Reports of Cases

JUDGMENT OF THE GENERAL COURT (Eighth Chamber)

16 October 2014*

(Community trade mark — Application for Community word mark GRAPHENE — Absolute ground for refusal — Descriptiveness — Article 7(1)(c) of Regulation (EC) No 207/2009)

In Case T-458/13,

Joseba Larrañaga Otaño and **Mikel Larrañaga Otaño**, residing in Saint-Sébastian (Spain), represented by F. Bueno Salamero, lawyer,

applicants,

v

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

defendant,

ACTION brought against the decision of the Second Board of Appeal of OHIM of 10 June 2013 (Case R 208/2013-2), relating to an application for registration of the word mark GRAPHENE as a Community trade mark,

THE GENERAL COURT (Eighth Chamber),

composed of D. Gratsias, President, M. Kancheva (Rapporteur) and C. Wetter, Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 23 August 2013,

having regard to the response lodged at the Court Registry on 26 November 2013,

having regard to the fact that no application for a hearing was submitted by the parties within the period of one month from notification of closure of the written procedure, and having therefore decided, acting upon a report of the Judge-Rapporteur and pursuant to Article 135a of the Rules of Procedure of the General Court, to give a ruling without an oral procedure,

gives the following

* Language of the case: Spanish.

Judgment

Background to the dispute

1 On 18 May 2012, the applicants, Messrs Joseba Larrañaga Otaño and Mikel Larrañaga Otaño, jointly filed an application for registration of a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) under Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

2 The mark sought to be registered is the word sign GRAPHENE.

3 The goods in respect of which registration was sought are, inter alia, in Classes 13, 23 and 25 of the Nice Agreement of 15 June 1957 concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as revised and amended, and correspond, for each of those classes, to the following description:

— Class 13: 'Firearms; Ammunition and projectiles; explosives; fireworks';

— Class 23: 'Yarns and threads, for textile use';

— Class 25: 'Clothing, footwear, headgear'.

4 By decision of 28 November 2012, the examiner dismissed the application for registration of a Community trade mark for the goods referred to at paragraph 3 above on the grounds set out in Article 7(1)(b) and (c) of Regulation No 207/2009.

5 On 28 January 2013, the applicants lodged an appeal with OHIM under Articles 58 to 64 of Regulation No 207/2009 against the examiner's decision.

6 By decision of 10 June 2013 ('the contested decision'), the Second Board of Appeal of OHIM dismissed the appeal. It essentially found that the trade mark was, for all the goods referred to, devoid of distinctiveness and descriptive within the meaning of Article 7(1)(b) and (c) of Regulation No 207/2009.

7 As regards, first of all, the relevant public, the Board of Appeal held that the relevant public comprised both the general public and the specialist public such as, for example, professional security guards, demolition firms or textile manufacturers, and comprised consumers who speak English, since the word 'graphene' is an English one.

8 Secondly, with regard to the descriptiveness, within the meaning of Article 7(1)(c) of Regulation No 207/2009, of the trade mark applied for, the Board of Appeal first of all pointed out that it was clear from the documents produced by the applicants that that trade mark comprised an English word designating a bidimensional allotrope of carbon, and that the relevant English-speaking public would perceive the trade mark as the name of a specific material. On the basis of the same documents the Board stated, first of all, that although graphene was not a recent discovery, its isolation in 2004 had enabled scientists to identify its properties, in particular its bidimensional structure having the thickness of an atom, its transparency, its flexibility and elasticity, its thermal and electrical conductivity, its resistance, its lightness and its impermeability, or at least its controlled permeability; and, secondly, that the possible areas of application of nanomaterials such as graphene include information technology, mobile telephones and electronics, shielding, energy and the environment, medicine and health. Next, the Board reviewed separately the properties and applications of graphene specific to 'firearms' within Class 13; to 'ammunition and projectiles; explosives' within Class 13; to 'fireworks' within Class 13; to 'yarns and threads, for textile use' within Class 23; and to 'clothing,

footwear, headgear' within Class 25. For each of those five categories of goods, it found that, having regard to those properties and applications, the examiner was correct to hold that the goods referred to could contain graphene or be made using graphene. Finally, the Board concluded that the mark applied for was descriptive since the word 'graphene' directly informs the relevant public, particularly specialists, of a characteristic of the goods referred to, that is to say their composition, and the consumer identifies the sign applied for as the word for the material 'graphene', which is one of the components of those goods, without any intermediate cognitive process or further effort.

9 Thirdly, and finally, with regard to the lack of distinctiveness of the mark applied for within the meaning of Article 7(1)(b) of Regulation No 207/2009, the Board of Appeal held that the mark applied for was devoid of distinctiveness, on the ground that the relevant public would perceive it as the word for a material which is one of the components of the goods referred to, which indicates the characteristics conferred by that material on those goods and not their commercial origin.

Forms of order sought

10 The applicants claim that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

11 OHIM contends that the Court should:

— dismiss the action;

— order the applicants to pay the costs.

Law

12 In support of the application, the applicants raise three pleas, namely infringement of Article 7(1)(c) of Regulation No 207/2009; of Article 7(1)(b) of the same regulation; and of the principle of non-discrimination.

First plea: infringement of Article 7(1)(c) of Regulation No 207/2009

13 By their first plea, the applicants criticise the Board of Appeal for having found that the trade mark applied for was descriptive within the meaning of Article 7(1)(c) of Regulation No 207/2009 and, in this connection, they advance two pleas. By the first plea, while recognising that the relevant public will perceive the mark applied for as the name of a specific and particular material, they argue that there is no direct connection between the goods referred to in the application for registration and graphene, the properties of which do not, according to 'serious' scientific publications, constitute a 'panacea', and the applications of which are therefore limited to specific areas such as nanotechnology, information technology, electronics and telephone technology, none of which are associated with those goods. It is permissible to register as a trade mark a sign with a meaning, however little the meaning denotes the goods covered by that mark, as is the case here. By the second plea, they allege that the Board of Appeal's analysis related to general categories of goods, wrongly attributing to all the goods thus grouped together characteristics of graphene, such as impermeability or controlled permeability, which relate to particular goods only, such as ionic conductors and molecular storage apparatus.

14 OHIM disputes the applicant's arguments.

15 Article 7(1)(c) of Regulation No 207/2009 provides that 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 service are not to be registered.

16 The signs and indications referred to in Article 7(l)(c) of Regulation No 207/2009 are thus only those which may serve in normal usage, from the point of view of the relevant public, to designate, either directly or by reference to one of their essential characteristics, goods or services in respect of which registration is sought (judgment of 20 September 2001 in *Procter & Gamble* v *OHIM*, C-383/99 P, ECR, EU:C:2001:461, paragraph 39). It follows that, for a sign to be caught by the prohibition set out in that provision, there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see judgments of 22 June 2005 in *Metso Paper Automation* v *OHIM (PAPERLAB)*, T-19/04, ECR, EU:T:2005:247, paragraph 25 and the case-law cited, and 30 April 2013 in *ABC-One* v *OHIM (SLIM BELLY)*, T-61/12, EU:T:2013:226, paragraph 17 and the case-law cited).

17 The distinctiveness of a mark can therefore be assessed only, first, in relation to the perception of the section of the relevant public and, second, in relation to the goods or services referred to (see judgments of 27 February 2002 in *Eurocool Logistik* v *OHIM (EUROCOOL)*, T-34/00, ECR, EU:T:2002:41, paragraph 38, and 7 July 2011 in *Cree* v *OHIM (TRUEWHITE)*, T-208/10, EU:T:2011:340, paragraph 17 and case-law cited).

18 The concept of public interest which underlies Article 7(1)(c) of Regulation No 207/2009 requires that signs or indications which may serve, in trade, to designate characteristics of the goods or services in respect of which registration is sought may be freely used by all. That provision prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (judgments of 23 October 2003 in *OHIM* v *Wrigley*, C-191/01 P, ECR, EU:C:2003:579, paragraph 31, and 12 January 2006 in *Deutsche SiSi-Werke* v *OHIM*, C-173/04 P, ECR, EU:C:2006:20, paragraph 62) and prevents an undertaking from monopolising a descriptive term to the detriment of other undertakings, including its competitors, thus limiting the range of words available to them to describe their own goods (judgments of 6 March 2007 in *Golf USA* v *OHIM (GOLF USA)*, T-230/05, EU:T:2007:76, paragraph 32, and *SLIM BELLY*, cited at paragraph 16 supra, EU:T:2013:226, paragraph 18).

19 In this case, first of all, the definition of the relevant public used by the Board of Appeal (see paragraph 7 above), which is not contested by the applicants, must be approved.

20 With regard to the first plea, which relates essentially to there being no direct connection between the goods referred to and graphene at the current stage of technology, it must be observed that, according to settled case-law, in order for OHIM to refuse registration on the basis of the ground set out in Article 7(1)(c) of Regulation No 207/2009, the signs or indications comprising the trade mark need not actually be in use at the time when registration is applied for, for the purposes of describing goods or services such as those in respect of which the application is made or of describing the characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications may be used for such purposes. A word sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned (judgments in *OHIM* v *Wrigley*, cited at paragraph 18 supra, EU:C:2003:579, paragraph 32; of 21 January 2009 in *Korsch* v *OHIM (PharmaCheck)*, T-296/07, EU:T:2009:12, paragraph 43; and *SLIM BELLY*, cited at paragraph 16 supra, EU:T:2013:226, paragraph 36). Furthermore, it is immaterial whether the characteristics of the goods or services being described are commercially essential or secondary (see judgment in *SLIM BELLY*, cited at paragraph 16 supra, EU:T:2013:226, paragraph 37 and case-law cited).

21 It is also clear from the case-law that the fact that the mark applied for describes a characteristic which does not, at the current stage of the technology, exist does not preclude it being perceived as descriptive by the relevant public (see, to this effect, judgments of 16 September 2008 in *ratiopharm* v *OHIM (BioGeneriX)*, T-47/07, EU:T:2008:377, paragraph 30, and *ratiopharm* v *OHIM (BioGeneriX)*, T-48/07, EU:T:2008:378, paragraph 29).

22 Having regard to that case-law, it is sufficient, in order to justify refusal of the mark applied for in this case, that in the perception of the relevant public it be able to be used for the purposes of designating an actual or potential characteristic of the goods referred to, even if that characteristic does not yet pertain at the current stage of technology. That possibility must, pursuant to the case-law cited at paragraph 17 above, be assessed by reference to the perception of the relevant public and not according to the findings of scientific experts.

23 In this case, it must be pointed out that the Board of Appeal, at paragraphs 23 to 28 of the contested decision, set out material on the perception of the relevant public as to the properties and applications of graphene for five categories of goods: firstly, for 'firearms' within Class 13, the relevant properties of graphene are its electrical conductivity, its lightness and resistance and include, in particular, applications in the fields of information technology and electronics and shielding; secondly, for 'ammunition and projectiles; explosives' within Class 13, graphene's lightness and resistance are highly prized characteristics; thirdly, for 'fireworks' within Class 13, the electrical conductivity of graphene permits great spatial and temporal precision; fourthly, for 'yarns and threads, for textile use' within Class 23, impermeability or controlled permeability and resistance, lightness and flexibility are highly valued qualities; fifthly, for 'clothing, footwear, headgear' within Class 25, the Board of Appeal highlighted the thermal and impermeable properties of graphene, and its resistance.

24 It must be taken into account that, in so doing, the Board of Appeal rightly found, on the basis of a full examination, and taking account of the perception of the relevant public, that there was a sufficiently direct and specific link between the mark applied for and the goods referred to in the application for registration such as to enable the relevant public to perceive, immediately and without further thought, a description of an actual or potential characteristic of the goods, namely the fact that they contain graphene.

25 Since the Board of Appeal did not err in upholding the refusal of the mark applied for in application of the ground set out at Article 7(1)(c) of Regulation No 207/2009, the first plea cannot be accepted.

26 As to the second plea, essentially alleging that the fact that there is no analysis of the descriptiveness for each of the goods referred to, it must be borne in mind that, according to settled case-law, although the decision to refuse to register a trade mark must in principle state reasons in respect of each of the goods or services concerned, the competent authority may, where the same ground of refusal is given for a category or group of goods or services, use only general reasoning for all of the goods and services which are sufficiently directly and specifically connected, to the point that they comprise a category or group of goods of sufficient homogeneity (see judgment in *SLIM BELLY*, cited at paragraph 16 supra, EU:T:2013:226, paragraph 33; see also, to this effect, order of 18 March 2010 in *CFCMCEE* v *OHIM*, Case C-282/09 P, ECR, EU:C:2010:153, paragraphs 37 to 40; and to this effect, and by analogy, judgment of 15 February 2007 in *BVBA Management, Training en Consultancy*, ECR, C-239/05, EU:C:2007:99, paragraphs 34 to 38).

27 In this case, it is necessary to point out that the Board of Appeal, at paragraphs 23 to 28 of the contested decision, distinguished five homogeneous categories of goods referred to, namely 'firearms' within Class 13, 'ammunition and projectiles; explosives' within Class 13, 'fireworks' within Class 13, 'yarns and threads, for textile use' within Class 23, and 'clothing, footwear, headgear' within Class 25, which it analysed separately, setting out in respect of each one the specific properties and applications of graphene in the perception of the relevant public, before concluding that the mark applied for was descriptive for each of the homogeneous categories of the goods referred to (see paragraphs 8 above).

With regard, in particular, to 'yarns and threads, for textile use' and 'clothing, footwear, headgear', even if the impermeability or controlled permeability of graphene cannot be perceived in relation to those goods by the relevant public, the public will none the less perceive the other characteristics of graphene highlighted by the Board of Appeal in relation to those goods, that is to say its resistance, its lightness, its flexibility and its thermal properties.

28 Since the Board of Appeal duly stated its reasons for its decision with regard to each homogenous category of goods referred to, the second plea cannot succeed.

29 The first plea in law must therefore be dismissed.

Second plea: infringement of Article 7(1)(b) of Regulation No 207/2009

30 By the second plea, the applicants criticise the Board of Appeal for having also failed to take account of the distinctiveness of the mark applied for, since the word graphene is not the usual way of designating the goods referred to and does not give the relevant public any information on the possible characteristics of those goods.

31 It is settled case-law that it is evident from the wording of Article 7(1) of Regulation No 207/2009 that, if one of the absolute grounds for refusal listed in that provision applies, that suffices for the sign at issue not to be registrable as a Community trade mark (judgments of 19 September 2002 in *DKV* v *OHIM*, C-104/00 P, ECR, EU:C:2002:506, paragraph 29; 6 November 2007 in *RheinfelsQuellen H. Hövelmann* v *OHIM (VOM URSPRUNG HER VOLLKOMMEN)*, T-28/06, ECR, EU:T:2007:330, paragraph 43; and *SLIM BELLY*, cited at paragraph 16 supra, EU:T:2013:226, paragraph 45)

32 In this case, since the Board of Appeal correctly found the ground for refusal provided for in Article 7(1)(c) of Regulation No 207/2009, there is no need to examine the plea of infringement of Article 7(1)(b) of that regulation.

33 The second plea must therefore be dismissed.

Third plea: infringement of the principle of non-discrimination

34 By their third plea, the applicants allege an infringement of the principle of non-discrimination, taken together with the principles of equality of treatment and sound administration, on the basis that OHIM has previously permitted registration of the Community trade mark GRAFENO for goods in Classes 3, 7, 9 and 12, under number 10879682, and of the Community mark GRAPHENE for goods in Classes 4, 5, 8, 11, 14 to 21, 24 and 26 to 34, under number 10900645, without raising any objection as to the descriptiveness or lack of distinctiveness of those signs for the goods referred to.

35 It is sufficient to recall that, according to settled case-law, the legality of decisions of the Boards of Appeal which are adopted in the exercise of circumscribed powers and are not a matter of discretion must be assessed solely on the basis of Regulation No 207/2009, as interpreted by the Union judicature, and not on the basis of a previous decision-making practice of OHIM which cannot in any event bind the Union judicature (see judgments of 15 September 2005 in *BioID* v *OHIM*, C-37/03 P, ECR, EU:C:2005:547, paragraph 47; *Deutsche SiSi-Werke* v *OHIM*, cited at paragraph 18 supra, EU:C:2006:20, paragraph 48; and 30 April 2013 in *Boehringer Ingelheim International* v *OHIM (RELY-ABLE)*, T-640/11, EU:T:2013:225, paragraph 33).

36 Although, having regard to the principles of equality of treatment and of sound administration, OHIM must take into account the decisions already taken in respect of similar applications and consider with especial care whether it should decide in the same way or not, the way in which the principles of equal treatment and sound administration are applied must be consistent with respect for legality, such that

there cannot be equality in an unlawful act, and a person who files an application for registration of a sign as a trade mark cannot rely on a possibly unlawful act committed, to his advantage or to the benefit of someone else, in order to secure an identical decision (see, to this effect, judgment of 10 March 2011 in *Agencja Wydawnicza Technopol* v *OHIM*, C-51/10 P, ECR, EU:C:2011:139, paragraphs 73 to 76). Moreover, for reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered, and that examination must be undertaken in each individual case since the registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (see judgments in *Agencja Wydawnicza Technopol* v *OHIM*, EU:C:2011:139, paragraph 77, and *RELY-ABLE*, cited at paragraph 35 supra, EU:T:2013:225, paragraph 34).

37 In this case, it is clear from examination of the first plea that the Board of Appeal was right to find, on the basis of a full examination and having regard to the perception of the relevant public, that the application for a Community trade mark submitted by the applicants conflicted with the absolute ground for refusal set out in Article 7(1)(c) of Regulation No 207/2009. Consequently, pursuant to the case-law cited at paragraphs 35 and 36 above, that finding cannot be called into question by virtue of the mere fact that the Board of Appeal did not follow OHIM's decision-making practice in the present case (see, to that effect, judgment of 3 July 2013 in *Airbus* v *OHIM (NEO)*, T-236/12, ECR, EU:T:2013:343, paragraph 52), regardless of the matters set out at paragraph 34 above.

38 In addition, it must be observed that even if the registrations of trade marks relied on by the applicants (see paragraph 34 above) benefit under Article 99 of Regulation No 207/2009 from a presumption of validity in infringement proceedings brought before the Community trade mark courts, it none the less remains true that under Article 52 of that regulation they could, where appropriate, be declared invalid upon application to OHIM or by way of counterclaim in infringement proceedings.

39 The third plea must therefore fail.

40 Since none of the pleas in law relied upon by the applicant is well founded, the action must be dismissed in its entirety.

Costs

41 Under Article 87(2) of the Rules of Procedure of the General Court, 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 applicants have been unsuccessful, they must be ordered to pay the costs in accordance with the forms of order sought by OHIM.

On those grounds,

THE GENERAL COURT (Eighth Chamber)

hereby:

1. Dismisses the action;

2. Orders Joseba Larrañaga Otaño and Mikel Larrañaga Otaño to pay the costs.

Gratsias Kancheva Wetter

Delivered in open court in Luxembourg on 16 October 2014.

[Signatures]