

European Court of Justice, 12 February 2004, Postkantoor

postkantoor

TRADEMARK LAW

Taking account of all the relevant facts and circumstances

- That a trade mark registration authority and a court asked to review a decision on an application to register a trade mark must have regard, in addition to the mark as filed, to all the relevant facts and circumstances.

Relevance registration in another Member State

- The fact that a trade mark has been registered in a Member State in respect of certain goods or services has no bearing on the examination by the trade mark registration authority of another Member State of an application for registration of a similar mark in respect of goods or services similar to those in respect of which the first mark was registered.

Public interest

- Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that such signs or indications may be freely used by all.

As the Court has already held (...), Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that such signs or indications may be freely used by all. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks. That public interest requires that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods. Therefore, marks consisting exclusively of such signs or indications are not eligible for registration unless Article 3(3) of the Directive applies.

Exclusively descriptive

- Existence synonymous irrelevant

It is irrelevant whether there are other, more usual, signs or indications for designating the same characteristics of the goods or services referred to in the application for registration than those of which the mark concerned consists.

Number of competitors irrelevant

- The number of competitors who may have an interest in using the signs or indications of which the mark consists is large or small is not decisive.

Any operator at present offering, as well as any operator who might in the future offer, goods or services

which compete with those in respect of which registration is sought must be able freely to use the signs or indications which may serve to describe characteristics of its goods or services.

Translations

- Where national law extends registration to its translation, authority must ascertain as regards each of those translations whether the mark does not consist exclusively of descriptive signs.

where, as in the case before the national court, the applicable national law provides that the exclusive right, conferred where a competent authority in an area in which a number of officially recognised languages co-exist registers a word mark expressed in one of those languages, extends automatically to its translation in the other languages, such a provision in fact allows a number of different marks to be registered.

Therefore, the authority must ascertain as regards each of those translations whether the mark does not consist exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services in respect of which registration is sought.

Scope descriptive and distinctive character

- A mark which is descriptive of the characteristics of certain goods or services cannot be regarded as necessarily having distinctive character.

That Article 3(1) of the Directive must be interpreted as meaning that a mark which is descriptive of the characteristics of certain goods or services but not of those of other goods or services for the purposes of Article 3(1)(c) of the Directive cannot be regarded as necessarily having distinctive character in relation to those other goods or services for the purposes of subparagraph (b) of the provision.

It is of no relevance that a mark is descriptive of the characteristics of certain goods or services under Article 3(1)(c) of the Directive when it comes to assessing whether the same mark has distinctive character in relation to other goods or services for the purposes of Article 3(1)(b) of the Directive.

Word composed of elements

- A mark consisting of a word composed of elements is itself descriptive of those characteristics, unless there is a perceptible difference between the word and the mere sum of its parts.

A mark consisting of 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 those characteristics for the purposes of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that

the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the second case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purpose of the same provision.

Commercially essential irrelevant

- It is also irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary.

Conditional registration

- Prohibition on registering a mark in respect of certain goods or services if they do not possess a particular characteristic.

The national court explains in that regard that the question seeks to ascertain whether 'Postkantoor' could be registered, for example, for services such as direct-mail campaigns or the issue of postage stamps 'provided they are not connected with a post office'. (...) that the Directive prevents a trade mark registration authority from registering a mark for certain goods or services on condition that they do not possess a particular characteristic.

Manifestly inadmissible marks

That the practice of a trade mark registration authority which concentrates solely on refusing to register 'manifestly inadmissible' marks is incompatible with Article 3 of the Directive.

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European Court of Justice, 12 February 2004

(V. Skouris, C. Gulmann, J.N. Cunha Rodrigues, R. Schintgen and F. Macken)

JUDGMENT OF THE COURT (Sixth Chamber)

12 February 2004 (1)

(Approximation of laws - Trade marks - Directive 89/104/EEC - Article 3(1) - Grounds for refusal to register - Taking account of all the relevant facts and circumstances - Prohibition on registering a mark in respect of certain goods or services if they do not possess a particular characteristic - Word made up of components each of which describes characteristics of the goods or services concerned)

In Case C-363/99,

REFERENCE to the Court under Article 234 EC by the Gerechtshof te 's-Gravenhage (Netherlands) for a preliminary ruling in the proceedings pending before that court between

Koninklijke KPN Nederland NV
and

Benelux-Merkenbureau,

on the interpretation of Articles 2 and 3 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 COURT (Sixth Chamber),

composed of: V. Skouris, acting for the President of the Sixth Chamber, C. Gulmann, J.N. Cunha Rodrigues, R. Schintgen and F. Macken (Rapporteur), Judges, Advocate General: D. Ruiz-Jarabo Colomer, Registrar: H. von Holstein, Deputy Registrar, after considering the written observations submitted on behalf of:

- Koninklijke KPN Nederland NV, by K. Limperg and T. Cohen Jehoram, advocaten,
 - the Benelux-Merkenbureau, by J.H. Spoor and L. De Gryse, advocaten,
 - the Commission of the European Communities, by K. Banks and H.M.H. Speyart, acting as Agents, having regard to the Report for the Hearing, after hearing the oral observations of Koninklijke KPN Nederland NV, of the Benelux-Merkenbureau and of the Commission at the hearing on 15 November 2001, after hearing the Opinion of the Advocate General at the sitting on 31 January 2002,
- gives the following

Judgment

1. By judgment of 3 June 1999, received at the Court on 1 October 1999, the Gerechtshof te 's-Gravenhage (Regional Court of Appeal, The Hague) referred to the Court for a preliminary ruling pursuant to Article 234 EC nine questions on the interpretation of Articles 2 and 3 of the 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 Directive').

2. Those questions were raised in proceedings between Koninklijke KPN Nederland NV ('KPN') and the Benelux Merkenbureau (Benelux Trade Mark Office; 'the BTMO') concerning the latter's refusal to register as a trade mark the sign 'Postkantoor' applied for by KPN for various goods and services.

Legal background

Community legislation

3. The purpose of the Directive - according to the first recital in its preamble - is to approximate the trade mark laws of the Member States so as to remove the disparities which may impede the free movement of goods and freedom to provide services and may distort competition within the common market.

4. However, as the third recital in its preamble makes clear, the Directive does not aim for full-scale approximation of the trade mark laws of the Member States and is limited to bringing about an approximation of those national provisions of law which most directly affect the functioning of the internal market.

5. The seventh recital in the preamble to the Directive states that attainment of the objectives at which the approximation of the trade mark laws of the Member States is aiming requires that the conditions for obtaining and continuing to hold a registered trade mark are, in general, identical in all Member States and that the grounds for refusal or invalidity concerning the trade mark itself, for example, the absence of any distinctive character, are to be listed in an exhaustive manner, even if some of these grounds are listed as an option for

the Member States, which will therefore be able to maintain or introduce those grounds in their legislation.

6. The 12th recital in the preamble to the Directive states that all Member States of the Community are bound by the Paris Convention for the Protection of Industrial Property of 20 March 1883, as last revised at Stockholm on 14 July 1967 (United Nations Treaty Series, Vol. 828, No 11847, p. 108) and that it is necessary that the provisions of the Directive be entirely consistent with those of the Paris Convention.

7. Article 2 of the Directive, entitled 'Signs of which a trade mark may consist', provides as follows:

'A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.'

8. Article 3 of the Directive, which lists the grounds for refusal or invalidity, provides at paragraphs (1) and (3):

'1. The following shall not be registered or if registered shall be liable to be declared invalid:

- (a) signs which cannot constitute a trade mark;
- (b) trade marks which are devoid of any distinctive character;
- (c) 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;
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;
- ...
- (g) 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;
- ...

3. A trade mark shall not be refused registration or be declared invalid in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character. Any Member State may in addition provide that this provision shall also apply where the distinctive character was acquired after the date of application for registration or after the date of registration'.

The Uniform Benelux Law on Trade Marks

9. The Uniform Benelux Law on Trade Marks was amended, with effect from 1 January 1996, by the Protocol of 2 December 1992 amending that law (Nederlands Traktatenblad 1993, No 12, 'the UBL'), in order to incorporate the Directive into the laws of the three Benelux States.

10. Article 1 of the UBL provides:

'The following may be registered as individual marks: names, designs, imprints, stamps, letters, numerals, the

shape of goods or their packaging, and any other signs which serve to distinguish the goods of an undertaking. However, shapes which result from the nature of the goods themselves, or which affect the substantial value of the goods, or which give rise to a technical result may not be registered as trade marks.'

11. Article 6a of the UBL provides as follows:

'1. The Benelux Trade Mark Office shall refuse registration where it considers that:

- (a) the sign filed does not constitute a trade mark within the meaning of Article 1, in particular because it is devoid of any distinctive character, as provided for in Article 6 quinquies B(2) of the Paris Convention;
- (b) the filing relates to a trade mark referred to in Article 4(1) and (2).

2. The refusal to register must relate to the sign that constitutes the trade mark in its entirety. It may be confined to one or more of the goods for which the mark is intended to be used.

3. The Benelux Office shall inform the applicant without delay and in writing of its intention to refuse registration in whole or in part, shall state the grounds and shall allow him a right to respond within a period of time to be laid down in an implementing regulation.

4. If the objections of the Benelux Office to registration have not been removed within the period granted, registration of the filing shall be refused in whole or in part. The Benelux Office shall notify the applicant without delay and in writing, stating the grounds for refusal and advising of the possibility of review of the decision set out in Article 6b.'

12. Article 6b of the UBL provides:

'The applicant may, within two months following notification under Article 6a(4), file at the Cour d'Appel, Brussels, the Gerechtshof at The Hague or the Cour d'Appel, Luxembourg, an application for an order that the filing be registered. The applicant's address, that of his representative, or the postal address given upon filing shall determine which court has territorial jurisdiction.'

13. Article 13C(1) of the UBL provides:

'The exclusive right to a trade mark expressed in one of the national or regional languages of the Benelux territory extends automatically to its translation in another of those languages.'

The main proceedings and the questions referred for a preliminary ruling

14. On 2 April 1997, KPN lodged with the BTMO an application for registration of 'Postkantoor' (which may be translated as 'post office') as a trade mark in respect of certain goods and services falling within Classes 16, 35 to 39, 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 ('the Nice Agreement'), classes which include paper, advertising, insurance, postage-stamps, construction, telecommunications, transport, education and technical information and advice.

15. By letter of 16 June 1997, the BTMO informed KPN that it was provisionally refusing registration on

the ground that 'the Postkantoor sign is exclusively descriptive of the goods and services mentioned in Classes 16, 35, 36, 37, 38, 39, 41 and 42 in relation to a post office' and that '[it] therefore ... has no distinctive character as provided for in Article 6a(i)(a) of the Uniform Benelux Law on Trade Marks'.

16. By letter of 15 December 1997, KPN raised an objection to the refusal but the latter was definitively confirmed by a letter from the BTMO of 28 January 1998.

17. On 30 March 1998 KPN brought proceedings before the Gerechtshof te 's-Gravenhage, which held that the answer to certain questions, which concerned the interpretation of the UBL, called for a referral to the Benelux Court of Justice and that other questions, concerning the interpretation of the Directive, should be referred to the Court of Justice of the European Communities.

18. It was in those circumstances that the Gerechtshof te 's-Gravenhage decided to stay the proceedings and refer the following nine questions to the Court for a preliminary ruling:

'1. Must the Benelux Trade Marks Office, which under the Protocol of 2 December 1992 amending the Uniform Benelux Law on Trade Marks (Trb. 1993, 12) is responsible for the assessment of the absolute grounds for refusal to register a trade mark laid down in Article 3(1) in conjunction with Article 2 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) have regard not only to the sign as it appears in the application for registration but also to all the relevant facts and circumstances known to it, including those of which it was informed by the applicant (for example, the fact that, prior to the application, the applicant already used the sign widely as a trade mark for the relevant products, or the fact that investigation shows that use of the sign for the goods and/or services mentioned in the application will not be of such a nature as to deceive the public)?

2. Does the reply to the [first] question ... also apply to consideration by the Benelux Trade Marks Office of the question whether its objections to registration of the application have been removed by the applicant, as well as to its decision to refuse registration in whole or in part, as provided for in Article 6a(4) of the UBL?

3. Does the reply to the [first] question ... also apply to the judicial review to which Article 6b of the UBL refers?

4. In the light of the provisions of Article 6 quinquies (B)(2) of the Paris Convention, do the marks which under Article 3(1)(c) of the Directive are not to be registered or, if registered, may be declared invalid, also include marks composed of signs or indications which may serve, in trade, to indicate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of service or other characteristics of the goods or services, even if that configuration is not the (only or most) usual indication used? Does it make any difference in that connection whether there are many or only

a few competitors who may have an interest in using such indications (see the judgment of the Benelux Court of Justice of 19 January 1981, NJ 1981, 294, in P Ferrero & Co S.p.A. v Alfred Ritter Schokoladefabrik GmbH (Kinder))?

Is it also relevant that under Article 13C of the UBL the right to a trade mark expressed in one of the national or regional languages of the Benelux area extends automatically to its translation in another of those languages?

5. (a) In the assessment of the question whether a sign consisting of a (new) word made up of components which in themselves have no distinctive character with regard to the goods or services in respect of which the application is made answers the description given in Article 2 of the Directive (and Article 1 of the UBL) of a mark, must a (new) word of that kind be taken to have in principle a distinctive character?

(b) If not, must a word of that kind (leaving aside the fact that it may have acquired distinctive character through use, "inburgering") be taken to have in principle no distinctive character, it being otherwise only where, because of other circumstances, the combination is more than the sum of its parts?

Is it relevant in that connection whether the sign is the only or an obvious term for indicating the relevant quality or (combination of) qualities, or whether there are synonyms which may reasonably also be used, or that the word indicates a commercially essential or rather an incidental quality of the product or service?

Is it also relevant that, under Article 13C of the UBL, the right to a trade mark expressed in one of the national or regional languages of the Benelux area extends automatically to its translation in another of those languages?

6. Does the mere fact that a descriptive sign is also lodged for registration as a mark for goods and/or services of which the sign is not descriptive warrant the conclusion that the sign thereby has distinctive character in relation to those goods and/or services (for example, the sign "Postkantoor" for furniture)?

If not, in order to determine whether such a descriptive sign has distinctive character for such goods and/or services, must regard be had to the possibility that, in the light of its descriptive meaning or meanings, (a part of) the public will not perceive that sign as a distinctive sign for (all or some of) those goods or services?

7. In the assessment of the abovementioned questions, is significance to be attached to the fact that, since the Benelux countries have chosen to have applications for registration of trade marks examined by the Benelux Trade Marks Office as a requirement prior to registration, the appraisal policy of the Office under Article 6a of the UBL, according to the common commentary of the Governments, "must be a cautious and restrained one whereby all concerns of commercial life must be taken into account and efforts must be focused on establishing solely which applications are manifestly inadmissible and rectifying or refusing them"? If so, under what rules does it fall to be determined whether an application is "manifestly inadmissible"?

It is assumed that in invalidity proceedings (which may be initiated after registration of a sign) it is not necessary, in addition to reliance on the nullity of the sign lodged as a mark, for the sign to be “manifestly inadmissible.”

8. Is it consistent with the scheme of the Directive and the Paris Convention for a sign to be registered for specific goods or services subject to the limitation that the registration applies only to those goods and services in so far as they do not possess a specific quality or specific qualities (for example, registration of the sign “Postkantoor” for the services of direct-mail campaigns and the issue of postage stamps “provided they are not connected with a post office”)?

9. Is it also material to the answer to be given to the questions whether a corresponding sign for similar goods or services is registered as a trade mark in another Member State?

The first, second and third questions

19. By the first question, the national court asks essentially whether Article 3 of the Directive is to be interpreted as meaning that a trade mark registration authority must have regard, in addition to the mark as filed, to all the relevant facts and circumstances known to it. By the second and third questions, which it is appropriate to examine together, it asks at which stage of the procedure before it should the competent authority have regard to all the relevant facts and circumstances and, where application is made to a court for review, whether the court must also have regard to them.

Observations submitted to the Court

20. KPN submits that when the BTMO examines whether a mark should be registered, it must not base its assessment exclusively on the mark but may take into account certain facts which are a matter of common knowledge and information produced by the applicant. However, it must confine itself to the relevant facts and circumstances known to it at the time when the application is filed.

21. KPN maintains that the BTMO should apply the same criteria for both the provisional assessment and the final assessment of an application for registration but should nevertheless be able to take into account, at the time of the final assessment, relevant facts which have been drawn to its attention since the provisional assessment.

22. Finally, KPN suggests that the court asked to review a decision of the BTMO must examine the same facts as those relied on by the latter.

23. The BTMO maintains that it is required to have regard to all the facts and circumstances known to it and which are relevant to the question whether the mark, as filed, is able to fulfil its function of being distinctive with regard to the goods and services in respect of which registration is sought. It cannot therefore take account merely of information provided to it by the applicant or which is common knowledge, bearing in mind that if it wishes to rely on matters which are not known to the applicant it must give the latter the opportunity to comment, in accordance with the principle that the rights of the defence must be observed.

24. Furthermore, the obligation to take into account all relevant facts and circumstances applies at every stage of the procedure before it.

25. Finally, the BTMO submits, in essence, that a court asked to review one of its decisions must assess the merits of the application on the basis of all the facts and circumstances which were known to the BTMO at the time of the final refusal, and cannot take into account new facts raised for the first time before the court.

26. The Commission submits that it is inconceivable that either the mark applied for, or the question whether one of the grounds for refusal set out in Article 3 of the Directive applies to it, should be assessed in the abstract.

27. On the one hand, for each trade mark - particularly word marks - the answer to that question is dependent on the meaning of the mark, which in turn is dependent on the use to which the mark is put in economic and social intercourse, in particular as regards the public at which the mark is aimed. On the other hand, protection is never claimed in absolute terms but rather in respect of certain goods or services which must be specified in the application for registration. The ability of the mark to distinguish the goods or services of one undertaking from those of other undertakings must always be assessed in the light of the goods or services in respect of which registration of the mark is sought.

28. Finally, although Member States are quite free to lay down procedural rules in the matter of trade marks, compliance with the substantive rules prescribed by the Directive should not be made dependent on the stage of the procedure concerned. Therefore, the obligation to have regard to actual circumstances in the assessment of the application for registration applies both before the competent authority and before the court.

The Court's reply

29. As regards the question whether a competent authority must have regard to all the relevant facts and circumstances when examining a trade mark application, it is appropriate to point out, first, that the 12th recital in the preamble to the Directive states that ‘all Member States of the Community are bound by the Paris Convention for the Protection of Industrial Property’ and that ‘it is necessary that the provisions of this Directive are entirely consistent with those of the Paris Convention’.

30. Article 6 quinquies C(1) of the Paris Convention provides that ‘in determining whether a mark is eligible for protection, all the factual circumstances must be taken into consideration, particularly the length of time the mark has been in use.’

31. Second, when the competent authority examines a trade mark application and, for that purpose, must determine, inter alia, whether or not the mark is devoid of any distinctive character, whether or not it is descriptive of the characteristics of the goods or services concerned and whether or not it has become generic, it cannot carry out the examination in the abstract.

32. In the course of that examination, it is for the competent authority to have regard to the characteristics peculiar to the mark for which registration is sought,

including the type of mark (word mark, figurative mark, etc.) and, in the case of a word mark, its meaning, in order to ascertain whether or not any of the grounds for refusal set out in Article 3 of the Directive apply to the mark.

33. Moreover, since registration of a mark is always sought in respect of the goods or services described in the application for registration, the question whether or not any of the grounds for refusal set out in Article 3 of the Directive apply to the mark must be assessed specifically by reference to those goods or services.

34. A trade mark's distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see, *inter alia*, [Joined Cases C-53/01 to C-55/01 Linde and Others \[2003\] ECR I-3161, paragraph 41](#), and [Case C-104/01 Libertel \[2003\] ECR I-3793, paragraphs 46 and 75](#)).

35. In its assessment, the competent authority has regard to all the relevant facts and circumstances, including, where appropriate, the results of any study submitted by the applicant seeking to establish, for example, that the mark is not devoid of any distinctive character or is not misleading.

36. As to the stage of the examination procedure before the competent authority at which account must be taken of all the relevant facts and circumstances and, where national law provides for the possibility of review by a court of a decision of that authority, whether that court must also have regard to the relevant facts and circumstances, the competent authority must have regard to all the relevant facts and circumstances before adopting a final decision on an application to register a trade mark. A court asked to review a decision on an application for a trade mark registration must also have regard to all the relevant facts and circumstances, subject to the limits on the exercise of its powers as defined by the relevant national legislation.

37. The answer to the first, second and third questions must therefore be that Article 3 of the Directive is to be interpreted as meaning that a trade mark registration authority must have regard, in addition to the mark as filed, to all the relevant facts and circumstances.

It must have regard to all the relevant facts and circumstances before adopting a final decision on an application to register a trade mark. A court asked to review a decision on an application to register a trade mark must also have regard to all the relevant facts and circumstances, subject to the limits on the exercise of its powers as defined by the relevant national legislation.

The ninth question

38. By the ninth question, which it is appropriate to examine in second place, the referring court asks whether the fact that a trade mark has been registered in a Member State in respect of certain goods or services has any effect on the examination by the trade mark

registration authority in another Member State of an application for registration of a similar mark in respect of goods or services which are similar to those in respect of which the first mark was registered.

Observations submitted to the Court

39. KPN submits that where a mark is registered in respect of certain goods or services in a Member State the consequence is not that the same or a similar mark will in all circumstances also have to be registered for the same goods and services in other Member States. A particular mark will not necessarily have the same intrinsic distinctive character in every Member State. In each Member State the extent to which the mark in question has distinctive character in the perception of the relevant public in that Member State concerned will have to be determined.

40. The BTMO contends that it cannot take into account, for the purposes of its examination of an application for registration of a mark, not only that mark but marks filed in other Member States. In addition, a mark, although originally devoid of distinctive character, may have been registered in another Member State because there it has acquired distinctiveness through use and the applicant has gained recognition of that. Finally, a mark does not acquire distinctive character because another mark which is equally devoid of distinctive character has been registered in error. Errors of assessment are inevitable but should not have to be replicated on the basis of a misinterpretation of general principles of law such as the protection of a legitimate expectation or legal certainty.

41. The Commission submits that where a final registration has been made in a Member State following a review of the grounds for refusal, that may provide some guidance for the competent authorities of other Member States when they carry out a review pursuant to Article 3(1)(b) to (d) of the Directive. However, as regards word marks, such a registration is relevant only if the word concerned is a word in one of the languages of the trade mark law in question. In any event, such a registration is purely indicative and cannot function as a substitute for the assessment which the competent authorities of other Member States must undertake on the basis of the specific circumstances of each case, taking account of the protection of interested parties in those Member States.

The Court's reply

42. As stated in paragraph 32 of this judgment, it is for the competent authority to have regard to the characteristics peculiar to the mark for which registration is sought in order to ascertain whether or not any of the grounds for refusal set out in Article 3 of the Directive apply. Furthermore, as recalled in paragraph 33 of the present judgment, registration of a mark is always sought in respect of the goods or services described in the application for registration.

43. Therefore, the fact that a mark has been registered in one Member State in respect of certain goods and services cannot have any bearing on whether or not any of the grounds for refusal set out in Article 3 of the Directive apply to a similar mark, registration of which is

applied for in a second Member State in respect of similar goods or services.

44. The answer to the ninth question must therefore be that the fact that a trade mark has been registered in a Member State in respect of certain goods or services has no bearing on the examination by the trade mark registration authority of another Member State of an application for registration of a similar mark in respect of goods or services similar to those in respect of which the first mark was registered.

The fourth question

45. By the first part of the fourth question, which it is appropriate to consider in third place, the national court asks whether Article 3(1)(c) of the Directive precludes registration of a mark composed exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services in respect of which registration is sought, when there are more usual indications for designating the same characteristics. It also asks whether the fact that there are many or few competitors who may have an interest in using the signs or indications of which the mark is composed has any bearing on the answer to that question. By the second part of the fourth question, it asks what the consequences are for the application of Article 3(1)(c) of the Directive of a national rule which provides that the exclusive right conferred by registration, by a competent authority in an area in which a number of officially recognised languages coexist, of a mark expressed in one of those languages extends automatically to its translation in the other languages.

Observations submitted to the Court

46. In KPN's submission, it is not unusual for a duly registered mark to have something allusive or descriptive about it. Such a mark cannot, however, be refused registration even if it immediately brings to mind, for a particular section of the public, characteristics of the goods in respect of which it is registered. Signs which, at the time of filing, are not a customary indication of a particular quality of the goods but are only allusive are not signs of the kind referred to by Article 3(1)(c) of the Directive.

47. KPN adds that it is important to know whether competitors have any other options, since the greater the number of other possibilities, the lower the risk will be of a competitor being restricted in its use of an allusive sign as a distinctive sign.

48. The BTMO contends that the ground for refusal stated in Article 3(1)(c) of the Directive applies where a mark consists exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services in respect of which registration is sought and that it is irrelevant that there is scope for designating the same characteristics other than by the use of those signs or indications. That analysis is borne out by the judgment in [Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee \[1999\] ECR I-2779](#).

49. The BTMO also contends that the question as to whether many or few competitors wish to use the signs or indications in question is not a determining factor when Article 3(1)(c) of the Directive is applied.

50. Finally, under Benelux trade mark law, Benelux territory is one and indivisible, so that if a sign is descriptive in one only of the Benelux States or in one only of the Benelux languages or is devoid of distinctive character there for another reason, its registration as a mark must be refused throughout the Benelux territory.

51. Relying on [Windsurfing Chiemsee](#), the Commission maintains that the purpose of the prohibition on descriptive marks set out in Article 3(1)(c) of the Directive is to ensure that signs which are descriptive of the characteristics of the goods may be freely used by all. In that regard, it is not necessary for there to be an actual or definite risk of a monopoly being created for such marks to be prohibited. Furthermore, whether signs or indications capable of being used to describe the characteristics of the goods have synonyms has no bearing on the issue.

52. Finally, the Commission submits that it is also immaterial whether few or many competitors may be affected by any monopoly created as a result of registration of a mark consisting exclusively of such signs or indications.

The Court's reply

53. So far as the first part of the question is concerned, it is appropriate to recall that, under Article 3(1)(c) of the Directive, marks consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services in respect of which registration is sought are not to be registered.

54. As the Court has already held ([Windsurfing Chiemsee](#), paragraph 25, [Linde](#), paragraph 73, and [Libertel](#), paragraph 52), Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that such signs or indications may be freely used by all. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

55. That public interest requires that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods. Therefore, marks consisting exclusively of such signs or indications are not eligible for registration unless Article 3(3) of the Directive applies.

56. In those circumstances, the competent authority must, under Article 3(1)(c) of the Directive, determine whether a trade mark for which registration is sought currently represents, in the mind of the relevant class of persons, a description of the characteristics of the goods or services concerned or whether it is reasonable to assume that that might be the case in the future (see to that effect [Windsurfing Chiemsee](#), paragraph 31). If, at the end of that assessment, the competent authority reaches the conclusion that that is the case, it must refuse, on the basis of that provision, to register the mark.

57. It is irrelevant whether there are other, more usual, signs or indications for designating the same character-

istics of the goods or services referred to in the application for registration than those of which the mark concerned consists. Although Article 3(1)(c) of the Directive provides that, if the ground for refusal set out there is to apply, the mark must consist 'exclusively' of signs or indications which may serve to designate characteristics of the goods or services concerned, it does not require that those signs or indications should be the only way of designating such characteristics.

58. Similarly, whether the number of competitors who may have an interest in using the signs or indications of which the mark consists is large or small is not decisive. Any operator at present offering, as well as any operator who might in the future offer, goods or services which compete with those in respect of which registration is sought must be able freely to use the signs or indications which may serve to describe characteristics of its goods or services.

59. So far as the second part of the fourth question is concerned, where, as in the case before the national court, the applicable national law provides that the exclusive right, conferred where a competent authority in an area in which a number of officially recognised languages coexist registers a word mark expressed in one of those languages, extends automatically to its translation in the other languages, such a provision in fact allows a number of different marks to be registered.

60. Therefore, the authority must ascertain as regards each of those translations whether the mark does not consist exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services in respect of which registration is sought.

61. The answer to the fourth question must therefore be that Article 3(1)(c) of the Directive precludes registration of a trade mark which consists exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services in respect of which registration is sought, and that is the case even when there are more usual signs or indications for designating the same characteristics and regardless of the number of competitors who may have an interest in using the signs or indications of which the mark consists. Where the applicable national law provides that the exclusive right conferred by registration, by a competent authority in an area in which a number of officially recognised languages coexist, of a word mark expressed in one of those languages extends automatically to its translation in the other languages, the authority must ascertain as regards each of those translations whether the mark actually consists exclusively of signs or indications which may serve, in trade, to designate characteristics of those goods or services.

The sixth question

62. By the first part of the sixth question, which it is appropriate to examine in fourth place, the national court asks, essentially, whether Article 3(1) of the Directive must be interpreted as meaning that a trade mark which is descriptive, for the purposes of subparagraph (c) of that provision, of the characteristics of certain goods or services, but not of those of other goods or services, must be regarded as necessarily hav-

ing distinctive character in relation to those other goods or services for the purposes of subparagraph (b) of the provision. If that is not the case, the national court asks, by the second part of the question, if, for the purpose of determining whether such a mark is devoid of any distinctive character in relation to certain goods or services of which it is not descriptive, account must be taken of the possibility that the public will not perceive that mark as distinctive for those goods or services because it is descriptive of characteristics of other goods or services.

Observations submitted to the Court

63. KPN submits, first, that if by 'descriptive sign' the national court means a word in everyday language, then where such a word is filed as a mark for goods or services of which it is not descriptive, the conditions set out in Articles 1 and 3 of the Directive are fulfilled as regards the mark's distinctive character. Second, the distinctive character of a mark must be assessed in relation to the goods or services in respect of which the application has been filed and not in relation to goods or services which might have some connection with the goods or services in respect of which registration of the mark is sought.

64. In the BTMO's submission, a mark like 'Postkantoor' may serve inter alia to indicate the intended purpose of the goods or services, for example furniture intended to be used in a post office. In those circumstances, the fact that the mark may be perceived by the relevant public as an indication relating to one characteristic of the goods or services concerned, notably their intended purpose, renders the mark ineligible for registration under Article 3(1)(c) of the Directive.

65. However, even if the public were not to perceive 'Postkantoor' for particular goods or services as an indication under Article 3(1)(c) of the Directive, it would remain incapable of serving as a mark by virtue of that provision. The provision is concerned not so much with the way in which the mark is currently perceived by the relevant public as with whether it may serve in trade to designate the characteristics or circumstances to which it alludes. In addition, it is appropriate to have regard to the perception which it may reasonably be assumed the relevant sectors of the public will have of the mark in the future.

66. The Commission submits, first, that whether a mark has distinctive character is dependent both on the goods or services for which protection is sought and on the perception which the average consumer, reasonably well informed and reasonably observant and circumspect, has of those goods or services. Second, the grounds for refusal set out in paragraphs (b) and (c) of Article 3(1) of the Directive must be assessed separately, in spite of the overlapping which may appear in practice. In those circumstances, the fact that a mark is not exclusively descriptive of those goods or services is not sufficient to conclude that it has distinctive character in respect of those goods or services.

The Court's reply

67. As regards the first part of the question, it is clear from Article 3(1) of the Directive that each of the

grounds for refusal listed in that provision is independent of the others and calls for a separate examination (see, inter alia, *Linde*, paragraph 67). That is true in particular of the grounds for refusal listed in paragraphs (b), (c) and (d) of Article 3(1), although there is a clear overlap between the scope of the respective provisions (see to that effect [Case C-517/99 Merz & Krell \[2001\] ECR I-6959](#), paragraphs 35 and 36).

68. Furthermore, according to the Court's case-law, the various grounds for refusing registration set out in Article 3 of the Directive must be interpreted in the light of the public interest underlying each of them (see in particular [Case C-299/99 Philips \[2002\] ECR I-5475](#), paragraph 77, *Linde*, paragraph 71, and *Libertel*, paragraph 51).

69. It follows that the fact that a mark does not fall within one of those grounds does not mean that it cannot fall within another (see to that effect *Linde*, paragraph 68).

70. In particular, it is thus not open to the competent authority to conclude that a mark is not devoid of any distinctive character in relation to certain goods or services purely on the ground that it is not descriptive of them.

71. Second, as has been observed in paragraph 34 of this judgment, whether a mark has distinctive character for the purposes of Article 3(1)(b) of the Directive must be assessed by reference to the goods or services described in the application for registration.

72. Further, under Article 13 of the Directive 'where grounds for refusal of registration ... exist in respect of only some of the goods or services for which that trade mark has been applied for ... , refusal of registration ... shall cover those goods or services only'.

73. It follows that, where registration of a mark is sought in respect of various goods or services, the competent authority must check, in relation to each of the goods or services claimed, that none of the grounds for refusal listed in Article 3(1) of the Directive applies to the mark and may reach different conclusions depending upon the goods or services in question.

74. Therefore, it is not open to the competent authority to conclude that a mark is not devoid of any distinctive character in relation to certain goods or services purely on the ground that it is descriptive of the characteristics of other goods or services, even where registration is sought in respect of those goods or services as a whole.

75. As regards the second part of the question, whether a mark has distinctive character must be assessed, as has been observed in paragraph 34 of this judgment, first, by reference to the goods or services in respect of which registration of the mark has been sought, and, second, by reference to the way in which it is perceived by the relevant public, which consists of average consumers of those goods or services, reasonably well informed and reasonably observant and circumspect.

76. It follows that if, on completion of the examination of a trade mark application, the competent authority finds, in the light of all the relevant facts and circumstances, that the average consumer of certain goods or services, reasonably well informed and reasonably at-

tentive, perceives a mark as devoid of any distinctive character with regard to those goods or services, it must refuse to register the mark for those goods or services pursuant to Article 3(1)(b) of the Directive.

77. However, it is of no relevance that the average consumer of other goods or services, reasonably well informed and reasonably observant, perceives the same mark as descriptive of the characteristics of those other goods or services for the purposes of Article 3(1)(c) of the Directive.

78. It does not follow from either Article 3 of the Directive or from any other provisions thereof that the fact that a mark is descriptive of certain goods or services is a ground for refusing to register that mark for other goods or services. As is stated in the seventh recital in the preamble to the Directive, grounds for refusal concerning the trade mark itself are listed exhaustively.

79. The answer to the sixth question must therefore be that Article 3(1) of the Directive must be interpreted as meaning that a mark which is descriptive of the characteristics of certain goods or services but not of those of other goods or services for the purposes of Article 3(1)(c) of the Directive cannot be regarded as necessarily having distinctive character in relation to those other goods or services for the purposes of subparagraph (b) of the provision.

It is of no relevance that a mark is descriptive of the characteristics of certain goods or services under Article 3(1)(c) of the Directive when it comes to assessing whether the same mark has distinctive character in relation to other goods or services for the purposes of Article 3(1)(b) of the Directive.

The fifth question

80. As a preliminary point, it is appropriate to observe, first, that the purpose of Article 2 of the Directive is to define the types of signs of which a trade mark may consist ([Case C-273/00 Sieckmann \[2002\] ECR I-11737](#), paragraph 43), irrespective of the goods or services for which protection might be sought (see to that effect *Sieckmann*, paragraphs 43 to 55, *Libertel*, paragraphs 22 to 42, and *Case C-283/01 Shield Mark [2003] ECR I-0000*, paragraphs 34 to 41). It provides that a trade mark may consist inter alia of 'words' and 'letters', provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

81. In view of that provision, there is no reason to find that a word like 'Postkantoor' is not, in respect of certain goods or services, capable of fulfilling the essential function of a trade mark, which is to guarantee the identity of the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see, in particular, [Case C-39/97 Canon \[1998\] ECR I-5507](#), paragraph 28, *Merz & Krell*, paragraph 22, and *Libertel*, paragraph 62). Accordingly, an interpretation of Article 2 of the Directive appears not to be useful for the purposes of deciding the present case.

82. It follows, however, from the wording of the fifth question that the national court is in fact asking whether a mark for which registration is sought in respect of certain goods or services falls within any ground of refusal. Thus, the question must be taken to mean that the national court is seeking an interpretation of Article 3(1) of the Directive.

83. Second, as is clear from paragraph 15 of the present judgment, in the main proceedings the BTMO relied on the ground that the Postkantoor sign 'is exclusively descriptive of the goods and services [in question] in relation to a post office' in order to conclude that 'Postkantoor' was not distinctive.

84. Thus, the national court's assumption that 'Postkantoor' may be devoid of distinctive character arises from the finding that the mark is descriptive of characteristics of the goods and services concerned, given that it is composed exclusively of elements which are themselves descriptive of those characteristics.

85. In that regard, and as has been pointed out in paragraph 67 of this judgment, although each of the grounds for refusal listed in Article 3(1) of the Directive is independent of the others and calls for separate examination, there is a clear overlap between the scope of each of the grounds for refusal set out in subparagraphs (b), (c) and (d) of that provision respectively.

86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.

87. Therefore, in order to give a useful answer to the national court, the fifth question (which it is appropriate to examine in fifth place) must be construed as asking in essence whether Article 3(1)(c) of the Directive is to be interpreted as meaning that a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, may be regarded as not itself descriptive of the characteristics of those goods or services and, if so, in what circumstances. In that respect, it asks if it is of any importance whether there are synonyms for the word or that the characteristics of the goods or services capable of being described by the word are commercially essential or merely ancillary.

Observations submitted to the Court

88. KPN claims that when the components of a mark are devoid of any distinctive character in relation to the goods or services for which registration is sought, the mark will more often than not also be devoid of any such character. However, if the components of the mark are not devoid of all distinctive character but merely allude to the goods or services concerned, so that they could theoretically be used in trade to allude to certain of their qualities, the mark could none the less be distinctive in relation to those goods or services.

89. In the BTMO's submission, each mark, whether or not it is composite, must satisfy the conditions laid down by Articles 2 and 3(1)(b) to (d) of the Directive. A new combination of words, each of which is devoid of distinctive character, will not be distinctive merely because it is new.

90. The BTMO contends that, most frequently, the issue is whether a combination of words, each of which is merely descriptive of characteristics of the goods concerned, nevertheless manages to acquire sufficient distinctiveness for the mark consisting of that combination of words not to be descriptive for the purpose of Article 3(1)(c) of the Directive. In that connection, if the combination is merely the sum of two components which, being descriptive, are not distinctive, the combination, although new in the strict sense, will usually not be regarded as distinctive.

91. Finally, the fact that there are synonyms for a mark which is by definition descriptive is not a key factor in any decision about the mark's validity.

92. The Commission submits that a mark composed of elements, each of which is devoid of distinctive character in relation to the goods or services referred to in the application, is also, as a general rule, except where distinctiveness has been acquired through use, itself devoid of any distinctive character, unless related circumstances, such as a graphic or semantic alteration of the combination of those elements, give the mark an additional attribute such as to render it capable, as a whole, of distinguishing the goods or services of one undertaking from those of other undertakings. Such an assessment should, however, always be based on the specific circumstances of each case.

The Court's reply

93. Article 3(1)(c) of the Directive provides that marks consisting 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.

94. As has been pointed out in paragraph 68 of this judgment, the various grounds for refusing registration set out in Article 3 of the Directive must be interpreted in the light of the public interest underlying each of them.

95. It follows from paragraphs 54 and 55 of the present judgment that Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications descriptive of the characteristics of the goods or services in respect of which registration is applied for may be freely used by all. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

96. If a mark, such as that at issue in the main proceedings, which consists of a word produced by a combination of elements, is to be regarded as descriptive for the purpose of Article 3(1)(c) of the Directive, it is not sufficient that each of its components may be

found to be descriptive. The word itself must be found to be so.

97. It is not necessary that the signs and indications composing the mark that are referred to in Article 3(1)(c) of the Directive 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 those signs and indications could be used for such purposes. A word 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 (see to that effect, in relation to the identical provisions of Article 7(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), [Case C-191/01 P OHIM v Wrigley \[2003\] ECR I-0000, paragraph 32](#)).

98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark.

100. Thus, a mark consisting of 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 those characteristics for the purposes of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the second case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purpose of the same provision.

101. Furthermore, for the reason given in paragraph 57 of this judgment, it is irrelevant for the purposes of determining whether the ground for refusal set out in

Article 3(1)(c) of the Directive applies to such a mark whether or not there are synonyms permitting the same characteristics of the goods or services to be designated.

102. It is also irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. The wording of Article 3(1)(c) of the Directive does not draw any distinction by reference to the characteristics which may be designated by the signs or indications of which the mark consists. In fact, in the light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially.

103. Finally, the Court has already responded, in paragraphs 59 and 60 of this judgment, to the question concerning the effect on the interpretation of Article 3(1)(c) of the Directive of a national provision such as Article 13C(1) of the UBL.

104. The answer to the fifth question must therefore be that Article 3(1)(c) of the Directive must be interpreted as meaning that a mark consisting of 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 that provision, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that because of the unusual nature of the combination in relation to the goods or services the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the latter case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purposes of the same provision.

For the purposes of determining whether Article 3(1)(c) of the Directive applies to such a mark, it is irrelevant whether or not there are synonyms capable of designating the same characteristics of the goods or services mentioned in the application for registration or that the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary.

The eighth question

105. By the eighth question, to be examined in sixth place, the national court asks essentially whether the Directive or the Paris Convention prevents a trade mark registration authority from registering a mark for certain goods or services subject to the condition that they do not possess a particular characteristic.

106. The national court explains in that regard that the question seeks to ascertain whether 'Postkantoor' could be registered, for example, for services such as direct-

mail campaigns or the issue of postage stamps 'provided they are not connected with a post office'.

Observations submitted to the Court

107. KPN submits that the question is not regulated by the Directive and thus does not fall within the Court's jurisdiction. In the alternative, it maintains that such limitations are permissible and that exclusions may be accepted or even required when the application is filed.

108. The BTMO contends that under the Directive, although procedural issues are a matter for the Member States, the conditions for obtaining and continuing to hold a trade mark are, in general, identical in all of them. Those conditions include the obligation to draw up the registration in accordance with internationally accepted standards, in particular the classification provided for in the Nice Agreement.

109. Under the Nice Agreement there is no provision for registration of the absence of a particular characteristic which cannot be objectively defined as a sub-category of a list of goods or services.

110. The Commission argues, first, that the Court has no jurisdiction to adjudicate on the compatibility of a provision of national law with the Paris Convention. Second, relying on Regulation No 40/94, it submits that Article 3(1)(c) of the Directive does not prevent marks which are descriptive of certain goods or services from being refused in relation to some of the goods or services listed in the application for registration, a practice which is also followed by the Office for Harmonisation in the Internal Market Trade Marks and Designs (OHIM).

The Court's reply

111. The Nice Agreement divides goods and services into classes in order to facilitate the registration of trade marks. Each class brings together various goods or services.

112. Although an undertaking may apply for registration of a mark in respect of all the goods or services falling within such a class, nothing in the Directive prohibits it from seeking registration solely in respect of only some of those goods or services.

113. Likewise, when registration of a mark is sought in respect of an entire class within the Nice Agreement, the competent authority may, pursuant to Article 13 of the Directive, register the mark only in respect of some of the goods or services belonging to that class, if, for example, the mark is devoid of any distinctive character in relation to other goods or services mentioned in the application.

114. By contrast, where registration is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic.

115. Such a practice would lead to legal uncertainty as to the extent of the protection afforded by the mark. Third parties - particularly competitors - would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they might thus be led to refrain from using

the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods.

116. Since the Directive precludes such a practice, there is no need to examine the request for an interpretation of the Paris Convention.

117. In those circumstances, the answer to the eighth question must be that the Directive prevents a trade mark registration authority from registering a mark for certain goods or services on condition that they do not possess a particular characteristic.

The seventh question

118. By the seventh question, which must be considered last, the national court asks whether the practice of a trade mark registration authority which concentrates solely on refusing to register 'manifestly inadmissible' marks is precluded by Article 3 of the Directive.

Observations submitted to the Court

119. In KPN's submission, by providing in Article 3(1) that marks can either not be registered or can be declared invalid once registered, the Directive expressly allows the Member States to register marks liable subsequently to be declared invalid. It follows that the Member States are free to provide that, at the stage of registration, only 'manifestly inadmissible' marks are to be refused. It is also open to them to determine which marks are to be regarded as 'manifestly inadmissible' and which are not to be regarded as such. Putting this test into practice may entail registering a mark even where there is reasonable doubt as to whether it has sufficient distinctive character. However, in invalidity proceedings in respect of a registered mark, the criteria set out in Articles 1 to 3 of the Directive must be strictly adhered to.

120. The BTMO and the Commission argue, by contrast, that since the Directive entered into force the Benelux States are no longer able to rely either on their governments' common commentary or on the earlier case-law of the Benelux Court of Justice, which is rendered inoperative by the Directive, but must rely on the wording, the purpose and the scope of Article 3 of the Directive. That provision does not draw any distinction between 'inadmissible' applications and 'manifestly inadmissible' applications.

The Court's reply

121. It is clear from the last paragraph of point I.6 of the preamble to the Protocol of 2 December 1992 amending the UBL that 'the appraisal policy of the [BTMO] ... must be a cautious and restrained one, which takes account of all commercial concerns and is focused on rectifying or refusing manifestly inadmissible applications' and that 'the examination must remain within the boundaries laid down in Benelux case-law, in particular that of the Benelux Court of Justice'.

122. In that regard, it is appropriate to observe that although the third recital in the preamble to the Directive states that the full-scale approximation of the trade mark laws of the Member States does not appear necessary at present, the seventh recital makes clear that the conditions for obtaining and continuing to hold a registered trade mark are, in general, identical in all the

Member States and that, to that end, the grounds for refusal of registration concerning the trade mark itself are listed exhaustively in the Directive.

123. In addition, the scheme of the Directive is founded on review prior to registration, even though it also makes provision for ex post facto review. The examination of the grounds for refusal listed in Article 3 of the Directive in particular, which takes place when registration is applied for, must be thorough and full in order to ensure that trade marks are not improperly registered (see to that effect [Libertel](#), paragraph 59).

124. Therefore, the competent authority within a Member State must refuse to register any mark caught by one of the grounds for refusal laid down by the Directive, in particular in Article 3.

125. Article 3 does not distinguish between marks which cannot be registered and those which 'manifestly' cannot be registered. Consequently, the competent authority cannot register marks caught by one of the grounds for refusal listed in that article on the ground that the marks are not 'manifestly inadmissible'.

126. The answer to the seventh question must therefore be that the practice of a trade mark registration authority which concentrates solely on refusing to register 'manifestly inadmissible' marks is incompatible with Article 3 of the Directive.

Costs

127. The costs incurred by the Commission of the European Communities, which has submitted observations to the Court, are not recoverable. Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court.

On those grounds,

THE COURT (Sixth Chamber),

in answer to the questions referred to it by the *Gerechshof te 's-Gravenhage* by judgment of 3 June 1999, hereby rules:

1. Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that a trade mark registration authority must have regard, in addition to the mark as filed, to all the relevant facts and circumstances.

It must have regard to all the relevant facts and circumstances before adopting a final decision on an application to register a trade mark. A court asked to review a decision on an application to register a trade mark must also have regard to all the relevant facts and circumstances, subject to the limits on the exercise of its powers as defined by the relevant national legislation.

2. The fact that a trade mark has been registered in a Member State in respect of certain goods or services has no bearing on the examination by the trade mark registration authority of another Member State of an application for registration of a similar mark in respect of goods or services similar to those in respect of which the first mark was registered.

3. Article 3(1)(c) of Directive 89/104 precludes registration of a trade mark which consists exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services in respect of which registration is sought, and that is the case even when there are more usual signs or indications for designating the same characteristics and regardless of the number of competitors who may have an interest in using the signs or indications of which the mark consists.

Where the applicable national law provides that the exclusive right conferred by registration, by a competent authority in an area in which a number of officially recognised languages coexist, of a word mark expressed in one of those languages extends automatically to its translation in the other languages, the authority must ascertain as regards each of those translations whether the mark actually consists exclusively of signs or indications which may serve, in trade, to designate characteristics of those goods or services.

4. Article 3(1) of Directive 89/104 must be interpreted as meaning that a mark which is descriptive of the characteristics of certain goods or services but not of those of other goods or services for the purposes of Article 3(1)(c) of Directive 89/104 cannot be regarded as necessarily having distinctive character in relation to those other goods or services for the purposes of subparagraph (b) of the provision.

It is of no relevance that a mark is descriptive of the characteristics of certain goods or services under Article 3(1)(c) of Directive 89/104 when it comes to assessing whether the same mark has distinctive character in relation to other goods or services for the purposes of Article 3(1)(b) of the Directive.

5. Article 3(1)(c) of Directive 89/104 must be interpreted as meaning that a mark consisting of 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 that provision, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that because of the unusual nature of the combination in relation to the goods or services the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the latter case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purposes of the same provision.

For the purposes of determining whether Article 3(1)(c) of Directive 89/104 applies to such a mark, it is irrelevant whether or not there are synonyms capable of designating the same characteristics of the goods or services mentioned in the application for registration or that the characteristics of the goods or services which

may be the subject of the description are commercially essential or merely ancillary.

6. Directive 89/104 prevents a trade mark registration authority from registering a mark for certain goods or services on condition that they do not possess a particular characteristic.

7. The practice of a trade mark registration authority which concentrates solely on refusing to register 'manifestly inadmissible' marks is incompatible with Article 3 of Directive 89/104.

OPINION OF ADVOCATE GENERAL RUIZ-JARABO COLOMER

delivered on 31 January 2002 (1)

Case C-363/99

Koninklijke KPN Nederland NV

v

Benelux-Merkenbureau

(Reference for a preliminary ruling from the Gerechtshof te 's-Gravenhage, Netherlands)

(Composite word marks - Distinctive character - 'Postkantoor')

1. By order of 3 June 1999, the Gerechtshof te 's-Gravenhage (Regional Court of Appeal, The Hague, Netherlands) referred to the Court of Justice 10 questions (2) concerning the interpretation of Articles 2 and 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ('the Trade Mark Directive'). (3)

I. The facts and the main proceedings

2. On 2 April 1997, Koninklijke KPN Nederland NV ('KPN') lodged with the Benelux Trade Marks Office (the Benelux-Merkenbureau, 'Merkenbureau') an application for registration of 'Postkantoor' as a word sign for paper, card and products manufactured therefrom, (4) and a wide variety of services. (5) In Dutch, 'postkantoor' means 'post office'.

3. On 16 June 1997, the Merkenbureau informed KPN that it was provisionally refusing registration because the sign applied for did not have distinctive character, since it merely described the goods and services it was intended to identify.

4. KPN raised objections to the provisional refusal of the application and requested either that the refusal be withdrawn or that consultations be initiated with a view to disclaiming the protection afforded by the mark for the products and services which the sign described. The Merkenbureau saw no reason to review its decision and, by letter of 28 January 1998, it notified KPN that its decision to refuse the application was now final.

5. KPN brought an action forthwith before the Gerechtshof, seeking an order requiring the Merkenbureau to register the sign in respect of all the classes applied for or, at any rate, in respect of such classes as the court might determine in its judgment.

6. By an interim decision dated 3 December 1998, the Gerechtshof notified the parties that it would be appropriate to refer to the Court of Justice, and to the

Benelux Court, a number of questions concerning the interpretation of the Trade Mark Directive and the Uniform Benelux Law on trade marks ('the Uniform Law'). (6) Finally, by order of 3 June 1999, the Gerechtshof stayed the proceedings and referred those questions, on which it had sought the views of the parties, to both courts.

II. The questions referred for a preliminary ruling

7. The questions which the Gerechtshof has referred to the Court are worded as follows:

'IV. (a) Must the Benelux-Merkenbureau which, under the Protocol of 2 December 1992 amending the Uniform Benelux Law on trade marks (Trb. 1993, 12), is responsible for the assessment of the absolute grounds for refusal to register a trade mark, as laid down in Article 3(1), in conjunction with Article 2, of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ... have regard not only to the sign as per the application for registration but to all the relevant facts and circumstances known to it, including those of which it was informed by the applicant (for example, that the applicant, prior to the application, already used the sign on a large scale as a trade mark of the relevant products, or that it appears on inquiry that the sign intended for the goods and/or services mentioned in the application will not be capable of misleading the public)?

...

V. Does the reply to Question IV(a) and (b) also apply to the assessment of the Benelux-Merkenbureau concerning the question whether its objections to registration of the application have been dispelled by the applicant, as well as to its decision to refuse registration in whole or in part, as provided for in Article 6a(4) of the Uniform Law? (7)

VI. Does the reply to Question IV(a) and (b) also apply to the judicial assessment of the application to which Article 6b of the Uniform Law refers?

...

IX.(a) In light of the provisions of Article 6d(B)(2) of the Paris Convention, do the marks which under Article 3(1)(c) of the Trade Mark Directive are not to be registered or, if registered, may be declared invalid, also include marks consisting of signs or indications which may serve in commerce to indicate the kind, quality, quantity, designation, value, place of origin or date of manufacture of the goods or provision of the service or other characteristics of the goods or services, even if that configuration is not the (only or most) usual name used? Does it make any difference in that connection whether there are many or only a few competitors who may have an interest in using such indications (see the judgment of the Benelux Court of Justice of 19 January 1981, NJ 1981, 294, in P Ferrero & Co S.p.A. v Alfred Ritter Schokoladefabrik GmbH (Kinder))?

Is it also relevant that under Article 13C of the Uniform Law the right to a trade mark expressed in one of the national or regional languages of the Benelux area automatically extends to its translation in the other Benelux languages?

...

X.(a) In the assessment of the question whether a sign consisting of a (new) word made up of components, which in themselves have no distinctive character with regard to the goods or services for which the application is made, answers the description given in Article 2 of the Trade Mark Directive (and Article 1 of the Uniform Law) of a mark, must a (new) word of that kind in principle be taken to have a distinctive character?

X.(b) If not, must a word of that kind (leaving aside the fact that it may have become part of everyday language) in principle be taken to have no distinctive character, and may that be otherwise only under attendant circumstances which result in the combination being more than the sum of its parts?

Is it of any importance in that connection whether the sign is the only or, at any rate, the most usual term for indicating the relevant characteristic or (combination of) characteristics, or whether there are synonyms which may reasonably also be used, or that the word indicates a commercially essential or rather an incidental attribute of the product or service?

Is it also relevant that, under Article 13C of the Uniform Law, the right to a trade mark expressed in one of the national or regional languages of the Benelux area automatically extends to its translation in another of those languages?

...

XI. Does the mere fact that a descriptive sign is also lodged for registration as a mark for goods or services of which the sign is not descriptive warrant an assessment that the sign thereby has distinctive character as regards those goods or services (for example, the sign “postkantoor” for furniture)?

If not, in order to determine whether such a descriptive sign has descriptive character for those goods or services, must regard be had to the possibility that, in light of its descriptive meaning, (a part of) the public will not perceive that sign as a distinctive sign for (all or some of) those goods or services?

XII.(a) In the assessment of the abovementioned questions, is significance to be attached to the fact that, since the Benelux countries have chosen to have applications for registration of trade marks examined by the Benelux-Merkenbureau as a requirement of registration, the appraisal policy of the Merkenbureau under Article 6a of the Uniform Law, according to the common commentary of the Governments, “must be a cautious and restrained one whereby all concerns of commercial life must be taken into account and efforts must be focused on establishing which are the evidently inadmissible applications and refusing them”?

If so, under what rules does it fall to be determined whether an application is “evidently inadmissible”?

It is assumed that in invalidity proceedings, which may be initiated after registration of a sign, there is no requirement that the sign be “evidently inadmissible.”

...

XIII.(a) Is it consistent with the scheme of the Trade Mark Directive and the Paris Convention for a sign to be registered for specific goods or services, subject to

the limitation that the registration applies only to those goods and services in so far as they do not possess certain characteristics (for example, registration of the sign “Postkantoor” for the services: direct-mail campaigns and the issue of franking seals “provided they are not connected with a post office“)?

...

XVI. Is it also material to the answer to be given to the questions whether a corresponding sign for similar goods or services is registered as a mark in another Member State?

III. The legal framework

1. The international protection of trade marks

8. Trade marks, like other forms of industrial property, have long enjoyed extensive international protection, which was initiated by the Paris Convention for the Protection of Industrial Property (‘the Paris Convention’) of 20 March 1883, (8) to which all the Member States are signatories. (9)

9. As I pointed out in a previous Opinion, the first provision of the Convention establishes the Union for the protection of industrial property (Article 1(1)), known as the Union of Paris. The Convention constitutes a point of reference, which the laws of the signatory States and the agreements and treaties entered into by those States between themselves must respect (Articles 25 and 19). (10)

10. The substantive provisions of the Paris Convention, which regulate the international protection of the different forms of industrial property (Articles 1 to 11), contain a notable number of articles providing for the protection of trade marks, including Article 6d(B), pursuant to which:

‘Trade marks covered by this Article may be neither denied registration nor invalidated except in the following cases:

...

2. when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed;

...’.

11. Article 6 quinquies (C)(1) of the Convention provides that: ‘In determining whether a mark is eligible for protection, all the factual circumstances must be taken into consideration, particularly the length of time the mark has been in use.’

2. Trade marks in Community law

A. The Treaty establishing the European Community

12. Article 30 EC provides:

‘The provisions of Articles 28 EC and 29 EC shall not preclude prohibitions or restrictions on imports, exports or goods in transit justified on grounds of ... the protection of industrial and commercial property. Such prohibitions or restrictions shall not, however, consti-

tute a means of arbitrary discrimination or a disguised restriction on trade between Member States.’

B. The Trade Mark Directive

13. With a view to the establishment and functioning of the internal market, the First Directive is aimed at approximating the laws of the Member States relating to trade marks. However, it is only aimed at partial approximation, meaning that the role of the Community legislature is limited to trade marks acquired by registration, leaving Member States free to fix the provisions of procedure concerning the registration, revocation and invalidity of trade marks so acquired. (11)

14. Article 2 sets out the signs of which a trade mark may consist:

‘A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.’

15. Article 3 of the Trade Mark Directive lists the cases in which a trade mark registration may be refused or, where appropriate, declared invalid:

‘1. The following shall not be registered or if registered shall be liable to be declared invalid:

- (a) signs which cannot constitute a trade mark;
- (b) trade marks which are devoid of any distinctive character;
- (c) 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;
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;

...

3. A trade mark shall not be refused registration or be declared invalid in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character. Any Member State may in addition provide that this provision shall also apply where the distinctive character was acquired after the date of application for registration or after the date of registration.

...

16. Article 5 governs the rights of the proprietors of trade marks in the following manner:

‘1. The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

- (a) any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered;
- (b) any sign where, because of its identity with, or similarity to, the trade mark and the identity or similar-

ity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association between the sign and the trade mark.

2. Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

...

17. Article 6 limits the rights conferred by ownership of a trade mark, stipulating that:

‘1. The trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade,

...

(b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services;

...

C. The Community trade mark regulation

18. On 20 December 1993, the Council adopted Regulation (EC) No 40/94 on the Community trade mark (‘the Regulation’), (12) in order, as I pointed out in the Opinion referred to above, that the internal market could enjoy conditions similar to those in a national market and, in particular, conditions which, from a legal perspective, ‘... enable undertakings to adapt their activities to the scale of the Community, whether in manufacturing and distributing goods or in providing services ...’. (13) The aim was to create ‘trade marks ... which are governed by a uniform Community law directly applicable in all Member States.’ (14) This aim is to be pursued but does not purport to replace the laws of the Member States on trade marks. (15)

19. The Regulation adopts the same approach as and uses identical wording to the Trade Mark Directive, in that it lists the signs of which a Community trade mark may consist (Article 4) and then goes on to set out the grounds for refusal of registration (Articles 7 and 8). Like the Directive, it stipulates the rights conferred by a Community trade mark (Article 9) and the limitations of the effects of such a trade mark (Article 12).

3. Trade marks in the Benelux Economic Union

20. With the aim of promoting the free movement of goods between their respective territories, the three Member States of the Benelux Economic Union signed a convention on trade marks on 19 March 1962, (16) under which they were each required to transpose into their national legal systems the accompanying Uniform Law.

21. The convention, which entered into force on 1 July 1969, created a new administrative body, the Benelux-Merkenbureau, which is situated in The Hague and is responsible for enforcing the Uniform Law and its implementing provisions. The courts of the three Benelux

States are responsible for interpreting the legislation, and the Benelux Court has jurisdiction to give preliminary rulings. (17)

22. With a view to transposing the Trade Mark Directive into Benelux law, and to supplementing it with the relevant provisions governing the Community trade mark, on 2 December 1992, Belgium, Luxembourg and the Netherlands signed a protocol aimed at amending the Uniform Benelux Law. (18) Under Article 8, the protocol and the amendments it inserted into the Uniform Law entered into force on 1 January 1996.

23. The final paragraph of Point I(6) of the common commentary of the governments in question regarding the protocol states that: 'the appraisal policy of the Benelux-Merkenbureau ... must be a cautious and restrained one, which takes account of all commercial concerns and is focused on rectifying or refusing evidently inadmissible applications. Needless to say, the examination must remain within the boundaries laid down in Benelux case-law, in particular that of the Benelux Court'.

24. In accordance with Article 1 of the Uniform Benelux Law:

'The following may be registered as individual marks: names, designs, imprints, stamps, letters, numerals, the shape of goods or their packaging, and any other signs which serve to distinguish the goods of an undertaking. However, shapes which result from the nature of the goods themselves, or which affect the substantial value of the goods, or which give rise to a technical result may not be registered as trade marks.'

25. Article 6a provides:

'1. The Benelux-Merkenbureau shall refuse registration where, in its view:

(a) the sign applied for does not satisfy the description in Article 1 of a mark, in particular where it is devoid of any distinctive character within the meaning of Article 6 quinquies (B)(2) of the Paris Convention;

...

2. Refusal of registration must relate to the whole of a sign constituting a mark. It may be limited to one or more of the goods for which the mark is intended.

3. The Benelux Trade Mark Office shall inform the applicant forthwith in writing of its intention to refuse registration wholly or in part, stating the reasons therefor, and shall afford the applicant the possibility of replying within such period as may be laid down in the implementing regulations.

4. If the objections of the Benelux Trade Mark Office to registration are not lifted within the period laid down, registration shall be refused in whole or in part. The office shall forthwith inform the applicant in writing of such refusal, stating the reasons therefor and informing him of his right of action against the decision under Article 6b.'

26. Article 6b provides that: 'Within two months of the notification mentioned in Article 6a(4), the applicant may apply to the Hof van Beroep [Court of Appeal] te Brussel, the Gerechtshof te 's-Gravenhage, or the Cour d'appel [Court of Appeal] de Luxembourg for an order for registration.'

27. Article 13C provides that the exclusive right to a trade mark expressed in one of the national or regional languages of the Benelux territory 'extends to its translation in another of those languages.'

IV. Analysis of the questions referred for a preliminary ruling

1. Introduction

28. It is worrying that a court of recognised competence should harbour so many doubts concerning the application of Community trade mark provisions. There appears to be a significant distortion within the system, since it is difficult to believe that the work of the European Union legislature could be so lacking in this area, or that those who are responsible for its implementation should fail to understand their role. Regardless of the reason, the Court of Justice is required to supplement and facilitate the work of others within the interpretative role conferred on it under Article 234 EC.

2. Criteria for interpretation

29. In the Opinion I delivered in *Merz & Krell*, cited above, I noted the special structure of Community trade mark law, (19) which, rather like an onion, is made up of different layers which sit one on top of the other. The first, purely internal, layer corresponds to the Community trade mark Regulation. The second comprises the laws of the Member States, which have been harmonised pursuant to the Trade Mark Directive. The third and final layer consists of the international trade mark obligations entered into by all the Member States.

30. The present case sees the insertion of another layer between the last two, which corresponds to the uniform Benelux legislation on this type of industrial property. The three Member States of that economic association unified their respective trade mark laws, but, in addition, they harmonised those same laws with the laws of the other Member States of the European Union by adapting the Uniform Law to the Trade Mark Directive, and naturally they did so in compliance with their commitments under the Paris Convention.

31. Therefore, the Court is required to provide an integrated interpretation of the provisions of the Trade Mark Directive referred to in the *Gerechtshof's* questions, and in doing so the Court must have regard to the whole body of Community trade mark law.

32. When performing that task, it is important not to lose sight of the *raison d'être* of trade mark law, which is to guarantee the identity of the origin of the product or service identified by the sign to the consumer or end-user, by enabling him to distinguish that product or service from products or services having a different origin, thereby contributing to the establishment of a genuine system of competition in the internal market. (20) In order to achieve that goal, the trade mark owner is granted an assortment of rights and powers which must be considered in the light of the latter objective. The rights of advantage which ownership of a trade mark confers on its owner exist so that consumers will be able to distinguish the marked product or service from products or services of different origins. As such, they may also be subject to restrictions, including restrictions deriving from the fact that it is in the public

interest to ensure that certain names remain as widely available as possible ('the requirement of availability').

33. In short, the relationship between the rights conferred by ownership of a registered trade mark and the trade mark itself is instrumental. For that reason, in order to determine the precise scope of the exclusive right granted to a trade mark owner, regard must be had to the essential function of the trade mark. (21)

3. The nature of the assessment of distinctive character (Questions IV(a), V, VI, XI, XIII(a) and XVI)

34. By these questions the national court seeks to understand the nature of the judicial assessment of whether a sign is capable of constituting a trade mark.

35. First of all (Questions IV(a), V and VI), the *Gerechtshof* wishes to know, in detail, if the assessment of whether a sign is capable of constituting a trade mark must be carried out in the abstract or, alternatively, by reference to the specific circumstances of each case. In that regard, the *Gerechtshof* points out that, prior to lodging its application, the applicant had already used the sign on a large scale as a trade mark for the products in question, and that it appeared on inquiry that, vis-à-vis the goods and services which it was intended to identify, the sign would not be liable to mislead the public.

36. By way of a preliminary point, the facets of the *Gerechtshof's* questions which relate to the individual procedural stages under current Benelux law, namely, the initial appraisal carried out by the trade mark office (Question IV(a)), the assessment - by the same body - of the applicant's objections (Question V), and the subsequent judicial assessment (Question VI), must be disregarded. The Trade Mark Directive contains no provisions governing the regulation of the registration procedure, stating instead that Member States are free to organise that procedure as they see fit. (22) The Court's reply must, therefore, be restricted to the assessment carried out by 'the competent authorities in accordance with domestic law.'

37. Additionally, and for similar reasons, no special significance should be attached to the fact that Question IV(a) refers only to 'the absolute grounds for refusal ... as laid down in Article 3(1) in conjunction with Article 2 of ... [the] Directive ...'. Although it is correct that, under the Community law scheme, the first circumstance mentioned by the national court is required to be assessed in the context of the absolute grounds for refusal, the second circumstance - which relates to the likelihood of error or confusion - must be assessed in the context of the relative grounds listed in Article 4. Since - and I must reiterate this - the Trade Mark Directive is neutral in relation to the Member States' procedural options, there is nothing to preclude a national legal system from stipulating that both matters must be assessed simultaneously. The Court's reply cannot disregard that fact.

38. On that basis, it can be concluded that an assessment of the conditions which must be met in order for a sign to be eligible for protection by registration as a trade mark must - essentially - be specific in nature, in

the sense that a variety of factual circumstances must be taken into consideration, as quite clearly follows from the absolute rule laid down in Article 6 quinquies (C)(1) of the Paris Convention. (23)

39. Under Article 3(1)(a) of the Trade Mark Directive, in conjunction with Article 2, during the relevant procedural phase the competent authority is required to have regard not only to whether the sign applied for is capable of distinguishing the goods or services in question, but also to whether it is capable of being represented graphically. Where, as in the main proceedings, the sign in question is a word, it is difficult to imagine that that would not be the case. (24) This is the only assessment which may be somewhat abstract in nature.

40. The authority is then required to establish whether the sign meets the conditions laid down in Article 3(1)(b), (c) and (d), namely that it must distinguish the goods or services in question, and that it must not be descriptive of or generic to those goods or services. Each condition is independent of the others and requires a separate assessment, although, in practice, the same sign may frequently fail to meet more than one condition. (25) It is also necessary to assess whether a sign, despite being devoid of any distinctive character for the purposes of Article 3(1)(b), (c) and (d), has acquired such character through use, as laid down in Article 3(3).

It follows from Article 3(3) that signs which meet the conditions laid down in subparagraphs (b), (c) and (d) have 'distinctive character'. It is regrettable that the legislature created such ambiguity, as a result of which it is necessary to consider whether a sign is 'capable of distinguishing' or has a potentially distinctive character (Article 2), whether it has a definite distinctive character (Article 3(1)(b)), or whether it has a distinctive character as a category (Article 3(3)), thereby adding to the already considerable difficulties involved in conceptual delimitation.

The competent authority must also ensure that the sign in respect of which registration is sought is not liable to deceive the public as to the nature, quality or geographical origin of the product or service (Article 3(1)(g)), and that it is not likely to cause confusion with other, earlier trade marks (Article 4(1)(b)).

The factual assessment does not end there, since the Trade Mark Directive provides that signs which are contrary to public policy or to accepted principles of morality are to be refused registration or are liable to be declared invalid (Article 3(1)(f)).

41. It is almost impossible to imagine that an assessment of each of the above conditions could be carried out in the abstract, in particular the condition as to the distinctive character of a sign recognised as a category of goods or services. Indeed, signs distinguish, are descriptive or are generic by reference to the specific goods or services which they are intended to designate, and in relation to which protection is sought. (26)

The limitation of protection to one or a few categories of goods or services, together with the limitation created by the territorial area in which the trade mark will

take effect, mean that the assessment of distinctive character should be conducted from the point of view of the average consumer of the same types of goods or services in the territory in respect of which registration is applied for, (27) such a consumer being presumed to be 'reasonably well-informed and reasonably observant and circumspect'. (28)

Despite a recent judgment of the Court, (29) it is my view that the linguistic factor must also be assessed only by reference to the average consumer specifically characterised above. In other words, it is necessary to have regard not so much to whether that consumer speaks the language in which the sign is formulated as to whether, irrespective of the language or languages of the territory concerned, the consumer taken as a reference can reasonably be expected to perceive in the sign a meaning such as to enable it to qualify under Article 3(1)(b), (c) and (d). (30)

42. In short, it is appropriate to reply to the referring court that, when assessing whether a sign is eligible for registration as a trade mark, the competent authority must have regard not only to the sign as per the application for registration but to all the other relevant circumstances, including the possibility that the sign has acquired distinctive character through use, and the likelihood of error or confusion perceived from the point of view of an average consumer, bearing in mind at all times the goods or services identified by the sign.

43. The referring court also asks whether the mere fact that a descriptive sign has been lodged for registration as a trade mark for goods or services in respect of which it is not descriptive is sufficient for a finding that the sign has distinctive character. If that is not the case, the national court goes on to ask whether any importance should be attached to the fact that, specifically on account of the sign's descriptive character, the public does not perceive the sign as being capable of distinguishing all, or any of, the relevant goods or services (Question XI).

44. As I indicated above, each of the conditions stipulated in Article 3(1)(b), (c) and (d) of the Trade Mark Directive requires a separate assessment. Accordingly, the fact that a sign is not descriptive does not necessarily mean that it has distinctive character, either in a broad sense (in other words, as a category of sign which meets all the conditions of Article 3(1)(b), (c) and (d)) or, still less, in a strict sense (ex Article 3(1)(b)). Moreover, as I have also pointed out, signs are distinctive, descriptive or generic only by reference to the goods or services being identified. Descriptiveness, like the other attributes in question, is a purely relative quality and, therefore, under the Trade Mark Directive the scenario to which the *Gerechtshof* refers in the alternative cannot arise.

45. The Netherlands court also enquires whether a system under which it is permissible to register a sign, limiting protection to goods and services which do not possess a specific characteristic, is consistent with the Trade Mark Directive (Question XIII(a)).

This question concerns the so-called 'disclaimer' mechanism, which is recognised under Benelux trade

mark law and by means of which an applicant may disclaim the protection afforded by a trade mark for certain goods which either possess, or are devoid of, a particular characteristic.

I can find nothing in the wording of the Trade Mark Directive to preclude national authorities from administering their registration system on the basis of such disclaimers which, in any event, by merely specifying the goods or services to which protection applies, do not affect the primary purpose of enabling consumers to identify the undertaking of origin. Nor is my opinion changed by the Nice Agreement, (31) whose classification system is, in any event, not mandatory.

46. Finally, the *Gerechtshof* wishes to know whether the fact that a corresponding sign has been registered in another Member State for similar goods or services is material to the assessment of the sign (Question XVI).

47. The Trade Mark Directive seeks to approximate the laws of the Member States, without unifying them. National courts are therefore required to interpret domestic law in the light of the wording and purpose of the directive in order to achieve the result pursued by the latter and thereby comply with the third paragraph of Article 249 EC, (32) referring questions to the Court of Justice for a preliminary ruling where appropriate.

There is, however, no hierarchical relationship between the Court of Justice and the national courts, nor between the national courts themselves. Nor is there any requirement that those courts must reach the same conclusions, save that they apply the same principles of interpretation. Therefore, the practices of one Member State are not binding on the authorities of another Member State. Nevertheless, in the interests of prudence and mutual trust, the basis for which is the pursuit of the abovementioned objective, those practices - and, in particular, the reasoning on which they are based - constitute a useful indication to which the competent authority may refer in its assessment of whether a sign has distinctive character.

4. Descriptive marks (Question IX(a))

48. Article 3(1)(c) of the Trade Mark Directive prohibits marks which consist exclusively of signs 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.

49. In connection with such signs or indications, which may be described succinctly as 'descriptive', the *Gerechtshof* seeks guidance from the Court regarding:

- The scope for prohibiting or permitting signs or names which describe the service or product in question, but which are not the only ones to do so, nor the ones which are used most regularly.

- The bearing which the number of competitors who may have an interest in using the indications might have on the assessment of whether the indications are descriptive in character, in addition to the relevance to that assessment of the fact that, under domestic law, the right to a trade mark expressed in one of the national or regional languages of the Benelux area automatically

extends to its translation in the other Benelux languages.

50. According to the parties, the Gerechtshof seeks guidance in relation to descriptive marks because it is uncertain as to whether the case-law of the Benelux Court which preceded the amendment of the Uniform Law to comply with the Trade Mark Directive (Kinder (33) and Juicy Fruit (34)) is still applicable. (35) Such a question may not be raised before this Court. It is not for the Court of Justice either to review the national laws of the Member States or of regional unions such as the Benelux Union or, indeed, to review the case-law of their courts. As regards references for preliminary rulings, the Court's task is to provide a correct interpretation of Community law. Accordingly, it is not appropriate to analyse the Uniform Law as it stood prior to its adaptation to the Trade Mark Directive or the interpretation of the Law delivered by the competent courts. Instead, the task to be performed entails determining the scope of Article 3(1)(c) of the Trade Mark Directive in relation to descriptive trade marks.

51. Article 3(1)(c) precludes so-called descriptive trade marks on the basis that that type of representation of signs and products lacks the capacity to distinguish, the reason being that where the kind, quality, quantity or other characteristics of an object are designated, it is the object itself which is being described. It is precisely because such signs fail to individualise the goods or services to which they relate that no one is permitted to register them in order to distinguish their goods and services from those of other persons.

However, in assessing whether or not a sign is descriptive, regard may also be had to certain public-interest considerations which are different in nature.

52. As the Commission rightly points out in its observations, the question posed by the referring court relates to the question whether the so-called 'requirement of availability' principle of German law (Freihaltebedürfnis) applies within the context of the Trade Mark Directive. According to that proposition, in addition to the impediments associated with a lack of distinctive character, there are also other public-interest considerations which militate in favour of limiting the registration of certain signs so that they may be used freely by all operators.

53. The Court of Justice explained the extent to which those considerations apply to the Trade Mark Directive in *Windsurfing Chiemsee*, cited above.

54. In that case, the Court held that Article 3(1)(c) of the Trade Mark Directive pursues an aim which is in the public interest, namely that descriptive signs may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs from being reserved to one undertaking alone because they have been registered as trade marks. (36)

55. As regards indications of geographical origin, the Court held that it is in the public interest that they remain available, because they may be an indication of the characteristics of the goods concerned, and may also give rise to a favourable response. (37) As a result

of that proviso, which relates to 'indications which may serve to designate the geographical origin', the competent authority is required to assess whether a geographical name, in respect of which application for registration as a trade mark is made, designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned (as with geographical locations which are already well-known for those goods), or whether it is reasonable to assume that such an association may be established in the future. (38)

56. The same reasoning applies, *mutatis mutandis*, to all categories of descriptive sign. (39)

57. The Court of Justice thus held that underlying Article 3(1)(c) there is a requirement that any assessment is guided by the fact that it is in the public interest to keep certain signs available but that it is not necessary for that requirement of availability to be real, current or serious as had been held under German case-law. Such an assessment is not, however, possible in relation to Article 3(3) of the Trade Mark Directive, since this Article does not permit any differentiation as regards distinctiveness by reference to the perceived importance of keeping the geographical name available for use by other undertakings. (40)

58. I must also point out that, while the *Baby-dry* judgment does not expressly contradict that case-law, it does not restate it either. Although *Baby-dry* concerned the interpretation of the Community trade mark Regulation, as opposed to the Trade Mark Directive, the two pieces of legislation are intended to be applied uniformly.

Therefore, at paragraph 37 of *Baby-dry*, the Court held that the purpose of prohibiting registration of purely descriptive signs or indications as trade marks is to prevent protection being afforded to signs or indications which, because they are no different from the usual way of designating the relevant goods or services, or their characteristics, are not able to fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function.

59. That recent judgment thus fails to refer to the public interest there is in availability. It is the case that in *Baby-dry*, unlike in *Windsurfing Chiemsee*, the issue was not specifically debated, (41) but it is also the case that the appellant raised the issue at that time, claiming that the reasoning of the Court of First Instance amounted to an acceptance that Community law does recognise, to some extent, the requirement of availability and that the Court of Justice avoided the issue and delivered a judgment in general terms. There is, therefore, some uncertainty as to whether the proposition applies to Community trade mark law, which it is for the Court to dispel by either approving or overruling *expressis verbis* its earlier case-law.

60. In light of that uncertainty, it would be desirable, when assessing whether a sign is descriptive, to continue to bear in mind the possibility that there may be public-interest considerations aimed at retaining a cer-

tain degree of availability, as was found in Windsurfing Chiemsee. (42)

61. Recently, it has become fashionable - particularly among groups whose impartiality is questionable - to assert that, contrary to the view hitherto held, trade mark law does not create any monopoly in relation to the signs which are its object. It is said, on the one hand, that the exclusive right thereby created may be exercised only in relation to the goods and products designated and that, in any event, the descriptive terms forming part of a mark may continue to be used freely. To my mind, that reasoning is fallacious. First, monopolies are always relative, whether to a product, to a territory, or to a moment in time. A trade mark does not monopolise a term but specifically the use of that term as a trade mark, and, furthermore, it does not impose any limitation as to time. Second, a trade mark creates a privilege which enables an operator to register a sign in order to designate its goods or services. That privilege becomes all the more excessive when it concerns expressions in everyday use. It is fair and natural that a public authority should be able to reward, with a higher level of protection, signs which demonstrate ingenuity or imagination, (43) and that it should require other signs, which merely reflect aspects or attributes of the products in question, to satisfy more rigorous conditions in order to be eligible for registration. Nor do I think it appropriate for economic development and the promotion of commercial initiatives that established operators should be able to register for their own benefit all the descriptive combinations imaginable, or the most effective such combinations, to the detriment of new operators, who are obliged to use invented names which are more difficult to remember and to establish. For those reasons, in the absence of a specific statement by the Court, it is my view that the rule in Windsurfing Chiemsee still applies, and that Community trade mark law does, to a certain extent, recognise the requirement of availability.

62. The *Gerechtshof* also enquires whether the fact that, under domestic law, the right to a trade mark expressed in one of the national or regional languages of the Benelux area automatically extends to its translation in the other Benelux languages has any bearing on the assessment of whether the indications are descriptive in character.

63. When implementing the Trade Mark Directive, national authorities must ensure that its provisions are complied with in the territories over which they have sovereignty. If a particular territory has implemented a system of trade mark registration which covers several linguistic regions, it would be in keeping with the aims of the directive for an assessment of the distinctive character of a sign to be carried out in relation to each of the languages spoken.

5. Composite word marks (Question X(a) and (b))

64. The Netherlands court wishes to know whether it is possible for a sign made up of various components, each of which is devoid of distinctive character, to have distinctive character itself, or whether such a sign has distinctive character only where the combination is

more than the sum of its parts. In addition, the Netherlands court asks whether, for those purposes, it is relevant that there are synonyms, or that the sign indicates an essential or an incidental attribute.

65. It is first of all appropriate to note that a combination of components, each of which is devoid of distinctive character, can have distinctive character, provided that it amounts to more than just a mere sum of its parts.

66. It is therefore necessary to determine when a combination creates a sign which is distinct from the mere sum of its parts.

67. That very issue was central to the *Baby-dry* case. The Court held that, as regards trade marks composed of words, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination, enabling it to be registered as a trade mark. (44) Going on to assess the word combination, 'Baby-dry', itself, the Court held that, from the point of view of an English-speaking consumer, the word combination was composed of words which, despite being descriptive in themselves, were juxtaposed in an unusual manner, with the result that it was not a familiar expression in the English language, either for designating the products in question or for describing their essential characteristics. Accordingly, the word combination was capable of bestowing distinctive power and could not be refused registration. (45)

68. That judgment gives rise to a number of difficulties.

First of all - as I have already indicated - it casts doubt on the applicability of the precepts laid down barely two and a half years earlier in *Windsurfing Chiemsee* concerning recognition of the requirement of availability.

Second - as I have also pointed out -, it presupposes that the mother tongue of the average consumer concerned must be English, while the advantage of the disputed word combination was precisely the fact that it conveyed a highly descriptive message to a multi-linguistic public who could, nevertheless, be assumed to understand the rudiments of the lingua franca of our time.

Third, the judgment contains an assessment of factual matters, such as the perception of the descriptiveness of a word combination by likely consumers, which is not within the jurisdiction of an appeal court and which the Court was not equipped to perform, since no expert evidence on the subject had been submitted. (46)

69. Nor do I agree with the test which was proposed in order to determine whether a word combination made up of descriptive components has distinctive character. The Court held that 'any perceptible difference' between the terms usually used to designate the product,

or its essential characteristics, and the combination of words in question was sufficient for that purpose.

If that, purely minimum, test is not tempered by the 'requirement of availability' approach, to which the judgment in question did not refer, I do not believe that it is capable of ensuring that trade marks are not essentially descriptive in nature.

70. However, what is at issue is a very recent decision, which was, moreover, adopted by the Court in plenary session, for which reason it will probably be of no avail to seek a reversal of precedent. Suffice it therefore to propose that, for the purposes of Article 3(1)(c), a difference will be regarded as perceptible if it affects important components of either the form of the sign or its meaning. As regards form, a perceptible difference arises where, as a result of the unusual or imaginative nature of the word combination, the neologism itself is more important than the sum of the terms of which it is composed. As regards meaning, a difference will be perceptible provided that whatever is evoked by the composite sign is not identical to the sum of that which is suggested by the descriptive components.

71. That view is consistent with the one I proposed in relation to Article 3(1)(e) of the Trade Mark Directive in Case C-299/99 Philips. (47) Article 3(1)(e) precludes the registration of 'signs which consist exclusively of [certain shapes]', while Article 3(1)(c) does likewise in relation to 'trade marks which consist exclusively of signs or indications which may serve ... to designate ...'. Although the two provisions have different purposes, the similarity of the wording indicates that a uniform approach to the two cases should be adopted.

72. On that occasion, I took the view that, for the purposes of Article 3(1)(e), second indent, 'purely functional shape' is to be understood as any shape whose essential characteristics are attributable to the achievement of a technical result. I adjusted my interpretation referring to 'essential characteristics' in order to clarify that a shape only containing one arbitrary element which, from a functional point of view, is minor, such as its colour, does not escape the prohibition. Nor does Article 3(1)(c) permit any difference whatsoever to qualify, allowing instead only those which are relevant to the description.

73. As regards the prohibition on the registration of functional shapes as trade marks, I concluded that, although it only served to prevent a slight risk that trade mark rights might unduly encroach on the field of patents, the public interest should not have to tolerate such a risk, since operators are able to protect their products by the addition of arbitrary features.

74. A similar line of argument also applies to this case. The prohibition of descriptive marks means that everyone is able freely to use signs which designate goods and services, or the essential characteristics thereof. While it is true that Article 6(1) of the Trade Mark Directive precludes the proprietor of a trade mark from preventing the use of such indications by third parties, it is also true that permitting the registration of descriptive marks unfairly precludes the use of such indications as trade marks by a section of operators,

and maintains the advantage initially acquired over a resource that is very likely to be exhausted, such as, in relation to the goods they designate, descriptive terms with positive associations. I see no reason why Community law should tolerate such a risk of stagnation when operators could easily resort to solutions that are imaginative or original.

75. It follows from the above that considerations relating to the existence of synonyms or the essential, or incidental, nature of the descriptive element of a sign are immaterial to the assessment of distinctive character.

76. The *Gerechtshof* wishes to know whether the fact that the protection conferred on a trade mark expressed in one of the national or regional languages of the Benelux area extends to its translation in the other Benelux languages has any bearing on the assessment of distinctive character in relation to a sign composed of descriptive components.

77. As I stated above, (48) if a particular territory has implemented a system of trade mark registration which covers several linguistic regions, it would be in keeping with the aims of the Trade Mark Directive for an assessment of the distinctive character of a sign to be carried out in relation to each of the languages spoken.

6. Peculiarities of Benelux law

78. By Question XII(a), the national court seeks guidance concerning the significance to be attached to the appraisal policy which, under Benelux law, the *Merkembureau* is obliged to follow, particularly in relation to the rules governing 'evidently inadmissible applications', and with regard to the common commentary of the governments of the Benelux area concerning the amendment of the Uniform Law on Trade Marks. (49)

79. This question clearly requires an interpretation of current Benelux legal practice, rather than Community law, and that is not within the jurisdiction of the Court of Justice. The question must therefore be held inadmissible.

Conclusion

80. In the light of the above, I propose that the Court of Justice should reply to the questions referred for a preliminary ruling by the *Gerechtshof te 's-Gravenhage* as follows:

(1) In assessing whether a sign is eligible for registration as a trade mark, the competent authority must, under First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, have regard not only to the sign as per the application for registration but to all the other relevant circumstances, including the possibility that the sign has acquired distinctive character through use, and the likelihood of error or confusion perceived from the point of view of an average consumer, bearing in mind at all times the goods or services identified by the sign.

(2) The fact that a sign is not descriptive does not necessarily mean that it has distinctive character. Signs are distinctive, descriptive or generic only by reference to the goods or services which they identify.

(3) The directive does not preclude a national system under which applicants may disclaim the protection afforded by a trade mark in respect of certain goods which either possess, or are devoid of, a particular characteristic.

(4) Article 3(1)(c) of the directive does not merely prohibit the registration as trade marks of descriptive signs which are currently associated, in the relevant sectors, with the category of goods in question; instead, it also applies to signs which may, in all reasonable likelihood, be used in those sectors in the future.

(5) If a particular territory, to which the directive applies, has implemented a system of trade mark registration which covers several linguistic regions, it is in keeping with the aims of the directive for an assessment of the distinctive character of a sign to be carried out in relation to each of the languages spoken.

(6) As regards trade marks composed of words, descriptive character must be assessed not only in relation to each term taken separately but also in relation to the whole which they form. Any perceptible difference between the meaning conveyed by the combination of words submitted for registration and the terms used in everyday language by the relevant group of consumers to designate the product or service in question, or the essential characteristics thereof, will be apt to confer distinctive character on the word combination. For those purposes, a difference will be regarded as perceptible where it affects important aspects of the form or meaning of the sign.

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- 1: - Original language: Spanish.
 - 2: - By the same order, the Gerechtshof refers a further 15 questions to the Benelux Court of Justice.
 - 3: - OJ 1989 L 40, p. 1.
 - 4: - Class 16 under the Nice Agreement of 15 June 1957 concerning the international classification of goods and services for the purposes of registration of marks, as revised and amended.
 - 5: - Included in classes 35, 36, 37, 38, 39, 41 and 42.
 - 6: - Uniform Benelux Law on trade marks of 19 March 1962, as amended (Nederlands Traktatenblad 1962, No 58, pp. 11-39, and 1983, No 187, pp. 2-10).
 - 7: - The Uniform Benelux Law on trade marks.
 - 8: - As regards trade marks, the Convention was extended by the two Madrid Agreements of 1891, one concerning the repression of false and deceptive indications of source on goods and the other concerning the international registration of marks; by the Trade Mark Law Treaty of 1994; and by the Nice Agreement, cited in footnote 4.
 - 9: - The Netherlands has been a State party to the Convention since 7 July 1884.
 - 10: - See the Opinion of 18 January 2001 in Case C-517/99 *Merz & Krell* [2001] ECR I-6959, and in particular point 6 thereof. Article 2(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights, annexed to the Agreement establishing the World Trade Organisation, done at Marrakesh on 15 April 1994 (OJ 1994 L 336, pp. 214 to 223), provides that, in

respect of, inter alia, trade marks, Member States shall comply with Articles 1 to 12, and Article 19, of the Paris Convention.

- 11: - See the first, third, fourth and fifth recitals in the preamble to, and Article 1 of, the Trade Mark Directive.
- 12: - OJ 1994 L 11, p. 1.
- 13: - First recital in the preamble to the Regulation.
- 14: - Third recital in the preamble.
- 15: - Fifth recital in the preamble.
- 16: - Nederlands Traktatenblad 1962, No 58, pp. 1 to 9.
- 17: - See Article 10. Established by a treaty dated 31 March 1965 and inaugurated on 1 January 1974, the judicial role fulfilled by the Benelux Court of Justice is the same as that which is assigned to the Court of Justice of the European Communities at a Community level; namely, the interpretation of provisions of uniform Benelux law by means of replies to questions referred for preliminary rulings by the three Member States. Advocate General Jacobs remarked on this similarity of roles in the Opinion he delivered on 29 April 1997 in Case C-337/95 *Parfums Christian Dior* [1997] ECR I-6013, paragraphs 13 and 26.
- 18: - Nederlands Traktatenblad 1993, No 12, pp. 1 to 12.
- 19: - See points 23 to 29 of that Opinion.
- 20: - See the judgments in Case C-10/89 *HAG II* [1990] ECR I-3711, paragraph 14, and in Case C-349/95 *Loendersloot* [1997] ECR I-6227, paragraph 24.
- 21: - See the judgment in *HAG II*, cited above, paragraph 14 in fine.
- 22: - Fifth recital in the preamble.
- 23: - See point 11 above.
- 24: - The same cannot be said of sensory phenomena, such as smells, which are not capable of being represented graphically (in that connection, see the Opinion I delivered in Case C-273/00 *Sieckmann* [2002] ECR I-11737).
- 25: - As the Commission rightly notes in its written observations, a descriptive sign will generally be devoid of distinctive character for the purposes of Article 3(1)(b).
- 26: - On the likelihood of confusion, see Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 22.
- 27: - See Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29.
- 28: - See, inter alia, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraphs 30 to 32.
- 29: - See Case C-383/99 *P Procter & Gamble* [2001] ECR I-6251 ('Baby-dry') (paragraph 42), in which it was held without any explanation that an assessment only needed to be carried out from the point of view of an English-speaking consumer.
- 30: - Thus, for example, a sign intended to identify computing goods or services must be assessed not merely by reference to the language of the territory but also by reference to certain English terminology with which operators and consumers in that sector are as-

sumed to be familiar. The same applies to foreign terms which have become part of the shared global lexicon and which frequently acquire a separate meaning that does not necessarily correspond to their meaning in the original language. Consider the words 'light', 'premium', and perhaps even 'baby' or 'dry'.

31: - Cited in footnote 4.

32: - On the question of the harmonisation of trade marks, see the judgment in Case C-63/97 BMW [1999] ECR I-905, paragraph 22.

33: - Judgment of the Benelux Court of Justice of 19 January 1981 in Case A 80/3 Ferrero v Ritter, Jurisprudence Cour de Justice Benelux, 1980-1981, vol. 2, p. 69.

34: - Judgment of the Benelux Court of Justice of 5 October 1982 in Case A 81/4 Wrigley v Benzon, Jurisprudence Cour de Justice Benelux, 1980-1982, vol. 3, p. 20.

35: - Pursuant to that case-law, in order to determine whether a sign is descriptive the following must be taken into consideration: (a) whether the words of which the mark is composed are the only ones which are appropriate to designate the product or, alternatively, whether there are synonyms which could be used; (b) whether, from a commercial perspective, the words designate an essential attribute of the product or merely an incidental characteristic; (c) the nature of the product and the definition of the target consumer; and (d) the level of repute which the mark enjoys. Signs which, while not classed as descriptive, are evocative of the product or service in question may be registered as trade marks.

36: - Windsurfing Chiemsee, paragraph 25.

37: - Ibid., paragraph 26.

38: - Ibid., paragraphs 29 to 31.

39: - This can be inferred from the wording of paragraph 26 of the judgment in Windsurfing Chiemsee ('more particularly'), and from the general wording of paragraph 35.

40: - Judgment in Windsurfing Chiemsee, paragraphs 35 and 48.

41: - The contested judgment of the Court of First Instance does not contain an assessment based on those considerations.

42: - The fact that, according to Procter & Gamble, this could amount to an 'outdated view of trade marks' (Baby-dry, paragraph 30) does not affect my opinion.

43: - Signs which have a highly distinctive character. See Case C-39/97 Canon [1998] ECR I-5507, paragraph 18.

44: - Judgment in Baby-dry, paragraph 40.

45: - Ibid., paragraphs 42 to 44.

46: - Without wishing to get involved in a lengthy marketing discussion, it seems clear that ordinary consumers of disposable nappies would be people of parenting age. Furthermore, according to the judgment, they must also speak English as their mother tongue. Indeed, the Court, unsupported by any external proof, decided to offer its own opinion of the descriptive character of the word combination in question, despite the fact that only one of the Members of the Court was

a native English speaker and that all of them appeared to have left that happy stage behind them. In addition, by holding that 'Baby-dry' is an unusual juxtaposition of an expression that is unfamiliar in the English language, the Court adopted an excessively academic view. The Court should instead have considered whether the construction was capable of provoking a semantic response, such as 'This product keeps my baby dry'. Finally, had the Court used as a reference point a European consumer of the age indicated, who might have known both words, then it would have been in a position to conclude that the chosen word order corresponds to that used by speakers of Romance languages.

47: - [2002] ECR I-5475.

48: - See points 62 and 63 above.

49: - See point 23 above.