JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)

5 December 2000 *

In Case T-32/00,

Messe München GmbH, established in Munich, Germany, represented by M. Graf of the Munich Bar, Mitscherlich & Partner, 33 Sonnenstraße, Munich,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by D. Schennen, Head of the Legal Affairs Service and A. von Mühlendahl, Vice-President responsible for Legal Affairs, acting as Agents, with an address for service in Luxembourg at the office of C. Gómez de la Cruz, of the Commission's Legal Service, Wagner Centre, Kirchberg,

defendant,

* Language of the case: German.

APPLICATION for annulment of the Decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 17 December 1999 (Case R 177/1998-2) refusing registration of the sign 'electronica' as a Community trade mark,

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

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

Registrar: G. Herzig, Administrator,

having regard to the application lodged with the Registry of the Court on 18 February 2000,

having regard to the defence lodged with the Registry of the Court on 6 April 2000 and

further to the hearing on 5 July 2000,

gives the following

Judgment

Facts

1 On 19 March 1996 the applicant filed with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (hereinafter 'the Office') an application for a Community trade mark in respect of the word 'electronica'. As regards the type of trade mark, the application form allowed for a choice between the following: 'word mark', 'figurative mark', 'three-dimensional mark' and 'other'. The applicant chose the latter and specified 'script' ('Schriftzug').

2 In its application the applicant sought registration of the trade mark in respect of goods and services in classes 16, 35 and 41 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, corresponding to the following descriptions for each class:

'Class 16: catalogues for electronic component and assembly trade fairs; such goods primarily aimed at persons acting in the course of trade.

Class 35: organising electronic component and assembly trade fairs; such services primarily aimed at persons acting in the course of trade.

Class 41: organising trade conferences on electronic components and assemblies; publishing and distributing catalogues for electronic component and assembly trade fairs and conferences; all such services primarily aimed at persons acting in the course of trade.'

3 By letter of 11 March 1998 the Office's examiner raised an objection against the application and notified the applicant that there was a ground for refusal under Article 7(1)(b) and (c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.

4 The applicant replied to that objection by letter of 5 May 1998.

5 By decision of 25 August 1998 the examiner declared that he was maintaining his objection and refused the application in respect of all the goods and services claimed.

6 On 22 October 1998 the applicant filed with the Office a notice of appeal under Article 59 of Regulation No 40/94 against the examiner's decision.

7 The appeal was dismissed by Decision R 177/1998-2 of 17 December 1999 of the second Board of Appeal of the Office (hereinafter 'the contested decision'). The contested decision was received by the applicant by fax of 21 December 1999 and by registered letter with request for acknowledgement of receipt on 31 December 1999.

Forms of order sought

8 The applicant claims that the Court should:

— annul the contested decision;

— order a refund of the fee for appeal paid to the Office;

— order the Office to pay the costs;

— in the alternative, in the event that the trade mark is not accepted for the entire list of goods and services in respect of which registration is sought, add the following statement to that list:

'Alle vorgenannten Waren/Dienstleistungen für eine in München stattfindende Messe' (all such goods and services for a trade fair held in Munich).

9 The Office contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

The application for a refund of the fee for appeal

10 It is necessary to deal first of all with the applicant's request for a refund of the fee for appeal.

11 Article 136 of the Rules of Procedure of the Court of First Instance provides:

'...

Costs necessarily incurred by the parties for the purposes of the proceedings before the Board of Appeal and costs incurred for the purposes of the production... of translations of pleadings or other documents into the language of the case [before the Court of First Instance] shall be regarded as recoverable costs.

...'

12 That being so, the applicant's request for a refund of the fee for appeal paid to the Office may be regarded as part of its application for costs.

The main claim

Arguments of the parties

13 The applicant essentially claims that the contested decision is vitiated by an infringement of Articles 7(1)(b) and (c) of Regulation No 40/94, in that it constitutes a refusal to register a trade mark which fulfils the requirements for registration laid down by those provisions.

14 It observes first of all that the mark in question does not simply consist of the word 'electronica' but includes a particular graphic representation of the usual written form of that word.

15 At the hearing the applicant sought to justify that position on the basis both of the peculiarities of German trade mark law and the fact that nouns begin with a capital letter in German.

16 Next, it argues that a mark can only be refused registration under Article 7(1)(b) of Regulation No 40/94 on the ground that it is devoid of distinctive character if it possesses not the slightest distinctive character. It submits that it was for the examiner to show that.

17 It also claims that, whilst it may be true that the term 'electronics' — as a specialist field of electro-technology, one of the aims of which is to use electric currents to make electrons move — broadly defines the underlying technology, it is not really descriptive. On the contrary, when applied to services connected with trade fairs, it may be regarded as a fanciful term.

18 As regards the examiner's argument, endorsed in the contested decision, that the trade mark in question is devoid of distinctive character and is merely a descriptive indication of the nature of the goods and services, the applicant contends that Article 7(1)(c) of Regulation No 40/94 can only apply in the specific case where a particular reason makes it imperative that the sign concerned remain available.

19 In response to the examiner's observation that, at least in Spanish, the word 'electronica' describes the intended purpose of the goods and services (designed for, or relating to, items or matters connected with electronics), the applicant observes that, first, the Spanish word 'electrónica' (electronics) is spelt with an accent on the 'o' and, secondly, the word 'electronics' designates a general concept and is not in any way descriptive in relation to the goods and services claimed in the application.

20 The applicant furthermore observes that it is not appropriate to base an argument on the meaning of the word 'electronica' in Spanish given that English is the reference language in the field of electronics.

21 It adds, in relation to the descriptiveness of the trade mark in question in Dutch, which the Office raised, that the Dutch word 'Elektronica' is spelt with a 'k' instead of a 'c'.

22 Furthermore, even if the word 'electronica' were deemed equivalent to the German word 'Elektronik', the latter is purely generic and only has a meaning if used with another descriptive word.

23 The applicant further claims that the Spanish word 'electrónica', used for trade fairs, possesses distinctive character just as the German word 'Elektronik' does.

24 Finally, the applicant points out that the trade mark in question has been registered in the Benelux countries, France, Italy and the former German Democratic Republic.

25 The Office contends first of all that, as was stated in the contested decision, the mark applied for does not display any graphic feature differentiating it from a word mark.

26 Secondly, the Office notes that the Board of Appeal made the very relevant point that the trade mark in question is also barred from registration as a Community trade mark under Article 7(1)(c) of Regulation No 40/94.

27 It was found in the contested decision that the word 'electronica' was descriptive in regard to the goods and services claimed in the application in, for example,

Spanish, Dutch, German and English, the meaning of the word being without doubt comprehensible in all the languages of the Community. In any event, in the light of Article 7(2) of Regulation No 40/94, it need merely be observed that the word is descriptive in part of the Community.

28 Thirdly, the Office claims that registration of the trade mark in question was also rightly refused on the basis of Article 7(1)(b) of Regulation No 40/94, because it is devoid of distinctive character.

29 The reasons why the trade mark applied for lacks distinctive character and is descriptive coincide in this case.

Findings of the Court

30 The Court notes first of all that the word 'electronica', as it appears in the trade mark application, is written in helvetica script.

31 However, using that script does not add any figurative or other feature capable of distinguishing the word 'electronica', having regard, *inter alia*, to its functional use as a simple word mark. Furthermore, in the application form, the applicant,

faced with a choice between the designations 'word mark', 'figurative mark', 'three-dimensional' and 'other', chose the latter, specifying 'script' ('Schriftzug').

32 The trade mark 'electronica' must therefore not be regarded as figurative in any way but as a simple word mark.

33 Secondly, it must be determined whether the mark has distinctive character or is purely descriptive.

34 Under Article 4 of Regulation No 40/94, the decisive factor if a sign capable of being represented graphically is to be eligible for registration as a Community trade mark is its capacity to distinguish the goods of one undertaking from those of another (see Case T-163/98 *Procter & Gamble* v *OHIM (BABY-DRY)* [1999] ECR II-2383, paragraph 20, and Case T-19/99 *DKV* v *OHIM (Companyline)* [2000] ECR II-1, paragraph 23).

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

36 Under Article 7(1)(b) of Regulation No 40/94, 'trade marks which are devoid of any distinctive character' are not to be registered.

37 In this case, the Court notes that the word 'electronica' is almost identical to the word 'electrónica' in Spanish and Portuguese.

38 However, the fact that there is no accent on the 'o' in the word 'electronica' is clearly not an additional characteristic such as to render the sign, taken as a whole, capable of distinguishing the applicant's services from those of other undertakings (see, by way of analogy, *BABY-DRY*, paragraph 27, and *Companyline*, paragraph 26).

39 It cannot be argued that the average Spanish or Portuguese speaking consumer of the goods and services claimed in the application for the trade mark in question will notice that there is no accent on the letter 'o' in the word electronica and then interpret that as a factor capable of conferring on that word the character of a trade mark.

40 In addition, the words 'elettronica' in Italian, 'elektronica' in Dutch and 'ilektronika', the transliteration into Latin characters of the neuter plural of the Greek 'ηλεκτρονικά' (electronics), are so close to the word 'electronica' that the mark's distinctive character in those languages must, similarly, be considered to be almost or completely non-existent.

41 Furthermore, under Article 7(1)(c) of Regulation No 40/94, 'trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of the rendering of the service, or other characteristics of the goods or service', are not to be registered.

42 In this case the trade mark application relates to catalogues and the organisation of trade fairs and conferences on electronic components and assemblies.

43 The goods and services thus all relate to electronic components or assemblies. Electronics is the basic subject area or context to which those goods and services relate. They are identifiable by their relationship to that subject.

44 In that sense, the trade mark consists exclusively of a word which, at least in Spanish and Portuguese, describes an essential characteristic of the goods and services in question: it indicates the actual goods and services, not their link with the undertaking which makes or provides them. The mark therefore has no feature such as might differentiate it from its meaning as an actual description of the goods and services concerned.

45 As regards the applicant's submission that the mark has been registered in some countries, the purpose of the Community trade mark is, according to the first recital in the preamble to Regulation No 40/94, to enable 'the products and services of undertakings to be distinguished by identical means throughout the entire Community, regardless of frontiers' (Case T-122/99 *Procter & Gamble* v *OHIM (Soap Bar Shape)* [2000] ECR II-265, paragraph 60).

46 Therefore, registrations in Member States, or indeed in third countries, are a factor which is not decisive when considering an application to register a Community trade mark but may only be taken into consideration to that end (*Soap Bar Shape*, paragraph 61).

47 The Community trade mark regime is an autonomous system with its own set of objectives and rules peculiar to it; it is self-sufficient and applies independently of any national system.

48 In addition, the applicant has not claimed that the trade mark in question is registered in Spain or Portugal.

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

50 It follows from the foregoing that the word 'electronica' is devoid of distinctive character and is purely descriptive for the purposes of Articles 7(1)(b) and (c) and 7(2) of Regulation No 40/94.

51 Consequently, 'electronica' was not registrable as a Community trade mark and the Office cannot be criticised for having adopted the contested decision.

52 The applicant's main claim must therefore be dismissed.

The subsidiary claim

Arguments of the parties

53 In the context of its challenge to the contested decision, the applicant points out that it has been organising the 'electronica' trade fair in Munich for many years.

54 In the alternative, it states that it would be prepared to add to the list of goods and services in respect of which registration is sought the following statement: 'Alle vorgenannten Waren/Dienstleistungen für eine in München stattfindende Messe' (all such goods and services for a trade fair held in Munich).

55 According to the applicant, 'that limitation clearly shows that this case relates exclusively to a trade fair held in a specific place and not to a term which has to be used as a descriptive indication in countries outside Germany'.

56 At the hearing the applicant explained that, by its alternative claim, it was requesting that the list of goods and services in respect of which registration of the trade mark was sought be shortened.

57 The Office observes that the applicant proposes to restrict the list of goods and services pursuant to Article 44(1) of Regulation No 40/94, not to disclaim protection in respect of an element of the trade mark under Article 38(2).

58 However, the Office submits that the proposed restriction cannot alter the fact that there are absolute grounds for refusal. The trade mark sought to be registered is descriptive, whether or not it is used for a trade fair in Munich. It is also devoid of distinctive character because it is not capable of denoting a specific exhibition, wherever held.

59 Furthermore, the trade mark itself gives no indication as to any particular town. The list of goods and services could conceivably be limited to goods from a certain town or region or to a certain place where services are provided in order to avoid the ground for refusal relating to trade marks of such a nature as to deceive the public (Article 7(1)(g) of Regulation No 40/94) where the trade mark includes the name of the town or region concerned. But this trade mark application bears no relation to such cases, since no geographical indication is involved.

60 According to the Office, the applicant's subsidiary application could also be interpreted as claiming protection limited geographically to the area of Munich or Germany and as not intended to prevent use of the word 'electronica' in respect of trade fairs or exhibitions in other Member States.

61 However, the Office contends that to limit the territorial validity and scope of protection of a Community trade mark geographically in that way would be incompatible with the principle of the unitary character of the mark.

Findings of the Court

62 By its subsidiary claim, the applicant is not requesting that the mark itself be altered, but that the list of goods and services in respect of which registration of the trade mark was applied for in the main proceedings be shortened. However, the goods and services in respect of which the trade mark is claimed still refer to electronics.

63 That being so, the subsidiary claim in no way affects the mark's lack of distinctive character or its descriptiveness, as explained above.

64 Consequently, without prejudice to the admissibility of the subsidiary claim, it would not in any event lead to the trade mark being registered and must therefore be dismissed.

Costs

65 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they were applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it must be ordered to pay the defendant's costs, as applied for by that party.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

1. **Dismisses the action;**

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

Tiili Moura Ramos Mengozzi

Delivered in open court in Luxembourg on 5 December 2000.

H. Jung

Registrar

P. Mengozzi

President