JUDGMENT OF THE GENERAL COURT (Third Chamber)

9 July 2010 *

In Case T-85/08,

Exalation Ltd, established in Ilford, Essex (United Kingdom), represented by K. Zingsheim, lawyer,

applicant,

v

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

defendant,

* Language of the case: German.

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 17 December 2007 (Case R 1037/2007-4), concerning an application for registration of the word sign Vektor-Lycopin as a Community trade mark,

THE GENERAL COURT (Third Chamber),

composed of J. Azizi, President, E. Cremona and S. Frimodt Nielsen (Rapporteur), Judges,

Registrar: K. Andová, Administrator,

having regard to the application lodged at the Court Registry on 19 February 2008,

having regard to the response lodged at the Court Registry on 15 July 2008,

further to the hearing on 2 March 2010,

gives the following

Judgment

Background to the case

1 On 6 January 2006, the applicant, Exalation Ltd, filed an application for registration of a Community trade mark at 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 by Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

2 The mark for which registration was sought is the word sign Vektor-Lycopin.

3 The goods in respect of which registration was sought come within Classes 5, 29 and 30 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 in particular, for each of those classes, to the following description:

— Class 5: 'Pharmaceutical and veterinary preparations for medical purposes; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies';

— Class 29: 'Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats';

— Class 30: 'Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); ice'.

4 By decision of 4 May 2007 ('the examiner's decision'), the examiner rejected, under Article 38 of Regulation No 40/94 (now Article 37 of Regulation No 207/2009), the trade mark application in respect of the goods listed in paragraph 3 above, on the grounds that the mark Vektor-Lycopin was descriptive and lacked distinctive character for the German- and English-speaking public of the European Community and that it could not be registered under Article 7(1)(b) and (c) and Article 7(2) of Regulation No 40/94 (now Article 7(1)(b) and (c) and Article 7(2) of Regulation No 207/2009).

5 On 3 July 2007, the applicant filed a notice of appeal under Articles 57 to 62 of Regulation No 40/94 (now Articles 58 to 64 of Regulation No 207/2009) against the examiner's decision.

6 By decision of 17 December 2007 ('the contested decision'), the Fourth Board of Appeal of OHIM dismissed the appeal and upheld the examiner's decision.

7 In the contested decision, the Board of Appeal held that the absolute grounds for refusal referred to in Article 7(1)(b) and (c) of Regulation No 40/94 were applicable in the German- and English-speaking parts of the Community. Those provisions, in conjunction with those of Article 7(2) of Regulation No 40/94, therefore precluded registration of the mark Vektor-Lycopin.

8 As regards application of the absolute ground for refusal referred to in Article 7(1)(c) of Regulation No 40/94, the Board of Appeal endorsed the findings of the examiner that, first, the German term 'Vektor' (vector) is used in genetic engineering to apply to molecules of deoxyribonucleic acid (DNA) used to introduce foreign DNA into a host cell and, secondly, the term 'vector' in medicine and in the field of pest and disease control refers to organisms which transmit diseases (paragraph 18 of the contested decision).

9 The Board of Appeal also endorsed the examiner's observations that the German term 'Lycopin' (lycopene) means a carotenoid with antioxidant properties (paragraph 18 of the contested decision).

10 The Board of Appeal also noted that the elements 'vektor' and 'lycopin' were linked by a hyphen, following the rules in the German and English languages (paragraph 18 of the contested decision).

11 The Board of Appeal, lastly, endorsed the examiner's findings that the sign applied for, taken overall, had a specific descriptive meaning in respect of the goods referred to in the application for registration. It is in fact a food supplement, the active ingredient of which may be found in the composition of pharmaceutical preparations or dietetic preparations for medical use, or in baby food or in any of the food products

falling within Classes 29 and 30 listed in paragraph 3 above (paragraphs 19 to 21 of the contested decision).

12 Moreover, in order to ascertain the relevant public, it is necessary to include not only consumers but also producers of, and traders in, the goods covered by the application for registration (paragraph 22 of the contested decision).

Forms of order sought

13 In the application, the applicant claims that the Court should:

— annul the contested decision;

— annul the examiner's decision;

— order OHIM to register the mark Vektor-Lycopin;

— order OHIM to pay the costs.

14 OHIM contends that the Court should:

— dismiss the application;

— order the defendant to pay the costs.

15 At the hearing, the applicant abandoned its second and third heads of claim, formal note of which was taken in the minutes of the hearing.

Law

16 In support of its application for annulment of the contested decision, the applicant puts forward two pleas in law alleging, first, infringement of Article 7(1)(c) of Regulation No 40/94 and, second, infringement of Article 7(1)(b) of Regulation No 40/94. The Court will examine the first plea first.

The plea alleging infringement of Article 7(1)(c) of Regulation No 40/94

Arguments of the parties

17 First the applicant points out that the sign Vektor-Lycopin consists of two components, the combination of which is unusual and unknown. There is no evidence of the sign Vektor-Lycopin either in dictionaries, or in the oral or written language. It is not known or in current use in medicine, biology, physics or mathematics. The sign Vektor-Lycopin therefore constitutes a neologism satisfying the criteria laid down in the case-law whereby the juxtaposition of two descriptive words is not descriptive if, because of the unusual nature of the combination, the sign at issue creates an impression sufficiently far removed from that produced by the meaning of the terms composing it, with the result that that sign, taken as a whole, is more than the sum of its parts. Being entirely new, the sign Vektor-Lycopin is therefore unknown to the public specialising in medicine, biology, pharmacy or physics and to the end consumer.

18 Secondly, the applicant contends that there is no single definition of the word element 'vektor'. The Board of Appeal merely took into account the meaning of that term in the field of genetic engineering. However, that term has a number of other meanings in various fields, such as physics. The semantic restriction applied by the Board of Appeal is open to criticism since, without due reason, it is unfavourable to the applicant. Moreover, the meaning of the German term 'Vektor' specific to the field of genetic engineering is not known either to the specialist public consisting of biologists, physicists, doctors, pharmacists, mathematicians or other specialists, nor a fortiori to the average end consumer of the goods described in the application for registration. Thus, the target public cannot infer from the sign Vektor-Lycopin that it

describes a mixture of extracts of liquorice and tomato. In support of its claims, the applicant proposes to submit to the Court some results of opinion surveys.

19 Thirdly, the applicant maintains that, if the 'vektor' element was descriptive, as the Board of Appeal asserts, no mark including that term should be registrable. However, there are many Community, national and international marks including the term 'vektor'. The position adopted by the Board of Appeal should therefore, according to the applicant, lead to cancellation, under Article 51(1)(a) of Regulation No 40/94 (now Article 52(1)(a) of Regulation No 207/2009), of all Community trade marks including the term 'vektor'.

20 Lastly, the applicant maintains that the arguments it put forward, both in support of its trade mark application and during the proceedings before the Board of Appeal, are maintained in full and also form an integral part of this action.

21 OHIM disputes all the appellant's arguments.

Findings of the Court

22 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 rendering of the service, or other characteristics of the goods or service are not to be registered. Moreover, Article 7(2) of that regulation states that paragraph 1 is to apply notwithstanding that the grounds of non-registrability obtain in only part of the Community.

23 Signs or indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under Article 7(3) of Regulation No 40/94 (now Article 7(3) of Regulation No 207/2009) (Case C-191/01 P *OHIM* v *Wrigley* [2003] ECR I-12447, paragraph 30).

24 According to settled case-law, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all (*OHIM* v *Wrigley*, paragraph 23 above, paragraph 31, and Case T-316/03 *Münchener Rückversicherungs-Gesellschaft* v *OHIM (MunichFinancialServices)* [2005] ECR II-1951, paragraph 25).

25 In order for refusal to register a trade mark under Article 7(1)(c) of Regulation No 40/94 to be justified, it is not necessary that the signs and indications composing the mark at issue actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A word sign must therefore be refused registration if at

least one of its possible meanings designates a characteristic of the goods or services concerned (*OHIM* v *Wrigley*, paragraph 23 above, paragraph 32).

26 Consequently, OHIM must, under Article 7(1)(c) of Regulation No 40/94, determine whether a trade mark for which registration is sought represents, in the mind of the relevant class of persons, a description of the characteristics of the goods or services concerned or whether it is reasonable to assume that that might be the case in the future. If, at the end of that assessment, the Board of Appeal reaches the conclusion that that is the case, it must refuse, on the basis of that provision, to register the mark (see, by analogy, Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 56).

— Concerning the applicant's offer to provide evidence

27 In support of its arguments contesting that the relevant public is aware of the meaning adopted by the Board of Appeal of the German term 'Vektor', on the one hand, and of the term 'Vektor-Lycopin' on the other, the applicant proposes to submit to the Court several public opinion surveys.

28 It should be noted that the legality of a measure of the European Union falls to be assessed on the basis of the elements of fact and of law existing at the time when the measure was adopted. The legality of a decision of the Board of Appeal cannot therefore be called into question by pleading new facts before the Court unless it is proved that the Board of Appeal should have taken those facts into account of its own motion during the administrative procedure before adopting any decision in the

matter. According to Article 74(2) of Regulation No 40/94, OHIM may disregard facts or evidence which are not submitted in due time by the parties concerned. Accordingly, in an action for annulment the Court may not take into consideration factors of which OHIM was unable to be aware during the administrative procedure (see, to that effect, Case T-222/02 *HERON Robotunits* v *OHIM (ROBOTUNITS)* [2003] ECR II-4995, paragraphs 50 and 51 and case-law cited).

29 In this case, it must be noted that the opinion surveys the applicant proposes to adduce to the Court were not submitted either to the examiner or to the Board of Appeal during the administrative procedure. The applicant, moreover, does not contend that those surveys were available on the date on which the contested decision was adopted. Even if the results of those surveys had been available on that date they do not constitute facts which are well known, that is, which are capable of being taken into account by OHIM of its own motion and which are likely to be known by anyone or, at least, may be learnt from generally accessible sources (Case T-185/02 *Ruiz-Picasso and Others* v *OHIM — DaimlerChrysler (PICARO)* [2004] ECR II-1739, paragraph 29, and Case T-318/03 *Atomic Austria* v *OHIM — Fabricas Agrupadas de Muñecas de Onil (ATOMIC BLITZ)* [2005] ECR II-1319, paragraph 35). It follows that, whatever the probative value of that evidence, the applicant cannot attempt to dispute the legality of the contested decision on the basis of the evidence which it proposes to submit for the first time to the Court.

30 Consequently, the applicant's offer to submit evidence must be rejected.

— Concerning the applicant's reference to the arguments put forward in its trade mark application and during the proceedings before the Board of Appeal

31 The applicant states in the application initiating the proceedings that the arguments it put forward when submitting its application for registration of the trade mark and during the proceedings before the Board of Appeal are maintained in full and that they also form an integral part of this action.

32 Under Article 21 of the Statute of the Court of Justice and Article 44(1)(c) of the Rules of Procedure of the General Court, which applies to intellectual property matters by virtue of Articles 130(1) and 132(1) of those rules, applications must include a brief statement of the grounds relied on.

33 That statement must be apparent from the text of the application itself and be sufficiently clear and precise to enable the defendant to prepare its defence and the Court to rule on the action, if necessary without any other supporting information (Joined Cases C-189/02 P, C-202/02 P, C-205/02 P to C-208/02 P and C-213/02 P *Dansk Rørindustri and Others* v *Commission* [2005] ECR I-5425, paragraphs 94 and 100, and Case C-214/05 P *Rossi* v *OHIM* [2006] ECR I-7057, paragraph 37).

34 The Court has also held that, whilst the text of the application may be supported by references to specific passages in documents annexed to it, a general reference to other documents cannot make up for the absence of the essential arguments in the application (see Case T-169/03 *Sergio Rossi* v *OHIM — Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 30 and case-law cited).

35 It follows that, in so far as it refers to the written pleadings submitted by the applicant before OHIM, the application is inadmissible because the general reference made in it cannot be linked to the pleas and arguments put forward in the application (see, to that effect, *SISSI ROSSI*, paragraph 34 above, paragraph 31).

— Ascertaining the relevant public

36 The Board of Appeal concluded in the contested decision that the relevant public included all producers and consumers of pharmaceutical, veterinary and dietetic preparations, food for babies and other food products listed in paragraph 3 above, that is to say certain professionals as well as the general public. That definition, which is not disputed either by the applicant or by OHIM, must be approved.

37 It is thus necessary to examine whether, through its arguments, the applicant manages to establish that the sign Vektor-Lycopin does not constitute, for the relevant public defined in paragraph 36 above, a description of the characteristics of the goods concerned and that it is not reasonable to envisage that that would be the case in the future (see paragraphs 25 and 26 above).

— The applicant's challenge in respect of the assessment that the term 'lycopin' is descriptive

38 In paragraph 18 of the contested decision, the Board of Appeal stated that the applicant had not submitted any substantiated evidence to invalidate the examiner's observations to the effect that the element 'lycopin' (lycopene) designated a carotenoid with antioxidant properties.

39 For the first time at the hearing, the applicant challenged the Board of Appeal's assessment that the term 'lycopin' is descriptive. The Court observes that the applicant has not given any details to support its claims and there is thus no need to consider whether such an argument may be raised at this stage in the proceedings. In particular, the applicant has put forward no argument capable of calling into question the meaning attributed to the term 'lycopin' by the Board of Appeal. In those circumstances, the Court must find that the applicant has not succeeded in challenging the meaning attributed to the element 'lycopin' by the examiner and by the Board of Appeal.

40 First, that technical term designates a food supplement necessarily known by some of the relevant public, in particular professionals dealing with dietetic, pharmaceutical and veterinary preparations.

41 Secondly, the Board of Appeal established in the contested decision that the meaning of the term 'lycopin' was easily accessible to consumers of all the goods covered by the application for registration. The meaning of the term 'lycopin' does in fact appear in dictionaries and on web sites. It is probable therefore that the substance designated by that term is also known by some of the consumers of all the goods listed in paragraph 3 above.

42 Thirdly, consumers of pharmaceutical, veterinary, dietetic and sanitary preparations for medical use who are not aware of the meaning of the term 'lycopin' will often tend to seek advice from the informed section of the relevant public, namely doctors, pharmacists, dieticians and other traders in the goods concerned. Thus, by means of the advice received from those who prescribe it or through information from various media, the less well informed section of the relevant public is likely to become aware of the meaning of the term 'lycopin'.

43 The relevant public must therefore be regarded as being aware of the meaning of the term 'lycopin', or at least it is reasonable to envisage that the relevant public will become aware of it in the future (see paragraphs 25 and 26 above).

44 It should also be noted that it is by no means excluded that lycopene might be incorporated during the preparation of any of the goods covered by the application for registration. Since the applicant has not limited its application for registration to goods which do not or could not contain lycopene, the Court finds that there exists, or it is reasonable to envisage that there will exist in the future, a sufficiently direct and specific link in the mind of the relevant public between the element 'lycopin' and the composition of the goods listed in paragraph 3 above (see, to that effect, Case T-458/05 *Tegometall International* v *OHIM — Wuppermann (TEK)* [2007] ECR II-4721, paragraph 94 and case-law cited).

45 Hence, the Board of Appeal did not err in finding that the term 'lycopin' in the trade mark applied for was descriptive as regards the goods listed in paragraph 3 above.

— The applicant's argument based on the polysemy of the term 'vektor'

46 In paragraph 18 of the contested decision, referring to a dictionary entry which OHIM annexed to the response, the Board of Appeal stated that, in the field of genetic engineering, biology, medicine and plant protection, 'vektor' (vector) meant an agent transmitting a molecule, substance or disease.

47 Without disputing the meaning adopted by the Board of Appeal, the applicant claims that, in the field of mathematics and physics, the German term 'Vektor' has other meanings.

48 In order for registration of a sign to be impossible, it is sufficient for that sign to be descriptive in at least one of its meanings. A word sign must be refused registration under Article 7(1)(c) of Regulation No 40/94 if at least one of its possible meanings designates a characteristic of the goods or services concerned (*OHIM* v *Wrigley*, paragraph 23 above, paragraph 32).

49 Clearly, in the sign in question the term 'vektor' is combined with the term 'lycopin', which, as the Board of Appeal rightly established, designates a substance which may enter into the composition of goods listed in paragraph 3 above (see paragraph 44 above). Therefore, when construed with the meaning adopted by the Board of Appeal, the term 'vektor' will evoke, in the mind of the relevant public, a property of the goods covered by the application for registration consisting of the capacity to transmit a substance or an active ingredient which may be included in the composition of those goods.

50 It follows that, within the meaning adopted by the Board of Appeal, the German term 'Vektor' is descriptive of the goods listed in paragraph 3 above and that, in those circumstances, the applicant cannot succeed by arguing that the same term may have other meanings in certain specialist fields such as mathematics or physics.

— The applicant's argument that the sign Vektor-Lycopin produces an impression that is sufficiently removed from that produced by the sum of the elements that compose it

51 It follows from the foregoing that the term 'vektor' and the term 'lycopin' are both descriptive of the goods covered by the application for registration (see paragraphs 45 and 50 above).

52 The applicant claims, however, that the combination of the terms 'vektor' and 'lycopin' in the sign Vektor-Lycopin is unusual and unknown, since there is no evidence of that sign either in dictionaries, or in the oral or written language. According to the applicant, the sign Vektor-Lycopin thus creates an impression sufficiently far from that produced by the meaning of the terms of which it is composed that the sign, taken as a whole, is more than the sum of its parts.

53 The Court has consistently held that the juxtaposition of two descriptive words may not be descriptive if, because of the unusual nature of the combination, the sign at issue creates an impression which is sufficiently far removed from that produced by the meaning of the terms of which it is composed, with the result that that sign, taken as a whole, is more than the sum of its parts. In that connection, an analysis of the term in question in the light of the relevant lexical and grammatical rules is useful (see, to that effect, Case T-207/06 *Europig* v *OHIM (EUROPIG)* [2007] ECR II-1961, paragraph 29 and case-law cited; see also, by analogy, *Koninklijke KPN Nederland*, paragraph 26 above, paragraphs 98 and 100].

54 In the sign for which registration is sought in this case, the two terms 'vektor' and 'lycopin' are linked by a hyphen. As the Board of Appeal stated without contradiction by the applicant, this way of combining words is usual in both German and English.

55 Moreover, for the purpose of assessing the descriptive nature of a sign it is irrelevant whether or not there is evidence of it in dictionaries (see judgment of 23 October 2007 in Case T-405/04 *Borco-Marken-Import Matthiesen* v *OHIM (Caipi)*, not published in the ECR, paragraph 42 and case-law cited).

56 Therefore, the Court finds that, in the mind of the relevant public, the combination Vektor-Lycopin, associated with the food, dietetic, sanitary, veterinary and pharmaceutical preparations covered by the application for registration, will evoke the property of those goods as transmitters of lycopene. The relevant public, faced with the sign for which registration is sought associated with the goods covered by the application for registration, would consider that the goods at issue contain lycopene and allow consumers of them to assimilate that substance.

57 Consequently, the Court finds that the combination of the terms 'vektor' and 'lycopin', as in the sign Vektor-Lycopin, will constitute in the mind of the relevant public an indication of the properties of the goods listed in paragraph 3 above, and there is no need to give a ruling on the disputed question whether the relevant public is capable of understanding that the sign Vektor-Lycopin designates a food additive based on tomato and liquorice extracts manufactured by the applicant.

58 The Board of Appeal was therefore correct in finding that the mark Vektor-Lycopin consisted exclusively of terms which may serve, in trade, to designate characteristics of the goods listed in paragraph 3 above and should therefore be refused registration under Article 7(1)(c) of Regulation No 40/94.

— The applicant's argument alleging registration of marks including the terms 'vektor' or 'vector'

59 The applicant seeks to base an argument on the registration of a number of Community, national or international trade marks including the term 'vektor' but does not provide any evidence to support its claims. At the hearing the applicant also relied on registration of the sign Vector-Lycopin as a Community trade mark.

60 It should be noted in that regard that the registrability of a sign as a Community trade mark can be assessed only on the basis of the relevant Community rules, as interpreted by the judicature of the European Union. Therefore, the fact that, even under legal systems containing similar rules, marks that are identical or comparable to a mark for which registration is sought have been registered may, at most, be taken into account for information purposes but cannot be regarded as binding on OHIM or on the judicature of the European Union (see, to that effect, Case T-24/00 *Sunrider* v *OHIM (VITALITE)* [2001] ECR II-449, paragraph 33 and case-law cited, and Case T-16/02 *Audi* v *OHIM (TDI)* [2003] ECR II-5167, paragraph 40 and case-law cited).

61 Hence, even if it were correct, the applicant's argument alleging the existence of Community, national and international registrations of marks including the term 'vektor' and of the trade mark Vector-Lycopin is ineffective and must be rejected.

62 Furthermore, the legality of the decisions of Boards of Appeal must be assessed solely on the basis of the relevant rules and not on the basis of their previous practice in taking decisions (Case T-106/00 *Streamserve* v *OHIM (STREAMSERVE)* [2002] ECR II-723, paragraph 66).

63 Therefore, in any event, the applicant is not justified in claiming that confirmation by the Court of the Board of Appeal's decision in this case with regard to registration of the mark Vektor-Lycopin should lead to cancellation of earlier Community trade marks.

64 In the light of all the above, the Court finds that the Board of Appeal did not err in confirming the examiner's refusal to register the sign under Article 7(1)(c) of Regulation No 40/94.

The plea alleging infringement of Article 7(1)(b) of Regulation No 40/94

65 It is evident from the wording of Article 7(1) of Regulation No 40/94 that if one of the absolute grounds for refusal listed in that provision applies that suffices for the sign at issue not to be registrable as a Community trade mark (Case C-104/00 P *DKV* v *OHIM* [2002] ECR I-7561, paragraph 29).

66 Accordingly, the action must be dismissed in its entirety, there being no need to rule on the second plea in law alleging infringement of Article 7(1)(b) of Regulation No 40/94.

Costs

67 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. As the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by OHIM.

On those grounds,

THE GENERAL COURT (Third Chamber)

hereby:

1. Dismisses the action;

2. Orders Exalation Ltd to pay the costs.

Azizi Cremona Frimodt Nielsen

Delivered in open court in Luxembourg on 9 July 2010.

[Signatures]