JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)
5 December 2002 *

In Case T-91/01,

BioID AG, established in Berlin (Germany), in judicial liquidation, represented by A. Nordemann, lawyer,

applicant,

v

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

defendant,

* Language of the case: German.

ACTION brought against the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 20 February 2001 (Case R 538/1999-2) concerning the registration of a figurative mark containing the abbreviation BioID,

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

composed of: R.M. Moura Ramos, President, J. Pirrung and A.W.H. Meij, Judges,

Registrar: J. Plingers, Administrator,

having regard to the written procedure and further to the hearing on 11 July 2002,

gives the following

Judgment

1 On 8 July 1998, the applicant, acting under its former name, D.C.S. Dialog Communication Systems AG, 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. The Office received the application on 10 July 1998.

2 The mark in respect of which registration is sought is the sign reproduced below:



3 The goods and services in respect of which registration of the sign is sought fall under Classes 9, 38 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. They correspond to the following descriptions, which were set out in the application for registration of the mark:

— 'Computer software, computer hardware and parts therefor, optical, acoustic and electronic apparatus and parts therefor, all the aforesaid goods in particular for and in connection with the monitoring of user passwords, for computer intercommunication and for the computer-aided identification and/or verification of live organisms based on one or more specific biometric characteristics' in Class 9.

— 'Telecommunications; security services in connection with computer communications, access to databases, electronic payment transactions, the checking of user passwords and the computer-aided identification and/or verification of live organisms based on one or more specific biometric characteristics' in Class 38.

— 'Providing of software on the internet and other communications networks, on-line maintenance of computer programs, computer programming, all the aforesaid services in particular for and in connection with the monitoring of user passwords, computer intercommunication and the computer-aided identification and/or verification of live organisms based on one or more specific biometric characteristics; technical development of systems for monitoring user passwords, for computer intercommunication, and of systems for the computer-aided identification and/or verification of live organisms based on one or more specific biometric characteristics' in Class 42.

4 By decision of 25 June 1999, the examiner refused the application under Article 38 of Regulation No 40/94 on the ground that the mark applied for was descriptive of the goods and services and devoid of any distinctive character within the meaning of Article 7(1)(c) and (b) of Regulation No 40/94.

5 On 20 August 1999, the applicant filed at the Office an appeal against the examiner's decision in accordance with Article 59 of Regulation No 40/94.

6 By decision of 20 February 2001, which was notified to the applicant on 23 February 2001, the Second Board of Appeal dismissed the appeal ('the contested decision'). The Board of Appeal found, essentially, that the abbreviation BioID, read as a whole, constituted a shortened form of the words 'biometric identification'. Accordingly, the Board of Appeal considered that the mark applied for described characteristics of the goods and services claimed and that registration of the mark should be refused in accordance with Article 7(1)(c) of Regulation No 40/94. As regards the graphic form of the mark applied for, the Board of Appeal considered that the graphic elements were minimal and therefore could not endow the mark with any distinctive character.

7 On 13 March 2001, the change of the applicant's name to 'BioID AG' was registered in the commercial register of the Amtsgericht Charlottenburg.

Procedure and forms of order sought by the parties

8 By application lodged at the Registry of the Court of First Instance on 25 April 2001, the applicant brought the present action. On 6 August 2001, the Office lodged a response.

9 The applicant claims that the Court should:

— annul the contested decision;

— order the Office to admit the trade mark sought for publication;

— order the Office to pay the costs.

10 The Office contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

11 Since the applicant had informed the Court of First Instance at the hearing that it was in liquidation, the President asked it to state whether it wished to pursue the action by 15 September 2002 at the latest. By letter of 13 September 2002, the liquidator declared that the action brought by the applicant would be pursued. The President subsequently closed the oral procedure.

12 At the hearing, the applicant withdrew its second claim for an order against the Office to admit the trade mark sought for publication and the Court of First Instance took formal notice thereof in the minutes of the hearing. The applicant also produced certain documents. The Office did not object to the inclusion of those documents in the case file.

Law

13 The applicant raises two pleas in law alleging infringement of Article 7(1)(c) and Article 7(1)(b) respectively of Regulation No 40/94.

The plea alleging infringement of Article 7(1)(b) of Regulation No 40/94

Arguments of the parties

14 The applicant submits, generally, that even a minimal degree of distinctive character is sufficient to exclude the absolute ground of refusal laid down in

Article 7(1)(b) of Regulation No 40/94. In that regard, it refers to Case T-87/00 *Bank für Arbeit und Wirtschaft* v *OHIM (EASYBANK)* [2001] ECR II-1259, paragraphs 39 and 40.

15 The applicant submits that the abbreviation BioID is not directly descriptive of the goods and services concerned but is merely suggestive. In addition, the applicant claims that the abbreviation in question is an invented term which does not appear in any dictionary and is not actually used, except as a mark by the applicant only.

16 According to the applicant, even if the element 'ID' must be regarded as meaning 'identification', the abbreviation 'BioID' does not indicate how that identification is carried out. That is true regardless of the semantic content of the element 'Bio' (which, as the case may be, expresses the idea of a connection with life in general or with organic life or that of a connection with nature). In that context, the applicant observes that the goods and services concerned, which fall within the sector of data processing, are in no way connected with biology, nature or organic life.

17 The applicant submits that the graphic form of the mark applied for is so unusual that the targeted trade circles will perceive the mark as a distinctive sign.

18 Moreover, the applicant observes that the abbreviation Bioid has been registered in Germany as a word mark for the following goods and services: 'computer software recorded on data carriers of all kinds; printed matter; telecommunications; computer programming'. According to the applicant, the German Patent

and Trade Mark Office applies the grounds of refusal resulting from a lack of distinctive character in a relatively restrictive manner.

19 Finally, the applicant refers to decisions of the Office recognising the registrability of other marks containing the prefix 'bio', such as BIOWIRE, BIOTAG, BIOWATT, BIOSELECT, BIOPLOT, BIOSPRINT, BIOTECT, BIOSLIM, BIOPRIME and BIOSTAR. According to the applicant, those decisions concern marks similar to that at issue in the present case and, therefore, support the view that that mark should be regarded as registrable.

20 The Office contends that each of the elements of which the abbreviation BioID is composed is devoid of distinctive character in relation to the goods and services claimed and that the way in which those elements are combined does not alter that assessment. In that regard, the Office submits that, since the relevant public is formed by consumers with specialised knowledge who either are English speakers or, at least, have a knowledge of English, it will perceive the abbreviation in question as denoting 'biometric identification' and thus as an indication of the kind or intended purpose of the goods and services. In addition, the Office submits that the expression 'biometric identification' is actually used as a generic term by the applicant's competitors.

21 The Office submits that the graphic form of the mark applied for consists of a widely used standard typeface, namely 'Arial'. In addition, the Office states that the fact that each of the two syllables is represented by characters of different boldness cannot alter the overall perception of the mark by the consumer and that the use of upper case characters in the second syllable merely reinforces the descriptive character of the sign, because the element 'ID', which is generally used as an abbreviation of 'identification', will immediately be recognised as such. According to the Office, the graphic form of the trade mark applied for does not therefore alter its descriptive character and does not, in itself, endow it with distinctive character.

Findings of the Court

22 According to Article 7(1)(b) of Regulation No 40/94, 'trade marks which are devoid of any distinctive character' are not to be registered. In addition, 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'.

23 As is clear from the case-law, the signs referred to in 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 in connection with the presentation of the goods or services concerned or in respect of which there is, at least, evidence that they could be used in that way. Such signs do not enable the relevant public to repeat the experience of a purchase, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition of the goods or services concerned (see, to that effect, Case T-79/00 *Rewe-Zentral* v *OHIM (LITE)* [2002] ECR II-705, paragraph 26).

24 The distinctiveness of a mark can therefore be assessed only by reference to the goods or services for which registration of the mark has been requested and to the perception of the public targeted.

25 In its response, the Office stated that the relevant public was composed of consumers 'with specialised knowledge who are well informed about the goods on the market'. The applicant disputed that definition at the hearing and alleged that users of computers and the internet in general are also part of the relevant public. In the light of those arguments and having regard to the types of goods and services concerned, the Court of First Instance considers that the relevant public is, in any event, one with experience in the sector of the goods and services in question.

26 With respect to the mark applied for, it should be noted, first of all, that it contains not only a word element, namely the abbreviation BioID, but also figurative elements which, as such, are devoid of any semantic content, namely the typographical features of the abbreviation. In addition, it contains two graphic elements placed after the abbreviation BioID, namely a full stop (■) and a sign (®).

27 In that regard, it should be observed that Article 7(1)(b) of Regulation No 40/94 does not distinguish between different categories of trade marks. The criteria for the assessment of the distinctive character of trade marks composed of figurative elements or of a combination of word and figurative elements are no different from those applicable to other categories of trade mark. Moreover, a trade mark composed of several elements (a 'compound trade mark') must, for the purposes of assessing its distinctive character, be considered as a whole. However, that is not inconsistent with a successive examination of the different composite elements of the mark.

28 Firstly, the abbreviation BioID is composed of two elements ('Bio' and 'ID'). In English, the element 'ID' is a standard abbreviation of the noun identification, as the Board of Appeal demonstrated in paragraph 16 of the contested decision. The prefix 'Bio' may constitute either an abbreviation of an adjective ('biological', 'biometrical') or the abbreviation of a noun ('biology'). Thus, since the abbreviation BioID is composed of abbreviations which are part of the vocabulary of the reference language, it does not represent an exception to the lexical rules of that language and is therefore not unusual in its structure.

29 Moreover, it should be noted that, in the light of the goods and services claimed, the relevant public understands the abbreviation BioID as meaning 'biometrical identification'. In that respect, the applicant's claims that the various meanings of the element 'Bio' relate to the idea of life and not to the goods and services in question are irrelevant.

30 As regards, first of all, the goods within the categories described as 'computer software, computer hardware and parts therefor, optical, acoustic and electronic apparatus and parts therefor, all the aforesaid goods in particular for and in connection with the monitoring of user passwords, for computer intercommunication and for the computer-aided identification and/or verification of live organisms based on one or more specific biometric characteristics' (Class 9), it should be noted that the biometric identification of live organisms involves or even requires the use of those goods. To be more precise, biometric identification is one of several technical functions of those goods and not simply an area of use. Moreover, the application for registration of the mark expressly refers, albeit by way of guidance, to the use of the goods in the context of methods based on biometric identification. From the point of view of the relevant public, the abbreviation BioID is therefore perceived as being likely to be commonly used, in trade, to present those goods.

31 Further, as regards the services within the categories described as 'security services in connection with computer communications, access to databases, electronic payment transactions, the checking of user passwords and the computer-aided identification and/or verification of live organisms based on one or more specific biometric characteristics' (Class 38) and 'technical development of systems for monitoring user passwords, for computer intercommunication, and of systems for the computer-aided identification and/or verification of live organisms based on one or more specific biometric characteristics' (Class 42), it must be pointed out that, since those services are provided by means of biometric identification or relate to the development of systems for such identification, the abbreviation BioID directly refers to one of the qualities of those services, which may be taken into account by the relevant public when choosing such services. From the point of view of the relevant public, the abbreviation BioID is therefore also perceived as being likely to be commonly used, in trade, to present those services.

32 Finally, as regards the services within the categories described as 'telecommunications' (class 38) and 'providing of software on the internet and other communications networks, on-line maintenance of computer programs, com-

puter programming, all the aforesaid services in particular for and in connection with the monitoring of user passwords, computer intercommunication and the computer-aided identification and/or verification of live organisms based on one or more specific biometric characteristics' (Class 42), it should be observed that there is a close functional link between those services and the goods and services referred to in paragraphs 30 and 31 above. In addition, as regards the categories of services within class 42, the application for registration of the mark expressly indicates, albeit by way of guidance, that those services are provided in connection with methods based on biometric identification. Accordingly, it must be held that the abbreviation BioID is also likely to be commonly used, in trade, to present those services.

33 Furthermore, even if the abbreviation BioID is not likely to be commonly used, in trade, for the presentation of all the goods and services in the categories referred to in the application for registration, it should be observed that the applicant sought registration of the abbreviation at issue in respect of all those categories without distinguishing between the different goods and services which they cover. It is therefore appropriate to confirm the assessment of the Board of Appeal in so far as it relates to those categories of goods and services as a whole (see, to that effect, Case T-359/99 *DKV* v *OHIM (EuroHealth)* [2001] ECR II-1645, paragraph 33).

34 It follows that, since, from the point of view of the relevant public, the abbreviation BioID is likely to be commonly used, in trade, for the presentation of the goods and services in the categories referred to in the application for registration, it is devoid of distinctive character as regards those categories of goods and services.

35 Secondly, as regards the figurative sign composed of the typographical elements of the abbreviation BioID ('Arial' typeface, difference in the boldness of the characters used for the two syllables 'Bio' and 'ID'), paragraph 21 of the contested decision implies that the Board of Appeal considered that a compound

mark is devoid of distinctive character where the word element is descriptive of the goods and services concerned and the relative importance of the figurative elements is 'minimal' in comparison with that of the word element.

36 In that regard, it should be noted that the absence of distinctive character of a compound mark cannot be determined solely by reference to the relative importance of certain elements of which it is composed as compared with that of other elements of the mark, in respect of which an absence of distinctive character has been established. A compound mark cannot fall under Article 7(1)(b) of Regulation No 40/94 if one of its composite elements is distinctive in respect of the goods and services concerned. That is true even if the sole distinctive element of the compound mark is not dominant in relation to the other composite elements of the mark. It is therefore not permissible, for the purposes of Article 7(1)(b) of Regulation No 40/94, to disregard an element of a compound mark. Consequently, the Office authorities cannot dispense with an examination of some elements of a compound mark on the ground that their importance is minimal in comparison with that of other elements. On the contrary, the distinctive character of a compound mark must be assessed in the light of all the elements of which it is composed.

37 It must therefore be considered, in the present case, whether the figurative elements consisting of the typographical features of the abbreviation BioID are devoid of distinctive character in respect of the categories of goods and services concerned. The Office's response and the answers which it gave at the hearing to the questions put by the Court of First Instance in that respect indicate that the 'Arial' typeface and characters of different boldness are commonly used, in trade, for the presentation of all types of goods and services. The figurative elements are therefore equally likely to be used in that way for the goods and services covered by the application for registration of the mark. Accordingly, the claim made by the applicant at the hearing that, as a result of the presence of those elements, the

relevant public will be led to perceive the mark as an indication of origin is irrelevant. It must therefore be held that the figurative elements consisting of the typographical features of the abbreviation BioID are devoid of distinctive character in relation to the goods and services in question.

38 As regards the full stop (■), the applicant itself declared at the hearing that that element is commonly used as the last of several elements in a word mark, indicating that the mark is an abbreviation.

39 Finally, the Office rightly stated at the hearing that the function of the sign (®) is limited to indicating that the mark has been registered for a specific territory and that, in the absence of such registration, the use of that graphic element would be misleading for the public. Moreover, that element, in combination with one or more other signs, is commonly used, in trade, in presenting all types of goods and services.

40 Accordingly, the graphic elements referred to in paragraphs 38 and 39 above are likely to be used, in trade, to present the goods and services claimed and are therefore devoid of distinctive character in respect of those goods and services.

41 It follows that the mark applied for is composed of a combination of elements each of which is likely to be used, in trade, to present the goods and services claimed and is therefore devoid of distinctive character in respect of those goods and services.

42 Furthermore, the case-law shows that if a compound mark is composed only of elements devoid of distinctive character in respect of the goods and services concerned the overall mark is likewise likely to be commonly used in trade to present those goods and services. That would only not be the case if concrete evidence, such as, for example, the way in which the various elements are combined, were to indicate that the compound trade mark, taken as a whole, is greater than the sum of its parts (see, to that effect, the Opinion of Advocate General Ruiz-Jarabo Colomer in Case C-363/99 *Koninklijke KPN Nederland and PTT Nederland* [2004] ECR, paragraph 65).

43 Contrary to what the applicant claims, there appears to be no such evidence in the present case. The structure of the mark applied for — consisting, essentially, of the combination of a descriptive abbreviation with the typographical features described in paragraph 37 above and the graphic elements referred to in paragraphs 38 and 39 above — does not preclude the conclusion that the overall mark is likely to be commonly used in trade to present the goods and services in the categories referred to in the application for registration of the mark.

44 The trade mark applied for is therefore devoid of distinctive character in respect of the categories of goods and services concerned.

45 In its application, the applicant relied on the registration of the word mark Bioid in Germany and, at the hearing, on the registration in the United States of America of a figurative mark identical to that at issue in the present case. In that regard, it is settled case-law that the Community trade mark regime is an autonomous system with its own set of objectives and rules peculiar to it and that it applies independently of any national system (Case T-32/00 *Messe München* v *OHIM (electronica)* [2000] ECR II-3829, paragraph 47). The registrability of a sign as a Community mark can therefore be assessed only on the basis of the

relevant Community rules. The Office and, as the case may be, the Community judicature are not bound by a decision taken by a Member State or a third country acknowledging the registrability of the same sign as a national trade mark. That is the case even where that decision was taken in accordance with national legislation harmonised under Directive 89/104.

46 The applicant's arguments based solely on the registrations in Germany and the United States of America therefore have no bearing on the issue. Moreover, the applicant has put forward no substantive argument which might be derived from those national decisions and relied upon in support of the plea raised.

47 With respect to the applicant's arguments relating to the decisions of the Boards of Appeal recognising the registrability of other marks containing the element 'Bio', it should be observed that factual or legal grounds contained in a previous decision may certainly constitute arguments supporting a plea alleging infringement of a provision of Regulation No 40/94. Nevertheless, in the present case, the applicant has not relied on grounds contained in those decisions which might call into question the above findings as to the distinctive character of the trade mark applied for.

48 At the hearing, the applicant also relied on the registration by the Office of the word mark 'Bioid' for the categories of goods and services described as 'printing products', 'telecommunications' and 'computer programming'. In that regard, it should be observed that, contrary to what the applicant apparently claims, the figurative mark at issue in the present case and the word mark 'Bioid' are not interchangeable and that, as the Office rightly pointed out, the fact, in particular, that in the word mark 'Bioid' the letters 'id' are in lower case characters distinguishes it, as regards its semantic content, from the abbreviation 'BioID' as it appears in the mark applied for.

49 The plea alleging infringement of Article 7(1)(b) of Regulation No 40/94 must therefore be rejected with regard to all the categories of goods and services referred to in the application for registration of the mark.

50 Accordingly, it is unnecessary to consider the plea alleging infringement of Article 7(1)(c) of Regulation No 40/94. In accordance with well-established case-law, it is sufficient that one of the absolute grounds of refusal applies for the sign to be ineligible for registration as a Community trade mark (Case T-24/00 *Sunrider* v *OHIM (VITALITE)* [2001] ECR II-449, paragraph 28).

51 The action must therefore be dismissed.

Costs

52 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been asked for in the successful party's pleadings. Since the applicant has been unsuccessful, it must, having regard to the form of order sought by the Office, be ordered to pay the latter's costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby:

1. **Dismisses the action;**

2. **Orders the applicant to pay the costs.Delivered in open court in Luxembourg on 5 December 2002.**

Moura Ramos Pirrung Meij

H. Jung

Registrar

N.J. Forwood

President