OPINION OF ADVOCATE GENERAL RUIZ-JARABO COLOMER
delivered on 31 January 2002 [1]

1. This question seeking a preliminary ruling (the first to be referred by the Benelux Court of Justice) concerns the assessment of distinctive character in relation to composite word marks. The same question, from a similar perspective, is among the matters dealt with in Case C-363/99 *Koninklijke KPN Nederland* v *Benelux-Merkenbureau*, which concerns a reference for a preliminary ruling from the Gerechtshof te 's-Gravenhage, (Regional Court of Appeal, The Hague).

Facts

2. On 18 March 1996 Campina applied to the Benelux-Merkenbureau (Benelux Trade Marks Office — 'the BTMO') for registration of the term BIOMILD in respect of goods in Classes 29, 30 and 32 (food and beverages).

3. By letter of 3 September 1996, the BTMO sent Campina the notification provided for in Article 6a(3) of the Eenvormige Beneluxwet op de Merken (Uniform Benelux Trade Marks Law — 'the UBL'). Campina contested the reasons set out by the BTMO in that document; however, the BTMO informed Campina, by letter of 7 March 1997, that the registration applied for had been refused. Campina thereupon referred the matter, within the prescribed period, to the Gerechtshof te 's-Gravenhage appealing against the refusal under Article 6b of the UBL. The appeal was dismissed.

4. 'Bio' is a prefix which is frequently used to indicate a certain degree of authenticity in foodstuffs, whilst 'mild' means 'mild' in Dutch. 'Biomild' is a new word in the sense that it did not exist in Dutch before the application for registration. Synonyms exist for both BIO and MILD, which can also reasonably be used if it is intended to make clear to the public that the product in question possesses the combination of characteristics which those terms describe.

5. Campina has, since September 1996, made extensive use of the mark BIOMILD and has carried out large-scale advertising of the product which it offers under that mark, with the result that, even when the

1 — Original language: Spanish.

BTMO decided to refuse registration (7 March 1997), it could be assumed that the sign's distinctive character had increased appreciably or had at least come into being as a result of the sign's general use.

6. The Hoge Raad, to which the case was referred on appeal, referred nine questions to the Benelux Court of Justice for a preliminary ruling.

7. The Benelux Court of Justice took the view that, in order to reply to three of those questions, an interpretation of Articles 2 and 3(1) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1) ('the Directive') was necessary, given that the term 'all distinctive character' corresponds to the term 'any distinctive character' used in the Directive (and the corresponding term in the Paris Convention).

The questions referred for a preliminary ruling

8. By judgment of 20 June 2000, the Benelux Court of Justice decided to stay the proceedings and to refer the following questions to the Court of Justice of the European Communities for a preliminary ruling:

'1. Must Articles 2 and 3(1) of the Directive be construed as meaning that, in determining whether a sign consisting of a new word composed of a number of elements has sufficient distinctive character to be capable of serving as a mark for the goods in question, it must be assumed that that question is in principle to be answered in the affirmative even if each of those elements is itself devoid of any distinctive character for those goods, and that the position will be different only if there are other circumstances, for instance if the new word constitutes an indication, which is obvious and directly comprehensible for any person, of a commercially essential combination of properties which cannot be indicated otherwise than through use of the new word?

2. If Question 1 is answered in the negative: must it then be assumed that a sign consisting of a new word composed of various elements, each of which is itself devoid of any distinctive character for the goods in question within the meaning of Article 3(1) of

the Directive, is itself also devoid of any distinctive character, and that the situation may be different only if there are other circumstances which result in the combination of the component parts being greater than the sum of those parts, for instance where the new word indicates a certain creativity?

3. Does it make any difference for the answer to Question 2 whether synonyms exist for each of the component parts of the sign, with the result that competitors of the applicant for registration who wish to make it clear to the public that their products too contain the combination of properties indicated by the new word can reasonably also do so by using those synonyms?'

Analysis of the questions referred

9. As I have already pointed out, the questions referred by the Benelux Court of Justice are identical to those put by the Gerechtshof te 's-Gravenhage in Case C-363/99 *Koninklijke KPN Nederland* v *Benelux-Merkenbureau* relating to registration of the sign 'Postkantoor'.

10. For that reason, I shall refer to my Opinion of today's date in that case and, in particular, to paragraphs 35 to 48 and 65 to 76.

Conclusion

11. I suggest that the Court of Justice replies to the Benelux Court of Justice as follows:

(1) In determining whether a sign is capable of serving as a mark, the competent authority must, under First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks,

take into account not only the sign as it was filed, but also any relevant circumstances, including the possibility that distinctive character has been acquired through use or the risk of mistake or confusion from the point of view of the average consumer, and do so always in relation to the goods or services designated by the sign.

(2) Where a trade mark is composed of words, whether it is descriptive must be determined not only by reference to each of the terms considered individually but also by reference to the whole which they form. Any perceptible difference between the meaning conveyed by the combination of words for which registration is sought and the terms used in everyday language by the relevant group of consumers to designate the product or the service or their essential characteristics is apt to confer distinctive character on that combination of words. For those purposes, a difference may be regarded as perceptible where it concerns significant elements of the form or meaning of the sign.