Reports of Cases

JUDGMENT OF THE GENERAL COURT (Third Chamber)

3 July 2013 *

(Community trade mark — Application for the Community word mark NEO — Absolute grounds for refusal — Lack of distinctive character — Article 7(1)(b) of Regulation (EC) No 207/2009 — Descriptive character — Article 7(1)(c) of Regulation No 207/2009 — Extent of the examination to be carried out by the Board of Appeal — Examination as to the merits conditional on the admissibility of the action — Articles 59 and 64(1) of Regulation No 207/2009 — Obligation to state reasons — Article 75 of Regulation No 207/2009 — Examination of the facts by the Office of its own motion — Article 76 of Regulation No 207/2009)

In Case T-236/12,

Airbus SAS, established in Blagnac (France), represented by G. Würtenberger and R. Kunze, lawyers,

applicant,

v

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

defendant,

ACTION brought against the decision of the First Board of Appeal of OHIM of 23 February 2012 (Case R 1387/2011-1), concerning an application for registration of the word sign NEO as a Community trade mark,

THE GENERAL COURT (Third Chamber),

composed of O. Czúcz (Rapporteur), President, I. Labucka and D. Gratsias, Judges,

Registrar: T. Weiler, Administrator,

having regard to the application lodged at the Registry of the General Court on 29 May 2012,

having regard to the response lodged at the Court Registry on 28 September 2012,

further to the hearing on 12 March 2013,

gives the following

* Language of the case: English.

Judgment

Background to the dispute

1 On 23 December 2010, the applicant, Airbus SAS, filed an application for registration of a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

2 Registration as a mark was sought for the word sign NEO.

3 The goods and services for which registration was sought are in Classes 7, 12 and 39 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, for each of those classes, to the following description:

— Class 7: 'Aircraft engines; machines and machine tools, especially for the manufacture and repair of aeronautical engines; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); turbines other than for land vehicles; [auxiliary] power units; parts and fittings for the aforesaid goods';

— Class 12: 'Vehicles; apparatus for locomotion by land, air, water and rail; aircraft; spacecraft; satellites; launch vehicles; air balloons; aerostructures; aeronautical apparatus, machines and appliances; screw-propellers; military vehicles for transport, in particular by air; parts and fittings for all aforesaid goods';

— Class 39: 'Transport; air transport; storage of aircrafts and parts of aircraft; recovery and recycling of aircrafts and parts of aircraft; certification and re-certification of vehicles; flight tests; air traffic management; flight safety services; airport operation services; refueling of vehicles; air refueling'.

4 By letter of 10 May 2011, OHIM notified the applicant of its decision that the mark was not eligible for registration for the goods applied for in Classes 7 and 12 under Article 7(1)(b) and (c) and 7(2) of Regulation No 207/2009. The application was, however, allowed to proceed for the services in Class 39.

5 On 6 July 2011, the applicant filed a notice of appeal against that decision with OHIM, seeking annulment of the decision in its entirety.

6 By decision of 23 February 2012 ('the contested decision'), the First Board of Appeal of OHIM dismissed the appeal.

7 As a preliminary point, the Board of Appeal found that, pursuant to Article 64(1) of Regulation No 207/2009, it could re-open *ex officio* the examination of the application in the light of all the absolute grounds for refusal set out in Article 7 of that regulation, without being limited in any manner whatsoever by the examiner's reasoning. It inferred from this that it had the power to re-open the examination also as regards the services which had been accepted for registration by the examiner.

8 First, the Board of Appeal examined the appeal in the light of Article 7(1)(c) of Regulation No 207/2009. In that connection, it found that, in the present case, the goods and services were addressed both to the general public and to professionals. In its assessment, in view of the nature of the goods and services, the consumer will display a high level of attention. The Board of Appeal also found that the professional public, by definition, had a higher level of attention.

9 The Board of Appeal then went on to find that the contested sign consisted of the prefix 'neo', which means 'new' in at least six languages of the European Union: English, French, German, Greek, Spanish and Portuguese. The fact that the word element 'neo' never appears alone but is always used as a prefix does not alter that conclusion. Indeed, in the Board of Appeal's view, unlike other prefixes, the term 'neo' has a clear and specific meaning. Furthermore, in modern Greek the word 'neo' exists on its own and means 'new'. The Board of Appeal found, in addition, that, in the abovementioned languages, the relevant consumer would deduce from the term 'neo' itself that it refers to something new, modern or in line with the latest technological developments. As a result, the sign is simply laudatory and intended to highlight the positive qualities of the goods and services covered by the mark applied for.

10 The Board of Appeal thereby concluded that the sign NEO may serve, on the part of the public concerned, to designate an essential and desired characteristic of the goods and services for which registration had been sought. In that connection, it found that the fact that the goods and services are new or up to date with the latest technological standards was a quality that appeals to relevant consumers, whether professionals or members of the general public.

11 The Board of Appeal then examined the appeal in the light of Article 7(1)(b) of Regulation No 207/2009. In that connection, it found that the word 'neo' was generic and used in a variety of contexts as a laudatory or promotional term, referring to something either new or in line with the latest technological developments. In the Board of Appeal's view, there was nothing to detract the relevant consumer from the plain meaning of the word under consideration. There was, therefore, nothing in the word 'neo' that might, beyond its basic promotional or laudatory meaning, enable the relevant public to memorise it easily and instantly as a distinctive mark for the goods and services concerned. From this the Board of Appeal concluded that the relevant public would not perceive the mark applied for as indicating the origin of all the goods that it covers.

12 Lastly, the Board of Appeal took the view that the mark applied for could not be found registrable simply because it might be the case that OHIM had accepted signs which the applicant considers similar.

13 Consequently, the Board of Appeal concluded that the mark applied for was devoid of any distinctive character to distinguish the goods and services for which registration was sought within the meaning of Article 7(1)(b) and (c) and 7(2) of Regulation No 207/2009 and that, therefore, 'the examiner' acted correctly when he 'refused the registration of the contested mark'.

Forms of order sought

14 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

15 OHIM contends that the Court should:

— dismiss the action for annulment in its entirety;

— order the applicant to pay the costs.

Law

16 In support of its action, the applicant relies on four pleas in law, alleging infringement of, first, Articles 64(1) and 59 of Regulation No 207/2009, secondly, Article 7(1)(b) and (c) and 7(2) of Regulation No 207/2009, thirdly, Article 75 of Regulation No 207/2009 and, fourthly, Article 76 of Regulation No 207/2009.

The first plea, alleging infringement of Articles 64(1) and 59 of Regulation No 207/2009

17 By the first plea, the applicant submits that the Board of Appeal infringed Articles 64(1) and 59 of Regulation No 207/2009 by re-opening the examination of the application for registration of the Community trade mark regarding the services in Class 39 in respect of which registration had been allowed by the examiner.

18 OHIM takes issue with the applicant's arguments and contends that the Board of Appeal acted correctly in accordance with the provisions of Regulation No 207/2009 and the case-law.

19 The present plea raises the question whether a Board of Appeal of OHIM, before which an applicant for a trade mark appeals against an Examiner's decision, may examine the application for registration of the Community trade mark at issue in the light of the absolute grounds for refusal in respect of all the goods and services referred to therein, although the Examiner, while allowing registration in respect of the services, has decided to refuse registration in respect of the goods and the applicant has requested that the Board of Appeal annul the contested decision in its entirety.

20 In that regard, the Board of Appeal found that, pursuant to Article 64(1) of Regulation No 207/2009, it could *ex officio* re-open the examination of the application for registration of the Community trade mark in respect of all the goods and services referred to therein in the light of all the absolute grounds for refusal set out in Article 7 of Regulation No 207/2009, although the Examiner had already allowed registration in respect of the services referred to in that application.

21 Clearly, under Article 64(1) of Regulation No 207/2009, following the examination as to the merits of the appeal, the Board of Appeal is to decide on the appeal and may, in doing so, exercise any power within the competence of the department which was responsible for the decision appealed against. It follows from that provision that, through the effect of the appeal against an Examiner's decision refusing registration, the Board of Appeal may carry out a new, full examination of the merits of the application for registration, in terms of both law and fact, that is to say, in the present case, itself decide on the application for registration by either rejecting it or declaring it to be founded, thereby either upholding or reversing the decision appealed against (see, by analogy, Case C-29/05 P *OHIM* v *Kaul* [2007] ECR I-2213, paragraphs 56 and 57).

22 That power to carry out a new, full examination of the merits of the application for registration, in terms of both law and fact, is, however, conditional on the admissibility of the appeal before the Board of Appeal (see, by analogy, order of 2 March 2011 in Case C-349/10 P *Claro* v *OHIM*, not published in the ECR, paragraph 44).

23 In that regard, the first sentence of Article 59 of Regulation No 207/2009 states that 'any party to proceedings adversely affected by a decision may appeal'. It follows from that provision that parties to proceedings before OHIM may appeal to the Board of Appeal against a decision taken by a lower department of OHIM only in so far as that decision has rejected their claims or applications. Inasmuch as the decision of the lower department of OHIM has, on the contrary, upheld the claims of a party, that party does not have standing to appeal to the Board of Appeal (see, to that effect, Case T-504/09 *Völkl* v *OHIM - Marker Völkl (VÖLKL)* [2011] ECR II-8179, paragraph 55 and the case-law cited).

24 It is apparent from the first sentence of Article 59 of Regulation No 207/2009 that, if, as in the present case, the Examiner has rejected an application for registration of a Community trade mark only in respect of the goods covered by that application, while allowing registration in respect of the services covered by it, the appeal brought by the applicant for the trade mark before the Board of Appeal can lawfully relate only to the Examiner's refusal to allow registration in respect of the goods covered by the application. The applicant may not, by contrast, legitimately appeal before the Board of Appeal against the Examiner's consent to register such an application in respect of the services.

25 Consequently, although it is true that, in the present case, the applicant appealed before the Board of Appeal seeking the annulment of the Examiner's decision in its entirety, the fact remains that, pursuant to the first sentence of Article 59 of Regulation No 207/2009, the Board of Appeal was legitimately seised of the appeal only in so far as the lower department had rejected the applicant's claims.

26 It follows that the Board of Appeal exceeded the limits of its powers as defined in Article 64(1) of Regulation No 207/2009, read in conjunction with the first sentence of Article 59 of that regulation, inasmuch as it *ex officio* re-opened the examination of the application for registration of the Community trade mark in respect of the services referred to in that application in the light of the absolute grounds for refusal set out in Article 7 of Regulation No 207/2009 and found that the mark applied for was devoid of any distinctive character to distinguish those services within the meaning of Article 7(1)(b) and (c) and 7(2) of that regulation.

27 The contested decision must therefore be annulled in so far as the mark in respect of which registration was applied for was declared descriptive and devoid of any distinctive character within the meaning of Article 7(1)(b) and (c) and 7(2) of Regulation No 207/2009 as regards the services in Class 39 in respect of which the Examiner had allowed registration.

The second plea, alleging infringement of Article 7(1)(b) and (c) and 7(2) of Regulation No 207/2009

28 The applicant submits that the Board of Appeal failed to prove that the prefix 'neo', considered in isolation, has a clear and specific meaning that will immediately be recognised by the trade circles addressed. What is more, if it were taken into account that the relevant trade circles will encounter the mark NEO in its 'applied-for form', namely, in capital letters, used as a catchword and without being interwoven in any (textual) context, on, for example, the body of an aeroplane, it could not truly be denied that that same mark will be considered as an indication of origin having distinctive character.

29 OHIM contends that the applicant has not shown that Greek consumers will not perceive the word 'neo' as having a descriptive and non-distinctive meaning in relation to the goods and services concerned. As noted in paragraph 25 of the contested decision, the word 'neo' exists in Greek on its own and means 'new'. It is reasonable to assume that among the relevant consumers, Greek consumers at least, will immediately perceive this term as having a directly descriptive and laudatory meaning, namely, that the goods and services in question are new. The applicant's submissions as regards the writing of the term 'neo' in capital letters or its use in specific contexts, are unable to counteract the impression that consumers will receive upon seeing this term.

30 It must be pointed out that, since it is apparent from the analysis of the first plea that the contested decision must be annulled for infringement of Article 64(1) of Regulation No 207/2009, read in conjunction with Article 59 thereof, in so far as the mark applied was declared devoid of any distinctive character as regards the services in respect of which the Examiner allowed registration, the present plea alleging infringement of Article 7(1)(b) and (c) and 7(2) of Regulation No 207/2009 must be dealt with only as regards the goods in respect of which the Examiner refused registration.

31 As regards, first, the head of claim alleging failure to comply with Article 7(1)(c) and 7(2) of Regulation No 207/2009, it must be borne in mind that, 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 must not be registered.

32 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. In that regard, it must be stated that the fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 207/2009 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. Consequently, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 207/2009 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see judgment of 24 April 2012 in Case T-328/11 *Leifheit* v *OHIM (EcoPerfect)*, not published in the ECR, paragraph 16 and the case-law cited).

33 By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 207/2009 pursues an aim which is in the public interest, namely, that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see Case T-344/07 *O2 (Germany)* v *OHIM (Homezone)* [2010] ECR II-153, paragraph 20 and the case-law cited).

34 Furthermore, it is apparent from Article 7(2) of Regulation No 207/2009 that a sign is to be refused registration where it is descriptive or is not distinctive in the language of one Member State, even if it is registrable in another Member State (see judgment of 23 November 2011 in Case T-59/10 *Geemarc Telecom* v *OHIM – Audioline (AMPLIDECT)*, not published in the ECR, paragraph 24 and the case-law cited).

35 In the present case, the Board of Appeal was right in finding, in paragraph 24 of the contested decision, that the goods covered by the application for registration of the mark at issue were addressed both to the general public and to professionals and that that relevant public will display a high level of attention.

36 The applicant does not dispute that the word 'neo' exists in Greek on its own and means 'new' in that language, as the Board of Appeal pointed out in paragraph 25 of the contested decision.

37 As regards the use of the sign NEO in modern Greek in respect of the goods covered by the application for registration, the relevant consumer will deduce from the term itself, without undertaking any complex thought processes, that it refers to something new, modern or in line with the latest technological developments and that, in that language, that sign is simply laudatory and intended to highlight the positive qualities of the goods covered by the application for registration, as the Board of Appeal found in paragraph 26 of the contested decision. The Board of Appeal based those findings, as it was entitled to do, on facts arising from practical experience generally acquired of the marketing of goods (see, to that effect, judgment of 14 December 2011 in Case T-237/10 *Vuitton Malletier* v *OHIM – Friis Group International (Representation of a locking device)*, not published in the ECR, paragraph 49).

38 It is irrelevant in that regard that the relevant public displays a high level of attention.

39 As OHIM correctly observed, it is also irrelevant, in that regard, that the sign in respect of which registration has been applied for is written in capital letters and is to be used as a catchword. According to the case-law of the General Court, a word mark is a mark consisting entirely of letters, of words or of associations of words, written in printed characters in normal font, without any specific graphic element. The protection which results from registration of a word mark concerns the word mentioned in the application for registration and not the specific graphic or stylistic elements accompanying that mark (see judgment of 22 May 2008 in Case T-254/06 *Radio Regenbogen Hörfunk in Baden* v *OHIM (RadioCom)*, not published in the ECR, paragraph 43 and the case-law cited). Having regard to those considerations, the applicant's arguments relating to the fact that the word 'neo' is written in capital letters and its use as a catchword must be rejected as unfounded.

40 In the light of the foregoing, it must be held, as regards the goods covered by the application for registration, that the Board of Appeal was right to find that the sign NEO is descriptive from the point of view of the relevant public with a command of modern Greek. As it constitutes a sufficient ground for refusal of registration under Article 7(1)(c) and 7(2) of Regulation No 207/2009 for a mark in respect of which registration has been sought to be identified as having descriptive character in part of the European Union, it is not necessary to rule on whether the sign has descriptive character in respect of the goods at issue in the other languages referred to in the contested decision.

41 The head of claim alleging failure to comply with Article 7(1)(c) and 7(2) of Regulation No 207/2009 must therefore be rejected.

42 As regards, secondly, the head of claim alleging failure to comply with Article 7(1)(b) and 7(2) of Regulation No 207/2009, it should be borne in mind that there is a measure of overlap between the scope of Article 7(1)(c) of Regulation No 207/2009 and that of Article 7(1)(b) of that regulation inasmuch as the descriptive signs referred to in Article 7(1)(c) of that regulation are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Article 7(1)(b) is distinguished from Article 7(1)(c) of that regulation in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings (Case C-51/10 P *Agencja Wydawnicza Technopol* v *OHIM* [2011] ECR I-1541, paragraphs 46 and 47).

43 In the present case, the Board of Appeal based its finding that the mark in respect of which registration had been applied for had no distinctive character on the descriptive character of the sign at issue, by finding, in paragraph 34 of the contested decision, that the word 'neo' is generic and used in a variety of contexts as a laudatory or promotional term, referring to something either new or in line with the latest technological developments, and that there is nothing to detract the relevant consumer from the plain meaning of the word under consideration.

44 As has been stated in paragraph 40 above, the sign NEO must be classified as descriptive for the purposes of Article 7(1)(c) of Regulation No 207/2009 from the point of view of the relevant public with a command of modern Greek in respect of the goods covered by the application for registration. In accordance with the case-law cited in paragraph 42 above, that finding alone, that the sign NEO has descriptive character, is sufficient for it to be regarded as also being devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 207/2009 as regards the goods covered by the application for registration in modern Greek and from the point of view of the relevant public.

45 As the lack of distinctive character on the part of the mark in respect of which registration was sought in part of the European Union constitutes a sufficient ground for refusal of registration under Article 7(1)(b) and 7(2) of Regulation No 207/2009, it is not necessary to rule on whether it has distinctive character in the other languages referred to in the contested decision.

46 It follows that the Board of Appeal could find, without erring in law, that the sign NEO was devoid of any distinctive character for the purposes of Article 7(1)(b) and 7(2) of Regulation No 207/2009 in respect of the goods covered by the application for registration.

47 The second plea must therefore be rejected as unfounded.

The third plea, alleging infringement of Article 75 of Regulation No 207/2009

48 By the third plea, the applicant submits that the Board of Appeal infringed Article 75 of Regulation No 207/2009 in that it disregarded the previous registration practice of OHIM and of the national offices of the Member States of the European Union and in that it failed to take account of the decisions of OHIM dealing with the mark NEO. It argues that the Board of Appeal adopted a decision running counter to OHIM's practice, without objective justification and without substantiating its differing view in detail. It submits that, by not taking account of the registrations for the mark NEO in the Member States of the European Union, the Board of Appeal infringed the applicant's right to be heard as well as its right to a statement of the full reasons for the decision. In addition, the Board of Appeal's argument that the prefix 'neo' means 'new' in at least six languages of the European Union does not fulfil the requirements as established by Article 75 of Regulation No 207/2009. In the applicant's submission, the Board of Appeal's line of argument is too vague for the applicant to determine the extent of the grounds for the rejection. The applicant, however, needs to know to which particular Member States the Board of Appeal found that the rejection applies, in view of the fact that it might wish to convert its Community trade mark application into national applications.

49 OHIM takes issue with the applicant's arguments and contends that the Board of Appeal was not bound by OHIM's previous practice or by the practice of the national offices, and that the Board of Appeal correctly stated the reasons in this respect. It emphasises, in addition, that Article 7(2) of Regulation No 207/2009 provides that paragraph 1 of Article 7 applies even if the grounds for refusal exist only in part of the European Union. In the present case, the Board of Appeal specified at least six languages in which the mark is descriptive. OHIM also contends that the conversion procedure provided for in Regulation No 207/2009 is merely optional for a trade mark applicant, with the result that the complaint alleging that it is impossible to determine the territorial scope of the rejection for the purposes of a possible request for conversion concerns only a future and uncertain legal situation. An applicant cannot, however, rely upon future and uncertain situations to justify its interest in applying for annulment of the contested act.

50 As regards, first, the arguments alleging failure to follow OHIM's decision-making practice, it must be borne in mind that OHIM is under a duty to exercise its powers in accordance with the general principles of European Union law. In the light of the principles of equal treatment and of sound administration, OHIM must take into account the decisions already taken in respect of similar applications and consider with especial care whether it should decide in the same way or not. The way in which those principles are applied must, however, be consistent with respect for the principle of legality. Consequently, a person who files an application for registration of a sign as a trade mark cannot rely, to his advantage and in order to secure an identical decision, on a possibly unlawful act committed for the benefit of someone else. Moreover, for reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. Such an examination must therefore be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (see, to that effect, judgment of 8 November 2012 in Case T-415/11 *Hartmann* v *OHIM (Nutriskin Protection Complex)*, not published in the ECR, paragraph 36 and the case-law cited).

51 In the present case, the Board of Appeal found, on the basis of a full examination and taking into account the perception of the relevant public, that in modern Greek the mark in respect of which registration had been applied for constituted a clear indication of the nature and quality of the goods covered by the application for registration. As is apparent from paragraphs 40 to 46 above, that finding is in itself sufficient to hold that the registration of the word sign NEO as a Community trade mark is rendered inadmissible, as regards the goods in question, by the absolute grounds for refusal in Article 7(1)(b) and (c) and 7(2) of Regulation No 207/2009. It follows that, contrary to the applicant's claims, the assessment of its application for registration of the word sign NEO as a Community trade mark in respect of the goods referred to in the application for registration was made in a manner consistent with the case-law, on the basis of a correct interpretation and application of Article 7(1)(b) and (c) and 7(2) of Regulation No 207/2009.

52 Consequently, since the legality of the contested decision regarding the registrability of the sign NEO as a Community trade mark for the goods in question is established directly on the basis of Article 7(1)(b) and (c) and 7(2) of Regulation No 207/2009, it is apparent from the case-law cited in paragraph 50 above that the contested decision cannot be called into question by virtue of the mere fact that the Board of Appeal did not follow OHIM's decision-making practice in the present case.

53 As regards, secondly, the arguments relating to failure to follow the registration practice of the national offices of the Member States, it must borne in mind that it is apparent from settled case-law that registrations already made in the Member States are a factor which may be taken into consideration only for the purposes of the registration of a Community trade mark, without being given decisive weight (see judgment of 22 May 2012 in Case T-110/11 *Asa* v *OHIM - Merck (FEMIFERAL)*, not published in the ECR, paragraph 52 and the case-law cited). Since the Community trade mark regime is an autonomous system, neither OHIM nor, as the case may be, the Courts of the European Union are bound by a decision adopted in a Member State finding a sign to be registrable as a national trade mark (see Case T-304/06 *Reber* v *OHIM - Chocoladefabriken Lindt & Sprüngli (Mozart)* [2008] ECR II-1927, paragraph 45 and the case-law cited).

54 Given that, in the present case, the legality of the contested decision regarding the registrability of the sign applied for as a Community trade mark for the goods in question is established directly on the basis of Article 7(1)(b) and (c) and 7(2) of Regulation No 207/2009 (see paragraph 51 above), it cannot be called into question by virtue of the mere fact that the Board of Appeal did not follow the decision-making practice of certain national offices of the Member States.

55 As regards, thirdly and lastly, the head of claim alleging non-compliance with Article 75 of Regulation No 207/2009 in that the Board of Appeal's line of argument is too vague, the applicant complains, in essence, that the Board of Appeal stated, in a general manner, that the prefix 'neo' means 'new' in 'at least six languages of the European Union'. According to the applicant, that statement does not allow it to take a decision regarding the Member States in which to request the conversion of its Community trade mark application into a national trade mark application pursuant to Article 112 et seq. of Regulation No 207/2009. The applicant takes the view that, as it may request conversion only in those Member States in which the ground for refusal of registration by OHIM does not apply, a detailed analysis of the legal situation regarding the individual Member States was necessary. The applicant submits that, by not providing it with such a detailed analysis, the Board of Appeal infringed Article 75 of Regulation No 207/2009.

56 Article 112(2)(b) of Regulation No 207/2009 provides that conversion of a Community trade mark application or Community trade mark into a national trade mark application must not take place for the purpose of protection in a Member State in which, in accordance with the decision of OHIM, grounds for refusal of registration or grounds for revocation or invalidity apply to the Community trade mark application or Community trade mark.

57 It must however be borne in mind that that provision requires OHIM to comply with such a decision only where one has already been made. By contrast, that provision cannot derogate from Article 7(2) of Regulation No 207/2009, which provides that the absolute grounds for refusal set out in Article 7(1) of that regulation apply notwithstanding that those grounds of non-registrability obtain in only part of the Community. The content of the rule provided for by Article 7(2) of Regulation No 207/2009 would be distorted by an interpretation of Article 112(2)(b) of Regulation No 207/2009 according to which the Board of Appeal, ruling on an appeal against the Examiner's refusal of an application for registration owing to the descriptive and non-distinctive character of the mark applied for the purpose of Article 7(1)(b) and (c) of Regulation No 207/2009, is required to carry out a detailed analysis of the distinctive character of the sign in all the Member States even if it is obvious that the sign has, in the perception of the relevant public and in respect of the goods and services covered by the application for registration, descriptive character in the language of one Member State.

58 It follows that there are no grounds either for assuming that Article 112(2)(b) of Regulation No 207/2009, read in conjunction with Article 75 of that regulation, is intended to require the Board of Appeal, ruling on an appeal against the Examiner's refusal of an application for registration owing to the descriptive and non-distinctive character of the mark applied for in part of the European Union for the purposes of Article 7(1)(b) and (c) and 7(2) of Regulation No 207/2009, to carry out a detailed analysis of the distinctive character of the sign with regard to the goods and services referred to in that application in all the Member States.

59 The third plea must therefore be rejected as unfounded.

The fourth plea, alleging infringement of Article 76 of Regulation No 207/2009

60 By the fourth plea, the applicant submits that the Board of Appeal infringed Article 76 of Regulation No 207/2009 by not supporting its decision with evidence of the alleged generic, laudatory and promotional use of the designation 'neo', considered in isolation, in the course of trade, especially in the field of business concerned as well as in at least six European languages. It submits that the Board of Appeal reverted to general and unsubstantiated allegations without examining the facts of the case.

61 OHIM disputes the applicant's arguments.

62 It must be borne in mind that, although it is true that under Article 76(1) of Regulation No 207/2009 OHIM must examine of its own motion the relevant facts that could lead it to apply an absolute ground for refusal set out in Article 7(1) of that regulation, the fact remains that if an applicant claims that a trade mark applied for is distinctive, despite OHIM's analysis, it is for that applicant to provide specific and substantiated information to show that the trade mark applied for has either intrinsic distinctive character or distinctive character acquired through usage (C-238/06 P *Develey* v *OHIM* [2007] ECR I-9375, paragraphs 49 and 50).

63 In the present case, the Board of Appeal based its conclusion as to the descriptive and non-distinctive character of the mark in respect of which registration had been applied for on, in particular, the finding that in modern Greek the word 'neo' exists on its own and means 'new', with the result that the relevant consumer would deduce from the sign NEO in modern Greek, as regards the goods covered by the application for registration, that that sign refers to something new, modern or in line with the latest technological developments.

64 As has been pointed out in paragraph 35 et seq. above, that finding relating to the descriptive and non-distinctive character of the mark in respect of which registration was applied for in part of the European Union constitutes a sufficient ground for refusing registration pursuant to Article 7(1)(b) and (c) and 7(2) of Regulation No 207/2009.

65 Furthermore, the fact remains that the applicant has not provided specific and substantiated information to show that the sign NEO could have distinctive and non-descriptive character in the mind of the relevant public in modern Greek as regards the goods covered by the application for registration.

66 Consequently, the arguments alleging infringement of the principle of examination of the facts by OHIM of its own motion pursuant to Article 76 of Regulation No 207/2009 cannot succeed. The fourth plea must therefore be rejected.

67 As the first plea, alleging infringement of Article 64(1) and Article 59 of Regulation No 207/2009, is well founded, the contested decision must be annulled in so far as the mark in respect of which registration was applied for was declared descriptive and devoid of any distinctive character within the meaning of Article 7(1)(b) and (c) and 7(2) of Regulation No 207/2009 as regards the services in Class 39, in respect of the Examiner allowed registration. As the other pleas are unfounded, the action must be dismissed as to the remainder.

Costs

68 Under Article 87(3) of the Rules of Procedure of the General Court, where each party succeeds on some and fails on other heads, the Court may order that the costs be shared or that each party bear its own costs. In the present case, as the applicant's application has been upheld only in respect of the services in respect of which registration was allowed by the Examiner, each party must be ordered to pay its own costs.

On those grounds,

THE GENERAL COURT (Third Chamber)

hereby:

1. **Annuls the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 23 February 2012 (Case R 1387/2011-1) as regards the services in Class 39 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;**

2. **Dismisses the action as to the remainder;**

3. **Orders each party to bear its own costs.**

Czúcz Labucka Gratsias

Delivered in open court in Luxembourg on 3 July 2013.

[Signatures]