JUDGMENT OF THE COURT OF FIRST INSTANCE (Third Chamber)

27 October 2005 *

In Case T-305/04,

Eden SARL, established in Paris (France), represented by M. Antoine-Lalance, avocat,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by A. Folliard-Monguiral, acting as Agent,

defendant,

ACTION brought against the decision of the First Board of Appeal of OHIM of 24 May 2004 (Case R 591/2003-1) concerning registration of the olfactory sign, Smell of ripe strawberries, as a Community trade mark,

* Language of the case: French.

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

composed of M. Jaeger, President, V. Tiili and O. Czúcz, Judges,

Registrar: B. Pastor, Deputy Registrar,

having regard to the application lodged at the Registry of the Court of First Instance on 26 July 2004,

having regard to the response lodged at the Court Registry on 25 October 2004,

further to the hearing on 21 April 2005,

gives the following

Judgment

Background to the dispute

1 On 26 March 1999 Laboratoires France Parfum SA ('LFP') filed an application for a Community trade mark with 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 in respect of which registration was sought is the olfactory sign, which is not perceived visually, described by the words 'smell of ripe strawberries' and consisting of the following colour image:



3 The goods in respect of which registration was sought are in Classes 3, 16, 18 and 25 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 3: 'Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps, deodorant soaps, perfumery, eau de toilette, scented water, essential oils, oils for toilet purposes, almond oils and almond milks for cosmetic purposes, cleansing milk for toilet purposes, colorants for toilet purposes, anti-perspirants (toiletries), cosmetics, lipsticks, cotton wool for cosmetic purposes, make-up powder, cosmetic preparations for skin care, cosmetic preparations for baths, cotton sticks for cosmetic purposes, cosmetic creams, cosmetic pencils, make-up removing preparations, make-up, paper guides for eye make-up, nail varnish for cosmetic purposes, pomades for cosmetic purposes, sun-tanning preparations (cos-

metics), shampoos, hair lotions, cosmetic dyes, shaving preparations, after-shave lotions, dentifrices, non medical mouth care preparations, talcum powder, depilatory preparations, hair lotions, hair cream preparations, hair oil preparations, perfumery, smoothing stones, polishing stones, pumice stones';

— Class 16: 'Stationery, fountain pens, pencils, pencil holders, erasers, paper sheets (stationery), writing or drawing books, blotters, pads (stationery); printed matter, books, magazines, newspapers, periodicals, instructional and teaching material (except apparatus), playing cards';

— Class 18: 'Goods of leather or imitation leather (except cases adapted for the goods they are designed to carry, gloves and belts), pocket wallets, key holders, purses, handbags, travelling bags, school bags, harness for animals, trunks and travelling bags, carrying bags adaptable for bicycles, coverings of skins or hides; umbrellas, walking sticks; clothing, particularly trousers, shirts and short-sleeved shirts, skirts and dresses, underwear, jackets and overcoats; footwear, headgear and all kinds of sportswear, clothing of leather';

— Class 25: 'Clothing, underwear, knickers, pants, underpants, T-shirts, combinations (clothing and underclothing), lingerie, suits, neckties, shirts, short-sleeved shirts, scarves, skirts, petticoats, brassieres, coats, trousers, dressing gowns, jackets, swimsuits, beachwear, dresses, socks, trouser straps; footwear, boots, sandals, footwear for sports; headgear, caps'.

4 By decision of 7 August 2003, the examiner rejected the application pursuant to Article 38 of Regulation No 40/94, on the ground, first, that the olfactory sign applied for was not capable of being represented graphically and therefore fell under Article 7(1)(a) of that regulation and, second, that it was devoid of any distinctive character within the meaning of Article 7(1)(b) of that regulation, in respect of some of the goods claimed.

5 On 6 October 2003 LFP filed an appeal with OHIM pursuant to Articles 57 to 62 of Regulation No 40/94 against the examiner's decision.

6 By decision of 24 May 2004 ('the contested decision'), the First Board of Appeal of OHIM dismissed the appeal on the ground that the mark applied for was not capable of being represented graphically within the meaning of Article 4 of Regulation No 40/94, and that it was therefore covered by the ground for refusal provided for in Article 7(1)(a) of Regulation No 40/94.

7 By deed of 21 December 2000 LFP was transferred to the applicant. That transfer was communicated to OHIM on 9 July 2004, which notified the registration of the transfer of the Community trade mark application at issue in favour of the applicant on 20 July 2004.

Forms of order sought

8 The applicant claims that the Court of First Instance 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.

Law

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

Arguments of the parties

11 The applicant points out that, in Case C-273/00 *Sieckmann* [2002] ECR I-11737, the Court held that signs which are not in themselves capable of being perceived visually, such as sounds or odours, may constitute a mark provided that they can be represented graphically. The applicant notes that, in that judgment, the Court considered that an odour may be represented graphically by means of images, lines or characters and must be 'clear, precise, self-contained, easily accessible, intelligible, durable and objective' (paragraph 55 of the judgment). The applicant notes that, as

regards more specifically olfactory signs, the Court held that 'the requirements of graphic representability are not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements' (paragraph 73 of the judgment).

12 The applicant criticises the Board of Appeal for applying that case-law to the present case without taking into account the characteristics of the application for registration at issue.

13 First, the applicant asserts that, unlike the application at issue in *Sieckmann*, this application for registration contains neither a sample nor a chemical formula. The applicant submits that the Board of Appeal should have considered whether the graphic representation contained in the application for registration, made up of a description in words and a representation in the colours of a ripe strawberry, met the condition laid down in Article 4 of Regulation No 40/94.

14 Second, the applicant submits that the Board of Appeal's analysis of the graphic elements of which the application for registration was composed was incorrect.

15 As regards, first, the representation in words, the applicant asserts, in reply to the argument that the description of the mark in the application for registration may be interpreted subjectively, that that observation is irrelevant since the perception of any sign may differ from one individual to another. The applicant submits that a sign has to be capable only of distinguishing the goods which it designates and that, for a mark to fulfil its function, it is sufficient that it is perceived as a mark by people. As

regards any sign, consumers make a conceptual link between the form that they perceive and the sign in question on the basis of their cultural background and their sensorial experiences.

16 Referring to *Sieckmann*, the applicant asserts that it is sufficient that the graphic representation be 'unequivocal' and that there is no need to inquire whether that representation will be perceived more or less subjectively by the consumer. To that effect, the applicant submits that no other type of sign is subject to an objectivity criterion and that therefore olfactory signs should not be subject to that criterion either.

17 As regards the Board of Appeal's assertion that there is a discrepancy between the description and the smell, because there is a considerable number of types of strawberries which can be distinguished by their smell, the applicant states that that assertion is incorrect. It claims that the evidence adduced shows that the smell of strawberries does not vary from one variety to another, and that only the taste differs according to the variety. It concludes that the smell of ripe strawberries is stable and durable.

18 The applicant adds that the smell deposited is also a specific one since it is not just any strawberry smell but that of ripe strawberries. Moreover, that smell is well-known to consumers who will have memories of it from childhood.

19 As regards, next, the figurative representation, the applicant claims that, in the contested decision, the Board of Appeal fails to explain why the combination of a description in words and an image is not sufficiently precise and clear. It asserts that the image of a ripe strawberry cannot be perceived in isolation either by the public

or by the competent authorities, but that it is associated with other aspects of the application for registration, namely the description 'smell of ripe strawberries' and 'olfactory mark'. The mark as applied for therefore forms a whole that the authorities and the public perceive as such.

20 As regards, finally, the combination of the two graphic elements, description and image, the applicant disputes the Board of Appeal's assertion that, 'if the description in words of the smell of ripe strawberries or the mere reproduction of the image of a strawberry are not capable of satisfying, in themselves, the requirements of graphic representation, nor is a combination of those elements able to satisfy such requirements, in particular those relating to clarity and precision'. The applicant submits that the Board of Appeal has merely reproduced the wording in *Sieckmann*, whereas the elements used to represent the mark at issue differ from those of the mark concerned in that judgment. The applicant criticises the Board of Appeal for assessing, in the contested decision, the description in words separately instead of assessing the representation of the mark as a whole.

21 The applicant therefore takes the view that the graphic representation of the mark satisfies the requirements laid down by the case-law. The applicant asserts that the description in words is clear, precise, easily accessible, intelligible, durable and objective and that the image enables the sign to be complete in itself. Since the combination of those two elements satisfies the requirement of graphic representation laid down in Article 4 of Regulation No 40/94, the application for registration should be accepted.

22 OHIM supports the Board of Appeal's findings.

Findings of the Court

23 Under Article 7(1)(a) of Regulation No 40/94, signs which do not conform to the requirements of Article 4 of that Regulation are to be refused registration. Article 4 provides that 'a Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings'.

24 As regards in particular the registration of olfactory marks, the Court of Justice has held, in relation to Article 2 of 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), which has the same wording as Article 4 of Regulation No 40/94, that 'a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective' (*Sieckmann*).

25 As a preliminary point, despite the fact that, as was stated at the hearing, the olfactory memory is probably the most reliable memory that humans possess and that, consequently, economic operators have a clear interest in using olfactory signs to identify their goods, it is nevertheless the case that a graphic representation of a sign must enable the sign to be precisely identified in order to ensure the sound operation of the trade mark registration system (*Sieckmann*, paragraphs 46 and 47; Case C-104/01 *Libertel* [2003] ECR I-3793, paragraph 28, and Case C-49/02 *Heidelberger Bauchemie* [2004] ECR I-6129, paragraphs 25 and 26). Consequently, the requirements relating to the validity of a graphic representation may not be modified or relaxed in order to facilitate the registration of signs whose nature makes their graphic representation more difficult.

26 In the present case, the olfactory mark applied for was the combination of a figurative element, the image reproduced in paragraph 2 above, and a description in words, 'smell of ripe strawberries'. The Board of Appeal considered that that representation did not constitute a valid graphic representation for the purposes of Article 4 of Regulation No 40/94, as interpreted by the case-law, and refused registration of the mark on the ground provided for in Article 7(1)(a) of Regulation No 40/94.

27 As regards, first, the word element, the Board of Appeal held, on the one hand, that the description at issue was imbued with subjective factors and could therefore be interpreted subjectively and, on the other hand, that it would be difficult to describe the sign at issue in a sufficiently clear, precise and unequivocal manner since the smell of strawberries differs according to the variety; therefore there is necessarily a discrepancy between the description itself and the actual smell. The Board of Appeal concluded that a description could not constitute a graphic representation of the smell in respect of which it purports to be the written expression.

28 The Court of First Instance considers in that respect that, although as follows from *Sieckmann*, a description cannot represent graphically olfactory signs which are capable of being described in many different ways, it cannot however be ruled out that an olfactory sign might possibly be the subject of a description which satisfies all the requirements laid down by Article 4 of Regulation No 40/94, as interpreted by the case-law.

29 In the present case, the applicant asserts that the smell of ripe strawberries does not vary from one type to the other and that, consequently, the description 'smell of ripe strawberries' is unequivocal, precise and objective. It basis that claim on two studies annexed to its application.

30 As regards, first of all, the study carried out by the 'Institut pour la protection des fragrances', it must be held that, since it was not submitted to the Board of Appeal, it cannot be taken into consideration. Since the purpose of actions before the Court of First Instance is to obtain review of the legality of decisions of the Boards of Appeal of OHIM for the purposes of Article 63 of Regulation No 40/94, it is not the Court's function to review the facts in the light of documents adduced for the first time before it (Case T-129/01 *Alejandro* v *OHIM — Anheuser-Busch (BUDMEN)* [2003] ECR II-2251, paragraph 67, and Case T-57/03 *SPAG* v *OHIM — Dann and Backer (HOOLIGAN)* [2005] ECR II-287, paragraph 20).

31 As regards next the study carried out by Coopération européenne dans le domaine de la recherche scientifique et technique (COST) (European Cooperation in the field of scientific and technical research), it must be pointed out that that study does not bear out the applicant's argument that all varieties of strawberries have the same smell. Thus, tables 4, 5 and 6 of that study indicate that examiners on a sensory panel were able to distinguish five of the nine crops examined by the study (in particular those of 9 July 1997, 3 and 10 June 1998, 15 July 1998 and 2 June 1999) by their smell with a probability of error equal to or less than 5%. That means, according to the explanations accompanying those tables, that the different varieties of strawberries produce significantly different smells. That interpretation is borne out by the fact that the probability of error for the descriptive term 'smell of strawberries' is identical, in respect of certain crops, to that found for other descriptive terms, such as 'strawberry-flavour (fragrance)' or 'sweet flavour', which are considered by the study to be very effective in terms of differentiating the varieties of strawberries.

32 Admittedly, it is clear from those tables that the smell of strawberries did not make it possible to distinguish between the varieties of strawberry in a significant way in respect of all the different crops. However, it should be noted that, in order to verify whether the applicant's argument that the smell of ripe strawberries is unique and unequivocal in respect of all varieties is well founded, it is not necessary that those varieties systematically produce significantly different smells. The mere finding that it was possible to differentiate the varieties by their smell in five of the nine crops analysed in the study is sufficient to show that strawberries do not have just one smell.

33 It must therefore be held that the evidence adduced before the Board of Appeal shows that the smell of strawberries varies from one variety to another. Consequently, since the description 'smell of ripe strawberries' could refer to several varieties and therefore to several distinct smells, it is neither unequivocal nor precise and does not eliminate all elements of subjectivity in the process of identifying and perceiving the sign claimed.

34 It is, moreover, common ground that, at the present time, there is no generally accepted international classification of smells which would make it possible, as with international colour codes or musical notation, to identify an olfactory sign objectively and precisely through the attribution of a name or a precise code specific to each smell.

35 It follows from the foregoing that the applicant has failed to show that the Board of Appeal erred in finding that the description 'smell of ripe strawberries' was not objective, clear and precise.

36 As regards, second, the figurative element, the Board of Appeal stated that 'such a representation (was) even less precise than a description in words' on the ground that, first, 'it (was) not possible for the competent authorities and the public ... to determine whether the sign, which is the subject of protection, is the image of the ripe strawberry itself, or its smell' and, second, the image of the strawberry [would] be replaced in the mind of the consumer by its equivalent in words 'red strawberry' (or) 'ripe strawberry', which amounts to defining once again the smell in words, such a definition having already been considered to be too vague'.

37 In that respect, it must first be stated, as the applicant asserts, that there is no reason to consider that the authorities and the public will not be able to determine whether the protected sign is a figurative sign, consisting of a strawberry, or an olfactory sign

which is supposed to have the same smell as ripe strawberries. Since it is stated in the application for registration that it is an olfactory mark, there can be no doubt concerning the nature of the sign registered, in the same way that the authorities and the public are able to determine whether a musical stave represents a figurative sign, consisting of lines and signs, or the melody of which the stave is the transcription.

38 Second, the Court finds that the fact that the image of the strawberry can be replaced in the mind of the consumer by the expression 'red strawberry' is irrelevant. Any figurative representation of a mark, whatever its type, may be described in words and will be replaced in the mind of the consumer by a description whenever that description is easier to commit to memory than the figurative representation itself. Thus, in particular, the musical stave of a sound sign consisting of a very well-known melody will most probably be replaced in the mind of the consumer by the name of that melody.

39 In *Sieckmann* (paragraph 69), the Court of Justice held that the graphic representation of an olfactory mark must, in order to be accepted, represent the odour whose registration is sought and not the product emitting that odour. It therefore held that the chemical formula of the substance emitting the odour in question could not be regarded as a valid graphic representation.

40 The Court of First Instance cannot but find therefore that since the image of a strawberry contained in the application for registration represents only the fruit which emits a smell supposedly identical to the olfactory sign at issue, and not the smell claimed, that does not amount to a graphic representation of the olfactory sign.

41 Moreover, that image is subject to the same criticism as the description 'smell of ripe strawberries'. As it has been established that strawberries, or at least some of them, have a different smell according to their variety, the image of a strawberry whose variety is not specified does not enable the olfactory sign claimed to be identified with clarity and precision.

42 Consequently, the findings of the Board of Appeal in relation to the image of the red strawberry must also be upheld.

43 As regards, third, the combination of the description in words and the image, the Board of Appeal considered that, since the two elements are not valid graphic representations, neither can their combination be regarded as a permissible representation.

44 The applicant criticises the Board of Appeal for examining the two elements of the representation separately instead of examining them as a single representation and asserts that the image supplements the description, in that it reflects the state of ripeness in which strawberries emit the smell in question, thus making the graphic representation complete in itself.

45 In that respect, the Court of First Instance notes, first of all, that it follows from the case-law that a combination of methods of representation not capable, in themselves, of satisfying the requirements of graphic representation is not able to satisfy those requirements and that at least one of the elements in the representation must satisfy all the requirements (*Sieckmann*, paragraph 72, and *Libertel*, paragraph 36). Consequently, since it has been found that the description in words in question and the image of a ripe strawberry, reproduced in paragraph 2 above, do not satisfy the conditions required of graphic representation, it must be held that their combination does not constitute a valid graphic representation.

46 Furthermore, contrary to what the applicant claims, the image adds no additional information in relation to the description in words. The information purportedly

added, that is, the state of ripeness in which a strawberry emits the smell in question, is already contained in the description given, since that description states that it is the smell of 'ripe' strawberries. Thus, since the two elements in the representation convey the same information, their combination cannot amount to more than the sum of the two parts and cannot overcome the criticisms raised against each of them individually.

47 It results from all the foregoing that the Board of Appeal correctly found that the olfactory sign in question had not been represented graphically for the purpose of Article 4 of Regulation No 40/94, as interpreted by the case-law.

48 Consequently, since the single plea in law relied on is unfounded, the action must be dismissed.

Costs

49 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by the defendant.

On those grounds,

THE COURT OF FIRST INSTANCE (Third Chamber)

hereby:

1. Dismisses the action;

2. Orders the applicant to pay the costs.

Jaeger Tiili Czúcz

Delivered in open court in Luxembourg on 27 October 2005.

E. Coulon M. Jaeger

Registrar President