JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)

19 November 2009 *

In Joined Cases T-425/07 and T-426/07,

Agencja Wydawnicza Technopol sp. z o.o., established in Częstochowa (Poland), represented by D. Rzążewska, lawyer,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by O. Montalto and K. Zajfert, acting as Agents,

defendant,

TWO ACTIONS brought against the decisions of the Fourth Board of Appeal of OHIM of 3 September 2007 (Cases R 1274/2006-4 and R 1275/2006-4), concerning

* Language of the case: Polish.

the applications for registration of the figurative marks 100 and 300 as Community trade marks,

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

composed of I. Pelikánová, President, K. Jürimäe and S. Soldevila Fragoso (Rapporteur), Judges,

Registrar: K. Pocheć, Administrator,

having regard to the applications lodged at the Court Registry on 16 November 2007,

having regard to the responses lodged at the Court Registry on 21 February 2008,

having regard to the order of 27 February 2008 joining Cases T-425/07 and T-426/07 for the purposes of the written and oral procedures,

having regard to the order of 29 April 2009 joining Cases T-425/07 and T-426/07 for the purposes of the judgment,

further to the hearing on 26 November 2008,

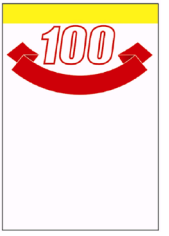
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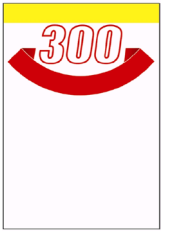
Judgment

Background to the dispute

1 On 15 June 2004, the applicant, Agencja Wydawnicza Technopol sp. z o.o. , filed two Community trade mark applications at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) 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 (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1)).

2 The marks for which registration was sought are the figurative signs 100 and 300 reproduced below:





3 The goods and services in respect of which registration of the marks was sought are in Classes 16, 28 and 41 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 for each of those classes:

— Class 16: 'Posters; albums; booklets; magazines; forms; printed matter; newspapers; calendars; crossword puzzles; rebuses';

— Class 28: ‘Manipulative puzzles; riddles; puzzles’;

— Class 41: ‘Organisation of competitions; publication of texts’.

4 By letters of 4 April 2006, the examiner informed the applicant that the signs were not eligible for registration for all the goods concerned, in accordance with Article 7(1)(b) and (c) of Regulation No 40/94 (now Article 7(1)(b) and (c) of Regulation No 207/2009). In its replies of 30 May 2006, the applicant maintained its position.

5 On 9 August 2006, the examiner refused to register the signs 100 and 300, on the basis of Article 7(1)(b) and (c) of Regulation No 40/94, for the following goods:

— Class 16: ‘posters, booklets, magazines, printed matter, newspapers’;

— Class 28: ‘Manipulative puzzles; riddles; puzzles’.

The examiner found that those signs were descriptive indications and that the colours and graphic elements used could not affect that conclusion.

6 On 27 September 2006, the applicant filed two appeals against the examiner's decisions.

7 On 22 February 2007, in accordance with Article 38(2) of Regulation No 40/94 (now Article 37(2) of Regulation No 207/2009), the President of the Fourth Board of Appeal requested the applicant to state within a period of two months that it disclaimed any exclusive right to the figures 100 and 300 included in the marks applied for. By two letters of 15 June 2007, the applicant refused to make the statements requested, arguing that the numerals were registrable. The Board of Appeal therefore dismissed the appeals by two decisions of 3 September 2007 ('the contested decisions').

Forms of order sought

8 The applicant claims that the Court should:

— annul the contested decisions in their entirety;

— order OHIM to pay the costs.

9 OHIM contends that the Court should:

— dismiss the actions;

— order the applicant to pay the costs.

Law

10 The applicant makes a preliminary observation on the registrability of numerals and in essence raises three pleas in law in support of its actions. The first plea in law alleges infringement of Article 38(2) of Regulation No 40/94, the second alleges infringement of Article 7(1) (c) of Regulation No 40/94, and the third alleges infringement of Article 7(1) (b) of that regulation.

Preliminary observation

Arguments of the parties

11 The applicant submits that Article 4 of Regulation No 40/94 (now Article 4 of Regulation No 207/2009) contains a general principle according to which numerals may be

registered as trade marks, and that there is no reason why numerals cannot help to distinguish in the market the goods or services of different competitors.

12 OHIM maintains that although that principle is correct, it only relates to the capability of numerals in theory to distinguish the goods and services in the market. That theoretical capability is a necessary, but not a sufficient, condition for registration, since the signs must also meet the requirements laid down in Article 7 of Regulation No 40/94.

Findings of the Court

13 It is clear from the wording of Article 4 of Regulation No 40/94 that numerals may be registered as Community trade marks.

14 However, in order to be registered, any sign must meet the requirements laid down in Article 7 of Regulation No 40/94, which prevents registration of signs not capable of fulfilling the function of identifying to the consumer the commercial origin of the goods or services covered by the application for registration (judgment of 9 July 2008 in Case T-302/06 *Hartmann* v *OHIM (E)*, not published in the ECR, paragraphs 29 and 30). Therefore, a numeral may be registered as a Community trade mark only if it is distinctive in relation to the goods and services covered by the application for registration and is not merely descriptive of those goods and services.

First plea in law, alleging infringement of Article 38(2) of Regulation No 40/94

Arguments of the parties

15 The applicant submits that the requirement to make a statement disclaiming any exclusive right to any of the elements of the marks applied for is unfounded since all the elements of those marks, and in particular the numerical elements '100' and '300', are distinctive. It states that, even if one of those elements were not distinctive, it would acquire distinctiveness in combination with other elements, since, in accordance with the case-law of the Court of Justice, a mark's distinctiveness must be assessed by reference to the overall impression produced by those elements.

16 The applicant also relies on the earlier registration of the signs 100 and 200, whose designs are less developed than those of the marks applied for, which gave the applicant cause to rely on the law as interpreted by OHIM.

17 OHIM contends that the plea in law should be rejected.

Findings of the Court

18 Article 38(2) of Regulation No 40/94 provides that where a trade mark contains an element which is not distinctive, and where the inclusion of that element could give rise to doubts as to the scope of protection afforded, OHIM may request, as a condition

for registration, that the applicant state that he disclaims any exclusive right to that element.

19 The function of those 'disclaimers' is to make apparent the fact that the exclusive rights of the proprietor of a mark do not extend to the non-distinctive elements of that mark. In that way, applicants may know that the non-distinctive elements of a registered mark in respect of which a disclaimer is made remain available for use.

20 The operation of Article 38 of Regulation No 40/94 is made clear by Rule 11(2) and (3) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1). In particular, the consequences of failing to submit the disclaimer required by OHIM are laid down in Rule 11(3) of Regulation No 2868/95. Thus, if an applicant fails to submit the disclaimer required by OHIM within the period specified, OHIM may refuse the application in whole or in part.

21 In the present case, the Court must determine whether the Board of Appeal was entitled, before holding against the applicant its failure to submit a disclaimer under Article 38(2) of Regulation No 40/94, to find, first, that the elements '100' and '300' of the marks applied for were not distinctive and, second, that their inclusion in the marks applied for might give rise to doubts as to the scope of protection of those marks.

22 First, as to the presence of non-distinctive elements in the marks applied for, it should be noted that the Board of Appeal referred in part to its decision of 7 August 2006 (Case R 447/2006-4), concerning the application for registration of the word mark 1000 (paragraph 18 of the contested decisions). In that regard, according to

settled case-law, a sufficient statement of reasons may be considered to have been given for a decision where the decision refers expressly to another document that has been communicated to the applicant, as in the present case (see Case T-304/06 *Reber* v *OHIM - Chocoladefabriken Lindt & Sprüngli (Mozart)* [2008] ECR II-1927, paragraph 48, and the case-law cited).

23 In its decision of 7 August 2006, the Board of Appeal in essence found that the figure 1000 could serve to designate the contents of the brochures and periodicals in Class 16. The Board of Appeal cites that decision as authority for finding in the present case that the elements '100' and '300' can designate the quantity, contents or issue of the goods concerned in Class 16. It also finds that those elements can designate the various components of the goods concerned in Class 28.

24 Even though the Board of Appeal made no finding in that regard, those goods must be regarded as targeted at the general public. Since the figures 100 and 300 are comprehensible in all the languages of the Community, the relevant public therefore comprises the average consumers of the goods in question throughout the European Community.

25 In the present case, the figures 100 and 300 refer to quantities, and will immediately be perceived by the consumer, without further thought, as a description of characteristics of the goods in question, in particular the number of posters in the sales batches, the number of pages in the publications or the number of pieces in the puzzles and riddles, which determine their degree of difficulty and are essential characteristics in deciding whether to make a purchase. Therefore, the relevant public will perceive those numerical elements as providing information on the goods designated and not as indicating the origin of the goods.

26 That conclusion cannot be invalidated by the applicant's arguments based on the case-law of the Court of Justice on assessing the distinctiveness of complex signs. In

the present case, the point is not to assess the distinctiveness of marks composed of elements which, taken separately, are not distinctive. It is to assess the distinctiveness of those elements in order to avoid improperly extending to them the exclusive rights deriving from marks. Therefore, whether the elements of the marks applied for are distinctive, for the purposes of Article 38(2) of Regulation No 40/94, must be assessed not by reference to the overall impression given by those marks, but by reference to the elements comprising them.

27 Second, as to whether there are doubts concerning the scope of protection, the Board of Appeal stated, at paragraph 19 of the contested decisions, that it was not possible to ascertain which element of the marks applied for would determine whether those marks were distinctive and this might give rise to doubts as to the scope of protection afforded. In the present case, the figurative elements of the marks applied for, that is to say the colours, frames, ribbons and the typography used, are too ordinary to make an impression on consumers. On the other hand, the numerals, as the only word elements, are more likely to attract the attention of the relevant consumers and they thus occupy a dominant position in the impression given by the marks applied for.

28 If registration of the marks applied for were not made subject to any conditions, the impression might therefore be given that the exclusive rights extended to the elements '100' and '300', thereby preventing them from being used in other marks. Consequently, the Board of Appeal was correct to find that the inclusion of those signs in the marks applied for might give rise to doubts as to the scope of protection afforded to the marks.

29 However, by its letters of 15 June 2007, the applicant refused to disclaim any exclusive right to those elements, arguing that the figures 100 and 300 were registrable. Moreover, those letters were received outside the two-month period specified by the

President of the Board of Appeal and the applicant has been unable to show that it had been granted an extension of time, in spite of its claims at the hearing. Since the applicant failed to submit the disclaimers referred to in Article 38(2) of Regulation No 40/94 and Rule 11(2) of Regulation No 2868/95, the Board of Appeal was therefore correct to refuse registration of the marks applied for, in accordance with Rule 11(3) of Regulation No 2868/95.

30 That conclusion cannot be invalidated by the applicant's argument based on the fact that the signs 100 and 200, whose designs are less developed that those of the marks applied for, have been registered by OHIM as Community trade marks for goods in Classes 16 and 28. In that connection, it should be noted that the legality of the decisions of the Boards of Appeal must be evaluated solely on the basis of Regulation No 40/94 and not on the basis of OHIM's previous practice in taking decisions (Case T-127/02 *Concept* v *OHIM (ECA)* [2004] ECR II-1113, paragraph 71, and judgment of 19 May 2009 in Joined Cases T-211/06, T-213/06, T-245/06, T-155/07 and T-178/07 *Euro-Information* v *OHIM* (*CYBERCREDIT*, *CYBERGESTION*, *CYBERGUICHET*, *CYBERBOURSE* and *CYBERHOME*), not published in the ECR, paragraph 44). In addition, in so far as that argument is to be interpreted as alleging that the principle of equal treatment has been infringed, it is apparent from settled case-law that the principle of equal treatment can be invoked only where the principle of legality has been observed, according to which a person may not rely, in support of his claim, on unlawful acts committed in favour of another (Case T-106/00 *Streamserve* v *OHIM (STREAMSERVE)* [2002] ECR II-723, paragraph 67, and judgment of 30 November 2006 in Case T-43/05 *Camper* v *OHIM — JC (BROTHERS by CAMPER)*, not published in the ECR, paragraphs 93 to 95).

31 It follows from the foregoing that the first plea in law must be rejected.

32 Since the Board of Appeal did not base the contested decisions on the lack of distinctiveness or on the descriptive character of the marks applied for, assessed by reference to the overall impression given by them, but on the fact they contain elements to

which Article 38(2) of Regulation No 40/94 is applicable, the second and third pleas in law, alleging infringement of Article 7(1) (b) and 7(1) (c) of Regulation No 40/94, are ineffective.

33 Consequently, the present actions must be dismissed in their entirety.

Costs

34 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. Since the applicant has been unsuccessful, it must be ordered to pay the costs in accordance with the form of order sought by OHIM.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby:

1. Dismisses the actions;

2. Orders Agencja Wydawnicza Technopol sp. z o.o. to pay the costs.

Pelikánová Jürimäe Soldevila Fragoso

Delivered in open court in Luxembourg on 19 November 2009.

[Signatures]