OPINION OF ADVOCATE GENERAL SHARPSTON

delivered on 6 July 2006 [1]

1. The present reference from the Hof van Beroep (Court of Appeal), Brussels, which arises out of a refusal to register a trade mark, raises a number of questions of interpretation of Article 3 of the Trade Marks Directive. [2]

The Trade Marks Directive

2. The preamble to the Trade Marks Directive includes the following recitals:

'[3] it does not appear to be necessary at present to undertake full-scale approximation of the trade mark laws of the Member States and it will be sufficient if approximation is limited to those national provisions of law which most directly affect the functioning of the internal market;

...

[5] Member States also remain free to fix the provisions of procedure concerning the registration, the revocation and the invalidity of trade marks acquired by registration; ... they can, for example, determine the form of trade mark registration and invalidity procedures ... ;

...

[7] attainment of the objectives at which this approximation of laws is aiming requires that the conditions for obtaining and continuing to hold a registered trade mark are, in general, identical in all Member States; ... the grounds for

1 — Original language: English.

2 — 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).

refusal or invalidity concerning the trade mark itself, for example, the absence of any distinctive character, ... are to be listed in an exhaustive manner'.

3. Article 3(1) provides:

'The following shall not be registered or if registered shall be liable to be declared invalid:

...

(b) trade marks which are devoid of any distinctive character;

(c) 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 other characteristics of the goods or service ...'.

4. Article 3(3) provides:

'A trade mark shall not be refused registration or be declared invalid in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration and following the use which has been made of it, it has acquired distinctive character. Any Member State may in addition provide that this provision shall also apply where the distinctive character was acquired after the date of application for registration or after the date of registration.'

5. Article 13 provides:

'Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.'

6. The Directive leaves the procedure for registration to the Member States (including for this purpose Benelux).

Benelux trade mark law

...

7. Under the Uniform Benelux Law on Trade Marks ('the UBL'), applications for trade marks in Benelux must be made to the Benelux-Merkenbureau (Benelux Trade Mark Office; 'the BMB' [3]).

8. At the material time, [4] Article 6*bis*(1)(a) of the UBL provided that registration was to be refused if the sign as filed did not constitute a mark within the meaning of Article 1, 'particularly due to lack of any distinctive character as provided in Article 6*quinquies*B(ii) of the Paris Convention'.

9. That article of the Paris Convention for the protection of industrial property [5] states, in so far as is relevant:

'B. Trademarks covered by this Article may be neither denied registration nor invalidated except in the following cases:

(ii) when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed'.

10. Article 6*bis*(2) of the UBL provides that a refusal to register a mark must concern the sign constituting the mark as a whole, but may be limited to one or several of the products which the mark is intended to cover.

11. Article 6*ter*(1) provides that an applicant whose mark has been refused registration may, on appeal to the relevant Court of Appeal (the Cour d'Appel/Hof van Beroep, Brussels, the Cour d'Appel, Luxembourg, or the Gerechtshof, the Hague), seek an order that the mark be registered.

3 — The Trade Marks Directive specifically applies to trade marks which are the subject of a registration or an application for registration in the Benelux Trade Mark Office: Article 1.

4 — It appears that Article 6*bis*(1) has subsequently been amended (with effect from 2004) and now reflects more closely the wording of Article 3(1)(a) to (d) of the Trade Marks Directive.

5 — Of 20 March 1883, as subsequently revised and amended.

The Nice Agreement

12. Registration of a trade mark under the Directive may be sought for goods or services. In practice, trade mark and service mark applications in respect of goods or services are now usually made by reference to the system of classification established by the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, [6] an international treaty administered by the World Intellectual Property Organisation.

13. The Nice Classification established by that agreement comprises 45 class headings accompanied by explanatory notes; and an alphabetical list of goods and services, with the class in which each product or service is placed. The class headings describe in very broad terms the nature of the goods or services contained in each of the 34 classes of goods and 11 classes of services. The explanatory notes describe in greater detail, where appropriate, the type of product or service included in the classes concerned. The alphabetical list comprises about 10 000 indications referring to goods and 1 000 indications referring to services.

14. The trademark offices of the contracting States of the Nice Agreement are required to include in the official documents and publications relating to registrations of marks the numbers of the classes of the classification to which the goods or services for which the mark is registered belong. [7]

15. Belgium, Luxembourg and the Netherlands are all party to the Nice Agreement. [8]

The *Vlaamse Toeristenbond* case

16. It appears from the order for reference and the observations in the present case that the referring court is not convinced that the earlier decision of the Benelux Court of Justice in *Benelux-Merkenbureau* v *Vlaamse Toeristenbond* [9] is compatible with the case-law of this Court and that that is what underlies the reference.

6 — Of 15 June 1957, as revised and amended.

7 — Article 2(3) of the Nice Agreement.

8 — As are all other Member States with the exception of Cyprus and Malta (both of which in fact use the Nice Classification).

9 — Case A 2002/2, judgment of the Benelux court of 15 December 2003.

17. In that case, Vlaamse Toeristenbond had sought registration of the word mark LANGS VLAAMSE WEGEN for all goods and services in classes 16, [10] 39 [11] and 41 [12] of the Nice Agreement. [13] The BMB refused registration for those three classes on the ground that the mark was purely descriptive in relation to those goods and services and hence lacked any distinctive character.

18. Vlaamse Toeristenbond appealed to the Hof van Beroep (Court of Appeal), Brussels, with a view to obtaining an order that the mark be registered for all the goods and services for which it had been sought or, in the alternative, that the Court of Appeal determine the goods and services for which the mark was to be registered.

19. The Court of Appeal allowed the appeal in part, and ordered the BMB to register the mark for goods and services in two of the three classes excluding certain specified goods and services. [14] It held that the BMB, when assessing whether a mark is registrable, must consider that question not only for the classes concerned as a whole but also for each product and service listed in the class.

20. The BMB took the view that the Court of Appeal could not, pursuant to Article *6ter* of the UBL, order partial registration for given goods or services if the BMB had refused registration not for those specific goods or services but for a complete class of goods or services. The BMB accordingly appealed on a point of the law to the Belgian Hof van Cassatie (Court of Cassation), which sought a preliminary ruling from the Benelux Court of Justice on the interpretation of Articles 6*bis* and 6*ter* of the UBL.

21. The Benelux Court of Justice ruled that pursuant to those articles the Courts of Appeal of the Benelux countries [15] were competent to rule solely on the validity of the BMB's refusal to register a mark. That implied that the appellate court could take into consideration only the elements on which the BMB had based or should have based its decision. Consequently the appellate court could not hear claims which went beyond that decision or which had not been

10 — 'Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.'

11 — 'Transport; packaging and storage of goods; travel arrangement.'

12 — 'Education; providing of training; entertainment; sporting and cultural activities.'

13 — Strictly speaking, the classes form part of the Classification rather than the Agreement, but the Court usually refers to classes of the Agreement.

14 — Judgment of 16 May 2000 (1998/AR/1599).

15 — See point 11 above.

made before the BMB. The Benelux Court of Justice accordingly held that, pursuant to Articles 6*bis* and 6*ter* of the UBL, those Courts of Appeal were authorised to order registration of a mark for specific goods or services within a class only if the BMB had also ruled on those goods or services as such and had not limited its decision to the class as a whole.

22. Following that ruling, the Hof van Cassatie [16] annulled the judgment of the Court of Appeal, Brussels, on the basis that it took account of elements other than those on which the BMB had based or should have based its decision.

The proceedings in the present case

23. In April 2000, BVBA Management Training en Consultancy ('MT&C') filed the word mark THE KITCHEN COMPANY [17] with the BMB with a view to its registration as a mark for certain goods in classes 11, 20 and 21 and certain services in classes 37 and 42 of the Nice Agreement. For each of the classes referred to, the specific goods and services for which trade mark protection was sought were listed. [18]

24. The BMB refused registration of the mark on the ground that it was solely descriptive of the kind, quality, origin or intended purpose of the goods and services

16 — No C.00.0472.N, judgment of the Court of Cassation of 13 May 2004.

17 — It is interesting to note that the proposed mark consists of a combination of English words although the official languages of the jurisdiction where registration is sought do not include English. The referring court notes: 'Neither this combination of words nor the component parts thereof appertain as such in the Benelux territory to one of the languages predominantly spoken there by local consumers to whom the mark is directed; nor are they used in common parlance in order to indicate the goods and services for the purposes of Article 3(1)(c) of the EC Trade Marks Directive. Nevertheless, it must be supposed that the English language has secured a sufficient foothold in the language communities in the Benelux territory for the consumer to whom the sign applied for is directed aurally to recognise the words in question as English, both singly and in combination, even though that language is not specifically used in the context of the goods and services appertaining to the goods and services mentioned.' That analysis reflects the approach taken by Advocate General Jacobs and the Court in Case C-421/04 *Matratzen Concord* [2006] ECR I-2303 and in my Opinion, delivered on 30 March 2006, in Case C-108/05 *Bovemij Verzekeringen*.

18 — '(11) ovens with control panels, hot plates, refrigerators, microwave ovens, freeze boxes, deep freezers, boilers, electrical chip friers, ovens, built-in grills, extractor hoods, kitchen sinks, taps; (20) wooden and plastic kitchen furniture, kitchen chairs, kitchen work surfaces made of wood, plastic, granite, natural stone or tiled; (21) kitchen utensils and household and kitchen equipment made of glass, porcelain, non-precious metals, plastic and earthenware; (37) the placing and assembly of kitchen furniture and apparatus, maintenance and repair activities; (42) advising in relation to use, nature and application of kitchen apparatus, planning and advising in regard to the installation of kitchens and built-in apparatus, including at the time of purchase.'

mentioned in classes 11, 20, 21, 37 and 42 provided by, for or in connection with a kitchen company, and accordingly had no distinctive character. The referring court notes that the BMB did not formulate a final conclusion in respect of each of the separate goods and services but, in respect of the protection sought as a whole, merely stated that the sign applied for lacked any distinctive character.

25. MT&C has challenged that refusal before the referring court. It seeks annulment of the contested decision and an order that the BMB register its application in respect of classes 11, 20, 21, 37 and 42. In the alternative, it seeks an order for registration in respect of the classes for which the court considers that distinctive character does exist.

26. The referring court takes the view that, with regard to the goods and services in classes 11, 20, 37 and 42, the word combination lacks any distinctive character. With regard to the goods in class 21 for which protection is sought, however, the referring court considers that the mark is descriptive, on the basis of nature and intended purpose, only with regard to kitchen utensils. As regards the other goods, the word combination 'The Kitchen Company' will not, in the perception of the averagely well informed consumer, on the basis of spontaneous linguistic reflex, refer to the intended use of the goods. The referring court concludes that since it is not descriptive, the mark is indeed distinctive with regard to those goods. [19]

27. The BMB has objected before the referring court to that approach. It submits that the court cannot uphold MT&C's claim in the alternative for registration for the goods and services with regard to which the court considers the mark to be distinctive. That is because MT&C did not specifically request the BMB to consider registration with regard to certain goods or services only; and, following the judgments of the Benelux Court of Justice and the Belgian Court of Cassation in *Vlaamse Toeristenbond*, the national appellate court cannot adjudicate on matters neither covered by the BMB's decision nor raised before the BMB.

28. The referring court is unsure whether that case-law can be squared with the judgment of the Court of Justice in *Postkantoor*. [20] In that case the Court held that (i) a trade mark office must take account of the relevant facts and circumstances before making a final decision whether to register a trade mark; [21] (ii) the court reviewing that decision must also have regard to all the

19 — I.e., household and kitchen equipment made of glass, porcelain, non-precious metals, plastic and earthenware.

20 — Case C-363/99 [2004] ECR I-1619.

21 — Paragraph 36.

relevant facts and circumstances, subject to the limits on the exercise of its powers as defined by the relevant national legislation; [22] and (iii) where registration of a mark is sought in respect of various goods or services, the trade mark office must check, in relation to each of those goods or services, that none of the grounds for refusal listed in Article 3(1) of the Trade Marks Directive applies to the mark and may reach different conclusions depending upon the goods or services in question. [23]

29. The referring court considers that it follows from *Postkantoor* that the trade mark office must examine the application for registration in respect of each of the goods and services for which protection is sought; and that it may in respect of each of them reach divergent conclusions. If so, the provisional and final decisions refusing registration must so state.

30. It also considers that the 'relevant facts and circumstances' may change between the moment when the trade mark authority reaches a decision against which an appeal is brought and the moment when the court reviewing that decision reaches a determination on the appeal.

31. In the present case the BMB did not formulate a final conclusion in respect of each of the separate goods and services. It simply gave a decision in general terms that the sign applied for lacked any distinctive character.

32. According to the referring court, the consequence of such a general decision for the court reviewing the decision may be that, under its national legislation, that court cannot take account of all relevant facts and circumstances, as required by *Postkantoor*. That is because a 'relevant fact' in the assessment of the mark may be that no ground of refusal is available in respect of one product, but may be so available for others included in the application. If the decision does not refer to each product or service individually, the court of review cannot exercise its competence where (i) national legislation prescribes that that court may adjudicate only in respect of matters which were before the trade mark authority and which come within its decision and (ii) neither the application for registration nor the decision focused on the individual goods and services.

22 — Ibid.

23 — Paragraph 73.

33. The referring court has accordingly stayed the proceedings and has referred the following questions concerning Article 3 of the Trade Marks Directive to the Court for a preliminary ruling:

'(1) Is the trade mark authority required, after its examination of all relevant facts and circumstances concerning an absolute ground of refusal, to state in its provisional and in its definitive decision on the application its conclusion in regard to each of the goods and services separately in respect of which trade mark protection is sought?

(2) May the relevant facts and circumstances to be taken into account by the adjudicating authority in the event of an appeal against the decision of the trade mark authority be different as a result of a lapse of time between the two dates on which the decisions are made or must the adjudicating authority only take account of such facts and circumstances as were available at the moment when the trade mark authority made its decision?

(3) Does the interpretation by the Court of Justice in the *Postkantoor* judgment preclude national legislation in regard to the competence of the adjudicating authority from being construed as meaning that that authority is prevented from taking account of any alteration in the relevant facts and circumstances or from ruling on the distinctive character of the mark for each of the goods and services in themselves?'

34. Written observations have been submitted by the BMB, the German Government and the Commission. No hearing was requested and none has been held.

The first question

35. In its first question, the referring court asks essentially whether Article 3 of the Trade Marks Directive requires the decision [24] by which a trade mark office refuses registration of a mark on the basis of an absolute ground of refusal to state its conclusion separately for each of the goods and services for which trade mark protection is sought.

24 — The first question is worded in terms of 'the provisional and definitive decision' refusing registration, reflecting the procedure used by the BMB. Procedures vary, however, in the different Member States, and the general principles laid down by the Court must apply equally to procedures based on a one-stage decision by the national trade mark office.

36. The BMB submits that the first question should be answered in the negative, while the German Government takes the opposite view. The Commission's stance is more nuanced, but broadly in line with the BMB.

37. The German Government relies on dicta in *Postkantoor* [25] to the effect that (i) since registration of a mark is always sought for goods or services specified in the application, the question whether registration may be refused on one of the absolute grounds set out in Article 3 must be assessed on the facts by reference to those goods or services [26] and (ii) where registration of a mark is sought for various goods or services, the examination must be carried out with regard to each of those goods or services and may lead to different conclusions depending on the goods or services in question. [27] It likewise relies on Article 13 of the Directive, which provides that where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.

38. I would certainly agree that, where registration of a mark is sought for various goods or services, the *examination* must be carried out with regard to each of those goods or services. How else is the trade mark office to determine the goods or services with regard to which the mark may validly be registered, and thereby ensure compliance with Article 13 of the Trade Marks Directive? More generally, such an exercise follows from the requirement that the trade mark office must carry out 'a stringent and full examination, in order to prevent trade marks from being improperly registered'. [28]

39. I do not however consider that it necessarily follows that the *decision* by which a trade mark office refuses registration of a mark on the basis of an absolute ground of refusal must state its conclusion separately for each of those individual goods and services. Where registration is refused on that basis for an entire group or category of goods or services, it is sufficient that the decision, whether provisional or definitive, so states and explains adequately why the group or category as such is ineligible for registration.

40. As the Commission correctly points out, the Court's case-law requires that there

25 — Cited in footnote 20.

26 — *Postkantoor*, paragraph 31 et seq.

27 — *Postkantoor*, paragraph 73.

28 — Case C-104/01 *Libertel* [2003] ECR I-3793, paragraph 59.

should be a right of judicial review of any decision by which a national authority refuses a right recognised by Community law. Effective judicial review must be able to cover the legality of the reasons for the contested decision. That presupposes in general that the court to which the matter is referred may require the competent authority to notify its reasons. [29] A national trade mark office is therefore required to give reasons for a decision refusing to register a mark. It is settled case-law, applied by the Court also in the field of trade marks, that the statement of reasons must disclose in a clear and unequivocal manner the reasoning followed by the institution which adopted the measure in question in such a way as to enable the persons concerned to ascertain the reasons for the measure and to enable the competent court to exercise its power of review. It is not however necessary for the reasoning to go into all the relevant facts and points of law, since the question whether the statement of reasons is sufficient must be assessed with regard not only to its wording but also to its context and to all the legal rules governing the matter in question. [30]

41. It is therefore not necessary for the national trade mark office to give reasons for refusing registration with regard to each individual product and service separately. Although the office is bound to give reasons for all goods and services concerned, it may none the less in principle use general reasoning if it considers that such reasoning is valid for all the goods and services in a given group taken together. In practical terms, it is not always useful to give individual reasons for each individual product or service.

42. That approach has the advantage, which cannot be over-emphasised, of being workable. The BMB notes that there are 35 000 trade mark applications made in the Benelux each year, mostly for several classes of goods and services and mostly listing numerous goods and services within those classes for which registration is sought. [31] The only workable method of examination is for the trade mark office first to regroup the goods and services specified around the apparent core goods and services concerned. The natural association between the goods and services so grouped together should be readily apparent to the relevant public. [32] What is important is that the office indicates clearly in its decision why it considers that there is an absolute ground for refusal in relation to that category of goods or services. When the trade mark office communicates its decision (whether provisional or definitive) to the applicant, it is for the latter, if it wishes, to indicate why and demonstrate

29 — Case 222/86 *Heylens* [1987] ECR 4097, paragraphs 14 and 15.

30 — Case C-447/02 P *KWS Saat* v *OHIM* [2004] ECR I-10107, paragraph 65.

31 — By way of reminder, the Nice Classification has 45 categories which cover approximately 11 000 individual products and services.

32 — That aggregation is likely to follow any categorisation used in the application for the mark, which in turn will be based on the Nice Classification.

how the ground for refusal does not hold good for certain specific goods and services amongst the goods and services for which the mark was filed. [33] That will then enable effective judicial review of the decision to be exercised with regard to the office's decision in respect of those goods and services.

43. In the present case, the application covered goods in three classes and services in two. It could be construed as seeking registration for 32 types of products and 13 types of services. [34] The BMB considered that the mark could not be validly registered for any of those classes of products or services on the basis of one absolute ground for refusal. Certainly, its decision should explain clearly, in respect of each class, why it considered that that absolute ground of refusal applied to the collectivity of goods and/or services within the class for which registration of the trade mark was sought. However, it seems to me that it would be manifestly disproportionate for Community law to require national trade mark offices in such a situation to set out the reason for refusal to register in respect of each and every product and service.

33 — The detailed procedure will of course depend on national rules.

34 — Depending on how the various permutations are counted.

44. I therefore conclude in answer to the first question referred that a trade mark authority which refuses registration of a trade mark is not required to state in its decision a separate conclusion with regard to each of the individual goods and services for which trade mark protection was sought. It is sufficient that it appears from the decision why registration was refused for the particular categories of goods and services to which the individual goods or services belong.

The second question and the first limb of the third question

45. By its second question the referring court asks essentially whether Article 3 of the Trade Marks Directive is to be read as meaning that a court which is reviewing the decision of a trade mark office refusing registration of a mark must take account only of the facts and circumstances which were available when the trade mark office made its decision, or whether that article permits such a court to take account of facts and circumstances which have arisen since that decision. By the first limb of its third question the referring court asks essentially whether it is consistent with Article 3 of the

Trade Marks Directive for national rules to preclude a court which is reviewing the decision of a trade mark office from taking account of any alteration in the relevant facts and circumstances.

46. Those two questions appear to be two sides of the same coin. The former asks whether, in the light of Article 3, a court of review *may* take account of intervening facts and circumstances. The latter asks whether, in that light, a court of review *may be precluded* by national law from taking account of intervening facts and circumstances. I therefore propose to examine them together.

47. The BMB considers that both questions are inadmissible: there is nothing in the order for reference to suggest that there was in fact any 'alteration' in the 'relevant facts and circumstances'.

48. It appears from the order for reference that the 'alteration' which the national court had in mind in formulating these questions is the difference between the views of, on the one hand, the trade mark office whose decision is being reviewed and, on the other hand, the court reviewing that decision.

49. It is not obvious to me that such a difference should be categorised as an alteration in a relevant 'fact or circumstance'. It is surely closer to a question of law, since the 'view' is reached by applying legal criteria to particular (constant) facts. Moreover, the paragraphs of the judgment in *Poskantoor* which appear to have prompted the questions clearly envisage 'facts' in the more usual sense of the term. [35] However, the questions have been put in general terms; and I consider that it is possible to answer them in general terms.

50. In any event, it does not seem to me that the questions should be regarded as inadmissible on the basis that one party to the proceedings considers that they are based on an erroneous assumption by the referring court. It is settled case-law that, in principle, [36] it is solely for the national court before which the dispute has been brought, and which must assume the responsibility for the subsequent judicial decision, to determine in the light of the particular circumstances in each case both the need for a preliminary ruling in order to enable it to deliver judgment and the relevance of the question which it submits to the Court. [37]

35 — See paragraphs 20 to 37.

36 — There are certain exceptions to this general rule, none of which however is invoked by the BMB.

37 — See for example Case C-127/92 *Enderby* [1993] ECR I-5535, paragraph 10.

51. BMB also objects, in the alternative, that Article 3 of the Trade Marks Directive can provide no answer to the second question. That objection appears to me to be unsustainable. The Court's ruling in *Postkantoor*, which prompted the questions, was an interpretation of Article 3.

52. The German Government submits that the Directive does not lay down exhaustive rules on the extent of judicial review of decisions of trade mark offices, as is clear from the second sentence of Article 3(3). It is therefore for national law to determine whether account may or must be taken of circumstances or facts which arise, or become apparent, only after registration. The Commission takes a similar view.

53. As the Commission points out, in *Postkantoor* the Court emphasised that the competent authority was to have regard to all the relevant facts and circumstances before adopting a final decision on an application to register a trade mark. [38] A court asked to review such a decision 'must also have regard to all the relevant facts and circumstances, subject to the limits on the exercise of its powers as defined by the relevant national legislation'. [39] In such proceedings, the court must rule on the lawfulness of a given decision of the trade mark office. That decision could (self-evidently) have been taken only on the basis of the facts available at the time. It is therefore in my view perfectly acceptable for a legal system to prohibit a court from annulling a decision on the basis of subsequent facts. Indeed, this accords with the practice of many judicial bodies when undertaking judicial review of decisions. Community law also recognises that principle. [40]

54. Moreover in the specific context of judicial review of decisions of the Community trade mark office [41] the Court has recently confirmed that 'the Court of First Instance may annul or alter a decision against which an action has been brought only if, at the time the decision was adopted, it was vitiated by one of [the prescribed] grounds for annulment or alteration [but] may not ... annul or alter that decision on grounds which came into existence subsequent to its adoption'. [42]

38 — Paragraph 35.

39 — Paragraph 36.

40 — See e.g. Case C-241/94 *France* v *Commission* [1996] ECR I-4551, paragraph 33.

41 — Office for Harmonisation in the Internal Market (Trade Marks and Designs).

42 — Case C-416/04 P *Sunrider* v *OHIM* [2006] ECR I-4237, paragraph 55.

55. I therefore conclude that the answer to the second question and the first limb of the third question referred should be that (i) it is for national law to determine whether a court reviewing a decision of a trade mark authority refusing registration of a mark may take account of facts and circumstances which were not available at the moment when the trade mark authority made its decision and (ii) it is consistent with Article 3 of the Trade Marks Directive for national rules to preclude a court which is reviewing such a decision from taking account of such facts and circumstances.

The second limb of the third question

56. By the second limb of its third question the referring court asks essentially whether it is consistent with Article 3 of the Trade Marks Directive for national rules to preclude a court which is reviewing the decision of a trade mark office from ruling on the distinctive character of the mark for each of the goods and services separately.

57. The BMB submits that, to the extent that the question concerns the competence of the court of review to rule on the distinctive power of the mark 'for each of the goods and services in themselves', it has been answered in the context of the first question. In so far as the question suggests that there is any conflict between the Court's judgment in *Postkantoor* and the interpretation of 'national legislation in regard to the competence of the adjudicating authority', it has no basis. The Court explicitly stated in *Postkantoor* that the competence of a court of review is 'subject to the limits on the exercise of its powers as defined by the relevant national legislation'. National law may therefore lay down the limits of national courts' competence.

58. The German Government submits in contrast that national rules may not limit the power of courts of review to assess distinctive character with regard to separate goods and services. The Directive as interpreted by the Court in *Postkantoor* gives national trade mark offices mandatory guidelines for their decisions. Courts which as a matter of national rules may review only the lawfulness of the decision must verify that those mandatory guidelines have been applied, and may and must therefore in principle rule separately for individual classes.

59. The Commission refers initially to the decision of the Benelux Court of Justice in *Vlaamse Toeristenbond.*[43] It notes that one of the factual differences between that case

43 — Cited in footnote 9. See points 16 to 22 above.

and the present case is that the Vlaamse Toeristenbond had sought registration for certain *complete classes* of the Nice Agreement. In the present case, in contrast, MT&C has sought registration for certain, but not all, goods and services in a number of classes.

60. The Commission then considers the arguments for and against the view that Article 3 of the Trade Marks Directive does not allow national rules to preclude a court which is reviewing the decision of a trade mark office from ruling on the distinctive character of the mark for each of the goods and services separately. It concludes that Article 3 permits such rules, on the basis principally that the Directive explicitly gives the Member States extensive freedom of action in regulating trade mark procedure. Moreover, the Commission notes that under the Benelux procedure, if the applicant mentions to the BMB its interest in obtaining registration for fewer goods and/or services than sought in the principal application, it appears that the BMB must examine that request and the applicant is then able to seek partial registration before the court reviewing refusal of registration. At the practical level, therefore, the Commission considers that the Benelux law appears to satisfy Article 13 of the Directive.

61. I agree with that approach.

62. The Directive, as is clear from the third recital in the preamble, does not seek to undertake full-scale approximation. According to the fifth recital, 'Member States also remain free to fix the provisions of procedure concerning the registration' of trade marks. It would seem to be consistent with that freedom for a national system to authorise partial registration (in the sense of registration of the mark sought but for some only of the goods or services concerned) on condition that the applicant requests it as an alternative to full registration in its application to the competent trade mark authority.

63. That freedom is merely an illustration of the more general principle laid down by the Court that 'in the absence of Community legislation governing the matter it is for the domestic legal system of each Member State to lay down the detailed procedural rules governing court actions for safeguarding rights which individuals derive from Community law' [44] (provided of course that the principles of equivalence and effectiveness are respected). In the specific context of trade marks, the Court noted in *Postkantoor* that 'a court asked to review a decision on an application for a trade mark registration must also have regard to all the relevant

44 — Case C-472/99 *Clean Car Autoservice* [2001] ECR I-9687, paragraph 28, and the cases there cited.

facts and circumstances, *subject to the limits on the exercise of its powers as defined by the relevant national legislation*'. [45]

64. It seems to me to be wholly consistent with that case-law for national rules to preclude a court which is reviewing the decision of a trade mark office from ruling on the distinctive character of the mark for each of the goods and services separately. It does not seem unreasonable or unduly onerous to expect a trade mark applicant which wishes to preserve its right to apply for partial registration to make that clear in its application for registration. It is, after all, at that stage that the applicant can best assess its commercial interests (indeed application for registration is likely to be the culmination of a period of assessment) and decide whether, if full registration of the trade mark sought is refused, it would be content with partial registration of that mark for fewer goods or services, or whether it would prefer to make a fresh application for a different mark for more goods or services.

65. The interests of procedural efficiency would also seem to be best served if the question of full versus partial registration is considered at the time of application for registration. A national trade mark office is surely a more appropriate forum than an appellate court for the first evaluation of that issue.

66. The Commission considers that the principal argument against the above view is the wording of Article 13 of the Trade Marks Directive, which states that refusal of registration cannot cover goods other than those for which there are grounds for refusal of registration.

67. That provision must however be read in the light of the overall scheme of the Directive, and in particular the competence it reserves to the Member States to lay down procedural rules. It seems to me that the spirit of Article 13 is accurately reflected provided that national law ensures that trade mark applicants may in the alternative seek partial registration in their application.

68. That interpretation is moreover in my view consistent with the dictum of the Court in *Postkantoor* to the effect that 'when registration of a mark is sought in respect of an entire class ... the competent authority may, pursuant to Article 13 of the Directive, register the mark only in respect of some of

45 — Paragraph 36; emphasis added.

the goods and services belonging to that class ...'.[46] The Court was there invoking Article 13 as the basis for giving the national trade mark office that (permissive) power. It does not, however, follow that Article 13 imposes a substantive obligation on a trade mark office to contemplate partial registration ex officio in all cases. On that basis, there is no conflict with Article 13 if national procedural rules require an applicant who wants the trade mark office to consider partial registration to make that clear in its application. On the contrary, such rules enhance procedural efficiency, are less rather than more cumbersome in the context of the procedure viewed as a whole, and do not make the exercise of Community law rights impossible or unduly difficult.

69. It appears from the documents before the Court that MT&C did not make a request in the alternative for partial registration either before the BMB, in its initial application, or when contesting the provisional decision before the BMB. Thus MT&C took neither of the two opportunities which the Benelux system offers by virtue of the two-step process — provisional and final — to make a subsidiary application for partial registration. It is only before the reviewing court that the subsidiary application appears to have been made. I cannot see any good reason why MT&C (or any other applicant) cannot make a subsidiary application (as provided for by national procedural rules) while its application is before the trade mark office.

70. Accordingly I conclude that when a national court is reviewing the decision of a trade mark office refusing registration of a trade mark, it is not contrary to Article 3 of the Trade Marks Directive for national procedural rules to preclude that court from ruling on the distinctive character of the mark for each of the goods and services separately, provided that those rules afford the applicant an effective opportunity to seek partial registration of the mark (namely, registration in respect of only certain of the goods and/or services covered by its principal application) in its application to the trade mark office.

46 — Paragraph 113.

Conclusion

71. For the above reasons I am of the view that the Court should rule as follows in answer to the questions referred by the Hof van Beroep, Brussels:

(1) Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks does not require a trade mark authority which refuses registration of a trade mark to state in its decision a separate conclusion with regard to each of the individual goods and services for which trade mark protection was sought. It is sufficient that it appears from the decision why registration was refused for particular categories of goods and services.

(2) Directive 89/104 leaves it to national law to determine whether a court reviewing a decision of a trade mark authority refusing registration of a mark may take account of facts and circumstances which were not available at the moment when the trade mark authority made its decision.

(3) It is consistent with Directive 89/104 for national rules to preclude a court which is reviewing such a decision from (i) taking account of facts and circumstances which were not available at the moment when the trade mark authority made its decision and (ii) from ruling on the distinctive character of the mark for each of the goods and services separately, provided that those rules afford the applicant an effective opportunity to seek partial registration of the mark (namely, registration in respect of only certain goods and/or services covered by its principal application) in its application to the trade mark office.