JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)

8 June 2005 *

In Case T-315/03,

Hans-Peter Wilfer, residing in Markneukirchen (Germany), represented by A. Kockläuner, lawyer,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by D. Schennen and G. Schneider, acting as Agents,

defendant,

* Language of the case: German.

ACTION brought against the decision of the First Board of Appeal of OHIM of 11 July 2003 (Case R 266/2002-1) concerning the registration of the word mark ROCKBASS as a Community trade mark,

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

composed of H. Legal, President, P. Lindh and V. Vadapalas, Judges,

Registrar: I. Natsinas, Administrator,

having regard to the application lodged at the Court Registry on 15 September 2003,

having regard to the response lodged at the Court Registry on 16 December 2003,

further to the hearing on 9 December 2004,

gives the following

Judgment

Background to the dispute

1 On 5 October 2001 the applicant filed a Community trade mark application at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) 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 for which registration was sought is the word mark ROCKBASS.

3 The goods in respect of which registration was sought are in Classes 9, 15 and 18 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:

— Class 9: 'Technical sound equipment, mixing desks, sound effect equipment, amplifiers, loudspeaker boxes, active loudspeaker boxes (combos); containers, cases and bags for the aforesaid goods';

— Class 15: 'Musical instruments, in particular guitars, electric guitars, bass guitars, acoustic guitars, guitar accessories, namely strings, frets, truss rods and straps; containers, cases and bags for the aforesaid goods';

— Class 18: 'Containers, cases and bags'.

4 By decision of 11 March 2002, the examiner refused the application pursuant to Article 7(1)(b) and (c) of Regulation No 40/94.

5 On 25 March 2002 the applicant appealed to OHIM against the examiner's decision under Articles 57 to 62 of Regulation No 40/94 and on 3 July 2002 he lodged a written statement setting out the grounds of that appeal.

6 On 2 July 2003 the applicant lodged an additional written statement containing a declaration by Mr Roesberg, a music magazine editor, and information on registrations of the ROCKBASS trade mark in Canada, Australia and New Zealand.

7 By decision of 11 July 2003 ('the contested decision'), notified to the applicant on 16 July 2003, the First Board of Appeal of OHIM dismissed the appeal under Article 7(1)(c) of Regulation No 40/94. Essentially, the Board of Appeal held that for the relevant public, composed of music specialists, the word 'rockbass' made reference to the bass guitar, which lends itself in particular to playing rock music,

and also designated a bass guitar technique — 'rock bass'. It therefore took the view that the word mark ROCKBASS was directly descriptive of musical instruments and their accessories, and of the other goods specified in the application, in so far as their descriptions include goods used in connection with bass guitars.

Forms of order sought by the parties

8 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

9 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

The request relating to the applicant's representation

10 At the hearing the applicant requested that it be noted that he was represented jointly by A. Kockläuner, lawyer, and S. Zech, Patentanwalt, or, in the alternative, that he was represented by A. Kockläuner, lawyer, assisted by S. Zech, Patentanwalt.

11 Mr Zech was authorised to address the Court at the hearing in the presence and under the supervision of the lawyer. However, the applicant's request for Mr Zech to be admitted as his representative cannot be granted. Under Article 19 of the Statute of the Court of Justice, only a lawyer authorised to practise before a court of a Member State or of another State which is a party to the Agreement on the European Economic Area (EEA) may represent or assist parties other than the States and institutions referred to in the first and second paragraphs of that article (see the order of the Court of First Instance of 9 September 2004 in Case T-14/04 *Alto de Casablanca* v *OHIM — Bodegas Chivite (VERAMONTE)* [2004] ECR II-3077, paragraph 9, and the case-law cited).

The attestation concerning the registration procedure for the ROCKBASS trade mark in the United States presented at the hearing

12 At the hearing the applicant lodged an attestation concerning the registration procedure for the ROCKBASS trade mark in the United States.

13 It should be noted first of all that it is clear from a reading of subparagraph (2) in conjunction with subparagraph (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. 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 (see Case T-222/02 *HERON Robotunits* v *OHIM (ROBOTUNITS)* [2003] ECR II-4995, paragraphs 50 and 51, and the case-law cited).

14 In the present case, the attestation lodged by the applicant was made after the contested decision was adopted. Furthermore, the evidence relating to the registration procedure for the ROCKBASS trade mark in the United States does not constitute facts which the Board of Appeal should have taken into account of its own motion before adopting the contested decision. Consequently, the attestation at issue cannot call into question the legality of that decision and must therefore be excluded from the proceedings.

The application for annulment

15 In support of his action, the applicant raises four pleas in law. The first plea concerns a failure by the Office to examine facts of its own motion. Whilst alleging a failure to comply with the obligation to state reasons, the applicant, in his second plea, essentially complains that the Board of Appeal failed to take into account the documents which he produced in his additional written statement of 2 July 2003. The third and fourth pleas are based on the infringement of Article 7(1)(c) and (b) of Regulation No 40/94.

First plea in law: failure by the Office to examine facts of its own motion in contravention of the first sentence of Article 74(1) of Regulation No 40/94

Arguments of the parties

16 The applicant claims that OHIM did not examine facts of its own motion in contravention of the first sentence of Article 74(1) of Regulation No 40/94 in so far as it failed to take into account information obtained from the internet in support of registration of the sign.

17 According to the applicant, OHIM in particular failed to take into account the fact that, on the internet, the word 'rockbass' was mainly used either to refer to his goods or to designate fish, namely 'rock bass'. As far as other examples of the use of this word are concerned, he claims that OHIM misunderstood the fact that they did not concern the essential characteristics of the goods in question.

18 OHIM contends that in the contested decision the Board of Appeal refers to 11 internet websites and examines their content. In addition, the applicant's complaint concerns the substance of the decision. Furthermore, OHIM maintains that Article 74(1) of Regulation No 40/94 is the expression of a procedural principle and not of an obligation imposed on it to examine facts of its own motion to a specific degree.

Findings of the Court

19 In the words of the first sentence of Article 74(1) of Regulation No 40/94 'in proceedings before it the Office shall examine the facts of its own motion'.

20 The Court has held that the examination carried out by the competent authority for trade marks must be a stringent and full examination, in order to prevent trade marks from being improperly registered (see, with regard to 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), Case C-104/01 *Libertel* [2003] ECR I-3793, paragraph 59). For reasons of legal certainty and proper administration, it is necessary to ensure that trade marks whose use could successfully be challenged before the courts are not registered (see, with regard to Directive 89/104, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 21).

21 It is established in the present case that the Board of Appeal examined a number of internet sites and that it took that information into account for the purposes of examining the trade mark application under Article 7(1)(c) of Regulation No 40/94. It should be pointed out in this regard that in the contested decision the Board of Appeal was not required to refer to all the information that it was able to find on the internet. In addition, the fact that the information includes several references to the use of the trade mark applied for in relation to the applicant's goods is not, in itself, such as to call into question the Board of Appeal's conclusion regarding the descriptive character of the sign within the meaning of Article 7(1)(c) of Regulation No 40/94.

22 Furthermore, the applicant's argument that OHIM misinterpreted the information found on the internet is actually directed at the assessment of the facts by the Board of Appeal in the contested decision. This argument should therefore be considered as part of the examination of the plea in law concerning an infringement of Article 7 (1)(c) of Regulation No 40/94.

23 Consequently, the first plea in law must be rejected.

Second plea in law: failure to take into account evidence submitted by the applicant

Arguments of the parties

24 The applicant complains that the Board of Appeal did not consider his additional written statement of 2 July 2003 and its annexes, containing the affidavit of Mr Roesberg, a music magazine editor, and the information on earlier registrations of the ROCKBASS trade mark. In the applicant's view, OHIM was required to explain why that additional evidence did not have to be taken into account.

25 OHIM contends that the written statement of 2 July 2003 was produced one year after the written statement setting out the grounds of appeal and just nine days before the contested decision was adopted. Since some time passed before the documents lodged were presented to the rapporteur in the case, the written statement in question had not actually been brought to the attention of the Board of Appeal.

26 OHIM also contends that the Board of Appeal was not permitted to take that written statement into account by reason of Article 74(2) of Regulation No 40/94 and even that it was prohibited from taking note of the content of a written statement lodged while the draft decision was being drawn up, otherwise it would have acted in breach of the principle of proper administration of justice.

27 Furthermore, the affidavit of Mr Roesberg produced by the applicant merely reiterated an argument which the applicant had already made before OHIM and

which the Board of Appeal considered in the contested decision. As regards the earlier registrations in non-Member States, only minor importance could be attached to this argument in the present case.

Findings of the Court

28 Under the third sentence of Article 59 of Regulation No 40/94, in appeals against decisions of the examiners, a written statement setting out the grounds of appeal must be filed within four months after the date of notification of the decision.

29 That provision cannot be construed as preventing new facts or evidence submitted during the hearing of an appeal on an absolute ground for refusal from being taking into account after the expiry of the prescribed period within which the grounds of appeal must be presented. Article 74(2) of Regulation No 40/94, which provides that OHIM may disregard facts or evidence which are not submitted in due time by the parties concerned, allows the Board of Appeal discretion in taking into account additional evidence produced after that period has expired. In addition, in response to a question asked by the Court of First Instance at the hearing, OHIM stated that the procedure for examining absolute grounds for refusal before the Boards of Appeal makes no provision for a specific period after the expiry of which the parties may no longer rely effectively on new facts or produce additional arguments.

30 It follows that in the present case the Board of Appeal should have examined the additional written statement of 2 July 2003 in order to ensure, at the very least, that it did not contain any new facts or evidence to be considered having regard to Article 74(2) of Regulation No 40/94.

31 In its written pleading and at the hearing OHIM admitted that the applicant's additional written statement had not been considered by the Board of Appeal. In this respect OHIM failed entirely to establish that, when the applicant's additional written statement was received, the Board of Appeal's decision had been adopted and that the Board of Appeal was therefore no longer, in practical terms, in a position to take it into account. It should also be pointed out that OHIM cannot merely contend that considerations relating to its administrative organisation did not allow the written statement in question to be brought to the attention of the Board of Appeal.

32 Therefore, in failing to consider that written statement the Board of Appeal made a procedural error.

33 However, a procedural irregularity will entail the annulment of a decision in whole or in part only if it is shown that had it not been for the irregularity the contested decision might have been substantively different (see, by analogy, Joined Cases 209/78 to 215/78 and 218/78 *Van Landewyck and Others* v *Commission* [1980] ECR 3125, paragraph 47, and Case C-142/87 *Belgium* v *Commission* [1990] ECR I-959, paragraph 48; see also Case C-447/02 P *KWS Saat* v *OHIM* [2004] ECR I-10107, paragraphs 47 to 50). It should be noted that the additional written statement lodged by the applicant with the Board of Appeal did not contain any new arguments or new evidence that was likely to affect the substance of the contested decision.

34 It is not disputed that Mr Roesberg's affidavit was submitted only in support of two arguments already relied on by the applicant before the examiner and before the Board of Appeal. Those two arguments, which were examined in paragraphs 19 to 22 of the contested decision, concerned, respectively, whether the word 'rockbass'

designates only a style of music and whether there exist bass guitars intended specifically for playing that style of music. It follows that Mr Roesberg's affidavit could not have affected the substance of the contested decision.

35 As regards the information on the registrations of the ROCKBASS trade mark in Canada, Australia and New Zealand, it must be borne in mind that the Community trade mark regime is an autonomous system with its own set of rules and pursuing objectives peculiar to it; it is self-sufficient and applies independently of any national system (Case T-32/00 *Messe München* v *OHIM (electronica)* [2000] ECR II-3829, paragraph 47). According to case-law, registrations already made in Member States are not a decisive factor, but may be taken into account only for the purposes of registering a Community trade mark, in particular by providing analytical support for the assessment of a Community trade mark application (see Case T-393/02 *Henkel* v *OHIM (shape of a white and transparent bottle)* [2004] ECR II-4115, paragraph 46, and the case-law cited). It follows, a fortiori, that registrations made in third countries, whose legislation is not subject to Community harmonisation, cannot in any way serve as proof that identical criteria to those set out in Article 7(1)(c) of Regulation No 40/94 were regarded as having been met.

36 Accordingly, since the additional written statement of 2 July 2003 did not contain any new matters of such a kind as to affect the substance of the contested decision, the Board of Appeal's failure to consider that written statement cannot result in the annulment of that decision.

37 It follows from the foregoing that the second plea in law must be rejected.

Third plea in law: infringement of Article 7(1)(c) of Regulation No 40/94

Arguments of the parties

38 The applicant disputes, first of all, the definition of the relevant public adopted by the Board of Appeal, according to which the goods in questions are aimed at music specialists. According to the applicant, the relevant public must be construed as the average, well-informed consumer.

39 With regard to the sign ROCKBASS, the applicant cites various meanings of its component parts. He also claims that in the English language the combination of words 'rock bass' has a specific meaning, namely the fish called the 'rock bass', which is extremely unusual in relation to the goods claimed. The sign in question, characterised by an unusual grammatical structure and an ambiguous meaning, is therefore seen by the relevant public as a fanciful expression.

40 The applicant goes on to assert that, despite its possible descriptive connotations, the sign ROCKBASS cannot constitute, in relation to the goods in question, a clear, plain indication that is not liable to be misunderstood. In particular, since the bass guitar does not possess any particular characteristics for rock music, it does not seem natural to understand the term 'rockbass' as an indication of a particular type of bass guitar or as the description of a function of the bass guitar.

41 Even if the term 'rockbass' indicates a bass guitar playing technique, this meaning is not descriptive of the use of the goods, since practically any style of music can be

played on any instrument. Consequently, the relationship between the sign and bass guitars is not direct, in particular because it does not relate to their essential characteristics.

42 As far as guitar accessories are concerned, the applicant states, with reference to the Court's judgment in Case T-219/00 *Ellos* v *OHIM (ELLOS)* [2002] ECR II-753, paragraph 41, that the case-law requires a separate examination of each category of goods or services claimed. In the present case, the word 'rockbass' has no clear link with either the essential characteristics of guitar accessories in Class 15 or with the goods designated in Classes 9 and 18.

43 OHIM contends that the meaning of the sign must be analysed with reference to the relevant public for the goods mentioned in the application and that the technical point of view has little importance. In this case, the relevant public is composed of practising professional or amateur musicians, who are a group of consumers who have specific knowledge or can ask for advice in a specialist shop.

44 As far as the components of the sign in question are concerned, OHIM states that the word 'bass' means both a musical instrument and the low notes of a piece of music. The word 'rock' corresponds, in this context, to rock music. It is irrelevant that the sign and its components may have other meanings in a different context. Thus, the sign in question, formed by a syntactically common juxtaposition of two words, designates, using a clear and grammatically correct form, a bass for playing rock.

45 That conclusion also follows from research carried out on several internet websites, including those indicated by the applicant, which make reference to the word 'rockbass' as a musical instrument.

46 OHIM contends that the applicant's argument that there exist no bass guitars specifically made for playing rock is unimportant to the relevant public, who understand the word 'rockbass' without further analysis of the technical possibilities. In order to establish the descriptive character of the sign in question, it is sufficient to indicate clearly to the consumer that the guitar also lends itself to playing rock.

47 In OHIM's submission, the ground for refusal applies not only to the category of goods in Class 15, which includes bass guitars, but also to all the goods mentioned in the application. With particular regard to sound equipment in Class 9, such equipment is needed in order to play rock with an electric bass guitar, which cannot produce sound without the use of amplifiers and loudspeakers. As regards the containers, cases and bags in Class 18, the sign is descriptive inasmuch as they are used to transport guitars and sound equipment, since the sign in question is construed as being a reference to the content of the cases.

48 As regards accessories, such as strings, frets, truss rods and straps, OHIM maintains that there are no accessories as such for the purposes of the application of Article 7 (1) of Regulation No 40/94, because such goods always accompany a particular main product, sharing its fate. Such a conclusion clearly follows from Article 12(c) of Regulation No 40/94. Even though the Court of First Instance took a different point of view in the judgments in Case T-219/00 *Ellos*, cited above, paragraph 41, and Case T-140/00 *Zapf Creation* v *OHIM (New Born Baby)* [2001] ECR II-2927, paragraph 31, OHIM considers an approach requiring a separate examination for each product covered by the application for registration, without account being taken of the relationship with other goods, to be inappropriate.

Findings of the Court

49 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.

50 Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (Case C-191/01 P *OHIM* v *Wrigley* [2003] ECR I-12447, paragraph 31, and Case T-219/00 *Ellos*, cited above, paragraph 27).

51 In that context, 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 services in respect of which registration is sought (Case C-383/99 P *Procter & Gamble* v *OHIM* [2001] ECR I-6251, paragraph 39). Accordingly, a sign's descriptiveness can only be assessed by reference to the goods or services concerned and to the way in which it is understood by the relevant public (Case T-356/00 *DaimlerChrysler* v *OHIM (CARCARD)* [2002] ECR II-1963, paragraph 25).

52 In the present case, with regard to the relevant public, the Board of Appeal ruled in paragraph 15 of the contested decision that the goods in question were intended for a specialist public, composed of professional and amateur musicians. However, as OHIM stated in its arguments, whilst the relevant consumers do not necessarily have specific knowledge, they can always ask for advice in a specialist shop.

53 Thus, it must be held that the relevant public here is composed of professional and amateur musicians, who do not necessarily have specific technical knowledge.

54 Since the sign ROCKBASS is composed of two English nouns, 'rock' and 'bass', the relevant public is, first and foremost, an English-speaking public. It should be noted, however, that the words composing the sign exist, with possible minor variations, in other Community languages.

55 As the Board of Appeal stated, one of the meanings of the word 'rock' designates a style of music and the word 'bass' designates inter alia the lowest sounds in a piece of music or the musical instrument which produces such sounds, for example a bass guitar.

56 In response to the applicant's argument, with reference to the different meanings of the components of the sign ROCKBASS, that the sign does not have a clear, distinct meaning, it must be stated that the descriptive character of a sign must be assessed in relation to the goods or services in respect of which registration has been sought (see, to that effect, Case T-222/02 *HERON Robotunits* v *OHIM (ROBOTUNITS)*, cited above, paragraph 41). In the present case, the Board of Appeal rightly adopted the meanings specifically connected with the goods in question.

57 It follows that, as the Board of Appeal held, the word 'rockbass' designates a bass guitar which lends itself to playing rock music or, conversely, a style of music played with a bass guitar.

58 That finding cannot be called in question by the fact that the word in question does not appear as such in dictionaries.

59 In that regard it should be noted that the Court of Justice has held that a trade mark consisting of a neologism composed of elements each of which is descriptive of characteristics of the goods or services in respect of which registration is sought is itself descriptive, unless there is a perceptible difference between the neologism and the mere sum of its parts; that assumes that, because of the unusual nature of the combination in relation to the goods or services, the neologism creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed (see, in connection with Directive 89/104, Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 100, and Case C-265/00 *Campina Melkunie* [2004] ECR I-1699, paragraph 43).

60 In the present case, the sign ROCKBASS does not diverge from English word composition rules, since it corresponds to the syntactically correct juxtaposition of the two words that make it up. There is therefore nothing unusual about the structure of the word (see *CARCARD*, paragraph 29, and *ROBOTUNITS*, paragraph 39), which does not create an impression far removed from that produced by the mere combination of meanings lent by its components.

61 With regard to the applicant's argument that technically there exist no bass guitars specifically intended for playing rock music, it should be borne in mind that, for the application of Article 7(1)(c) of Regulation No 40/94, it is sufficient for the sign to be descriptive of one of the possible intended purposes of the goods at issue, which the relevant public is liable to take into account when making a choice and which accordingly constitutes an essential characteristic thereof (*ROBOTUNITS*, paragraph 44, and Case T-311/02 *Lissotschenko and Hentze* v *OHIM (LIMO)* [2004] ECR II-2957, paragraph 41).

62 It is common ground that playing rock music is one of the possible intended purposes of the goods in question. Rock is a very well-known modern style which is associated with the electric guitar. Consequently, the reference to that style, followed by the reference to the electric bass guitar, is liable to be taken into account when a choice of guitar is made, particularly if the consumer intends to play rock music. Moreover, as the Board of Appeal has illustrated with reference to various internet sites, the sign composed of the words 'rock' and 'bass' is likely to be commonly used in trade to designate an electric bass guitar intended for playing rock music. The question of the technical accuracy of such a designation is not pertinent from the point of view of the relevant consumer, who does not have particular technical knowledge.

63 Consequently, with regard to bass guitars, the Board of Appeal rightly held that the sign ROCKBASS related directly to those goods, and to one of their intended purposes which the relevant public was liable to take into account when making a choice, and was therefore descriptive.

64 As regards the other musical instruments in Class 15 to which the application for registration relates, it must be observed that the applicant has applied for registration of the sign at issue for all goods in that category without drawing any distinction between them. Therefore, the Board of Appeal's assessment must be confirmed in so far as it relates to all goods in that category (see, to that effect, Case T-359/99 *DKV* v *OHIM (EuroHealth)* [2001] ECR II-1645, paragraph 33, Case T-106/00 *Streamserve* v *OHIM (STREAMSERVE)* [2002] ECR II-723, paragraph 46, Case T-355/00 *DaimlerChrysler* v *OHIM (TELE AID)* [2002] ECR II-1939, paragraph 34, *CARCARD*, paragraphs 33 and 36, and Case T-358/00 *Daimler-Chrysler* v *OHIM (TRUCKCARD)* [2002] ECR II-1993, paragraphs 34 and 37).

65 As regards the goods described in the application as being guitar accessories, namely strings, frets, truss rods and straps, containers, cases and bags for guitars, which are

all in Class 15, it should be pointed out that a designation of goods as 'accessories' has only indicative value (*New Born Baby*, paragraph 31).

66 Furthermore, a sign's descriptiveness must be assessed individually by reference to each of the categories of goods or service listed in the application for registration. For the purposes of assessing a word's descriptiveness in respect of a particular category of goods or service, one thing which is immaterial is whether the applicant for the trade mark in question is contemplating using or is actually using a particular marketing concept involving goods and services in other categories in addition to the goods and services within that category (*TELE AID*, paragraph 42, *CARCARD*, paragraph 46, and *TRUCKCARD*, paragraph 47).

67 Nevertheless, the services and goods specified in the trade mark application may be inseparably linked since the purpose of those services can only be the installation of those goods and a solution which is common to the goods and services should therefore be adopted (see, to that effect, Case T-216/02 *Fieldturf* v *OHIM (LOOKS LIKE GRASS... FEELS LIKE GRASS... PLAYS LIKE GRASS)* [2004] ECR II-1023, paragraph 33).

68 In the present case, both the goods designated in the application for registration as guitar accessories and containers, cases and bags for guitars are intended to be used exclusively in connection with guitars. An identical position should therefore be adopted with respect to those Class 15 goods as was previously outlined in relation to bass guitars.

69 That finding cannot, moreover, be called into question by an individual analysis of the abovementioned goods, which do not have any intended purpose other than in connection with handling guitars. Thus, if registration of the sign ROCKBASS were claimed solely for containers, cases and bags for guitars, and not for the guitars themselves, it would have to be held that ROCKBASS evokes the sole intended purpose of those goods.

70 In relation also to containers, cases and bags in Class 18, since the applicant has not drawn any distinctions within this generic category the Board of Appeal's findings must be confirmed in so far as they relate to all goods in that category.

71 With respect to the equipment in Class 9, it is clear from the arguments of the parties that the same equipment may be used for different instruments. Their use in connection with the bass guitar is therefore just one of their possible uses.

72 It should be pointed out in this connection that, according to the case-law, there is a sufficiently direct and specific relationship between the sign and the goods in question where the technique evoked by the sign involves, or indeed requires, the use of those goods. That technique does not merely constitute in this case a field in which those goods are applied but rather is one of their specific functions (see, to that effect, *STREAMSERVE,* paragraph 44). Accordingly, the fact that the goods in question may also be used in another way, to which the sign in question does not refer, cannot undermine that finding (*ROBOTUNITS*, paragraph 47).

73 In the present case, even though the equipment in question is not intended to be used exclusively in connection with bass guitars, it is nevertheless not used

autonomously in relation to the handling of electric instruments. In addition, that equipment must be used in order to play the electric guitar, which is not capable of producing musical sounds on its own. Thus, the possibility of playing an electric bass guitar is a function of the equipment referred to in the application and not simply one of the many fields in which the equipment is applied. In particular, the combined use of these two categories of goods is required or, at the very least, implied by their inherent characteristics.

74 For the reasons set out in paragraphs 69 and 70, the same solution must be adopted with regard to the containers, cases and bags for the abovementioned goods as for the goods for which they are designed.

75 In the light of the above considerations, the link between the sign ROCKBASS and the characteristics of all the goods referred to in the application for registration is sufficiently close to fall within the scope of the prohibition under Article 7(1)(c) of Regulation No 40/94.

76 The third plea in law must therefore be rejected.

77 In those circumstances, it is not necessary to examine the fourth plea in law concerning an infringement of Article 7(1)(b) of Regulation No 40/94. It is clear from Article 7(1) of Regulation No 40/94 that, for a sign to be ineligible for registration as a Community trade mark, it is sufficient that one of the absolute grounds for refusal applies (Case C-104/00 P *DKV* v *OHIM* [2002] ECR I-7561, paragraph 29).

78 Having regard to the foregoing, the Court must dismiss the action in its entirety.

Costs

79 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. However, under the first subparagraph of Article 87 (3) of the Rules of Procedure, the Court may order that the costs be shared where the circumstances are exceptional.

80 Whilst the applicant was unsuccessful, the Board of Appeal nevertheless failed to consider the applicant's additional written statement of 2 July 2003 and therefore committed a procedural error. The applicant must therefore be ordered to bear three quarters of its own costs and pay three quarters of the costs incurred by OHIM and OHIM must be ordered to bear one quarter of its own costs and pay one quarter of the costs incurred by the applicant.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

1. Dismisses the action;

2. **Orders the applicant to bear three quarters of its own costs and pay three quarters of the costs incurred by OHIM;**

3. **Orders OHIM to bear one quarter of its own costs and pay one quarter of the costs incurred by the applicant.**

Legal Lindh Vadapalas

Delivered in open court in Luxembourg on 8 June 2005.

H. Jung H. Legal

Registrar President