JUDGMENT OF THE COURT OF FIRST INSTANCE (Third Chamber)

16 March 2006 *

In Case T-322/03,

Telefon & Buch Verlagsgesellschaft mbH, established in Salzburg (Austria), represented by H. Zeiner and M. Baldares del Barco, lawyers,

applicant,

v

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

defendant,

the other party to the proceedings before the Board of Appeal of OHIM, intervener before the Court of First Instance, being

* Language of the case: German.

Herold Business Data GmbH & Co. KG, formerly Herold Business Data AG, established in Mödling (Austria), represented by A. Lensing-Kramer, C. von Nussbaum and U. Reese, lawyers,

ACTION brought against the decision of the First Board of Appeal of OHIM of 19 June 2003 (Joined Cases R 580/2001-1 and R 592/2001-1) relating to invalidity proceedings between Herold Business Data AG and Telefon & Buch Verlagsgesellschaft mbH,

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

composed of M. Jaeger, President, V. Tiili and O. Czúcz, Judges,
Registrar: J. Plingers, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 19 September 2003,

having regard to the response lodged at the Registry of the Court of First Instance on 15 September 2004,

having regard to the response of the intervener lodged at the Registry of the Court of First Instance on 15 September 2004,

further to the hearing on 14 September 2005,

gives the following

Judgment

Background to the dispute

1 On 2 October 1996 the applicant filed an application for a Community trade mark at the Office for Harmonization 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 mark applied for was the word sign WEISSE SEITEN. The goods and services in respect of which registration was sought are in Classes 9, 16, 41 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 to the following descriptions:

— Class 9: 'Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers and recorded storage media for data processing installations and equipment, in particular tapes, discs,

CD-ROMs; sound recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus';

— Class 16: 'Paper, cardboard and goods made from these materials, not included in other classes; printed matter, reference works, classified directories; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks';

— Class 41: 'Publishing services, in particular the publication of texts, books, magazines, newspapers';

— Class 42: 'Editing of written texts'.

3 The mark applied for was registered on 28 September 1999.

4 On 14 February 2000 Herold Business Data GmbH & Co. KG, formerly Herold Business Data AG, applied for a declaration that that registration be declared invalid pursuant to Article 51(1)(a) of Regulation No 40/94, on the ground that the registration was contrary to the absolute grounds for refusal laid down in Article 7(1)(b) to (d) and (g) of the Regulation. It referred to a decision of the Cancellation Division of the Patentamt (Austrian Patent Office) of 6 November 1998 declaring the Austrian mark WEISSE SEITEN invalid, and a decision of the Oberster Patent-

und Markensenat (Austrian Supreme Patent and Trade Mark Board) of 22 September 1999 upholding the decision of the Patentamt in relation to the following goods: 'paper and printed matter'. In addition, in support of its application for a declaration of invalidity it produced, inter alia, the following documents before the Cancellation Division of OHIM:

— the 'communication from the Commission to the Council and the European Parliament on future development of the market in directories and other telecommunications information services in a competitive environment' of 22 September 1995 ('the communication from the Commission');

— a variety of information from the Austrian postal service concerning telephone directories;

— copies of order forms for Austrian telephone directories for 1993/94 and 1994/95;

— guidelines relating to the publication of official directories, which was the subject of a contract concluded in 1992 between the intervener and the Austrian post and telegraph authorities;

— copies of letters exchanged between the intervener and various departments of the Austrian post and telegraph authorities concerning publication of the 'Weiβe Seiten' (white pages);

— the results of internet research.

5 On 5 April 2001 the Cancellation Division declared the mark WEISSE SEITEN to be partially invalid on the basis of Article 7(1)(d) and Article 7(2) of Regulation No 40/94 in so far as it concerned telephone directories of names in printed format or on electronic storage media (Classes 9 and 16) and publication, by a publishing house, of such telephone directories of names (Class 41). It thus restricted the list of goods and services by adding the words 'excluded from those goods are those which concern or contain telephone directories of names' in respect of Class 9, the words 'telephone directories of names are excluded from those goods' in respect of Class 16, and the words 'the publication of telephone directories of names is excluded from those services' in respect of Class 41. The remainder of the application for a declaration of invalidity was dismissed.

6 Both the intervener, in respect of the partial dismissal of its application for a declaration of invalidity, and the applicant, in respect of the declaration of partial invalidity of its mark, brought an appeal before OHIM, pursuant to Articles 57 to 62 of Regulation No 40/94, against the decision of the Cancellation Division.

7 Ruling on the two appeals, which were joined pursuant to Article 7(1) of Commission Regulation (EC) No 216/96 of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of OHIM (OJ 1996 L 28, p. 11), the First Board of Appeal, by decision of 19 June 2003 (Joined Cases R 580/2001-1 and R 592/2001-1) ('the contested decision'), partially upheld the intervener's appeal and dismissed that of the applicant. It annulled the decision of the Cancellation Division and declared the mark WEISSE SEITEN invalid for the following goods and services:

— 'magnetic data carriers and recorded storage media for data processing installations and equipment, in particular tapes, discs, CD-ROMs', within Class 9;

— 'Paper, cardboard and goods made from these materials, not included in other classes; printed matter, reference works, classified directories; artists' materials; office requisites (except furniture); instructional and teaching material (except apparatus)', within Class 16;

— 'Publishing services, in particular the publication of texts, books, magazines, newspapers', within Class 41;

— 'Editing of written texts', within Class 42.

8 The Board of Appeal held, first, that, as regards the goods in Class 9 referred to in the preceding paragraph and printed matter, reference works and classified directories in Class 16, the mark WEISSE SEITEN had been registered in infringement of Article 7(1)(d) of Regulation No 40/94. In addition, it held that Article 7(1)(b) and (c) of the Regulation applies in respect of all the goods and services referred to in the preceding paragraph ('the goods and services in question').

Forms of order sought

9 The applicant claims that the Court should:

— alter the contested decision to the effect that the application for a declaration of invalidity is dismissed in its entirety;

— in the alternative, annul the contested decision in so far as the application for a declaration of invalidity was upheld and order OHIM to come to a new decision, after an additional procedure if necessary, and to dismiss the application for a declaration of invalidity in its entirety;

— order OHIM to pay the costs.

10 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

11 The intervener contends that the Court should dismiss the action.

Admissibility of the action

12 Under Article 63(5) of Regulation No 40/94, actions against a decision of a Board of Appeal of OHIM must be brought within two months of the date of notification of that decision. In accordance with Article 102(2) of the Rules of Procedure of the Court of First Instance the prescribed time-limits are to be extended on account of distance by a single period of 10 days.

13 In the present case, the contested decision was notified to the applicant on 1 July 2003. The period for bringing an action, including the extension on account of distance, thus expired on 11 September 2003.

14 It is true that the application was received by fax at the Registry of the Court of First Instance on 8 September 2003, namely before expiry of the time-limit for bringing an action.

15 However, pursuant to Article 43(6) of the Rules of Procedure, the date on which a copy of the signed original of a pleading is received at the Registry of the Court of First Instance by fax is taken into consideration, for the purposes of compliance with procedural time-limits, only if the signed original of the pleading is lodged at the Registry no later than 10 days thereafter.

16 In the present case, the original of the application was not received at the Court Registry until 19 September 2003, namely outside the 10-day time-limit. Thus, in accordance with Article 43(6) of the Rules of Procedure, only the date on which the signed original was lodged, namely 19 September 2003, is to be taken into consideration for the purposes of compliance with the time-limit for bringing an action. Consequently, it must be found that the application was lodged after the expiry of that time-limit.

17 However, the applicant submits that its case is a typical case of force majeure or, at least, unforeseeable circumstances.

18 The concepts of force majeure and unforeseeable circumstances contain, besides an objective element relating to abnormal circumstances unconnected with the party in question, a subjective element involving the obligation, on his part, to guard against the consequences of the abnormal event by taking appropriate steps without making unreasonable sacrifices. In particular, he must pay close attention to the course of

the procedure and, in particular, demonstrate diligence in order to comply with the prescribed time-limits (Case C-195/91 P *Bayer* v *Commission* [1994] ECR I-5619, paragraph 32). Thus, the concepts of force majeure and unforeseeable circumstances do not apply to a situation in which, objectively, a diligent and prudent person would have been able to take the necessary steps before the expiry of the period prescribed for instituting proceedings (see, to that effect, Case 209/83 *Valsabbia* v *Commission* [1984] ECR 3089, paragraph 22, and the order in Case C-325/03 P *Zuazaga Meabe* v *OHIM* [2005] ECR I-403, paragraph 25).

19 In the present case, the applicant directly entrusted the Austrian postal service with the task of sending the original of its pleading on 9 September 2003, namely the very day after the fax was sent. Subsequently, the item of mail was passed by the Austrian postal service to the Luxembourg postal service on 11 September 2003 which, in turn, placed it in the hands of the company Michel Greco on 12 September 2003. However, that company took seven days to deliver the item to the Registry of the Court of First Instance.

20 Therefore, the main, or even sole, reason for the delay was that the application did not reach the Court until seven days after its arrival in Luxembourg (see, to that effect, Joined Cases 25/65 and 26/65 *Simet and Feram* v *High Authority* [1967] ECR 33). That must be regarded as unforeseeable circumstances in respect of the applicant and the latter, which displayed the diligence expected of an ordinarily prudent applicant in order to comply with the time-limits, cannot be accused of having contributed to the delay by conduct of its own.

21 The action is therefore admissible.

Admissibility of the second head of claim

22 In the second part of its second head of claim the applicant is essentially asking the Court to order OHIM to come to a new decision and to dismiss the application for a declaration of invalidity in its entirety.

23 Under Article 63(6) of Regulation No 40/94, OHIM is required to take the measures necessary to comply with the judgments of the Community judicature. Accordingly, it is not for the Court of First Instance to issue directions to OHIM. It is for the latter to give due effect to the operative part of judgments of the Community judicature and the grounds on which they are based (Case T-331/99 *Mitsubishi HiTec Paper Bielefeld* v *OHIM (Giroform)* [2001] ECR II-433, paragraph 33; Case T-34/00 *Eurocool Logistik* v *OHIM (EUROCOOL)* [2002] ECR II-683, paragraph 12; and Case T-129/01 *Alejandro* v *OHIM — Anheuser-Busch (BUDMEN)* [2003] ECR II-2251, paragraph 22).

24 The second part of the applicant's second head of claim is therefore inadmissible.

Substance

25 The applicant effectively puts forward four pleas in support of its action. The first plea alleges a conflict between the contested decision and the Austrian decision, and the second, third and fourth pleas allege, respectively, infringement of Article 7(1)(d), 7(1)(c) and 7(1)(b) of Regulation No 40/94.

The first plea, alleging a conflict between the contested decision and the Austrian decision

Arguments of the parties

26 The applicant submits that the contested decision is inconsistent in so far as it is based on an assessment of the Austrian public which differs from that made by the Austrian national authorities in the decision of the Oberster Patent- und Markensenat of 22 September 1999.

27 OHIM points out that it is not legally obliged to ensure that its decisions are consistent with national decisions. In addition, the facts to be assessed were not identical since the national authorities based their decision on linguistic habits in Austria, whereas OHIM had to take linguistic habits in the internal market as a whole into account, and, therefore, also those in Germany.

28 In addition, OHIM draws attention to the fact that the decision of the Oberster Patent- und Markensenat confirmed that the Austrian mark WEISSE SEITEN was invalid in so far as it related to 'paper and printed matter' due to its descriptive character (in the sense of 'white-coloured pages'), and that, consequently, the decisions were consistent in that respect.

29 The intervener points out that OHIM is under no obligation to endorse the assessment of a national authority. Therefore, the decision of 22 September 1999 is not relevant to determination of the perception of the mark in dispute by the Austrian public.

Findings of the Court

30 OHIM is not obliged to base its assessment of the perception that the relevant public has of the mark in dispute on a national decision. The Community trade mark regime is an autonomous system with its own set of objectives and rules 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). The registrability of a sign as a Community trade mark must therefore be assessed by reference only to the relevant Community rules. OHIM and, if necessary, the Community judicature are not bound by a decision given in a Member State, or 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 under 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 Case T-19/04 *Metso Paper Automation* v *OHIM (PAPERLAB)* [2005] ECR I-2383, paragraph 37).

31 Therefore, the fact that the contested decision might conflict with the Austrian decision cannot constitute an infringement of the relevant Community rules. The Court will examine in the context of the other pleas whether OHIM correctly analysed the perception of the relevant public in the present case.

32 Consequently, the first plea must be dismissed.

The second plea, alleging infringement of Article 7(1)(d) of Regulation No 40/94

Arguments of the parties

33 The applicant challenges the assessment of the Board of Appeal that the term 'weiße Seiten' became part of the German language as a synonym for 'alphabetisches Teilnehmerverzeichnis' (alphabetical directory of subscribers) no later than the time of publication of the communication from the Commission in 1995 and that it was already used beforehand in the sense of an alphabetical telephone directory in Austria. It submits that only an objective term which is comprehensible to the majority of those concerned and used regularly can constitute an absolute ground for refusal under Article 7(1)(d) of Regulation No 40/94. Sporadic use by those concerned of a sign as a generic term is not sufficient to constitute a term of that nature.

34 According to the applicant, it is possible that, in the anglophone world, the terms 'Yellow Pages' and 'White Pages' are customarily used to refer to the business and administrative parts of a directory or phonebook. As a result of the significant use of the term 'gelbe Seiten' (yellow pages), that sign has become a customary general indication for a business directory in current German. However, 'weiße Seiten' has never become a customary term in the German speaking world for referring, generically, to the administrative parts of directories or phonebooks. In addition, the communication from the Commission is more concerned with the translation of the English 'White Pages' than with the creation of a new objective term in the German language.

35 The applicant submits that the fact that someone else, who has omitted to register an exclusive right in his favour, has already used on one occasion, or perhaps even sporadically, such an original term referring indirectly to the goods does not justify

registration of the objective term being prevented, since the element of customary usage by the public and use in current language is, in its opinion, lacking. It is only where such a term is also taken up by other competitors and generally used that a bona fide practice can develop and that the sign can become part of current language. However, it is apparent from the case-file merely that the intervener has already used that term in certain exceptional cases together with the necessary explanations in order for it to be better understood. The case-file does not contain any evidence whatsoever that that original term for a publication has become part of current German. Such development of a sign cannot be assumed and deduced hypothetically but has to be proved. OHIM itself authorised the mark WEISSE SEITEN without restriction, in spite of the examiner's objections, since it considered that the term had not become customary in the eyes of the public and also was not part of general German vocabulary. In that case, it is for the party seeking a declaration of invalidity, namely the intervener, to prove that, during the notification procedure, OHIM failed to have regard to an essential aspect relating to the existence of an absolute ground for refusal.

36 Even if it were to be admitted that the Commission and the Austrian post and telegraph authorities created, by publishing and sporadically using the term 'weiße Seiten' together with explanations, an objective term, the Board of Appeal did not state why that term also applied to goods and services other than telephone directories in book form. The contested decision does not contain any reasons explaining why an electronic file or an internet site called 'WEISSE SEITEN', which is neither white nor made up of pages, should not be called 'WEISSE SEITEN', and why an objective term is at issue.

37 OHIM stresses, first, that neither the Board of Appeal nor the Cancellation Division stated, at any point, that the mere fact that the Commission used the term 'weiße Seiten' was sufficient to refuse registration. That use was regarded, as held in the decision of the Cancellation Division, as reflecting the moment in the evolution of

the language at which that term was presented as generic even at European level, at least in specialised circles, or, as held in the contested decision, as reflecting the very latest point at which it became part of the German language as a synonym for an alphabetical directory of subscribers.

38 The Board of Appeal's conclusion that the term in question became a generic expression before the date of application for registration is the result of analysis of voluminous documentation from the Austrian and German linguistic area and the communication from the Commission. In addition, the latter is based on documents and studies already using the term 'weiβe Seiten' as a generic term. The footnotes and the source references in the tables refer to a study carried out in 1992 by Coopers & Lybrand, Deloitte, which already used that term. Therefore, the communication from the Commission cannot be classed as a single use but as appropriate evidence for establishing that that term had become, at least within specialised circles, a generic indication for referring to alphabetical directories of subscribers.

39 In addition, use of that term is not restricted merely to Germany and Austria, since it has also been used, for a long time, in Luxembourg.

40 Consequently, according to OHIM, there is no doubt about the fact that the term 'weiβe Seiten' was already a generic term in Germany on the date of application for registration. 'Bona fide and established practices of the trade' needs to be understood as commercial usage and commercial custom. Therefore, customary use in a more restricted group than the general public is sufficient to constitute a ground for refusal. In any case, at the date of the communication from the Commission at the latest, which was addressed to a wide public, the term in question also became customary in the current language.

41 OHIM observes that, as regards electronic storage media, the applicant misunderstands the term 'weiße Seiten' in assimilating it to 'weißfarbige Seiten' (white coloured pages) and emphasising the fact that electronic storage media are not white and do not have pages. The Board of Appeal rightly considered that, since telephone directories are also available in electronic form, such an information medium could also be described more precisely by the term 'weiße Seiten'.

42 The intervener submits that the Board of Appeal rightly found that the term 'weiße Seiten' was an indication that had become customary for referring to telephone directories in which subscribers' numbers are listed alphabetically.

43 The documents of the Austrian post and telegraph authorities show that that term was already customary in Austria in 1992/93. Since only the term 'weiße Seiten', without any other indication, was used on order forms, the intervener comes to the conclusion that Austrian postal customers could obtain a directory only in so far as they were aware of the significance of that term. Therefore, the explanatory indication 'directory of subscribers' was not necessary in order for postal customers to be able to understand the term in dispute. The single reference to the type of product ('directory of subscribers') next to the name of the product ('weiße Seiten'), corresponding to the parallel use of the terms 'business directory' and 'gelbe Seiten', does not, therefore, stand in the way of the assumption that a term which had become customary for the product was involved.

44 According to the intervener, that use was neither isolated nor sporadic. The decisive factor is not the number of documents submitted, but the significance and the content of those documents. The information sheet was sent to all Austrian homes, which took note of it. In addition, use of the term at issue by all competitors or by a large number of them is not necessary at all to establish that the name of the product had become customary. What is important is whether the term was generally considered by the public to be customary. The main reason for the development of a

mark covering a generic term is, generally, the fact that, for a relatively long period of time, only one provider existed on the market for a specific product and that the public, for that reason, uses the mark and the name of the product synonymously. As a result of the State monopoly, no other provider of official directories existed in 1992 and 1993 alongside the Austrian postal service in the field of official telephone directories.

45 As regards the communication from the Commission, it shows that the term at issue was also used in other countries as a customary term for referring to directories listing subscribers. In its presentation of the state of the market the Commission used terms and names which it had come across in carrying out its preceding analysis. 'Weiβe Seiten' is not an arbitrary new creation of the Commission but a name which was already customary on the market for telephone directories.

46 Referring to research carried out on the internet for the purposes of the present action, the intervener states that it found that the term 'weiße Seiten' is used, inter alia, in Belgium ('pages blanches'), in France ('pages blanches'), in Italy ('pagine bianche'), in Romania ('white pages'), in San Marino ('pagine bianche'), in Switzerland ('pagine bianche'), in Morocco ('pages blanches'), in Mexico ('paginas blancas'), and in Australia and New Zealand ('white pages'). The intervener stresses that use of that term in other languages of the European Union is relevant since it is possible to bring an action based on the existence of a registered trade mark in the German-speaking part of the European Union against a name used in another language but which is identical.

47 Next, the intervener submits that, given that the absolute ground for refusal laid down in Article 7(1)(d) of Regulation No 40/94 was already present at the time at which the trade mark was lodged in 1996 and at the time of registration of the mark in 1999, it cannot be important whether action was taken to counter the development of a customary term.

48 Finally, the intervener claims that 'weiβe Seiten' is a general term for directories listing subscribers. Therefore, it does not cover only directories in printed form but all directories listing subscribers, regardless of the type of medium involved.

Findings of the Court

49 Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon* v *OHIM — Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

50 With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51 Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis

of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52 Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40).

53 In the present case, the Board of Appeal held that the registration of the mark WEISSE SEITEN had to be cancelled on the basis of Article 7(1)(d) of Regulation No 40/94 as regards 'magnetic data carriers and recorded storage media for data processing installations and equipment, in particular tapes, discs, CD-ROMs', within Class 9, and 'printed matter, reference works, classified directories', within Class 16. Therefore, the question whether the term 'weiße Seiten' is customary must be analysed in relation to those products.

54 Given that those products are intended for consumers in general, it is a question of analysing the perception of the average consumer. In addition, given that the mark in question is made up of words in German, the average consumer is German-speaking.

55 The documents submitted by the intervener before OHIM, listed in paragraph 4 above, regarding the customary nature of the term 'weiße Seiten' for the target public, show that that term has become the current generic term for the telephone directory for private individuals.

56 It is apparent from the communication from the Commission that the latter used the term 'weiße Seiten' several times in reference to an 'alphabetisches Teilnehmerverzeichnis'. That term is sometimes used on its own, and sometimes along with the latter description. The term 'gelbe Seiten' is also used in the communication, in reference to business telephone directories. The fact that the communication dates from September 1995 shows that the term 'weiße Seiten' entered the German language at that time at the latest. In addition, as rightly pointed out by OHIM, the communication makes reference to a study carried out in 1992 by Coopers & Lybrand, Deloitte, which itself already refers to that term.

57 The applicant's argument that it is more a question of the translation of the English 'White Pages' than of the creation of a new objective term in the German language cannot be upheld. Given that the documents of the institutions are translated by translators into their mother tongue, those persons use, as far as possible, either idiomatic or established terms and expressions.

58 In any case, the various information documents from the Austrian postal service regarding telephone directories show that the term 'weiße Seiten' was already used in Austria in the sense of telephone directories for private individuals from 1992 at the latest. Those documents were created by the Austrian postal service and some of them were sent to all subscribers, whereas others were intended for the general public. All of those documents concern the period prior to the date on which the application for registration of the mark WEISSE SEITEN was lodged. It is apparent from those documents that the term 'weiße Seiten' was not used sporadically, as claimed by the applicant, but that the Austrian postal service considered that the general public was aware of its meaning. If that had not been the case it would not have used the term on its information sheets.

59 As regards the order forms for Austrian telephone directories, it should be pointed out that they were created by the intervener. They concern the years 1993/94 and

1994/95 and contain both the term 'weiβe Seiten' and the term 'gelbe Seiten' without any supplementary explanation. Therefore, the recipients of the order forms were deemed to know what the term 'weiβe Seiten' meant.

60 It is also apparent from the guidelines relating to the publication of official directories, which was the subject of a contract concluded in 1992 between the intervener and the Austrian post and telegraph authorities, and the letters exchanged between the intervener and various departments of the Austrian post and telegraph authorities concerning publication of the 'Weiβe Seiten' that the intervener and the authorities were using the term 'weiβe Seiten' in their correspondence in 1992 without any further explanation as to its meaning.

61 In addition, it is apparent from the research carried out on the internet on 8 August 2000 that both 'weiβe Seiten' and 'weisse Seiten' refer to telephone directories, including in electronic or CD-ROM format.

62 Even though those documents were gathered fours years after the application for registration of the mark WEISSE SEITEN had been lodged, they confirm the linguistic development which took place and the conclusions which result from the documents concerning the period prior to the lodging of the application.

63 Moreover, the decision of the Oberster Patent- und Markensenat indeed shows that the Austrian mark WEISSE SEITEN was declared invalid as regards the following products: 'paper and printed matter'.

64 The intervener makes reference to the research annexed to its response carried out on the internet for the purposes of the present action in order to demonstrate that the term 'weiβe Seiten' is present in a number of countries. OHIM likewise refers to research carried out on the internet, which it annexed to its response.

65 Those documents, produced for the first time before the Court, cannot be taken into consideration. The purpose of actions before the Court of First Instance is to review the legality of decisions of the Boards of Appeal of OHIM for the purposes of Article 63 of Regulation No 40/94, so it is not the Court's function to review the facts in the light of documents produced for the first time before it. Accordingly, the abovementioned documents must be excluded, without it being necessary to assess their probative value (Case T-10/03 *Koubi* v *OHIM — Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraph 52; Case T-399/02 *Eurocermex* v *OHIM (Shape of a beer bottle)* [2004] ECR II-1391, paragraph 52; Case T-164/03 *Ampafrance* v *OHIM — Johnson & Johnson (monBeBé)* [2005] ECR II-1401, paragraph 29).

66 It follows from all of the above that the Board of Appeal rightly considered that the documents produced by the intervener before OHIM were sufficient to show that, for the target public, 'weiße Seiten' had, on the date on which the application for registration of the mark WEISSE SEITEN was lodged by the applicant, became customary as a generic term for the telephone directory for private individuals. In addition, the applicant did not produce any evidence before OHIM which showed that the mark WEISSE SEITEN did not fall within the field of application of the absolute ground for refusal laid down in Article 7(1)(d) of Regulation No 40/94.

67 The applicant's argument that the Board of Appeal did not give the reasons why the absolute ground for refusal laid down in Article 7(1)(d) of Regulation No 40/94 also applied to goods and services other than telephone directories in book form cannot be upheld. The Board of Appeal stated the following in paragraph 40 of the contested decision: 'Telephone directories are made available not only in paper form but also in electronic form. The applicant for a declaration of invalidity has been putting different telephone directories on the market in electronic form since the end of the 1980s. Furthermore, these days, telephone directories are no longer offered only on CD-ROM, namely electronic storage media, but are also directly accessible via the internet'. It repeated, in paragraph 53 of the contested decision, in

the context of the assessment of this absolute ground for refusal, that 'telephone directories are made available not only in paper form but also in electronic form', and are 'also directly accessible via the internet'.

68 In addition, it noted in paragraph 41 of the contested decision that, '[e]ven where a term is not normally used, in trade, in the presentation of all the goods covered by a trade mark application, it is the generic term mentioned which has to be contemplated in establishing the existence of an absolute ground for refusal'. The Board of Appeal considered that it is unable to 'distinguish between the various goods covered by that term, for example between (light) novels and telephone directories', and that it is obliged to 'assess whether there is a lack of distinctiveness in relation to all the goods featuring on the list submitted with the application'.

69 It is apparent from those passages that the Board of Appeal gave the reasons why it considered that the absolute ground for refusal also had to be applied to 'magnetic data carriers and recorded storage media for data processing installations and equipment, in particular tapes, discs, CD-ROMs', within Class 9, and 'printed matter, reference works, classified directories', within Class 16, and thus it satisfied its duty under Article 73 of Regulation No 40/94 to state the reasons on which its decisions are based.

70 Next, it is necessary to assess whether that reasoning is well founded.

71 It is common ground that telephone directories for private individuals are available not only on paper, but also in electronic form, on the internet or on CD-ROM. The Court has already been prompted to point out that 'recorded storage media for data processing installations and equipment, in particular CD-ROMs' and 'printed matter, reference works, classified directories' cover various types of products

suitable for containing, either on electronic media or on paper, telephone or communications directories (Joined Cases T-357/99 and T-358/99 *Telefon & Buch* v *OHIM (UNIVERSALTELEFONBUCH and UNIVERSALKOMMUNIKATIONSVERZEICHNIS)* [2001] ECR II-1705, paragraph 26).

72 Therefore, the term 'weiße Seiten' must also be considered to be a customary term for electronic directories, as is also apparent from the internet research carried out by the intervener during the administrative procedure before OHIM.

73 As regards 'magnetic data carriers and recorded storage media for data processing installations and equipment, in particular tapes, discs, CD-ROMs', within Class 9, it is to be noted that the applicant sought to register the mark at issue for that category of goods as a whole, without drawing any distinction between them.

74 Therefore, the Board of Appeal's assessment must be confirmed in so far as it relates to all the goods in that category (see, to that effect, Case T-359/99 *DKV* v *OHIM (EuroHealth)* [2001] ECR II-1645, paragraph 33; *STREAMSERVE*, paragraph 46; Case T-355/00 *DaimlerChrysler* v *OHIM (TELE AID)* [2002] ECR II-1939, paragraph 34; Case T-356/00 *DaimlerChrysler* v *OHIM (CARCARD)* [2002] ECR II-1963, paragraphs 33 and 36, and Case T-358/00 *DaimlerChrysler* v *OHIM (TRUCKCARD)* [2002] ECR II-1993, paragraphs 34 and 37).

75 As regards 'printed matter, reference works, classified directories', within Class 16, which include telephone directories in paper form, the applicant did not draw any distinction between the goods within that generic category and therefore the Board of Appeal's assessment must be upheld in so far as it concerns the category as a whole.

76 In those circumstances, it must be found that the Board of Appeal was fully entitled to cancel registration of the mark WEISSE SEITEN on the basis of Article 7(1)(d) of Regulation No 40/94 in relation to 'magnetic data carriers and recorded storage media for data processing installations and equipment, in particular tapes, discs, CD-ROMs', within Class 9, and 'printed matter, reference works, classified directories', within Class 16.

77 Consequently the applicant's second plea must be dismissed.

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

Arguments of the parties

78 The applicant states that the sign WEISSE SEITEN was composed in conformity with German grammar rules. It is plain for everyone to see that the mark is made up of the name of the colour 'weiß' (white), and of the word 'Seiten' (pages, sides) to which several meanings could be given. However, it is possible for there to be an absolute ground for refusal under Article 7(1)(c) of Regulation No 40/94 only if the sign gives relevant information about the goods and services in question.

79 The applicant points out that a publication is not made up of white pages since almost all publications are printed in black ink on white paper. The word 'Seiten' cannot designate a book since pages are only one of the elements which make up a book and that term is thus not sufficient to indicate to consumers that they are

going to receive a book if they ask for 'weiße Seiten'. As regards white paper, the applicant draws attention to the fact that blank paper is never designated by the word 'Seiten' (pages), since pages are only part of a publication.

80 According to the applicant, nobody faced with the sign WEISSE SEITEN would think of editorial or publication services. The word 'Seite' (page, side) cannot designate a service and neither does the indication of colour 'weiß' allude to services.

81 The applicant concludes from the above that, given that the term 'weiße Seiten' is not capable of describing appropriately and in an easily understandable manner an essential characteristic of each of the goods and services in question, with the exception of paper for which it is also not descriptive, the mark WEISSE SEITEN cannot be considered to be descriptive of any of those goods and services.

82 OHIM states that the applicant has misread the contested decision. As regards 'printed matter, reference works, classified directories' and 'magnetic data carriers and recorded storage media for data processing installations and equipment, in particular tapes, discs, CD-ROMs', the sign WEISSE SEITEN is descriptive of the goods designated as it is a synonym for telephone directories for private individuals and not because of the white colour of the pages of the books. In addition, a name which has become customary in current language is, as a general rule, also descriptive.

83 OHIM states that, even if a sign is descriptive for only a part of the products in a given category, it cannot be registered for that category. Given that the sign WEISSE

SEITEN is descriptive of telephone directories for private individuals it also cannot be registered for printed matter unless the applicant for, or proprietor of, the mark restricts the list of goods and services appropriately so as to exclude classified directories.

84 The Board of Appeal relied on the meaning 'weißfarbige Seiten' only as regards the following goods: 'Paper, cardboard and goods made from these materials, not included in other classes; artists' materials; office requisites (except furniture); instructional and teaching material (except apparatus)'. According to OHIM, the term 'weiße Seiten' can be used synonymously for 'weißfarbige Blätter' (white coloured sheets). Therefore, the sign WEISSE SEITEN is descriptive of all those products. OHIM observes, however, that the question whether consumers will also perceive that sign as synonymously descriptive of 'instructional and teaching material (except apparatus)' is to remain open since the applicant has not expressly contested that assessment in relation to those goods.

85 The intervener submits that the sign WEISSE SEITEN constitutes a direct and concrete indication of a characteristic or of a quality or the intended purpose of the goods and services in question within the meaning of Article 7(1)(c) of Regulation No 40/94.

86 According to the intervener, the terms 'Seite' and 'Blätter' are used synonymously, as demonstrated by an article which appeared in *GEO* and the other documents submitted by the intervener in the proceedings before OHIM.

87 Given that the indication 'weiß' designates pages and sheets which are not printed on and which are sold as such, it does describe in that way a quality of pages available in trade so that the term 'weiße Seiten' designates the type and quality of that product.

Findings of the Court

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

89 Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that signs or indications which are descriptive of the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (Case C-191/01 P *OHIM* v *Wrigley* [2003] ECR I-12447, paragraph 31, and Case T-219/00 *Ellos* v *OHIM (ELLOS)* [2002] ECR II-753, paragraph 27).

90 In that context, the signs and indications referred to in that provision are those which may serve in normal usage from the point of view of the target public to designate, either directly or by reference to one of their essential characteristics, the goods or services in respect of which registration is sought (Case C-383/99 P *Procter & Gamble* v *OHIM* [2001] ECR I-6251, paragraph 39). Accordingly, a sign's descriptiveness can only be assessed by reference to the goods or services concerned and to the way in which it is understood by the relevant public (*CARCARD*, paragraph 25).

91 For the purposes of Article 7(1)(c) of Regulation No 40/94, it is necessary to consider, on the basis of a given meaning of the word mark in question, whether, from the point of view of the relevant public, there is a sufficiently direct and specific association between the mark and the categories of goods and services in respect of which registration was accepted (see, to that effect, *CARCARD*, paragraph 28).

92 It must be borne in mind, in that regard, that, in order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to by that article 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 under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned (*OHIM* v *Wrigley*, paragraph 32).

93 In the present case, the Board of Appeal held that the absolute ground for refusal laid down in Article 7(1)(c) of Regulation No 40/94 was applicable to the following goods and services:

— 'magnetic data carriers and recorded storage media for data processing installations and equipment, in particular tapes, discs, CD-ROMs', within Class 9;

— 'Paper, cardboard and goods made from these materials, not included in other classes; printed matter, reference works, classified directories; artists' materials; office requisites (except furniture); instructional and teaching material (except apparatus)', within Class 16;

— 'Publishing services, in particular the publication of texts, books, magazines, newspapers', within Class 41;

— 'Editing of written texts', within Class 42.

94 Even though it is sufficient that one of the absolute grounds for refusal laid down in Article 7(1) of Regulation No 40/94 applies in order for the sign not to be registrable as a Community trade mark, it is appropriate to examine the justification for applying the absolute ground for refusal laid down in Article 7(1)(c) of Regulation No 40/94 also in relation to the goods listed in paragraph 76 above, in respect of which it has been held that Article 7(1)(d) of Regulation No 40/94 was correctly applied.

95 The term 'weiβe Seiten' is put together correctly in conformity with German grammar rules, as the applicant indeed states, and is made up of current German words.

96 As was pointed out when examining the previous plea, that term has become a synonym, in the German language, for telephone directories for private individuals. Therefore, it may also be considered to be descriptive of the goods for which it is regarded as being a customary term, namely 'magnetic data carriers and recorded storage media for data processing installations and equipment, in particular tapes, discs, CD-ROMs' and 'printed matter, reference works, classified directories', given that it refers in their regard to the kind of product (see, to that effect, *UNIVERSALTELEFONBUCH and UNIVERSALKOMMUNIKATIONSVERZEICHNIS*, paragraph 28).

97 Thus, the applicant's arguments that a publication is not made up of white pages since almost all publications are printed in black ink on white paper, and that the word 'Seiten' cannot designate a book since pages are only one of the elements which make up a book and the word is, thus, not sufficient to indicate to consumers that they are going to receive a book if they ask for 'weiße Seiten', are not relevant, given that the Board of Appeal found that the mark WEISSE SEITEN was descriptive of those goods as a synonym for a telephone directory for private persons and not due to the white-coloured pages of such a directory.

98 'Publishing services, in particular the publication of texts, books, magazines, newspapers', within Class 41, and 'editing of written texts', within Class 42, concern the creation and drawing-up of the products listed in paragraph 96 above, in particular of the products on paper which fall within Class 16. Therefore, the term 'weiße Seiten' may also be regarded as descriptive of those services, since it describes their intended purpose (see, to that effect, *UNIVERSALTELEFONBUCH and UNIVERSALKOMMUNIKATIONSVERZEICHNIS*, paragraphs 26 and 28).

99 Accordingly, the applicant's argument that nobody faced with the sign WEISSE SEITEN would think of editorial or publication services cannot be upheld, since the Board of Appeal established the existence of a sufficient connection between those services and the goods in respect of which the term 'weiße Seiten' means 'telephone directory for private individuals'.

100 Consequently, the Board of Appeal did not err in its appraisal of the goods and services referred to above.

101 It is still necessary to examine whether the mark WEISSE SEITEN is descriptive in relation to the following goods: 'Paper, cardboard and goods made from these materials, not included in other classes; artists' materials; office requisites (except furniture); instructional and teaching material (except apparatus)', within Class 16.

102 In paragraph 81 of the contested decision, the Board of Appeal held the following:

> '"Paper" consists of sheets. As soon as they are no longer separate but bound, stapled or joined together in another way, whether printed or not, they are called "Seiten" ... It also cannot be ruled out that the term "Seite" ... may become or has already become synonymous with the word "Blatt" (sheet). To state that white pages are at issue amounts to a concrete and direct indication of a characteristic of paper, which, in contrast to the opinion of the Cancellation Division, consumers will take into account when deciding what to buy. The generic term "office requisites" also includes paper so that the term "weiβe Seiten" ... is also a descriptive indication in their regard. The same is true for "instructional and teaching material", which consists primarily of books. To state that that material is printed on white pages amounts to an essential indication of the characteristics of the product. "Artists' materials" is another generic term which, as has already been pointed out, also covers drawing paper, and which is, therefore, also descriptive in its regard.'

103 The Board of Appeal's assessment is correct. The term in question can easily be understood in the sense of 'weiβfarbige Seiten' and it can be used, as submitted by OHIM and the intervener, as a synonym of 'weiβfarbige Blätter'. Therefore, it may be regarded as descriptive, as least for paper, and, given that the applicant did not draw any distinction within the generic category 'paper, cardboard and goods made from these materials, not included in other classes', for all those goods.

104 The category 'artists' materials' can include all resources used by artists. It can, thus, also include paper and, given that the applicant did not set out any restriction within this category and exclude paper, the term 'weiβe Seiten' must be regarded as descriptive of the category 'artists' materials'.

105 The category 'office requisites (except furniture)' can include, for example, notepads and printing paper and, given that the applicant did not set out any restriction within this category, the term at issue can also be regarded as descriptive of those goods.

106 Finally, the same reasoning applies to 'instructional and teaching material (except apparatus)' as to the goods referred to above. Given that the applicant has not excluded sheets or white pages from that material, the mark may be regarded as descriptive of those goods.

107 Therefore, since the applicant did not draw any distinction or set out any restriction within those generic categories, the Board of Appeal's assessment must be upheld in respect of all the goods referred to in paragraph 101 above.

108 In the light of the above considerations, the link between the mark WEISSE SEITEN and the characteristics of all the goods and services in dispute is sufficiently close to fall within the scope of the prohibition under Article 7(1)(c) of Regulation No 40/94.

109 Consequently, the applicant's third plea must be dismissed.

110 As regards the fourth plea, alleging infringement of Article 7(1)(b) of Regulation No 40/94, it must be pointed out that, as is evident from Article 7(1) of the Regulation, it is sufficient that one of the absolute grounds for refusal applies in order 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).

111 Furthermore, according to the case-law, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 7(1)(c) of Regulation No 40/94 is, on that account, necessarily devoid of any distinctive character in relation to those goods or services within the meaning of Article 7(1)(b) (see, by analogy, Case C-265/00 *Campina Melkunie* [2004] ECR I-1699, paragraph 19, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 86).

112 In those circumstances, the applicant's fourth plea cannot be upheld.

113 The action must, therefore, be dismissed in its entirety.

Costs

114 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 incurred by OHIM, as applied for by the latter. As the intervener has not applied for costs, it must bear its own costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Third Chamber)

hereby:

1. **Dismisses the action;**

2. **Orders the applicant to pay the costs, except those incurred by the intervener;**

3. **Orders the intervener to bear its own costs.**

Jaeger Tiili Czúcz

Delivered in open court in Luxembourg on 16 March 2006.

E. Coulon M. Jaeger

Registrar President