references for a preliminary ruling from the Bundespatentgericht were registered at the Court Registry on 25 February 2011.

19. By order of the President of the Court of 26 May 2011, Cases C-90/11 and C-91/11 were joined for the purposes of the oral procedure and judgment.

20. Written observations were lodged by one of the parties to the main proceedings, Securvita, by the Italian and Polish Governments and by the European Commission. None of the parties requested that a hearing be held.

4 — Furthermore, Securvita filed an application with OHIM to register the sign 'Natur-Aktien-Index' (without the abbreviation 'NAI') as a Community trade mark. The examiner rejected the application to register that trade mark on 14 February 2007. The appeal against that decision was dismissed on 26 May 2008 by the Fourth Board of Appeal of OHIM in Case R 525/2007-4. The action against that decision was, in turn, declared manifestly inadmissible by order of the Court of First Instance of the European Communities of 30 June 2009 in Case T-285/08 *Securvita* v *OHIM* (Natur-Aktien-Index) [2009] ECR II-2171.

IV – Analysis

A – *General observations*

1. Preliminary remarks

21. It should be observed at the outset that the provisions of Directive 2008/95 closely resemble the provisions of Regulation No 207/2009. In fact, the grounds for refusal or invalidity in Directive 2008/95, the interpretation of which is requested by the referring court, are, as I have already pointed out, identical to the absolute grounds for refusal referred to in Article 7(1)(b) and (c) of that regulation. On account of that identity, I shall also refer to the Court's case-law on the provisions of Article 7(1)(b) and (c) of Regulation No 207/2009.[5]

22. For the purposes of answering the questions referred to the Court, there is no need to distinguish between the questions raised in the two sets of main proceedings, since the point of law raised by the national court is essentially the same. Owing to the addition, in the first part, of the expression 'on its own',[6] the question referred in *Securvita* appears to be more precise, albeit similar in substance, to that raised in *Strigl*. For that reason, I shall, for the purposes of this Opinion, begin with the question as formulated in *Securvita*.

23. In the present cases, the referring court seeks, in substance, to ascertain how one is to assess, by reference to the grounds for refusal or invalidity referred to in Article 3(1)(b) and/or (c) of Directive 2008/95, a trade mark consisting, on the one hand, of a descriptive word combination and, on the other, of a letter sequence which reiterates the initial letters of the words of that word combination and which may, as such, be considered non-descriptive, is to be assessed.

2. Disclaimers

24. Since the trade marks at issue are composed of descriptive elements and also of elements which are non-descriptive in themselves, it is appropriate to draw a parallel with the system established by Regulation No 207/2009. Under Article 37(2) of that regulation, OHIM may make registration of the trade mark conditional on the applicant stating that he disclaims any exclusive right to an element of the trade mark which is not distinctive where the inclusion of that element in the trade mark could give rise to doubts as to the scope of the protection of the trade mark ('the disclaimer').[7]

25. However, under Regulation No 207/2009 the possibility afforded to OHIM to request a disclaimer on the part of the trade mark applicant does not mean that that disclaimer can have any effect on the question whether a sign may or may not be registered. As a general rule, a trade mark which consists of several elements, some of which are descriptive or non-distinctive, will be refused registration only if it is devoid of distinctive character as a whole.[8]

5 — However, it should be noted that the case-law in question mainly concerns Council Directive 89/104/EEC of 21 December 1988 (OJ 1989 L 40, p. 1) and Council Regulation (EC) No 40/94 of 20 December 1993 on the Community Trade Mark (OJ 1994 L 11, p. 1), replaced by Directive 2008/95 and Regulation No 207/2009 respectively.

6 — In the German version 'isoliert betrachtet'.

7 — Directive 2008/95 does not provide for such a disclaimer. None the less, since procedural questions do not form part of the harmonisation which that directive seeks to achieve, the national legislations of the Member States may provide for such a characteristic. It cannot therefore be precluded that the existence of a disclaimer in the legal order of some Member States may have an influence on the assessment of the trade marks at issue.

8 — See 'Study on the Overall Functioning of the European Trade Mark System', Max Planck Institute for Intellectual Property and Competition Law, Munich, 2011, which may be consulted at the address http://ec.europa.eu/internal-market/indprop/docs/tm/20110306_allensbach-study_en.pdf

26. While disclaimers may have an impact on the examination of the extent of the protection of a trade mark in the event of a trade mark conflict, OHIM does not appear to make use of that possibility conferred by Regulation No 207/2009. On the contrary, OHIM appears to apply the principle that signs composed of a number of components cannot be protected in respect of only one of those components. [9]

3. The general interests underlying the grounds for refusal or invalidity

27. When examining the grounds for refusal or invalidity provided for in Article 3(1)(b) and (c) of Directive 2008/95, it is appropriate to take due account of the purposes which they pursue and the general interests underlying them. For that reason, I believe that it would be helpful to make a number of observations on that point.

28. According to settled case-law, the various grounds for refusal or invalidity provided for in Article 3 of Directive 2008/95, and the absolute grounds for refusal referred to in Article 7 of Regulation No 207/2009, should be interpreted in the light of the general interest underlying each of them. [10]

29. In the first place, as regards the purpose of the ground for refusal or invalidity referred to in Article 3(1)(c) of Directive 2008/95, the object of that provision is to ensure the attainment of the general-interest objective that signs or indications descriptive of the characteristics of the goods or services in respect of which registration is sought may be freely used by all. [11]

30. The rationale underlying the ground for refusal or invalidity provided for in Article 3(1)(c) of Directive 2008/95 is therefore the need to ensure the availability of certain signs and thus to ensure that those signs may be freely used by all operators in the sector in question. [12] That principle, which has its origin in German law ('Freihaltebedürfnis'), thus constitutes an essential element for the purposes of the interpretation of that ground for refusal or invalidity. [13]

31. It follows from that need for availability that the ground for refusal or invalidity provided for in Article 3(1)(c) of Directive 2008/95 must therefore prevent the descriptive signs or indications to which that requirement refers from being reserved to a single undertaking because they have been registered as a trade mark. [14] Contrary to the view expressed in the German legal literature, however, the Court has emphasised that the application of the ground for refusal or invalidity provided for in Article 3(1)(c) of Directive 2008/95 does not depend on the existence of a requirement that availability be real, present or genuine, and that the number of competitors who have or might have an interest in using the sign in question is therefore irrelevant. [15]

9 — See, to that effect, point 73 of the Opinion of Advocate General Mengozzi in Case C-48/09 P *LegoJuris* v *OHIM* [2010] ECR I-8403.

10 — See in that regard, in the context of the interpretation of the grounds for refusal provided for in Article 7 of Regulation No 207/2099, Case C-273/05 P *OHIM* v *Celltech* [2007] ECR I-2883, paragraph 74, and Case C-37/03 P *BioID* v *OHIM* [2005] ECR I-7975, paragraph 59 and the case-law cited. As regards the grounds for refusal or invalidity set out in Article 3 of Directive 2008/95, see, inter alia, Case C-265/00 *Campina Melkunie* [2004] ECR I-1699, paragraph 34 and the case-law cited.

11 — See in that regard, inter alia, Case C-51/10 P *Agencja Wydawnicza Technopol* v *OHIM* [2011] ECR I-1541, paragraph 37 and the case-law cited; *Campina Melkunie*, paragraph 35 and the case-law cited; and Case C-191/01 P *OHIM* v *Wrigley* [2003] ECR I-12477, paragraph 31 and the case-law cited.

12 — As regards the characteristics of German legal writing, see, in particular, Frisch, A., *Das Freihaltebedürfnis im Markenrecht*, Nomos Verlagsgesellschaft, Baden-Baden, 2007.

13 — Advocate General Ruíz-Jarabo Colomer has already analysed in depth the scope and the origin of the requirement of availability in German law (at point 33 et seq. of his Opinion in Case C-102/07 *adidas and adidas Benelux* [2008] ECR I-2439), and I can therefore confine myself to a few introductory observations in order to permit a better understanding of the role which that concept plays in the context of European Union law.

14 — See, to that effect, in particular, Case C-173/04 P *Deutsche SiSi-Werke* v *OHIM* [2006] ECR I-551, paragraph 62 and the case-law cited; *OHIM* v *Celltech*, paragraph 75; and Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 25.

15 — See, to that effect, *Agencja Wydawnicza Technopol* v *OHIM*, paragraph 39 and the case-law cited.

32. In the second place, as regards the ground for refusal or invalidity provided for in Article 3(1)(b) of Directive 2008/95, it is clear from the Court's case-law that the relevant general interest is closely linked to the essential function of the trademark, namely to enable consumers or final users to distinguish without possible confusion the goods or services covered by the trademark from other goods or services having a different origin. [16]

33. It is important to bear those general interests in mind when examining the questions referred to the Court.

B – *Assessment of the grounds for refusal or invalidity*

1. The relationship between the descriptive character and the distinctive character of a trademark

34. I must emphasise at the outset that the grounds for refusal or invalidity referred to in Article 3(1)(b) and (c) of Directive 2008/95 are closely linked. Where the exclusively descriptive character has been established in accordance with Article 3(1)(c), it is possible to refer to Article 3(b) of that article. In other words, the absence of distinctive character of a word mark is assumed from the sign's descriptiveness and not vice versa. [17]

35. I shall carry out my analysis on that basis. In that context, it must, however, be borne in mind that a sign may be devoid of distinctive character for reasons other than its descriptive character [18] and that the absence of distinctive character of a sign cannot be based solely on its descriptiveness without taking account of different general interests underlying the two grounds for refusal. [19]

36. It is also important to note that, contrary to the Commission's assertion in its written observations, a distinction must be drawn between the various grounds for refusal or invalidity set out in Article 3(1)(b) and (c) of Directive 2008/95. Indeed, according to settled case-law, although there is a degree of overlap between their respective scope of application, each of those grounds is independent of the others and must be examined separately. [20]

37. In that context, it should be observed, moreover, that the Court has already held that the descriptive character of a trademark composed of several words or a word and a number may be examined, in part, for each of its terms, considered in isolation, but must in any event also be established for the whole which they make up. [21]

38. As a general rule, in accordance with the Court's case-law, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of Directive 2008/95. However, such a combination may not be descriptive within the meaning of that provision, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. [22]

16 — In the case-law the Court has expressed that idea, which refers to the distinctive function of the trade mark, in various ways. See, in particular, Case C-323/09 *Interflora and Interflora British Unit* [2011] ECR I-8625, paragraphs 37 to 39; Case C-324/09 *L'Oréal SA and Others* v *eBay International AG and Others* [2011] ECR I-6011, paragraph 80; Case C-304/06 P *Eurohypo* v *OHIM* [2008] ECR I-3297, paragraph 56 and the case-law cited; and Case C-206/01 *Arsenal Football Club* [2002] ECR I-10273, paragraph 51.

17 — See point 43 of the Opinion of Advocate General Ruíz-Jarabo Colomer in Case C-104/00 P *DKV* v *OHIM* [2002] ECR I-7561.

18 — See, to that effect, *Agencja Wydawnicza Technopol* v *OHIM*, paragraph 46 and the case-law cited.

19 — *Eurohypo* v *OHIM*, paragraphs 55 to 62.

20 — See, to that effect, *Eurohypo* v *OHIM*, paragraph 54 and the case-law cited.

21 — See, inter alia, Case C-17/08 P *MPDV Mikrolab* v *OHIM* [2009] ECR I-16, paragraph 38 and the case-law cited.

22 — *Campina Melkunie*, paragraphs 39 and 40.

39. In addition, the fact that each of those elements, taken separately, is devoid of distinctive character does not preclude the possibility that the combination of those elements may none the less have a distinctive character. [23]

40. As regards word marks, such as those at issue in the main proceedings, composed of descriptive words linked to a sequence of letters which correspond to the initial letters of those words and which, taken in isolation, may be considered to be non-descriptive, the question is whether the addition of the abbreviation which is non-descriptive in itself to a descriptive word group may have the effect that those word elements, taken together, acquire a non-descriptive, indeed a distinctive, character, as required for the purposes of the registration of such a trademark.

41. In other words, in the main proceedings, it must be determined whether one and the same sequence of letters for the same goods and services must always be assessed in the same way, independently of whether the trade mark relates to that sequence as such or to a combination of the sequence with other descriptive elements.

42. In that context, it is useful to note that, according to the Court, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of Directive 2008/95 is necessarily devoid of any distinctive character with regard to the same goods or services. [24]

43. In the light of those factors, it seems necessary to begin the assessment of the trade marks in question by analysing the elements of which those trade marks are composed, before embarking upon a global examination of the trade marks.

2. The elements composing the trade marks

44. As regards, first, the *Strigl* case and the Multi Markets Fund MMF trade mark, the referring court considers, in substance, that the word combination 'Multi Markets Fund' constitutes an indication which serves to designate the services referred to in the application, namely the services provided in the quite special context of an investment fund which invests in various markets. The referring court also states that the relevant public could readily understand the words making up the word combination 'Multi Markets Fund', whether taken individually or in the whole which they form.

45. As regards the letter sequence 'MMF", taken in isolation, the referring court observes that it should be regarded as a letter combination to which no descriptive meaning can be attributed in itself. However, it observes that that letter sequence immediately follows the word combination 'Multi Markets Fund', which leads the referring court to conclude that the letter sequence may well be perceived by the relevant public as the abbreviation of that word combination. According to the referring court, such an understanding is consistent with the natural and logical perception of the reasonably well-informed, reasonably observant and circumspect average consumer.

46. As regards, second, the *Securvita* case and the trade mark NAI — Der Natur-Aktien-Index, the expression 'Natur-Aktien-Index' describes, in the same way as the expressions 'Öko-Aktien', 'Umweltaktien' or 'grüne Aktien', the shares of ecologically-oriented undertakings and, consequently, a certain kind of stocks and shares. In addition, the sign 'Natur-Aktie' is very widely used to describe the characteristics of different products in the field of financial affairs. According to the national court, the word combination describes, from the viewpoint of the relevant public, the characteristics of the services referred to by the trade mark within the meaning of Article 3(1)(c) of Directive 2008/95.

23 — See in that regard Case C-92/10 P *Media-Saturn-Holding* v *OHIM* [2011] ECR I-0002, paragraph 36; *Eurohypo* v *OHIM*, paragraph 41; and *BioID* v *OHIM*, paragraph 29.

24 — See, in particular, Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 86.

47. As regards the letter sequence 'NAI', which, together with a dash, precedes the word combination 'Der Natur-Aktien-Index', the national court observes that that is not a common, generally understandable abbreviation which would be considered by the relevant public to be an indication of the characteristics of the services for which the trade mark was registered. Consequently, taken in isolation, the letter sequence 'NAI' could therefore not describe, for the purposes of Article 3(1)(c) of Directive 2008/95, a characteristic of the services for which the trade mark was registered.

3. The overall impression produced by the trade marks

48. I would observe at the outset that, even though letter sequences such as those at issue in the main proceedings might be considered to have a distinctive character, taken in isolation, with respect to the services referred to by the trade marks in question, the fact none the less remains that the perception of the relevant public must not be analysed solely by reference to the various elements making up the trade mark, but mainly by reference to the overall impression which the trade mark gives.

49. As regards the overall impression given by the trade marks at issue in the main proceedings, the referring court emphasises that the three upper-case letters in question, 'MMF' and 'NAI', respectively, are consistent with the three words of the word combinations in question, namely 'Multi Markets Fund' and 'Natur-Aktien-Index'. Thus, the public might readily recognise the letter sequence as the abbreviation of the word combination which, depending on the case, precedes it or follows it.

50. In the case of the composition of the trade mark NAI — Der Natur-Aktien-Index, it should also be noted that the letter sequence 'NAI' is followed by a dash that links it to the word combination. That dash might be regarded, as stated in the decision of referral, as reinforcing the overall impression that it is a mere abbreviation of the word combination that follows it. In that regard, the national court notes that that conclusion would not be called into question by the fact that the abbreviation 'NAI' does not contain the initial letter of the definite article 'Der' in the subsequent word combination, since the article 'Der' is ancillary to the nouns whose initial letters are reproduced in the abbreviation at issue.

51. In that context, I would observe, purely in passing, that I do not find the reasoning of the Fourth Board of Appeal of OHIM concerning the registration of the trade mark NAI — Der Natur-Aktien-Index as a Community trade mark convincing. According to OHIM, the letter sequence 'NAI', taken in isolation, has no descriptive meaning and the addition of the word combination 'Der Natur-Aktien-Index' does not change anything. It considered that a different conclusion would have the consequence that such a letter sequence might become descriptive 'subsequently' as a whole following the addition of descriptive word elements.[25]

52. It is certainly not ruled out that such letter sequences might, in themselves, assume distinctive character if they are capable of referring, as such, to other abbreviations and they do not describe in themselves the goods or services designated by the trade marks in question. I would none the less emphasise that the average consumer, as a general rule, will perceive the trade mark as a whole and will not undertake an examination of its different components.[26]

53. In effect, the point of view expressed in OHIM's decision ignores the overall impression which, as I have already stated, must be taken into account in the assessment of the grounds for refusal or invalidity set out in Article 3(1)(b) and (c) of Directive 2008/95. In view of the overall impression produced by trade marks composed of a word combination descriptive of the goods and services in question and of a letter sequence corresponding to the initial letters of the words forming that word

25 — See, in particular, paragraphs 12 and 16 of the decision of the Fourth Board of Appeal of OHIM of 15 October 2009 in Case R 1630/2008-4, referred to above.

26 — See, in particular, in the context of the assessment of the risk of confusion, Case C-254/09 P *Calvin Klein Trademark Trust* v *OHIM* [2010] ECR I-7989, paragraph 45 and the case-law cited.

combination, that word combination would appear to be the dominant element of such trade marks. To my mind, the letter sequence corresponding to the initial letters of the three words of the word combination at issue is not capable of producing an impression sufficiently removed from that created by the simple combination of the elements composing the trade mark.

54. I would add that a letter sequence which is perceived by the relevant public as the abbreviation of the word combination with which it is juxtaposed cannot prevail over the sum of all the elements of the trade mark taken as a whole, even though the sequence may be regarded as presenting, in itself, a distinctive character. The descriptive character of an element of the trade mark, namely that of the letter sequence, therefore derives from the trade mark taken in its entirety. Thus, for example, the overall impression produced by the imaginary trade mark 'Two for tea — 24T' is different from that given by '24T'.

55. It must be emphasised that the meaning of the trade mark must be determined globally. A global assessment of the trade mark may lead us, in the case of a trade mark whose elements are closely linked to each other and two elements of which explain each other, to a different conclusion from that which would be reached if each of those elements were examined in isolation.

56. It is for that reason that, on the basis of a global assessment of trade marks such as those at issue in the main proceedings, I consider that the public will attribute to the abbreviation, non-descriptive in itself, only the descriptive content that emerges from the word combination with which it is juxtaposed, owing to that juxtaposition of different elements which are mutually explanatory. It follows that the letter sequence using the initial letters of the words making up the word combination has, by comparison with that word combination, only an ancillary position, which leads me to conclude that the element consisting of such a letter sequence is negligible so far as the overall impression given by such a trade mark is concerned.[27] The word combination with a descriptive character thus confers a descriptive meaning on the trade mark considered as a whole.

57. Notwithstanding that conclusion, an answer must still be given to the referring court's question relating to the respective scope of the grounds for refusal or invalidity provided for in Article 3(1)(b) and (c) of Directive 2008/95 in relation to trade marks such as those at issue in the main proceedings.

4. The choice between the grounds for refusal or invalidity provided for in Article 3(1)(b) and (c) of Directive 2008/95

58. As regards the distinction that must be drawn between Article 3(1)(b) and (c) of Directive 2008/95 in the case of trade marks such as those at issue in the main proceedings, it is necessary to take into account not only the descriptive character of the trade marks in question, which must be established on the basis of the overall impression which the trade marks give, but also the general interests that underlie the respective grounds for refusal or invalidity. It is therefore appropriate, once again, to emphasise, first, the requirement of availability associated with certain signs and, second, the distinctive function of the trade mark, which must permit the goods and services covered by the trade mark to be distinguished from other goods or services having a different origin.

59. From that aspect, to allow the registration of a trade mark composed exclusively of descriptive signs or indications which must remain available to all would be contrary to the very rationale of the ground for refusal or invalidity set out in Article 3(1)(c) of Directive 2008/95.

60. Indeed, in order to ensure that that objective of availability to all is fully achieved, the Court has stated that it is not necessary that the signs and indications composing the trade mark that are referred to in that article are actually in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of

27 — See, by analogy, *Calvin Klein Trademark Trust* v *OHIM*, paragraph 57.

characteristics of those goods or services. It is sufficient that those signs and indications may be used for such purposes.[28] It follows that a word sign must be refused registration under Article 3(1)(c) of that directive if at least one of its possible meanings designates a characteristic of the goods or services concerned.[29]

61. However, the wording of Article 3(1)(c) of Directive 2008/95 is aimed at trade marks composed exclusively of descriptive signs or indications. In the main proceedings, the trade marks at issue are composed of descriptive elements (the word combinations), on the one hand, and of elements that are non-descriptive in themselves (the letter sequences), on the other. As I have observed above, in such a situation the descriptive meaning of the letter sequence, non-descriptive in itself, derives from a global assessment of the trade mark. More precisely, the descriptive character of those letter sequences results from the words of the word combination whose letters compose the letter sequences in question.

62. There is no need to ensure the availability either of such letter sequences taken separately or of the trade mark taken as a whole, since even if the trade mark has a descriptive meaning, it is not composed exclusively of such signs or such indications. For that reason, for the purposes of the examination of the trade marks at issue in the main proceedings, it is appropriate to turn to the criterion of distinctive character provided for in Article 3(1)(b) of Directive 2008/95.

63. As regards the examination of the distinctive character of such a combination of elements for the purposes of Article 3(1)(b) of that article, the national court must ascertain whether, considered as a whole, the trade marks at issue can or cannot guarantee the essential function of the trade mark, which consists in distinguishing the goods or services which it covers from other goods or services having a different origin. Here, the question is whether the combination of descriptive elements and an element non-descriptive in itself, but descriptive in the context of the trade mark in question, can give rise to an impression sufficiently removed from that produced by the mere combination of those elements.[30]

64. In conclusion, as regards the global assessment of a trade mark composed of the juxtaposition of a descriptive word combination and a sequence of letters consistent with the initial letters of the words of that word combination, I consider that the sequence of letters, non-descriptive in itself, acquires a descriptive character in that specific context. However, where a trade mark formed of such elements is not exclusively composed of descriptive signs or indications for the purposes of Article 3(1)(c) of Directive 2008/95, it is necessary to turn to Article 3(1)(b) of Directive 2008/95 in order to assess the possibility of registering a trade mark of that type.

V – Conclusion

65. In the light of all the foregoing considerations, I propose that the answer to the questions referred for a preliminary ruling by the Bundespatentgericht should be as follows:

A word mark which is composed of the juxtaposition of a descriptive word combination and a letter sequence, not descriptive in itself, corresponding to the initial letter of each word in the combination and for that reason perceived by the public as an abbreviation of that word combination and which, considered as a whole, may thus be understood as a combination of descriptive indications or abbreviations which are mutually explanatory, must be assessed by reference to the ground for refusal or invalidity provided for in Article 3(1)(b) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to harmonise the laws of the Member States relating to trade marks and not by reference to the ground for refusal or invalidity provided for in Article 3(1)(c) of that directive, because such a trade mark is not composed exclusively of descriptive signs or indications.

28 — See, in particular, *Agencja Wydawnicza Technopol* v *OHIM*, paragraph 38 and the case-law cited.

29 — See, in particular, order in Case C-80/09 P *Mergel and Others* v *OHIM* [2010] ECR I-17, paragraph 37 and the case-law cited.

30 — See, to that effect, Case C-408/08 P *Lancôme* v *OHIM* [2010] ECR I-1347, paragraph 61 and the case-law cited.