JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)
26 November 2003 *

In Case T-222/02,

HERON Robotunits GmbH, established in Lustenau (Austria), represented by M. Bergermann and R. Hackbarth, lawyers,

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,

ACTION against the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 6 May 2002 (Case R 1095/2000-1) refusing to register the word mark ROBOTUNITS as a Community trade mark,

* Language of the case: German.

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

composed of: V. Tiili, President, P. Mengozzi and M. Vilaras, Judges,

Registrar: J. Plingers, Administrator,

having regard to the written procedure and further to the hearing on 9 July 2003,

gives the following

Judgment

Background to the dispute

1 On 18 May 1999 the applicant, formerly Heron Systemprofile GmbH, filed at the Office for Harmonisation in the Internal Market (OHIM) an application for a Community word mark under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.

2 The trade mark in respect of which registration was sought is ROBOTUNITS.

3 The goods in respect of which registration was sought, after amendment of the initial application on 3 May 2000, are in Classes 6, 7 and 9 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:

— 'Profiles of metal, guide rails of metal, shaped static elements, shaped connecting elements', within Class 6;

— 'Guides for machines, straight-line and longitudinal guides, pressure cylinders, linear cylinders with various types of drive system, shaped pneumatic elements', within Class 7;

— 'Conveyor belts, striking systems with position controls', within Class 9.

4 By decision of 15 September 2000, the examiner refused the application on the basis of Article 7(1)(c) of Regulation No 40/94 on the ground that the mark applied for was descriptive of the goods concerned.

5 On 13 November 2000, the applicant filed notice of appeal against that refusal, the grounds of which were set out in its statement of 15 January 2001. In the course of the appeal proceedings the applicant proposed, in the alternative, that the list of goods be limited to the following: 'Profiles of metal, shaped static elements, shaped connecting elements', within Class 6.

6 By decision of 6 May 2002 ('the contested decision'), the First Board of Appeal of OHIM dismissed the appeal brought by the applicant on the ground that Article 7(1)(c) of Regulation No 40/94 prevented the registration of the word mark ROBOTUNITS, as it could serve to designate the intended purpose of the goods in respect of which registration was sought. According to the Board of Appeal, the meaning of 'robotunits', taken as a whole, is 'robot unit' or 'robot part' and there is a direct and immediate relationship between the goods covered by the trade mark applied for and that mark, which thus unequivocally describes the intended purpose of the goods, namely the fact that those goods may be used for the assembly of automated and programmed machines or the fact that they are installed in assembled machines.

Procedure and forms of order sought

7 By application lodged at the Registry of the Court on 23 July 2002, the applicant brought the present action. On 15 October 2002, OHIM lodged its response at the Registry of the Court.

8 Upon hearing the report of the Judge-Rapporteur, the Court (Fourth Chamber) decide to open the oral procedure and, as a measure of organisation of procedure pursuant to Article 64 of the Rules of Procedure of the Court of First Instance, it requested the applicant to reply to a written question.

9 The parties presented oral argument and replied to the Court's oral questions at the hearing on 9 July 2003. At that hearing, the applicant filed documents relating to the registration of the trade mark ROBOTUNITS in the United Kingdom and OHIM lodged a copy of the home page of the applicant's internet site, as was noted in the record of the hearing.

10 The applicant claims that the Court should:

— annul the contested decision;

— order the defendant to pay the costs.

11 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

Arguments of the parties

12 In support of its action the applicant raises a single plea in law alleging infringement of Article 7(1)(c) of Regulation No 40/94.

13 The applicant considers, with reference to the judgment in Case T-359/99 *DKV* v *OHIM (EuroHealth)* [2001] ECR II-1645, that a sign or indication can be regarded as descriptive only if the relevant section of the public can establish the descriptive relationship immediately and without further reflection.

14 It points out that the term 'robotunits' does not exist in English and is a neologism formed in an unusual way. It submits in that regard that the Court of Justice clearly held in Case C-383/99 P *Procter & Gamble* v *OHIM* [2001] ECR I-6251 that, as regards trade marks composed of several words, the only thing which mattered was the whole which those words form. It concludes from this that since the Board of Appeal essentially based its decision on the component 'robot' it thereby infringed the principles laid down by the Court of Justice in *Procter & Gamble* v *OHIM*.

15 It also considers that, where the Board of Appeal bases its decision on the fact that the English language also permits the direct juxtaposition of two nouns, that should not excuse the Board from checking whether the sign specifically lodged can directly describe the goods in respect of which registration is sought. It criticises the contested decision for not setting out sufficient findings on that point.

16 It considers that it is not apparent from the contested decision what a robot unit or a robot part is supposed to be, even though the Board of Appeal considers that those terms translate the whole expression 'robotunits'. It submits that 'robot-units' cannot be understood as 'robot parts' because, in English, the terms used to designate a particular piece or part of a machine are 'machine part' or 'machine piece' and not 'machine unit'. The applicant considers in that regard that the sign is a fanciful term which is not used at all in trade by its competitors or by undertakings in other business sectors.

17 The applicant considers that the link between ROBOTUNITS and the goods referred to in the registration application can be made out only by passing through several stages of reasoning. Accordingly, ROBOTUNITS is not immediately and without further reflection descriptive of the goods in respect of which registration of the sign is sought. It considers that the fact that those goods may possibly also be used in connection with computers or robots does not suffice to render the sign descriptive, since that connection is not made sufficiently directly and specifically and without further reflection.

18 It claims that in the present case ROBOTUNITS is at most only suggestive of the goods referred to and is not clearly descriptive.

19 Moreover, the applicant considers that the contested decision was taken in disregard of the case-law of the Court of Justice and the Court of First Instance. It submits that, in *Procter & Gamble* v *OHIM*, cited above, the Court of Justice departed from the position adopted in the judgment in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779 as regards there being a real, current and serious need to leave a sign free, given that, in *Procter & Gamble* v *OHIM*, the Court no longer based its decision at all on a possible need to leave the sign free.

20 The applicant criticises OHIM for not having carried out a genuine analysis of the goods covered by its application by failing to assess the goods individually.

21 In its reply to the Court's written question, the applicant stated that its action refers to all the goods in respect of which registration is sought, after amendment of the initial application on 3 May 2000, within Classes 6, 7 and 9 of the Nice Agreement. Thus the goods in Class 6 in respect of which registration of

ROBOTUNITS is sought are not specific machine elements or finished or assembled machines, but metal profiles or elements and, more specifically, semi-finished or intermediate laminated, pressed or extruded goods which have no connection with robot units. On the contrary, such elements can be used in any field. The same applies to shaped static elements, which are elements of bridges or various framework elements, and to shaped connecting elements, which are not necessarily shaped themselves. Connecting elements are purely mechanical connections.

22 It also stated that guides for machines and straight-line and longitudinal guides within Class 7 are devices which force an object (machine part or similar) to adopt a particular trajectory and position when it moves (for example a straight-line guide). Similarly, pressure cylinders and linear cylinders with various types of drive system within Class 7 do not have a sufficiently direct and specific link with automated machines. As regards shaped pneumatic elements, the applicant submits that pneumatics is the technical branch concerning the behaviour of gases, and primarily the phenomena of compressed and aspirated air and their applications.

23 As for conveyor belts, the applicant explains that they are not components of automated machines, but — like guides for machines and straight-line and longitudinal guides within Class 7 — continuous support and driving devices in a closed circuit. Finally, it adds that striking systems with position controls within Class 9 are generally buffer elements, for example (tempered) steel parts in (cutting) tool gauges.

24 At the hearing, the applicant stated that the goods covered by the registration application may be used in programmed machines, but that this is one use amongst thousands of others. It considers, with reference to the judgment in Case

T-356/00 *DaimlerChrysler* v *OHIM (CARCARD)* [2002] ECR II-1963, paragraph 40, that such a use amongst others is not sufficient to render the sign descriptive since this is not a technical function of the goods in question.

25 Finally, in its reply to the Court's written question, the applicant stated that the international registration of the word mark ROBOTUNITS has just been granted protection in the United Kingdom for the goods in question in the present case. It attached to its reply a letter from the Patent Office dated 18 June 2003 which states that protection was granted in the United Kingdom with effect from 12 December 2002.

26 OHIM states that the Board of Appeal made a careful finding that, taken as a whole, the expression 'robotunits' is made up of two components: 'robot' and 'unit'. The definition of 'robot' is 'any automated machine programmed to perform specific mechanical functions in the manner of a man', and the definition of 'unit' is 'a single undivided entity or whole'. It concluded on the basis of an analysis of the semantic content of the mark applied for that the immediate meaning of the term 'robotunits' is 'robot unit' or 'robot part'.

27 OHIM submits that the Board of Appeal regarded the mark as immediately and clearly descriptive on the basis of the following: faced with the mark in relation to the goods in question, the relevant public will immediately understand that it unequivocally describes the intended purpose of the goods, namely the fact that those goods may be used for the assembly of automated and programmed machines or the fact that they are installed in assembled machines.

28 As regards the connection with the goods in question OHIM considers that the Board of Appeal considered in detail the goods covered by the Community trade mark application. In its view, the Board of Appeal referred to the goods on several occasions in its decision.

29 OHIM considers that the goods in Classes 7 and 9 in particular are special components of machines or assembled machines. As regards Class 6, the Board of Appeal found that the applicant had applied for registration of its mark in relation to all the goods referred to in Class 6, without distinction, thereby including goods which could be used for the assembly of automated and programmed machines or which are installed in assembled machines.

30 As regards the Board of Appeal's observance of the principle of assessment of whether the mark is registrable and of its descriptiveness for the relevant public, OHIM points out that the Board of Appeal referred to a public of specialists responsible for the study, construction and maintenance of all types of machine. OHIM considers that it must be borne in mind in this connection that the relevant machine parts are not used by the average consumer and that the relevant public is therefore a specialist one which is well informed about the goods available on the market. It infers from this that the United Kingdom consumer and any specialist consumer in the technical field will be familiar with the English language and will immediately understand the meaning of ROBOTUNITS.

31 As regards the descriptiveness of the mark, OHIM considers that this follows directly from the relationship between the mark and the goods and that there is no need for a certain effort of mental association in translating a message expressed suggestively into a rational assessment.

32 Finally, as regards the registration of the word mark ROBOTUNITS in the United Kingdom, OHIM submits that that evidence was adduced late. It adds that nothing in the documents filed by the applicant excludes the possibility that the registration in question was based on usage.

Findings of the Court

33 Pursuant to Article 7(1)(c) of Regulation No 40/94, registration of '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' is to be refused. Furthermore, Article 7(2) of Regulation No 40/94 states that 'paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community'.

34 The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are those which may serve in normal usage from the point of view of the target public to designate, either directly or by reference to one of their essential characteristics, the goods or service in respect of which registration is sought (*Procter & Gamble* v *OHIM*, cited above, paragraph 39). Therefore, the assessment of whether a sign is descriptive can be made only, first, in relation to the goods or services concerned and, second, in relation to the understanding which a target public has of them (Case T-34/00 *Eurocool Logistik* v *OHIM (EUROCOOL)* [2002] ECR II-683, paragraph 38).

35 In the present case, the goods covered by the trade mark applied for include, in particular, components of machines or assembled machines which may operate automatically or be programmed. It is also generally known, as the Board of Appeal points out in paragraph 17 of the contested decision, that machines of

that type are nowadays used in all sectors, whether in factories for the assembly of motor cars, for example, or for the transport of goods, in which case conveyor belts may be involved.

36 As regards the target public, the Board of Appeal found, in paragraph 18 of the contested decision, that the goods and services concerned are aimed at 'a public of specialists responsible for the study, construction and maintenance of all types of machine [and that whilst] that public is composed in particular of persons whose mother tongue is English, it should be acknowledged that it also includes persons with at least a rudimentary knowledge of (specialist) English since technical [language] includes numerous words which are used only in English'. The applicant has not challenged the Board of Appeal's definition of the target public.

37 Therefore, pursuant to Article 7(2) of Regulation No 40/94, the target public in respect of which it is necessary to assess the absolute ground for refusal is a specialised English-speaking public since the sign in question consists of elements of the English language.

38 Accordingly, for the purposes of Article 7(1)(c) of Regulation No 40/94 it is necessary to consider, on the basis of a given meaning of the sign in question, whether, from the point of view of the intended public, there is a sufficiently direct and specific association between the sign and the categories of goods or services in respect of which registration is sought (*CARCARD*, cited above, paragraph 28, and Case T-355/00 *DaimlerChrysler* v *OHIM (TELE AID)* [2002] ECR II-1939, paragraph 28).

39 A preliminary observation is that ROBOTUNITS is composed of two nouns from the English language. There is nothing unusual about the structure of that sign. It does not diverge from English word composition rules but rather complies with

them. Therefore it will not be perceived as unusual by the consumer concerned (*CARCARD*, cited above, paragraph 29).

40 As regards the meaning of ROBOTUNITS, it is clear from paragraphs 21 and 22 of the contested decision and from the explanations given by OHIM in its response that OHIM considers the sign to mean 'robot unit' or 'robot part'. In that connection, the applicant submits that the sign in question does not have a clear and specific meaning. In its view the term 'robot units' has no meaning. It adds that, in English, to designate a particular piece or part of a machine, the terms 'machine piece' or 'machine part' are used, but not 'unit'.

41 Having regard to the goods in respect of which registration is sought, the meaning adopted by the Board of Appeal is the right one. As OHIM states in its response (paragraphs 43 and 48), the word 'unit' also means 'a single item or a separate item of something larger' and 'a small machine or a part of a machine which has a particular purpose'. Furthermore, it must be observed that, in order to come within Article 7(1)(c) of Regulation No 40/94, it is sufficient that at least one of the possible meanings of a sign designates a characteristic of the goods or services concerned (*CARCARD*, cited above, paragraph 30).

42 As to how the sign ROBOTUNITS and the goods concerned are connected, the Board of Appeal found in paragraph 23 of the contested decision that the sign unequivocally describes the intended purpose of those goods.

43 As regards the categories of goods in respect of which registration of the sign is sought, the applicant does not deny that the goods concerned may be used in machines which can operate automatically or be programmed, but submits that the fact that those goods may possibly also be used in connection with computers or robots does not suffice to render the sign descriptive, since that connection is not made sufficiently directly and specifically and without further reflection.

44 It follows that the sign ROBOTUNITS taken as a whole may serve to designate one of the possible intended purposes of all the goods covered by the application for registration. Furthermore, the fact that this sign includes the word 'robot' must be regarded as designating one intended purpose of those goods which the target public is liable to take into account when making a choice and which accordingly constitutes an essential characteristic thereof. The applicant itself admitted in its written pleadings and at the hearing that the goods in respect of which registration of the sign is sought might possibly also be used in connection with computers or robots. Therefore there is a sufficiently direct and concrete connection between the sign ROBOTUNITS and those goods, from the point of view of the target public.

45 It cannot of course be excluded that those goods may consist in parts unconnected with an automated machine and that ROBOTUNITS is not therefore descriptive of all the goods within the categories of goods in respect of which registration is sought. In that regard it is sufficient to note that the applicant has requested registration of the sign in question for all those goods together, without distinction. Accordingly, the finding of the Board of Appeal to the effect that the application for registration relates to all those categories of goods taken together must be upheld (*EuroHealth*, cited above, paragraph 33; *TELE AID*, cited above, paragraph 34, and *CARCARD*, cited above, paragraphs 33 and 36).

46 Since the applicant has not limited its application for registration by excluding the use of the goods referred to as robot parts, the fact that the sign in question may

serve to designate one of the possible intended purposes of the goods covered by the trade mark application is a sufficient basis for refusing registration, on the ground that the mark is descriptive.

47 That finding is not undermined by the applicant's interpretation of paragraph 40 of *CARCARD*, cited above. In that judgment, the Court held that the goods listed as 'stationary and transportable data processing equipment; programs on data carriers for data and/or text and/or image processing' within Class 9 could be used in a way that also involved a card linked to a car, but that such use of the goods would constitute, at most, one of many possible areas of use thereof, but not a technical function. In the present case, the fact that the goods referred to in the application may be used in automated or programmed machines is one of the technical functions of those goods. The fact that those goods may also be used in machines which are not automated or programmed does not preclude that technical function from being precisely the characteristic which renders the sign ROBOTUNITS descriptive of those goods.

48 It follows that the sign ROBOTUNITS may serve, within the meaning of Article 7(1)(c) of Regulation No 40/94, from the point of view of the target public, to designate essential characteristics of the goods falling within the categories referred to by the registration application.

49 The applicant's argument that the judgment in *Procter & Gamble* v *OHIM*, cited above, departed from the judgment in *Windsurfing Chiemsee*, cited above, as regards the existence of a need to leave a sign free cannot be upheld. The Court of Justice expressly reaffirmed the position adopted in the case giving rise to the judgment in *Windsurfing Chiemsee* in Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraphs 73 and 74.

50 Finally, as regards the applicant's argument that the Patent Office has registered the mark ROBOTUNITS for the same goods as those with which the present action is concerned, it should first of all be noted that it is clear from a combined reading of subparagraphs (2) and (3) of Article 63 of Regulation No 40/94 that decisions of the Boards of Appeal may be annulled or altered only where they contain a substantive or procedural irregularity. Next, it is settled case-law that the legality of a Community measure falls to be assessed on the basis of the elements of fact and of law existing at the time when the measure was adopted (Case T-123/97 *Salomon* v *Commission* [1999] ECR II-2925, paragraph 48, and Case T-126/99 *Graphischer Maschinenbau* v *Commission* [2002] ECR II-2427, paragraph 33). The legality of a decision of the Board of Appeal cannot therefore be called into question by pleading new facts before the Court unless it is proved that the Board of Appeal should have taken those facts into account of its own motion during the administrative procedure before adopting any decision in the matter (Case T-247/01 *eCopy* v *OHIM (ECOPY)* [2002] ECR II-5301, paragraph 46). According to Article 74(2) of Regulation No 40/94, OHIM may disregard facts or evidence which are not submitted in due time by the parties concerned.

51 Accordingly, only factors of which OHIM could have been aware during the administrative procedure are to be taken into consideration. Therefore, the registration of the mark ROBOTUNITS in the United Kingdom cannot be taken into consideration.

52 It must also be borne in mind in this regard that the purpose of the Community trade mark is, according to the first recital in the preamble to Regulation No 40/94, to enable 'products and services of undertakings to be distinguished by identical means throughout the entire Community, regardless of frontiers', and that registrations already made in Member States are a factor which may only be taken into consideration, without being given decisive weight, for the purposes of registering a Community trade mark (Case T-122/99 *Procter & Gamble* v *OHIM (Soap bar shape)* [2000] ECR II-265, paragraphs 60 and 61, and Case T-32/00 *Messe München* v *OHIM (electronica)* [2000] ECR II-3829, paragraphs 45 and 46). Thus, registrations already made in Member States may provide analytical

support for the assessment of a Community trade mark registration application. However, the documents produced by the applicant on the registration of the relevant sign in the United Kingdom are not capable of providing the answer in the present case. Those documents do not disclose the reasons why registration of the relevant sign was accepted in the United Kingdom. Those documents show only that the sign in question was registered in respect of the goods referred to in those documents.

53 That finding is not undermined by the fact that, in reply to the Court's questions on whether registration in the United Kingdom was based on prior use of the mark, the applicant submitted that any registration on that basis would be apparent from the registration documents. That argument does not affect the resolution of the dispute since the documents supplied by the applicant do not prove that the Patent Office assessed whether the mark applied for was descriptive of the goods in question, as was stated in the preceding paragraph.

54 It follows from all the foregoing that the single plea in law alleging infringement of Article 7(1)(c) of Regulation No 40/94 must be rejected and therefore that the action must be dismissed as unfounded.

Costs

55 Under Article 87(2) of the Rules of Procedure, 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 the defendant.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber),

hereby:

1. **Dismisses the action;**

2. **Orders the applicant to pay the costs.**

Tiili Mengozzi Vilaras

Delivered in open court in Luxembourg on 26 November 2003.

H. Jung
Registrar

V. Tiili
President