JUDGMENT OF THE COURT OF FIRST INSTANCE (First Chamber)

15 September 2009*

In Case T-471/07,

Wella AG, established in Darmstadt (Germany), represented by B. Klingberg and K. Sandberg, lawyers,

applicant,

v

Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), represented by D. Botis, acting as Agent,

defendant,

ACTION brought against the decision of the Second Board of Appeal of OHIM of 24 October 2007 (Case R 713/2007-2), relating to a territorial extension, to the European Community, of the protection in respect of the international registration of the word mark TAME IT,

* Language of the case: English.

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

composed of V. Tiili, President, F. Dehousse and I. Wiszniewska-Białecka (Rapporteur), Judges,

Registrar: N. Rosner, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 21 December 2007,

having regard to the response lodged at the Registry of the Court of First Instance on 19 March 2008,

further to the hearing on 17 February 2009,

gives the following

Judgment

Background to the dispute

1 On 10 January 2006, the applicant, Wella AG, obtained from the International Bureau of the World Intellectual Property Organisation (WIPO) the international registration of the word mark TAME IT for goods in Class 3 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, which correspond to the following description: 'soaps, perfumeries, essential oils, cosmetics, hair lotions, dentifrices'.

2 On 20 April 2006, the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) received a notification, pursuant to Article 3ter of the Protocol relating to the Madrid Agreement concerning the international registration of marks adopted at Madrid on 27 June 1989 (OJ 2003 L 296, p. 22) ('the Madrid Protocol'), of a request for territorial extension to the European Community of the protection in respect of that international registration.

3 On 20 October 2006, OHIM notified an ex officio provisional refusal of protection of the trade mark TAME IT in the European Community pursuant to Article 5 of the Madrid Protocol and Rule 113 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1), as amended, for all the goods covered by the international registration. The ground relied on was that the trade mark TAME IT lacked distinctive character within the meaning of Article 7(1)(b) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (now Article 7(1)(b) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1)).

4 On 21 December 2006, the applicant responded to the objections raised in the notification of provisional refusal.

5 By decision of 9 March 2007 ('the examiner's decision'), the examiner refused the extension to the European Community of the protection in respect of the mark TAME IT for all the goods, on the ground that that mark was devoid of any distinctive character within the meaning of Article 7(1)(b) of Council Regulation No 40/94.

6 On 9 May 2007, the applicant filed a notice of appeal at OHIM against that decision, pursuant to Articles 57 to 62 of Regulation No 40/94 (now Articles 58 to 64 of Regulation No 207/2009).

7 By decision of 24 October 2007 ('the contested decision'), the Second Board of Appeal of OHIM granted the appeal in part. In essence, the Board of Appeal found that the goods in respect of which the territorial extension of protection to the European Community had been sought were everyday consumer goods, that the relevant public consisted of average English-speaking consumers established in the Community, who are reasonably well-informed and reasonably observant and circumspect, that the verb 'to tame' meant 'to "soften"','to "harness or control"' or 'to "make tractable"' and that the combination of words 'tame it' followed the rules of ordinary English grammar and syntax. The Board of Appeal concluded that, in relation to hair lotions, cosmetics and essential oils — the latter two categories of goods also being capable of being used to tame hair — the relevant public would immediately, clearly and without any further thought understand the expression 'tame it' as a purely promotional message informing that public about the desired effect of using those goods. The Board of Appeal found that, as regards those goods, the mark TAME IT was devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94. However, the Board of Appeal found that no relevant connection could be established between the mark TAME IT and the 'soaps, perfumeries and dentifrices' and that therefore it could not conclude that, as regards those goods, that mark lacked distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94. In view of those considerations, the Board of Appeal, first, dismissed the appeal and upheld the examiner's decision in so far as it had refused the European Community designation of the international registration of the mark TAME IT for 'essential oils, cosmetics [and] hair lotions' and, secondly, annulled the examiner's decision and, consequently, allowed the European Community designation of the international registration of the mark TAME IT to proceed to publication for 'soaps, perfumeries [and] dentifrices'.

Forms of order sought

8 The applicant claims that the Court should:

— annul the contested decision in so far as it dismissed the appeal against the examiner's decision;

— order OHIM to pay the costs.

9 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

10 In support of its action, the applicant relies on a single plea in law, alleging infringement of Article 7(1)(b) of Regulation No 40/94. It submits, in essence, that the mark TAME

IT is not devoid of distinctive character within the meaning of that provision as regards the goods 'essential oils, cosmetics [and] hair lotions'.

11 OHIM disputes the arguments put forward by the applicant.

12 Under Article 146(1) of Regulation No 40/94 (now Article 151(1) of Regulation No 207/2009), an international registration designating the European Community is, from the date of the designation of the European Community pursuant to Article 3ter(2) of the Madrid Protocol, to have the same effect as an application for a Community trade mark. Article 149(1) of that regulation (now Article 154(1) of Regulation No 207/2009) provides that international registrations designating the European Community are to be subject to examination as to absolute grounds for refusal in the same way as applications for Community trade marks.

13 Article 7(1)(b) of Regulation No 40/94 provides that trade marks which are devoid of any distinctive character must not be registered. Article 7(2) of that regulation (now Article 7(2) of Regulation No 207/2009) provides that Article 7(1) is to apply notwithstanding that the grounds of non-registrability obtain in only part of the Community.

14 The marks referred to in Article 7(1)(b) of Regulation No 40/94 are those which are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services in question, thus enabling the consumer who acquired them to repeat the experience if it proves to be positive, or to avoid it if it proves to be negative, on the occasion of a subsequent acquisition (Case T-34/00 *Eurocool Logistik* v *OHIM (EUROCOOL)* [2002] ECR II-683, paragraph 37, and judgment of 20 January 2009 in Case T-424/07 *Pioneer Hi-Bred International* v *OHIM (OPTIMUM)*, not published in the ECR, paragraph 20).

15 According to settled case-law, registration of a trade mark which consists of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by that mark is not excluded as such by virtue of such use. A mark which, like an advertising slogan, fulfils functions other than that of a trade mark in the traditional sense of the term is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 however if it may be perceived immediately as an indication of the commercial origin of the goods or services in question so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the proprietor of the mark from those of a different commercial origin (Case T-122/01 *Best Buy Concepts* v *OHIM (BEST BUY)* [2003] ECR II-2235, paragraph 21, and Case T-184/07 *Avon Products* v *OHIM (ANEW ALTERNATIVE)*, not published in the ECR, paragraph 22).

16 For a finding that there is no distinctive character, it is sufficient that the semantic content of the word mark in question indicates to the consumer a characteristic of the product or service relating to its market value which, whilst not specific, comes from promotional or advertising information which the relevant public will perceive at first glance as such, rather than as an indication of the commercial origin of the product or service in question (Case T-281/02 *Norma Lebensmittelfilialbetrieb* v *OHIM (Mehr für Ihr Geld)* [2004] ECR II-1915, paragraph 31, and judgment of 12 March 2008 in Case T-128/07 *Suez* v *OHIM (Delivering the essentials of life)*, not published in the ECR, paragraph 20).

17 Furthermore, a mark's distinctiveness must be assessed, firstly, by reference to the goods and services in respect of which registration or protection in the European Community is sought and, secondly, by reference to the way in which the mark is perceived by the relevant public, which is constituted by average consumers of those goods or services (Case T-88/00 *Mag Instrument* v *OHIM (Torch shape)* [2002] ECR II-467, paragraph 30, and *Delivering the essentials of life*, paragraph 16 above, paragraph 21).

18 Lastly, it is apparent from the case-law that, where registration of a Community trade mark or the protection in the European Community of an international registration has been sought in respect of all goods falling within a category without distinguishing

between those goods, the fact that the mark in question is devoid of any distinctive character solely in relation to certain goods falling within that category does not preclude a finding that the mark in question lacks distinctive character in relation to all the goods in that category (see, to that effect and by analogy, Case T-359/99 *DKV* v *OHIM (EuroHealth)* [2001] ECR II-1645, paragraph 33, and Case T-304/06 *Reber* v *OHIM — Chocoladefabriken Lindt & Sprüngli (Mozart)* [2008] ECR II-1927, paragraph 92).

19 In the present case, the applicant disputes the refusal, by the Board of Appeal, of the European Community designation of the international registration of the mark TAME IT for the goods 'essential oils, cosmetics [and] hair lotions' ('the goods in question').

20 As a preliminary point, considering the nature of the goods in question, which are everyday consumer goods, and the fact that the mark TAME IT consists of English words, it must be pointed out that the Board of Appeal was right to find that the relevant public consists of average English-speaking consumers who are reasonably well-informed and reasonably observant and circumspect, and that was not, moreover, disputed by the parties. It is thus in relation to the perception of an average English-speaking consumer that it must be assessed whether the Board of Appeal was right to find that the mark TAME IT was devoid of any distinctive character in respect of the goods in question.

21 In that regard, it must be pointed out, first, that, as the Board of Appeal stated, the English verb 'to tame' means inter alia 'to "soften"','to "harness or control"' or 'to "make tractable"'. The Board of Appeal also stated, without that being disputed by the applicant, that the latter uses the verb 'to tame' on its internet site in the United Kingdom in the sense of 'to soften' to promote some of its haircare products.

22 Secondly, as the applicant submits, the neuter English pronoun 'it' can, in theory, have different meanings, thus leaving the consumer with a certain margin of discretion as regards what the verb 'to tame' refers to. However, as OHIM states, it is apparent from the case-law referred to in paragraph 17 above that a mark's distinctiveness must not be assessed in the abstract, but by reference to the goods in respect of which protection of that mark is sought. In the present case, the goods in question are hair lotions, cosmetics and essential oils. As regards the hair lotions, they are, by definition, intended for hair. As regards the cosmetics and essential oils, it is true, as the applicant states, that those categories include goods other than products intended for hair. However, the fact none the less remains that the category of cosmetics in general includes hair cosmetics and that, as the Board of Appeal pointed out, certain essential oils may be used to tame hair. However, on that point the applicant merely maintains that essential oils are 'uncommon' for use as haircare products and that the category of cosmetics comprises 'rather … skincare products …, bath oils and salts and decorative cosmetics …', without substantiating those claims.

23 As OHIM states, the pronoun 'it' may, in English, be used instead of the word 'hair' as the English word 'hair' is generally used in the singular. Thus, in relation to hair lotions, hair cosmetics and essential oils which may be used on hair, the pronoun 'it' will be perceived as a reference to hair.

24 Thirdly, it is not disputed that the combination of words in the expression 'tame it' follows the rules of ordinary English grammar and syntax. Furthermore, the expression 'tame it' contains a verb in the imperative.

25 It follows that, in relation to hair lotions, hair cosmetics and essential oils which may be used on hair, the mark TAME IT will be perceived by an average English-speaking consumer as an order or invitation to use those products in order to soften, control or make hair tractable. The semantic content of the mark TAME IT thus indicates to the relevant consumer a positive characteristic of those products, relating to their market

value, inasmuch as the softening or controlling of hair is an important function which the consumer seeks when he uses them.

26 Consequently, faced with the mark TAME IT in relation to hair lotions, hair cosmetics and essential oils which may be used on hair, the consumer will immediately perceive it as promotional or advertising information, inciting him to use those products and/or informing him about the desired effect of using those goods, rather than as an indication of their commercial origin.

27 The applicant errs in maintaining that because the verb 'to tame' has various different meanings, the main one of which refers to the domestication of wild animals, that promotional or advertising information will not be conveyed clearly, directly and immediately. In terms of the case-law referred to in paragraph 17 above, it is irrelevant that the verb 'to tame' or the expression 'tame it', when considered independently of the goods in question, has meanings other than that chosen by the Board of Appeal, even if the evidence adduced by the applicant in that regard is admissible. On the same ground it cannot reasonably be complained that the Board of Appeal disregarded the multiplicity of meanings suggested by the association of the words 'tame' and 'it'.

28 In the light of those factors, it must be held that the mark TAME IT, in relation to hair lotions, hair cosmetics and essential oils which may be used on hair, and in so far as it incites the consumer to use those products and/or informs him about the desired effect of using them, will immediately be perceived by the relevant public as an advertising message rather than as an indication of the commercial origin of those products. Therefore, in the light of the principle referred to in paragraph 18 above, the Board of Appeal was justified in finding that the mark TAME IT was devoid of any distinctive character in respect of all the goods in question.

29 It should be added in this connection that under Article 44(1) of Regulation No 40/94 (now Article 43(1) of Regulation No 207/2009), the applicant for the mark in question may at any time withdraw his Community trade mark application or restrict the list of goods or services contained therein. Thus, the power to restrict the list of goods or services is vested solely in the applicant for the Community trade mark, who may, at any time, apply to OHIM for that purpose (Case T-219/00 *Ellos* v *OHIM (ELLOS)* [2002] ECR II-753, paragraph 61, and Case T-402/02 *Storck* v *OHIM (Shape of a sweet wrapper)* [2004] ECR II-3849, paragraph 33). Pursuant to Article 149(1) of Regulation No 40/94, the same must be true in the context of an application for a European Community designation of an international registration.

30 In the present case, the applicant was in a position to make such a restriction, as provided for by Article 149(2) of Regulation No 40/94 (now Article 154(2) of Regulation No 207/2009), in particular in reply to the notification of provisional refusal of protection which granted it, in accordance with Rule 112(1) and Rule 113(1)(c) of Regulation No 2868/95, a time-limit of two months to correct the inadequacies which were the reason for that provisional refusal — namely, the lack of distinctive character of the mark TAME IT in relation to the goods for which protection in the European Community had been sought, given that it is perceived as a message relating to the positive effects of those products on hair. However, the applicant did not restrict the list of goods in respect of which it sought protection of the mark TAME IT in the European Community. Therefore, and having regard to the case-law referred to in paragraph 18 above, the applicant cannot now reasonably maintain that, in relation to certain cosmetics and certain essential oils not intended for hair, the mark TAME IT has distinctive character.

31 Nor do the other arguments put forward by the applicant make it possible to rebut the conclusion that the mark TAME IT is devoid of any distinctive character in respect of all the goods in question.

32 First, it is clear that, contrary to what the applicant maintains, the fact that the expression 'tame it' contains a verb in the imperative does not confer distinctive

character on the trade mark TAME IT. As OHIM states, the use of verbs in the imperative is customary in the field of advertising. Therefore, it reinforces the fact that, at first sight, that mark will be perceived as a promotional message inciting the relevant consumer to use the goods in question and/or informing him about the desired effect of using them.

33 Secondly, contrary to the applicant's claims, it is not apparent from the contested decision that the Board of Appeal disregarded the overall impression created by the mark TAME IT. The Board of Appeal referred, first, to 'the combination of words making up the sign at issue' to state that that combination of words followed the rules of ordinary English composition and spelling and, secondly, to the expression 'tame it' in its entirety to state that it would be perceived as a purely promotional message. It also found that 'the examiner rightly held that the word combination "TAME IT" is devoid of any distinctive character for [the goods in question]'. Therefore, it cannot be complained that the Board of Appeal failed to take into account the overall impression the mark TAME IT has on the relevant public.

34 Thirdly, the applicant submits that the fact that the Board of Appeal did not refer to one single example of the use of the expression 'tame it' to designate the goods in question proves the fact that the mark TAME IT is entirely capable of distinguishing those goods from those which have a different commercial origin. In that regard, it is sufficient to recall that, although the fact that a mark is capable of being commonly used in trade for the presentation of the goods or services in question is a relevant criterion in relation to Article 7(1)(c) of Regulation No 40/94 (now Article 7(1)(c) of Regulation No 207/2009), that criterion is not the yardstick by which Article 7(1)(b) of that regulation must be interpreted (Case C-329/02 P *SAT.1* v *OHIM* [2004] ECR I-8317, paragraph 36, and Case C-37/03 P *BioID* v *OHIM* [2005] ECR I-7975, paragraphs 61 and 62). It follows that the Board of Appeal did not have to refer to such examples since it had found that the mark TAME IT was devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94. That argument must therefore be rejected as irrelevant.

35 Fourthly, as regards the argument relating to the registration, by the United Kingdom Intellectual Property Office, of the word mark TAME for goods in Class 3 of the Nice Agreement, even if that argument and the evidence adduced in support of it are admissible, which OHIM disputes, it is sufficient to recall that the Community trade mark regime is an autonomous legal system which pursues objectives peculiar to it; it applies independently of any national system (Case T-32/00 *Messe München* v *OHIM (electronica)* [2000] ECR II-3829, paragraph 47, and judgment of 21 January 2009 in Case T-399/06 *giropay* v *OHIM (GIROPAY)*, not published in the ECR, paragraph 46). Consequently, the registrability or protectability of a sign as a Community mark must be assessed by reference only to the relevant Community rules. Accordingly, OHIM and, if appropriate, the Community judicature are not bound by a decision given in a Member State, or indeed a third country, that the sign in question is registrable as a national mark. That is so even if such a decision was adopted under national legislation harmonised with 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) or in a country belonging to the linguistic area in which the word sign in question originated (Case T-106/00 *Streamserve* v *OHIM (Streamserve)* [2002] ECR II-723, paragraph 47, and *GIROPAY*, paragraph 46). That argument must therefore also be rejected.

36 Fifthly, it must be borne in mind that, according to the case-law, as regards a sign comprising words, the distinctiveness of each of those elements, taken separately, may be assessed, in part, but must, in any event, depend on an appraisal of the whole which they comprise. Indeed, the mere fact that each of those elements, considered separately, is devoid of distinctive character does not mean that the combination of those elements cannot present a distinctive character (*SAT.1* v *OHIM*, paragraph 34 above, paragraph 28, and judgment of 9 July 2008 in Case T-58/07 *BYK-Chemie* v *OHIM (Substance for Success)*, not published in the ECR, paragraph 18). In accordance with that case-law, when the Board of Appeal stated that 'the sign applied for is no more than the mere sum of its parts', it merely stated that the mark TAME IT had no meaning other than the simple combination of the words 'tame' and 'it' and that, therefore, taken as a whole, it would continue to be perceived by the relevant public, at first glance, as a purely promotional message. That statement did not therefore seek, as the applicant claims, to indicate that the mark TAME IT lacked creativity or imaginativeness. Consequently, that argument must also be rejected.

37 It follows from all of the foregoing that, in the light of the ground referred to in Article 7(1)(b) of Regulation No 40/94, the Board of Appeal was right to refuse the European Community designation of the international registration of the mark TAME IT for essential oils, cosmetics and hair lotions.

38 Accordingly, the single plea in law, alleging infringement of Article 7(1)(b) of Regulation No 40/94, must be rejected as unfounded, as must the action in its entirety.

Costs

39 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. Since the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the forms of order sought by OHIM.

On those grounds,

THE COURT OF FIRST INSTANCE (First Chamber)

hereby:

1. Dismisses the action;

2. Orders Wella AG to pay the costs.

Tiili Dehousse Wiszniewska-Białecka

Delivered in open court in Luxembourg on 15 September 2009.

[Signatures]