JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)

31 January 2001 *

In Case T-331/99,

Mitsubishi HiTec Paper Bielefeld GmbH, formerly Stora Carbonless Paper GmbH, established in Bielefeld (Germany), represented by U. Ulrich, lawyer, with an address for service in Luxembourg,

applicant,

v

Office for Harmonisation in the Internal Market (Trade marks and Designs) (OHIM), represented by E. Joly, P. von Kapff and A. von Mühlendahl, acting as Agents, with an address for service in Luxembourg,

defendant,

APPLICATION for annulment of the decision of the Third Board of Appeal of the Office for Harmonisation in the Internal Market (Trade marks and Designs) of

* Language of the case: German.

8 September 1999 in Case R 175/1999-3 refusing registration of the word 'Giroform' as a Community trade mark,

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

composed of: V. Tiili, President, R.M. Moura Ramos and P. Mengozzi, Judges,

Registrar: G. Herzig, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 23 November 1999,

having regard to the defence lodged at the Registry on 10 March 2000,

further to the hearing on 5 July 2000,

gives the following

Judgment

Background to the dispute

1 On 28 April 1997 the applicant filed an application for registration of a Community trade mark with the German Patent Office (Deutsche Patentamt) which forwarded the application to the Office for Harmonisation in the Internal Market (Trade marks and Designs) ('the Office').

2 The mark in respect of which trade mark registration was sought was the word 'Giroform'.

3 The products covered by the application for registration fall within class 16 'paper, cardboard and goods made from those materials, not included in other classes; printed matter', 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.

4 By decision of 12 February 1999, the Office examiner refused the application in part under Article 38 of Council Regulation (EC) No 40/94 of 20 December

1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, on the ground that the word, for all the products within class 16 in respect of which registration was sought, except the sub-class 'cardboard and goods made from cardboard', was devoid of distinctive character and was exclusively descriptive.

5 On 12 April 1999, the applicant filed an appeal at the Office under Article 59 of Regulation No 40/94 against the examiner's decision refusing its application in part.

6 The appeal was dismissed by decision of 8 September 1999 ('the contested decision'), notified to the applicant on 23 September 1999, in which the Board of Appeal concluded that it was impossible to register the word 'Giroform' because there existed grounds for refusal under Article 7(1)(b) and (c) of Regulation No 40/94.

Forms of order sought by the parties

7 The applicant claims that the Court should:

— annul the contested decision and order the Office to publish the word 'Giroform' as a Community trade mark in accordance with Article 40 of Regulation No 40/94;

— order the defendant to pay the costs.

8 The defendant contends that the Court should:

— dismiss the application;

— order the applicant to pay the costs.

9 At the hearing, the applicant changed the form of order it sought and claimed, in the alternative, that the Court should order the Office to publish the word 'Giroform' with respect to paper and goods made from paper with the exception of forms used for bank transfer operations and printing products for paper-based transfers.

The claim for annulment

10 In support of its action the applicant pleads infringement of Article 7(1)(b) and (c) of Regulation No 40/94. The claim alleging infringement of Article 7(1)(c) of that regulation must be considered first.

Arguments of the parties

11 The applicant maintains that the Board of Appeal erred in law in finding that 'Giroform' was not a word capable of distinguishing the applicant's products from those of other undertakings.

12 It recalls that Article 7(1)(c) of Regulation No 40/94 prohibits the 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 time of production of the goods or of rendering of the service, or other characteristics of the goods or service. The descriptive nature of the trade mark must be clearly and unambiguously apparent.

13 The product in respect of which registration of the trade mark 'Giroform' was applied for consists of a paper compound forming a duplication medium similar to traditional carbon paper. The trade mark in question does not designate a finished product such as a form. In general, those who purchase that particular paper compound are printers using the paper to manufacture a product. There are, *ex hypothesi*, countless possible products in which the paper may subsequently be processed, such as, *inter alia*, the production of delivery orders, order confirmations and invoices. In consequence, the nature of the product in respect of which registration of the trade mark has been applied for is different from that of the forms used in the banking sector of which the Office considered the trade mark to be descriptive.

14 Even if the nature of the goods is not taken into account, there is in the circumstances no ground for refusal. The word 'giro' has several meanings and it is therefore impossible to regard it as directly descriptive. There is here an internal contradiction in the contested decision since, if the word 'giro' is a very general prefix, it cannot at the same time be directly descriptive. Furthermore, the trade

mark 'Giroform' is too vague to be seen as a clear and unambiguous indication. In those circumstances, the applicant's competitors, in whose interest it is to use clear and unambiguous terms, will not choose such a name to designate the intended purpose or nature of their goods.

15 The applicant challenges the Office's argument that the combination of 'giro' and 'form', in any event in the English-speaking part of the Community, constitutes a plain, clear, immediately recognisable indication of the nature and intended purpose of the product. It submits that the Office has not paid sufficient attention to the actual structure of the trade mark 'Giroform'. The combination of the words 'giro' and 'form' ought to be regarded as a single word beginning with a capital letter. However, in English those words usually begin with lower-case letters and expressions made up of compound words keep the words separate. The fact that the word 'Giroform' is spelt in an unusual and peculiar way constitutes a sufficient difference for the trade mark not to be considered to be descriptive. The object of the application concerned is to ensure protection of the 'Giroform' name and not of the terms 'giro form' or 'giro printed paper'.

16 Finally, the fact that the applicant has obtained registration for the same goods in such states as Australia, South Africa, Israel, Poland, Finland, Norway, Denmark, Greece and Bulgaria militates against a refusal to protect the trade mark. In particular, the fact that registration has been allowed in English-speaking countries argues in favour of its being possible to protect the trade mark 'Giroform'.

17 The Office contends, in essence, that inasmuch as the type of paper sold by the applicant is used, *inter alia*, for printing forms for paper-based bank transfers ('giro forms') the word 'Giroform' designates the quality and intended purpose of

the goods and may not, therefore, be registered, having regard to the absolute grounds for refusal set out in Article 7(1)(c) of Regulation No 40/94.

Findings of the Court

18 Under Article 4 of Regulation No 40/94, the decisive factor if a sign capable of being represented graphically is to be eligible for registration as a Community trade mark is its capacity to distinguish the goods of one undertaking from those of another.

19 One of the implications of this is that distinctive character can be assessed only in relation to the goods or services in respect of which registration of the sign is applied for.

20 Under Article 7(1)(c) of Regulation No 40/94, '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.

21 It was thus the intention of the legislature that such signs should, by their very nature, be regarded as incapable of distinguishing the goods of one undertaking from those of another.

22 Furthermore, Article 7(2) of Regulation No 40/94 states that Article 7(1) 'shall apply notwithstanding that the grounds of non-registrability obtain in only one part of the Community'.

23 In this case, the sign is composed exclusively of the words 'giro' and 'form', both of which are customary, at least in English-speaking countries. As pointed out in paragraph 21 of the contested decision, the word 'giro', from the Italian, is currently used in the field of banking in a precise sense, namely to designate the transfer of money between banks, and it appears as a prefix in numerous compound words in the sphere of banking transactions ('Girokonto', 'giro system', 'giro cheque, order') in order to designate transactions for making payments into current accounts held in credit institutions. The word 'form' has several meanings in English. When used to designate a paper product, however, it means a printed form.

24 Those two words, used together, therefore designate, in financial institution circles, a printed form relating to bank payment transactions for debiting a customer's account. The Office has produced evidence to show the current usage of the word with that meaning ('Electronic giro forms', 'Bank giro forms', 'Giro Form', 'Giro application form', 'Giro form'). In those circumstances, the Board of Appeal, relying on the way in which the word is perceived and normally understood in the relevant circles, was right in considering that it tells consumers of the intended purpose of the product (paragraph 18 of the contested decision). The fact that the product in respect of which registration of the trade mark was applied for can be used to print other sorts of forms does not invalidate that conclusion.

25 Moreover, the fact that the sign 'Giroform' consists of one word and begins with a capital letter whereas the expression 'giro form' consists of two words and in English is normally written in lower-case letters does not amount to evidence of any creative aspect capable of distinguishing the applicant's products from those of other undertakings (see Case T-163/98 *Procter & Gamble* v *OHIM ('Baby-*

Dry') [1999] ECR II-2383, paragraph 27, and Case T-19/99 *DKV Deutsche Krankenversicherung* v *OHIM ('Companyline')* [2000] ECR II-1, paragraph 26).

26 As regards the fact that the trade mark had previously been registered in certain Member States, it must be borne in mind that, according to the first recital in the preamble to Regulation No 40/94, the purpose of the Community trade mark is to enable 'the products and services of undertakings to be distinguished by identical means throughout the entire Community, regardless of frontiers'. So, registrations already made in the 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).

27 In those circumstances, having regard to the unitary character of the Community trade mark referred to in the second recital in the preamble to Regulation No 40/94, the Board of Appeal did not err in law in concluding that previous registration of the word mark in issue in some non-English-speaking Member States of the Community did not invalidate its conclusion.

28 Similarly, the Board of Appeal did not err in law with regard to previous registration of the trade mark in other countries which are English-speaking but not Member States of the Community, inasmuch as registration of trade marks in those states is governed by a system different from that of the Community.

29 It follows that the Board of Appeal correctly confirmed that, on the basis of Article 7(1)(c), the word 'Giroform' is not capable of constituting a Community trade mark.

30 As Article 7(1) of Regulation No 40/94 clearly states, for a sign to be ineligible for registration as a Community trade mark, it is sufficient that one of the absolute grounds of refusal should apply.

31 Consequently, it is not necessary to rule on the second plea in law alleging infringement of Article 7(1)(b) of Regulation No 40/94.

32 It follows that the claim for annulment must be dismissed.

The claim for an injunction to be directed to the Office

33 Under Article 63(6) of Regulation No 40/94, the Office is to take the measures necessary to comply with the judgment of the Court of Justice. Accordingly, the Court of First Instance is not entitled to issue directions to the Office. It is for the latter to draw the consequences of the operative part of this judgment and the grounds on which it is based (*Baby-Dry*, paragraph 53). This claim is therefore inadmissible.

Costs

34 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 defendant, be ordered to pay the latter's costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

1. **Dismisses the application;**

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

Tiili Moura Ramos Mengozzi

Delivered in open court in Luxembourg on 31 January 2001.

H. Jung
Registrar

V. Tiili
President