Reports of Cases

JUDGMENT OF THE GENERAL COURT (Ninth Chamber)

26 October 2017*

(EU trade mark — Application for EU word mark Klosterstoff — Absolute grounds for refusal — Descriptive character — Mark of such a nature as to deceive the public — Article 7(1)(b), (c) and (g) of Regulation (EC) No 207/2009 (now Article 7(1)(b), (c) and (g) of Regulation (EU) 2017/1001) — Previous EUIPO practice)

In Case T-844/16,

Alpirsbacher Klosterbräu Glauner GmbH & Co. KG, established in Alpirsbach (Germany), represented by W. Göpfert and S. Hofmann, lawyers,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by A. Schifko, acting as Agent,

defendant,

ACTION brought against the decision of the Fifth Board of Appeal of EUIPO of 6 October 2016 (Case R 2064/2015-5), relating to an application for registration of the word sign Klosterstoff as an EU trade mark,

THE GENERAL COURT (Ninth Chamber),

composed of S. Gervasoni, President, K. Kowalik-Bańczyk and C. Mac Eochaidh (Rapporteur), Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 29 November 2016,

having regard to the response lodged at the Court Registry on 1 March 2017,

having regard to the fact that no request for a hearing was submitted by the parties within three weeks after service of notification of the close of the written part of the procedure, and having decided to rule on the action without an oral part of the procedure, pursuant to Article 106(3) of the Rules of Procedure of the General Court,

gives the following

* Language of the case: German.

Judgment

Background to the dispute

1 On 13 April 2015, the applicant, Alpirsbacher Klosterbräu Glauner GmbH & Co. KG, filed an application for registration of a European Union trade mark at the European Union Intellectual Property Office (EUIPO), under Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended (replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1)). Registration as a mark was sought for the word sign Klosterstoff.

2 The goods in respect of which registration was applied for are in Classes 32 and 33 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description:

– Class 32: 'Beer and brewery products; mixed beverages containing beer, non-alcoholic beverages, in particular non-alcoholic beer; preparations for making beverages';

– Class 33: 'alcoholic beverages (except beer); spirits and liqueurs, in particular whisky, brandy, piquette; pre-mixed alcoholic beverages other than beer-based; preparations for making alcoholic beverages'.

3 By decision of 4 September 2015, the examiner refused the registration of the mark sought pursuant to Article 7(1)(b), (c) and (g) of Regulation No 207/2009 (now Article 7(1)(b), (c) and (g) of Regulation 2017/1001).

4 On 13 October 2015, the applicant filed a notice of appeal at EUIPO, pursuant to Articles 58 to 64 of Regulation No 207/2009 (now Articles 66 to 71 of Regulation 2017/1001), against the examiner's decision.

5 By decision of 6 October 2016 ('the contested decision'), the Fifth Board of Appeal of EUIPO dismissed the appeal. First, the Board of Appeal stated in paragraphs 15 and 16 of the contested decision that, given that the mark sought was made up of German words, it was the German-speaking public, or a public with knowledge of the basic vocabulary of German, reasonably well informed and reasonably observant and circumspect, that was involved. Secondly, in paragraphs 17 to 26 of the contested decision, it observed that the term 'klosterstoff', which was made up of the words 'kloster' and 'stoff', referred to goods containing or consisting of alcohol and coming from or produced in a monastery. In its view, the word sign sought was a simple juxtaposition of two terms which, when combined, are descriptive in respect of the goods 'beer and brewery products; mixed beverages containing beer; preparations for making beverages' in Class 32 and 'alcoholic beverages (except beer); spirits and liqueurs, in particular whisky, brandy, piquette; pre-mixed alcoholic beverages, other than beer-based; preparations for making alcoholic beverages' in Class 33. It thus concluded, in paragraph 26 of the contested decision, that registration of the mark was precluded by the ground for refusal laid down in Article 7(1)(c) of Regulation No 207/2009 in respect of those goods. Thirdly, in paragraphs 27 to 33 of the contested decision, the Board of Appeal found that the mark sought was also devoid of distinctive character within the meaning of Article 7(1)(b) thereof in respect of the same goods, on the ground that it merely conveyed the message that the goods concerned contain alcohol and come from or were produced in a monastery. Consumers were not, therefore, able to identify the commercial origin simply by seeing the sign. Fourthly, the Board of Appeal found, in paragraphs 34 to 37 of the contested decision, that the mark sought was misleading for the purposes of Article 7(1)(g) of the same regulation in that it gives consumers the impression that non-alcoholic beverages contain alcohol and that therefore it could not be registered in that connection for 'non-alcoholic beverages, in particular

non-alcoholic beer' in Class 32. Fifthly, it found, in paragraphs 38 and 39 of the contested decision, that the fact that various marks containing the component 'stoff' had been registered previously was not decisive for determining the lawfulness of the registration of the mark sought.

Forms of order sought

6 The applicant claims that the Court should:

– annul the contested decision;

– order EUIPO to pay the costs.

7 EUIPO contends that the Court should:

– dismiss the action;

– order the applicant to pay the costs.

Law

8 In support of its action, the applicant puts forward, essentially, four pleas in law. First, the Board of Appeal disregarded Article 7(1)(c) of Regulation No 207/2009 in finding that the mark sought was descriptive of the goods at issue. Second, the Board of Appeal infringed Article 7(1)(b) of Regulation No 207/2009 in finding that the mark sought was devoid of distinctive character for the purposes of that provision. Third, the Board of Appeal found, incorrectly, that the mark sought was misleading for the purposes of Article 7(1)(g) of Regulation No 207/2009 for certain of the goods at issue. Fourth, in essence, the Board of Appeal failed to follow its own earlier decision-making practice.

The first plea in law: infringement of Article 7(1)(c) of Regulation No 207/2009

9 The applicant claims, in essence, that the Board of Appeal made an error of assessment in finding that the mark applied for was descriptive of the goods at issue for the purposes of Article 7(1)(c) of Regulation No 207/2009.

10 EUIPO disputes that argument.

11 Under Article 7(1)(c) of Regulation No 207/2009, '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' may not be registered. Article 7(2) of that same regulation (now Article 7(2) of Regulation 2017/1001) states that Article 7(1) of that regulation is to apply notwithstanding that the grounds of non-registrability obtain in only part of the Union.

12 According to case-law, Article 7(1)(c) of Regulation No 207/2009 prevents the signs or indications to which it refers being reserved to one undertaking alone because they have been registered as trade marks. That provision pursues an aim which is in the public interest, namely that such signs or indications may be freely used by all (judgments of 27 February 2002, *Ellos* v *OHIM (ELLOS)*, T-219/00, EU:T:2002:44, paragraph 27; and of 2 May 2012, *Universal Display* v *OHIM* (*UniversalPHOLED*), T-435/11, not published, EU:T:2012:210, paragraph 14; see, to that effect, judgment of 23 October 2003, *OHIM* v *Wrigley*, C-191/01 P, EU:C:2003:579, paragraph 31).

13 Moreover, signs or indications which may serve, in trade, to designate characteristics of the goods or service in respect of which registration is sought are, by virtue of Article 7(1)(c) of Regulation No 207/2009, regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or service, thus enabling the consumer who acquires the goods or service designated by the mark to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (judgment of 2 May 2012, *UniversalPHOLED*, T-435/11, not published, EU:T:2012:210, paragraph 15; see, to that effect, judgment of 23 October 2003, *OHIM* v *Wrigley*, C-191/01 P, EU:C:2003:579, paragraph 30).

14 It follows that, for a sign to be caught by the prohibition set out in Article 7(1)(c) of Regulation No 207/2009, there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see judgment of 16 October 2014, *Larrañaga Otaño* v *OHIM (GRAPHENE)*, T-458/13, EU:T:2014:891, paragraph 16 and the case-law cited).

15 Lastly, it must be borne in mind that the descriptive character of a sign may only be assessed, first, in relation to the understanding of the mark by the relevant public and, second, in relation to the goods or services concerned (see judgment of 7 June 2005, *Münchener Rückversicherungs-Gesellschaft* v *OHIM (MunichFinancialServices)*, T-316/03, EU:T:2005:201, paragraph 26 and the case-law cited).

16 It is in the light of those considerations that the Court must examine whether, as the applicant submits, the Board of Appeal infringed Article 7(1)(c) of Regulation No 207/2009 by finding that the mark applied for had descriptive character.

17 Firstly, it should be remembered that, in paragraphs 15 and 16 of the contested decision, the Board of Appeal found that the relevant public in terms of the perception of the descriptive character of the mark sought was the general German-speaking public or a public with knowledge of the basic vocabulary of German. The Board of Appeal further found that the relevant public's level of attention was reasonably well informed and reasonably observant and circumspect. Those assessments are not incorrect and have not been called into question by the applicant.

18 Second, in paragraphs 17 to 26 of the contested decision, the Board of Appeal found that, when combined and by virtue of their juxtaposition, the terms 'kloster' and 'stoff' were descriptive in that they would be understood by the relevant public as referring to goods containing alcohol and coming from or produced in a monastery. Regarding first the goods, referring to the *Duden* dictionary, it observed that the word 'stoff' referred to alcohol and considered that the fact that that definition was a colloquial, slang meaning of term was irrelevant. The Board of Appeal also considered it irrelevant that the word 'stoff' could equally be assigned other meanings, as long as one of the possible meanings of the term can designate the goods at issue. Regarding, next, the public, it observed that the relevant public was accustomed to seeing representations or names of monasteries associated with alcoholic beverages. It noted that the words 'klosterbrauerei' (monastery brewery) and 'klosterbier' (monastery beer) were generally known amongst beer connoisseurs, since many beers were brewed in monasteries or abbeys. It also mentioned three French, German and Austrian abbeys and monasteries producing spirits, and noted that there was evidence of production of beer and spirits in monasteries since the Middle Ages. The Board of Appeal inferred therefrom that there was a clear link between the sign applied for and the goods in question. Lastly, it dismissed the applicant's argument that the term 'klosterstoff' was unusual and that the use of that word sign to refer to the goods in question could not be ruled out in future.

19 The applicant submits, in essence, that the Board of Appeal was incorrect in finding that the mark sought was descriptive on the basis of a separate analysis of the words 'kloster' and 'stoff', without taking sufficient account of the overall impression generated by that word sign. Taken as a whole, the sign allows the relevant public to perceive the mark sought as an imaginative and unusual way of

serving only to indicate the origin of the goods at issue. The mark sought is thus perceived as referring to a good — which is not described any more specifically than as 'stoff' but conveys the impression of something substantial, original and of the *terroir* — originating from or linked to a monastery. The applicant further argues that the use of the word 'stoff' to refer to alcoholic beverages, particularly beer, is not commonplace in German-speaking countries. Nor is that definition of the word 'stoff' to be found in the dictionaries, on the internet sites and in the results of search engines relied on by it. Even the *Duden* dictionary, referred to by the Board of Appeal, attests to use of the term 'stoff' only in a colloquial manner and only for spirits. The applicant further submits that the average consumer is unaware of the tradition of producing beer and spirits in monasteries, referred to by the Board of Appeal. It follows from those aspects that the relevant public will not perceive, without further thought, any direct link between the term 'klosterstoff' and the goods at issue. As the mark sought is not descriptive, the applicant submits that the need to keep the word sign freely available, noted by the Board of Appeal, is not applicable in the present case.

20 EUIPO disputes those arguments.

21 First, it should be noted that the Board of Appeal examined each component making up the mark sought on the basis of meanings taken from the *Duden* dictionary, which the applicant itself recognises is the most important and well-known dictionary of the German language. It is also common ground that the applicant does not disagree with the meaning of the word 'kloster' attributed to it by the Board of Appeal.

22 The applicant's argument that, contrary to the Board of Appeal's statement in paragraph 17 of the contested decision, the *Duden* dictionary restricted, with respect to alcoholic beverages, the meaning of the word 'stoff' solely to spirits and does not include beer and other brewery products, must be rejected. The applicant has not adduced any evidence before the Court to substantiate that assertion. Therefore, the Board of Appeal did not err in basing itself on that dictionary to find that the word 'stoff' referred to alcohol and would be perceived as such by the relevant public.

23 Secondly, the Board of Appeal's assessment is not put in doubt by the fact that a number of dictionaries, internet sites and results from search engines referred to by the applicant do not make a link between 'stoff' and alcohol. Nor is it of any importance that that meaning is not very commonplace or familiar in German. According to the case-law a word sign may not be registered if at least one of its potential meanings refers to a characteristic of the goods or services in question at issue (see judgment of 11 May 2017, *Bammer* v *EUIPO — mydays (MÄNNERSPIELPLATZ)*, T-372/16, not published, EU:T:2017:331, paragraphs 18 and 54 and the case-law cited).

24 The Board of Appeal was therefore correct in finding in paragraph 17 of the contested decision that the relevant public would perceive the mark sought as a descriptive indication, since the average consumer would understand that the goods in question contained alcohol coming from or produced in a monastery. As it observed in paragraph 26 of the contested decision, the word sign Klosterstoff therefore immediately informs the relevant public targeted of the nature and quality of some of the goods identified thereby.

25 Thirdly, in paragraphs 20 and 21 of the contested decision, the Board of Appeal discussed the tradition dating back to the Middle Ages of producing beer and spirits in monasteries, taking the view that those factors establish, in the minds of the relevant public, a clear connection between the mark sought and the goods in question.

26 In the applicant's submission, the average consumer is unaware of such a tradition. That argument cannot be accepted, however. First of all, the possibility cannot totally be ruled that a segment of the general public has a broad general knowledge of alcoholic beverages (see, to that effect, judgment of 19 May 2015, *Granette & Starorežná Distilleries* v *OHIM — Bacardi (42 VODKA JEMNÁ VODKA VYRÁBĚNÁ JEDINEČNOU TECHNOLOGIÍ 42%vol.)*, T-607/13, not published, EU:T:2015:292,

paragraph 105). Next, it is well known that consumers are accustomed to seeing representations or names of monasteries in connection with spirits and beer (see, to that effect, judgment of 8 October 2015, *Benediktinerabtei St. Bonifaz* v *OHIM — Andechser Molkerei Scheitz (Genuß für Leib & Seele KLOSTER Andechs SEIT 1455)*, T-78/14, not published, EU:T:2015:768, paragraphs 27 and 29). Lastly, even if the mark sought cannot be linked to that tradition, that does not cast doubt on the fact that, upon seeing the word sign at issue here, the relevant public will understand it as a reference to goods containing alcohol coming from or produced in a monastery.

27 The applicant's argument to the effect that the same brewing tradition will be unknown to the average consumer in certain Member States, particularly in the Mediterranean and eastern European areas, must also be rejected. The very wording of Article 7(2) of Regulation No 207/2009, stating as it does that Article 7(1) of that regulation is applicable notwithstanding that the grounds of non-registrability obtain in only part of the Union. The General Court has held previously in that regard that part of the Union may consist of a single Member State (judgment of 27 June 2017, *Jiménez Gasalla* v *EUIPO (B2B SOLUTIONS)*, T-685/16, not published, EU:T:2017:438, paragraph 29 and the case-law cited).

28 The Board of Appeal was therefore correct in finding that there was a clear link in the minds of the relevant public between the mark sought and all of the goods in question, including beer. There is therefore no need to rule on the statement in paragraph 20 of the contested decision and disputed by the applicant, to the effect that the words 'klosterbrauerei' and 'klosterbier' are known to 'beer connoisseurs'. That complaint is ineffective inasmuch as, even if it were upheld, it does not cast doubt on the foregoing considerations.

29 Fourthly, the applicant submits that the mark sought contains allusions to a certain good — which is not described any more specifically than as 'stoff' but conveys the impression of something substantial, original and of the *terroir* — originating from or linked to a monastery, without however designating or describing that particular object. Taken as a whole, the word sign Klosterstoff is therefore sufficiently imaginative, but also far enough removed from the customary linguistic usage of the relevant public, not to be perceived by it as a purely descriptive indication of the goods in question.

30 That argument is not convincing. It must be remembered that a trade mark consisting of a neologism or a word composed of elements each of which is descriptive of characteristics of the goods or services in respect of which registration is sought is itself descriptive of the characteristics of those goods or services for the purposes of Article 7(1)(c) of Regulation No 207/2009, unless there is a perceptible difference between the neologism or the word and the mere sum of its parts. That presupposes that, because of the unusual nature of the combination in relation to the goods or services, the neologism or word creates an impression which is far enough removed from that conveyed by a simple combination of the meanings of its constituent elements that it is more than the sum of its parts (see judgments of 22 June 2005, *Metso Paper Automation* v *OHIM (PAPERLAB)*, T-19/04, EU:T:2005:247, paragraph 27 and the case-law cited, and of 22 May 2008, *Radio Regenbogen Hörfunk in Baden* v *OHIM* (*RadioCom*), T-254/06, not published, EU:T:2008:165, paragraph 31 and the case-law cited).

31 It is clear in the present case that the word sign does not have an unusual structure in terms of the German language, so that, as the Board of Appeal in essence found — correctly — in paragraphs 17, 23 and 25 of the contested decision, it will convey clearly to the relevant public that the goods in question contain alcohol coming from or produced in a monastery.

32 The Board of Appeal therefore made no error in ruling out registration of the mark sought under Article 7(1)(c) of Regulation No 207/2009 for 'beer and brewery products; mixed beverages containing beer, preparations for making beverages' in Class 32 and 'alcoholic beverages (except beer); spirits and liqueurs, in particular whisky, brandy, piquette; pre-mixed alcoholic beverages other than beer-based; preparations for making alcoholic beverages' in Class 33. It follows that the first plea in law must be rejected.

The second plea: infringement of Article 7(1)(b) of Regulation No 207/2009

33 The applicant submits, in essence, that the Board of Appeal erred in finding that the mark applied for was devoid of distinctive character for the purposes of Article 7(1)(b) of Regulation No 207/2009.

34 EUIPO disputes that argument.

35 As is clear from Article 7(1) of Regulation No 207/2009, it is sufficient that one of the absolute grounds for refusal applies for the sign at issue not to be registrable as an EU trade mark (judgments of 19 September 2002, *DKV* v *OHIM*, C-104/00 P, EU:C:2002:506, paragraph 29, and of 7 October 2015, *Cyprus* v *OHIM (ΧΑΛΛΟΥΜΙ and HALLOUMI)*, T-292/14 and T-293/14, EU:T:2015:752, paragraph 74).

36 As a consequence, since it is apparent from examination of the previous plea that the sign submitted for registration is descriptive of the goods in question, within the meaning of Article 7(1)(c) of Regulation No 207/2009, and that this ground alone justifies refusal of the contested registration, there is no need, in any event, to examine the merits of the plea alleging breach of Article 7(1)(b) of that regulation (see, to that effect, order of 13 February 2008, *Indorata-Serviços e Gestão* v *OHIM*, C-212/07 P, not published, EU:C:2008:83, paragraph 28).

The third plea in law: infringement of Article 7(1)(g) of Regulation No 207/2009

37 The applicant submits that, contrary to what the Board of Appeal found, the mark sought was not of such a nature as to deceive the relevant public with respect to the goods 'non-alcoholic beverages, in particular non-alcoholic beer' in Class 32. In its submission, it is obvious for the average attentive consumer that non-alcoholic beverages do not contain beer or other types of alcohol. Moreover, the grounds of refusal of registration based on the possibility of the mark sought being misleading applies only if it was misleading for all the goods to which it refers.

38 EUIPO disputes those arguments.

39 It should be noted as a preliminary point that, by this plea, the applicant is questioning that part of the contested decision by which the Board of Appeal found that the mark sought was misleading for 'non-alcoholic beverages, in particular non-alcoholic beer', in Class 32. It is thus distinguished from the first two pleas, by which the applicant contested the refusal of registration with respect to the alcoholic beverages listed in Classes 32 and 33.

40 Given that difference, the case-law referred to in paragraphs 35 and 36 above is not applicable to the present plea. The finding that the word sign Klosterstoff was descriptive for alcoholic beverages does not relieve the General Court of its duty to examine the allegedly misleading nature of the mark sought on the ground that it designates a different type of good, namely 'non-alcoholic beverages, in particular non-alcoholic beer'.

41 Under Article 7(1)(g) of Regulation No 207/2009, registration is to be refused for trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service.

42 In that regard, it must be pointed out that, according to settled case-law, the circumstances for refusing registration referred to in Article 7(1)(g) of Regulation No 207/2009 presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived (see, to that effect, with respect to Article 3(1)(g) of 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), the wording of which is identical to that of Article 7(1)(g) of Regulation No 207/2009; judgments of 4 March 1999, *Consorzio per la tutela*

del formaggio Gorgonzola, C-87/97, EU:C:1999:115, paragraph 41; and of 30 March 2006, *Emanuel*, C-259/04, EU:C:2006:215, paragraph 47; see also judgments of 8 June 2017, *W. F. Gözze Frottierweberei and Gözze*, C-689/15, EU:C:2017:434, paragraph 54 and the case-law cited; and of 5 May 2011, *SIMS — École de ski internationale* v *OHIM — SNMSF (esf école du ski français)*, T-41/10, not published, EU:T:2011:200, paragraph 49 and the case-law cited).

43 In the present case, the Board of Appeal found, in paragraphs 35 and 36 of the contested decision, that, if average consumers see the word sign Klosterstoff on packaging for the goods in question, being 'non-alcoholic beverages, in particular non-alcoholic beer', because of the presence of the word 'stoff' they will tend to think that they contain alcohol. It follows, in its submission, that the mark sought is misleading because it conveys clear information to the effect that the goods in question referred to by that mark are alcoholic beverages, whereas 'non-alcoholic beverages, in particular non-alcoholic beer' do not contain alcohol.

44 Given the considerations set out under the first plea, the Board of Appeal's position that the average consumer will associate the word 'stoff' with alcohol must be upheld. The Board of Appeal was therefore correct in finding that the mark sought carried a misleading indication in also referring to non-alcoholic beverages.

45 This conclusion is not called into question by the fact, relied on by the applicant, that the composition of those beverages is indicated on the products. First of all, if that line of argument were followed, it would mean that the misleading nature of the mark would be detected by the average consumer only at the time of reading the label listing the ingredients of those beverages. Therefore, contrary to the applicant's assertions, there is no evidence whatsoever establishing that consumers will be aware that those beverages do not contain alcohol. As observed by EUIPO, consumers may be led to purchase the products in haste, without taking the time to examine the text on the packaging. Secondly, the case-law is clear on the point that offering consumers the opportunity to check the label to see which ingredients are used in the manufacture of a beverage does not in and of itself preclude the mark referring to those goods from being misleading (see, to that effect, judgment of 19 November 2009, *Torresan* v *OHIM — Klosterbrauerei Weissenohe (CANNABIS)*, T-234/06, EU:T:2009:448, paragraph 43).

46 Lastly, the applicant's argument that the grounds for non-applicability of Article 7(1)(g) of Regulation No 207/2009 apply only where the mark is misleading for all of the goods referred to by it cannot be upheld. EUIPO may refuse registration of a mark for some of the goods referred to by it even though its misleading nature concerns only those goods and not all the goods referred to (see, to that effect, judgments of 27 October 2016, *Caffè Nero Group* v *EUIPO (CAFFÈ NERO)*, T-37/16, not published, EU:T:2016:634, paragraphs 53 and 54, and of 27 October 2016, *Caffè Nero Group* v *EUIPO (CAFFÈ NERO)*, T-29/16, not published, EU:T:2016:635, paragraphs 48 and 49).

47 It follows that the third plea in law must be rejected.

The fourth plea in law: disregard of EUIPO's earlier decision-making practice

48 This plea is based on two complaints. By the first complaint, the applicant submits that, in refusing registration of the mark sought, the Board of Appeal failed to provide a sufficient statement of reasons for departing from EUIPO's earlier decision-making practice. In its submission, numerous earlier word marks containing the component 'stoff' were registered by EUIPO or were registered as national and international marks for goods in Classes 32 and 33. The second complaint, put forward for the first time before the General Court, alleges error of law by the Board of Appeal in that numerous earlier word marks containing the component 'kloster' were registered by EUIPO or were registered as German and international marks for goods in Classes 32 and 33.

49 EUIPO disputes those arguments.

50 As regards the first complaint, it should be borne in mind that, under the first sentence of Article 75 of Regulation No 207/2009 (now the first sentence of Article 94 of Regulation 2017/1001), decisions of EUIPO are to state the reasons on which they are based. According to the case-law, that duty has the same scope as that laid down by Article 296 TFEU and its purpose is, first, to allow interested parties to know the justification for the measure so as to enable them to protect their rights and, second, to enable the EU judicature to review the legality of the decision (see judgment of 28 April 2004, *Sunrider* v *OHIM — Vitakraft-Werke Wührmann and Friesland Brands (VITATASTE and METABALANCE 44)*, T-124/02 and T-156/02, EU:T:2004:116, paragraphs 72 and 73 and the case-law cited).

51 It must also be borne in mind that the decisions concerning registration of a sign as an EU trade mark which the Boards of Appeal of EUIPO are called on to take under Regulation No 207/2009 are adopted in the exercise of circumscribed powers and are not a matter of discretion. Therefore, the legality of those decisions must be assessed solely on the basis of that regulation, as interpreted by the Courts of the European Union, and not on the basis of a previous decision-making practice of EUIPO (see, to that effect, judgments of 26 April 2007, *Alcon* v *OHIM*, C-412/05 P, EU:C:2007:252, paragraph 65; of 2 May 2012, *UniversalPHOLED*, T-435/11, not published, EU:T:2012:210, paragraph 37; and of 8 May 2012, *Mizuno* v *OHIM — Golfino (G)*, T-101/11, not published, EU:T:2012:223, paragraph 77 and the case-law cited). It has also been held that although, while having regard to the principles of equal treatment and sound administration, EUIPO is obliged to take into account the decisions already taken and to consider with particular care whether it should decide in the same way or not, the application of those principles must nevertheless be consistent with respect for the principle of legality (see judgment of 21 January 2015, *Sabores de Navarra* v *OHIM — Frutas Solano (KIT, EL SABOR DE NAVARRA)*, T-46/13, not published, EU:T:2015:39, paragraph 47 and the case-law cited).

52 The European Union 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. Accordingly, the registrability of a sign as an EU trade mark is to be assessed on the basis of the relevant legislation alone. Therefore, neither EUIPO nor, as the case may be, the EU Courts are bound — even if they may take them into consideration — by decisions adopted in a Member State or a non-member country, and no provision in Regulation No 207/2009 requires EUIPO or, on appeal, the General Court, to come to the same conclusions as those arrived at by national administrative or judicial authorities in similar circumstances (see judgment of 15 July 2015, *Australian Gold* v *OHIM — Effect Management & Holding* (*HOT*), T-611/13, EU:T:2015:492, paragraph 60 and the case-law cited).

53 In the present case, in paragraph 38 of the contested decision the Board of Appeal found that the EU trade marks relied on by the applicant and using the term ‘stoff’ did not cast doubt on the examiner’s assessment. In the same paragraph it stated that the marks were not comparable signs in that although they contain the component ‘stoff’ it is as part of different terms. With regard to other marks also including the word component ‘stoff’ registered in the German register or the international register, it found in paragraph 39 of the contested decision that those registrations were not part of the proceedings before it and had no bearing on its conclusion as to the non-registrability of the mark sought.

54 Contrary to the applicant’s assertions, it is clear that that statement of reasons is sufficient.

55 As regards the second complaint, EUIPO submits that the material in Annex K 13 to the application is inadmissible on the ground that it was adduced for the first time before the General Court.

56 That annex consists of an extract from the German internet site polymark dated 23 November 2016. It lists seven word marks containing the word component ‘kloster’ which were registered as EU trade marks or German trade marks, or as international marks with extension of the protection to the EU.

57 Those documents, although produced for the first time only before the Court, are not evidence strictly speaking for the purposes of inter alia Article 85 of the Rules of Procedure of the General Court; rather, they relate to the decision-making practice of EUIPO and other national and international authorities, to which a party may refer even where that practice post-dates the proceedings before EUIPO (see, to that effect, judgments of 24 November 2005, *Sadas* v *OHIM — LTJ Diffusion (ARTHUR and FELICIE)*, T-346/04, EU:T:2005:420, paragraph 20; of 18 November 2014, *Repsol* v *OHIM– Adell Argiles (ELECTROLINERA)*, T-308/13, not published, EU:T:2014:965, paragraph 20; and of 24 November 2016, *CG* v *EUIPO — Perry Ellis International Group (P PRO PLAYER)*, T-349/15, not published, EU:T:2016:677, paragraphs 18 and 19). The objection of inadmissibility must therefore be rejected.

58 Under the case-law cited in paragraphs 51 and 52 above, however, the applicant's complaint must be rejected. In particular, as observed in paragraphs 32 and 44 above, the Board of Appeal was correct in finding that the mark sought was, first, descriptive in respect of the goods 'beer and brewery products; mixed beverages containing beer; preparations for making beverages' in Class 32 and 'alcoholic beverages (except beer); spirits and liqueurs, in particular whisky, brandy, piquette; pre-mixed alcoholic beverages other than beer-based; preparations for making alcoholic beverages' in Class 33 (see paragraph 32 above) and, secondly, of such a nature as to deceive the public when used to refer to non-alcoholic beverages (see paragraph 44 above), with the result that the applicant may not successfully rely on earlier decisions of EUIPO to call that conclusion into question (see, to that effect, judgment of 21 January 2015, *KIT, EL SABOR DE NAVARRA*, T-46/13, not published, EU:T:2015:39, paragraph 47 and the case-law cited). The fact that marks containing the word component 'kloster' have been registered previously does not call into question the descriptive and misleading character of the mark sought.

59 In the light of all those considerations, the fourth plea must be rejected, as must therefore the action in its entirety.

Costs

60 Under Article 134(1) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by EUIPO.

On those grounds,

THE GENERAL COURT (Ninth Chamber)

hereby:

1. Dismisses the action;

2. Orders Alpirsbacher Klosterbräu Glauner GmbH & Co. KG to pay the costs.

Gervasoni Kowalik-Bańczyk Mac Eochaidh

Delivered in open court in Luxembourg on 26 October 2017.

[Signatures]