JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)
8 July 2004 *

In Case T-270/02,

MLP Finanzdienstleistungen AG, established in Heidelberg (Germany), represented by W. Göpfert, lawyer,

applicant,

v

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

defendant,

ACTION brought against the decision of the Third Board of Appeal of OHIM of 26 June 2002 (Case R 206/2002-3) refusing to register the word mark 'bestpartner',

* Language of the case: German.

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

composed of: J. Pirrung, President, A.W.H. Meij and N.J. Forwood, Judges,

Registrar: D. Christensen, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 28 August 2002,

having regard to the response lodged at the Registry of the Court of First Instance on 19 December 2002,

having regard to the measures of organisation of procedure of 16 December 2003,

further to the hearing on 3 February 2004,

gives the following

Judgment

Facts

1 On 20 June 2001, the applicant lodged an application for registration of a Community trade mark with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to 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 was the word mark 'bestpartner'.

3 The services in respect of which the mark was sought come within classes 36, 38 and 42 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, after correction, to the following description:

— 'Insurance, insurance consultancy, insurance brokerage; financial services, financial consultancy, consultancy in matters relating to savings and investment, investment consultancy; financial analysis, asset management, in particular investment funds; capital investments; financial management for others; consultancy in the purchasing of real estate, real estate investment planning for others', coming within class 36;

— 'Internet services, namely providing, processing and presenting of information via the medium of the internet', coming within class 38;

— 'Data processing for others; development, creation, improvement and upgrading of programs for word processing and data processing and for process control; technical and applications consultancy relating to computers and data processing programs; services of an internet service provider, namely computer programming for solving sectoral problems on the internet, website creation and design, installation and maintenance of access to the internet and dial-in nodes for the internet', coming within class 42.

4 By decision of 2 January 2002, the examiner refused the application under Article 38 of Regulation No 40/94, relying on Article 7(1)(b) and (c) and (2) of the regulation, on the ground that the mark applied for was a customary expression and would be perceived as a descriptive advertising slogan devoid of any distinctive character, at least in English-speaking parts of the European Union. On 27 February 2002, the applicant filed at OHIM a notice of appeal against the examiner's decision, under Article 59 of Regulation No 40/94.

5 By decision of 26 June 2002 ('the contested decision'), the Third Board of Appeal dismissed the appeal on the grounds that the mark applied for is, first, devoid of any distinctive character and, second, composed exclusively of descriptive elements.

Forms of order sought

6 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

7 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

Arguments of the parties

8 The applicant relies, first, on infringement of Article 7(1)(b) of Regulation No 40/94, stating that the Board of Appeal failed to recognise the distinctive character of the mark applied for and, second, infringement of Article 7(1)(c) of the regulation because the Board of Appeal misapplied the criterion relating to the need for availability.

9 The applicant states that the terms 'best' and 'partner' may both be understood in different ways. A fortiori, the term 'bestpartner' resulting from the combination of those terms has no fixed meaning and allows the intended public, composed of average consumers but ones who are particularly well informed and reasonably attentive in the sensitive field of insurance and financial services, to distinguish the services it offers. The applicant stresses that the term 'bestpartner' is a neologism which is not found in dictionaries as a single term and should be examined separately from its constituent parts.

10 According to the applicant, it follows from those circumstances that the sign in respect of which it has applied for registration as a mark for financial, insurance and internet data processing services is not descriptive of those services. There is therefore no need for availability which would preclude registration. The applicant refers to Case T-135/99 *Taurus-Film* v *OHIM* (*Cine Action*) [2001] ECR II-379, paragraph 29, and states that a sign does not have a distinctive character if the

relationship between that sign and those services is too vague and indeterminate. Only statements which are purely descriptive, in a clear and unequivocal manner, must remain available in accordance with Article 7(1)(c) of Regulation No 40/94. In the present case, the sign 'bestpartner' should be viewed as an advertising slogan.

11 As to the results of an internet search referred to in paragraph 4 of the contested decision, the applicant states that the fact that the expression in question is widely used in business is not a good enough reason to refuse registration as a trade mark pursuant to Article 7(1)(c) of Regulation No 40/94. The applicant refers to examples of use of the sign in question as domain names on the internet and concludes that the use made of the sign in business shows that it is appropriate for designating that services come from a given undertaking.

12 In addition, it follows from the same circumstances that the sign 'bestpartner' is not devoid of the minimum degree of distinctive character required by the case-law (Case T-34/00 *Eurocool Logistik* v *OHIM* (*EUROCOOL*) [2002] ECR II-683, paragraph 39). The applicant states that the absence of distinctive character cannot arise merely from the finding that the sign in question lacks an additional element of imagination or does not look unusual or striking (Case T-87/00 *Bank für Arbeit und Wirtschaft* v *OHIM* (*EASYBANK*) [2001] ECR II-1259, paragraph 39).

13 Moreover, the fact that similar marks have been registered with OHIM, in particular the marks 'bestpartner classic' and 'bestpartner topinvest', as well as in Member States of the Community, should be viewed as an indication that the sign applied for is also capable of being registered as a trade mark.

14 Lastly, the applicant refers to the arguments it put forward before OHIM and states that they form an integral part of its action.

15 OHIM challenges all the pleas and arguments put forward by the applicant. Accordingly, the Board of Appeal was right to refuse the mark applied for by the applicant, in particular because it is devoid of the required minimum degree of distinctive character.

Findings of the Court

16 The Court notes, as a preliminary point, that the applicant concludes its application by asking that its submissions before OHIM be considered as forming an integral part of the pleas and arguments in the present case in order to 'avoid useless repetition'. It is settled case-law that, under Article 44(1) of the Rules of Procedure of the Court of First Instance, which is applicable in intellectual property matters by virtue of Article 130(1) and Article 132(1) of those rules, although specific points in the body of the application can be supported and completed by references to specific passages in the documents attached, a general reference to other documents cannot compensate for the lack of essential information in the application itself which, under the aforementioned provisions, must be contained in the application itself (Joined Cases T-305/94 to T-307/94, T-313/94 to T-316/94, T-318/94, T-325/94, T-328/94, T-329/94 and T-335/94 *LVM* v *Commission* [1999] ECR II-931, paragraph 39). Accordingly, the application, in so far as it refers to documents filed by the applicant before OHIM, is inadmissible because the general reference contained therein is not linked to a plea developed in the application.

17 On the substance, it must be remembered, first of all, that under Article 7(1)(b) of Regulation No 40/94, 'trade marks which are devoid of any distinctive character' are to be refused registration.

18 In addition, Article 7(2) of Regulation No 40/94 states that 'Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community'.

19 A sign's distinctiveness can be assessed only by reference first to the goods and services in respect of which registration is sought and secondly to the understanding which the relevant public has of that sign (see, for example, Case T-355/00 *DaimlerChrysler* v *OHIM* (*TELE AID*) [2002] ECR II-1939, paragraph 51).

20 In addition, account must be taken not only of the explicit and immediate meaning of the terms used to form a composite sign, but also of the connotations they are likely to evoke.

21 In the present case, the parties focused in their arguments on the fact that the two terms 'best' and 'partner' are English terms, but it is also true that they exist, possibly with minor variations, in other languages of the Community, including Dutch and German. In any event, since registration may be refused once there are grounds for refusal in part of the Community, it is clear that, if it were to be established that there is a ground for refusal in the English-speaking part of the Community, covering two Member States the existence of such a ground in other parts of the Community would not affect the outcome of the present case. Thus, the relevant public for the purposes of this case is the English-speaking public.

22 In addition, the relevant public is made up of particularly well-informed and reasonably attentive consumers, having regard to the specialised nature of the services connected with the trade mark application.

23 The sign in this case is composed solely of the terms 'best' and 'partner', both of which form part of inter alia the English language. The term 'best' evokes the notion of quality and thus suggests to the relevant public that the product or service is of the highest quality. The word 'partner' is used in various contexts, including the supply of services, to describe relationships of association or partnership by suggesting positive connotations of reliability and continuity. The Board of Appeal states correctly in paragraph 24 of the contested decision that, in modern advertising usage, the word is used to describe the supplier-customer relationship, with the former being viewed as the 'business partner' of the latter.

24 It is thus clear that the terms 'best' and 'partner' are generic words which simply denote the quality of services supplied by an undertaking to its clients (see, to that effect, Case T-19/99 *DKV* v *OHIM* (*COMPANYLINE*) [2000] ECR II-1, paragraph 26, upheld by the Court of Justice on appeal in Case C-104/00 P *DKV* v *OHIM* [2002] ECR I-7561, paragraphs 13 to 25).

25 Accordingly, the terms, taken individually, are descriptive of the relevant services. Terms which are descriptive of goods or services are also devoid of any distinctive character in relation to those goods or services (Case T-323/00 *SAT.1* v *OHIM* (*SAT.2*) [2002] ECR II-2839, paragraph 40, appeal pending). It would be different only if the term resulting from their being coupled together meant something other than the meaning denoted by the two terms placed side by side.

26 Coupling the two terms together without any graphic or semantic modification does not imbue them with any additional characteristic such as to render the sign, taken as a whole, capable for the relevant public of distinguishing the applicant's services from those of other undertakings (see, to that effect, *COMPANYLINE*, cited in paragraph 24 above, paragraph 26). It is evident from the term 'bestpartner' that the

meaning of the two terms comprising it is 'best partner', in the same way as the terms simply placed side by side. The fact that the term as such does not appear in dictionaries — whether as one word or otherwise — does not in any way alter that finding.

27 Consequently, the term 'bestpartner' is devoid of the minimum degree of distinctive character required by the case-law (see, for example, *EUROCOOL*, cited in paragraph 12 above, paragraph 39), and the Board of Appeal was thus right to find that the ground for refusal in Article 7(1)(b) of Regulation No 40/94 precluded registration of the mark applied for in the present case.

28 As is clear from Article 7(1) of Regulation No 40/94, for a sign to be ineligible for registration as a Community trade mark, it is sufficient that one of the absolute grounds for refusal applies (*COMPANYLINE*, cited in paragraph 24 above, paragraph 30). Consequently, it follows from the foregoing that this action must be dismissed without its being necessary to consider the applicant's argument concerning Article 7(1)(c) of Regulation No 40/94.

Costs

29 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 OHIM has applied for costs and the applicant has been unsuccessful, the applicant must be ordered to pay all the costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby:

1. Dismisses the application;

2. Orders the applicant to pay the costs.

Pirrung Meij Forwood

Delivered in open court in Luxembourg on 8 July 2004.

H. Jung J. Pirrung

Registrar President