

**European Court of Justice, 19 April 2007, Celltech****TRADEMARK LAW****Descriptive character**

- The Court of First Instance did not make an error of law by deciding that the Board of Appeal did not show that the mark CELLTECH is descriptive.

Accordingly, the Court of First Instance did not make an error of law by deciding that, by not establishing the scientific meaning of cell technology, the Board of Appeal did not show that the mark CELLTECH is descriptive of the goods and services referred to in the application for registration.

**Combination descriptive elements**

- It does not follow from the Court's case-law that the prior analysis of each of the elements of which a mark is composed is an essential step - its distinctive character may be assessed in relation to each of its elements depend on an appraisal of the whole which they comprise.

As OHIM pointed out, it follows from the Court's case-law that, 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 7(1)(c) of Regulation 40/94 (Koninklijke KPN Nederland, paragraph 98, and Campina Melkunie, paragraph 39). However, the Court added that such a combination may not be descriptive, within the meaning of that provision, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements (Koninklijke KPN Nederland, paragraph 99, and Campina Melkunie, paragraph 40). Accordingly, whilst, as regards a trade mark comprising words, its distinctive character may be assessed, in part, in relation to each of its elements, taken separately, it must, in any event, depend on an appraisal of the whole which they comprise (see, by analogy, concerning Article 7(1)(b) of Regulation No 40/94, SAT.1 v OHIM, paragraph 28, and BioID v OHIM, paragraph 29). It follows from the foregoing considerations that, contrary to OHIM's contention, it does not follow from the Court's case-law that the prior analysis of each of the elements of which a mark is composed is an essential step. On the contrary, OHIM's Boards of Appeal and, where an action is brought, the Court of First Instance are required to assess the descriptiveness of the mark, considered as a whole. In this case, it must be held that the Court of First Instance properly assessed the descriptive character of the mark CELLTECH considered as a whole and concluded that it was not established that the mark, even understood as meaning 'cell technology', was descriptive of the goods and services referred to in the application for registration. Therefore, it did not infringe Article 7(1)(c) of Regulation No 40/94.

Source: [curia.europa.eu](http://curia.europa.eu)**European Court of Justice, 19 April 2007**

(P. Jann, K. Lenaerts, E. Juhász, K. Schiemann and M. Ilešič)

JUDGMENT OF THE COURT (First Chamber)

19 April 2007 (\*)

*(Appeal – Community trade mark – Article 7(1)(b) and (c) of Regulation (EC) No 40/94 – Application for word mark CELLTECH – Absolute grounds for refusal – Lack of distinctive character – Descriptive character)*

In Case C-273/05 P,

APPEAL under Article 56 of the Statute of the Court of Justice, brought on 30 June 2005,

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by A. Folliard-Monguiral, acting as Agent,

appellant,

the other party to the proceedings being:

Celltech R&amp;D Ltd, established in Slough (United Kingdom), represented by D. Alexander QC and G. Hobbs QC, instructed by N. Jenkins, Solicitor, applicant at first instance,

THE COURT (First Chamber),

composed of P. Jann, President of the Chamber, K. Lenaerts, E. Juhász, K. Schiemann and M. Ilešič (Rapporteur), Judges,

Advocate General: E. Sharpston,

Registrar: L. Hewlett, Principal Administrator,

having regard to the written procedure and further to the hearing on 17 May 2006,

after hearing the [Opinion of the Advocate General at the sitting on 14 December 2006](#),

gives the following

**Judgment**

1 By its appeal, the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) seeks to have set aside the judgment of the Court of First Instance of the European Communities of 14 April 2005 in Case T-260/03 Celltech v OHIM (CELLTECH) [2005] ECR II- 1215 ('the judgment under appeal'), by which the Court of First Instance upheld the application of Celltech R&D Ltd ('Celltech') and annulled the decision of 19 May 2003 of OHIM's Second Board of Appeal (Case R 659/2002-2) refusing registration of the word mark CELLTECH ('the contested decision').

**Legal context**

2 Article 7(1)(b) and (c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) provides:

‘The following shall not be registered:

...

(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.’

3 Article 73 of that regulation provides:

‘Decisions of [OHIM] shall state the reasons on which they are based. They shall be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.’

4 Article 74(1) of that regulation provides ‘[i]n proceedings before it [OHIM] shall examine the facts of its own motion’.

#### **Background to the dispute**

5 On 30 June 2000, Celltech filed an application with OHIM, pursuant to Regulation No 40/94, for registration of the word mark CELLTECH as a Community trade mark.

6 The goods and services for which registration was sought are ‘pharmaceutical, veterinary and sanitary preparations, compounds and substances’, ‘surgical, medical, dental and veterinary apparatus and instruments’, and ‘research and development services; consultancy services; all relating to the biological, medical and chemical sciences’, in Classes 5, 10 and 42 respectively 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.

7 By decision of 4 June 2002, OHIM’s examiner rejected the application for registration, basing the rejection on Article 7(1)(b) and (c) of Regulation No 40/94. He held that the mark at issue consisted of the grammatically correct combination of the two terms ‘cell’ and ‘tech’ (an abbreviation of ‘technical’ or ‘technology’) and that, consequently, it could not serve as an indicator of origin for the goods and services in respect of which registration was sought, because all of them fell within the field of cell technology.

8 By the contested decision, OHIM’s Second Board of Appeal dismissed Celltech’s appeal against the examiner’s decision. In essence, the Board of Appeal held that, since the mark applied for was such as to be immediately and unambiguously perceived as a term designating activities in the field of cell technology and products, apparatus and equipment used in connection with, or resulting from, those activities, the connection between the goods and services to which the application for registration related and the trade mark was not sufficiently indirect to endow the mark with the minimum level of inherent distinctiveness required under Article 7(1)(b) of Regulation No 40/94.

#### **Procedure before the Court of First Instance and the judgment under appeal**

9 Celltech brought an action before the Court of First Instance for annulment of the contested decision.

10 After noting, in paragraphs 25 and 26 of the judgment under appeal, that the Board of Appeal had found that the trade mark applied for was devoid of distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94 on the ground that it would be perceived by the relevant public as descriptive of the type of goods and services referred to in the application for registration, the Court of First Instance considered,

in paragraph 27 of the judgment under appeal, that it must establish, in the first place, whether the Board of Appeal had shown that that mark was descriptive of those goods and services, within the meaning of Article 7(1)(c) of that regulation.

11 In paragraphs 29 to 31 of the judgment under appeal, the Court of First Instance held that the public targeted consisted not only of all specialist consumers from the medical field who are knowledgeable about scientific terms in their sphere of activity, regardless of their mother tongue, but also of average English-speaking consumers.

12 In paragraphs 32 and 33 of the judgment under appeal, the Court of First Instance held that at least one meaning of the mark CELLTECH is ‘cell technology’.

13 After noting, in paragraph 34 of the judgment under appeal, that the Board of Appeal had held that the term ‘celltech’ ‘designated activities in the field of cell technology and products, apparatus and equipment used in connection with, or resulting from, such activities’, the Court of First Instance examined, in paragraphs 35 to 41 of that judgment, whether the Board of Appeal had shown that the mark applied for was descriptive of the goods and services referred to in the application for registration. The Court concluded that it had not, for the following reasons:

‘36 In that regard, it must be noted that neither the Board of Appeal nor OHIM has given an explanation of the meaning in scientific terms of cell technology. OHIM merely produced as an annex to its response an extract from the Collins English Dictionary showing the definitions of the terms “cell” and “tech”.

37 Neither the Board of Appeal nor OHIM explained in what way those terms give any information about the intended purpose and nature of the goods and services referred to in the application for registration, in particular about the way in which those goods and services would be applied to cell technology or how they would result from it.

38 Admittedly, it is the case that the goods and services to which the application for registration relates are in general terms pharmaceutical goods and services and, on that account, have a connection with bodies which are composed of cells. However, the Board of Appeal did not show that the relevant public would immediately and without further reflection make a definite and direct association between the pharmaceutical goods and services claimed and the meaning of the word mark CELLTECH (see, to that effect, Case T-359/99 DKV v OHIM (EuroHealth) [2001] ECR II-1645, paragraph 35).

39 Furthermore, even supposing that the goods and services concerned may be used for functional purposes involving cell technology, that fact would not be sufficient for a finding that the word mark CELLTECH may serve to designate their intended purpose. Such use of them constitutes at most one of many possible areas of use, but not their technical function ([Case T-356/00 DaimlerChrysler v OHIM (CARCARD) [2002] ECR II-1963,] paragraph 40).

40 It follows from the foregoing considerations that the Board of Appeal did not establish that the term “celltech”, even taken as meaning cell technology, is such as to be immediately and unambiguously perceived as designating activities in the field of cell technology and products, apparatus and equipment used in connection with or resulting from such activities. Nor did it establish that the public targeted will view it purely as an indication of the type of goods and services designated by the sign.

41 Consequently, the Court must hold that the Board of Appeal did not demonstrate that the word mark CELLTECH was descriptive of the goods and services in respect of which registration was sought.’

14 In paragraphs 42 to 44 of the judgment under appeal, the Court of First Instance examined, in the second place, whether the Board of Appeal had put forward other arguments showing that the word mark at issue was devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94 and held that it had not.

15 Therefore, the Court of First Instance annulled the contested decision and ordered OHIM to pay the costs.

#### **The appeal**

16 In its appeal, in support of which it relies on five grounds, OHIM claims that the Court should:

- set aside the judgment under appeal;
- primarily, dismiss Celltech’s action at first instance and order it to pay the costs both of the proceedings before the Court of First Instance and of those before the Court of Justice;
- in the alternative, refer the case back to the Court of First Instance.

17 Celltech contends that the Court should dismiss the appeal and order OHIM to pay the costs.

18 At the outset, it is appropriate to note that neither OHIM nor Celltech challenges the Court of First Instance’s analysis, in paragraphs 25 to 27 of the judgment under appeal, that, although the Board of Appeal decided that the mark CELLTECH is not distinctive within the meaning of Article 7(1)(b) of Regulation No 40/94, it did so on the ground that the mark would be perceived by the relevant public as descriptive, within the meaning of Article 7(1)(c), of the goods and services referred to in the application for registration.

#### **The admissibility of the appeal**

19 Celltech submits that the Board of Appeal refused to register the mark applied for solely on the basis of Article 7(1)(b) of Regulation No 40/94, and that before the Court of First Instance the objections raised by OHIM against registration of that mark were also based on that provision. By contrast, OHIM now bases its appeal almost exclusively on Article 7(1)(c) of that regulation.

20 In Celltech’s submission, since a party is not entitled to put forward a plea in law for the first time before the Court of Justice, OHIM’s appeal must be declared inadmissible.

21 In that regard, it is settled case-law that to allow a party to put forward for the first time before the Court of Justice a plea in law which it has not raised before the Court of First Instance would be to allow it to bring before the Court, whose jurisdiction in appeals is limited, a case of wider ambit than that which came before the Court of First Instance. In an appeal the Court’s jurisdiction is therefore confined to review of the findings of law on the pleas argued before the Court of First Instance (see, in particular, Joined Cases C-186/02 P and C-188/02 P Ramondín and Others v Commission [2004] ECR I-10653, paragraph 60, and Case C- 25/05 P Storck v OHIM [2006] ECR I- 5719, paragraph 61).

22 It must be stated, however, that in this case OHIM’s appeal seeks solely to challenge the findings of law made by the Court of First Instance in the judgment under appeal.

23 In effect, first, the Board of Appeal refused the registration of the mark applied for on the sole basis of Article 7(1)(b) of Regulation No 40/94 and, second, Celltech’s appeal against the contested decision was based on breach of that provision. In those circumstances, it is only at the appeal stage that OHIM was in a position to challenge the Court of First Instance’s interpretation of Article 7(1)(c) of Regulation No 40/94 in the judgment under appeal which led that Court to annul the contested decision.

24 The appeal must therefore be declared admissible.

#### **The first ground of appeal**

##### **Arguments of the parties**

25 OHIM submits that the Court of First Instance wrongly required the Board of Appeal and itself to explain the meaning, in scientific terms, of the expression ‘cell technology’ in order to show ‘in what way those terms give any information about the intended purpose and nature of the goods and services referred to in the application for registration, in particular about the way in which those goods and services would be applied to cell technology or how they would result from it’.

26 First, the Court of First Instance made an error of law, in paragraph 36 of the judgment under appeal, by criticising the Board of Appeal for not having explained the meaning, in scientific terms, of ‘cell technology’, and by making such an explanation a condition in order to refuse the mark applied for as being descriptive.

27 OHIM submits that, although the Board of Appeal must state the reasons why it considers a word mark to be descriptive, it was not required, in this case, to provide a scientific definition of the expression ‘cell technology’.

28 It is clear upon reading the first sentence of Article 73 in conjunction with Article 74(1) of Regulation No 40/94 that, although the bodies of OHIM are required to give reasons for their decisions, they are not, however, required to state the facts that they have taken into consideration. Therefore, reasoning, even if it is in the abstract, suffices provided that it is correct and that it is not contradicted by a party’s evidence to the contrary. That interpretation is confirmed by the case-law

of the Court of Justice (Case C- 447/02 P KWS Saat v OHIM [2004] ECR I-10107, paragraphs 44 to 49) and of the Court of First Instance (Case T- 315/03 Wilfer v OHIM (ROCKBASS) [2005] ECR II-1981, paragraph 21).

29 The Board of Appeal's legal reasoning whereby, first, the mark applied for means 'cell technology' and, second, that meaning will be perceived by the relevant consumer as 'designating activities in the field of cell technology and products, apparatus and equipment used in connection with or resulting from such activities', was, in OHIM's submission, sufficient to support the refusal of registration under Article 7(1)(c) of Regulation No 40/94.

30 Moreover, the expression 'cell technology', which denotes the practical application of scientific research on cells, is sufficiently self-explanatory to be understood by both the average consumers and the specialists who form the relevant public. Any additional explanation and, in particular, a scientific explanation, would have been superfluous.

31 Second, the Court of First Instance also made an error of law by criticising the Board of Appeal, in paragraph 37 of the judgment under appeal, for not explaining in what way the expression 'cell technology' gives any information about the intended purpose and nature of the goods and services referred to in the application for registration.

32 OHIM submits that, if the Court of First Instance meant that the Board of Appeal was bound to refer to a scientific definition of that expression, it made an error of law for the reasons set out in paragraphs 26 to 30 of the present judgment.

33 If, on the other hand, it meant that the Board of Appeal should have demonstrated how the goods marketed and services provided by Celltech were actually applied to cell technology or how they actually resulted from it, it also made an error of law. The way in which an applicant for a Community trade mark intends to market or is marketing the goods or services in question is immaterial as regards the assessment of whether or not the mark is descriptive or whether or not it is devoid of any distinctive character, as such an assessment must be made in the context of an a priori examination, without reference to any actual use.

34 Celltech acknowledges that OHIM is not required to produce evidence of the meaning of a term in all the cases before it. However, it is required to do so where an expression consisting of a number of words is at issue, particularly a technical expression, which is not normally or ordinarily used descriptively.

35 That is the case in these proceedings. Celltech contends that the expression 'cell technology' – which it points out is different from the mark applied for, CELLTECH – does not have an established scientific meaning. It is not a technical term. The absence of a definition of that expression in dictionaries shows that cell technology does not exist in the scientific domain. The expression is not defined or used anywhere. It was to this point that the Court of First Instance was alluding when it said that OHIM had provided no

explanation in scientific terms of the expression 'cell technology'.

36 Celltech disputes OHIM's assertion that the meaning of that expression is clear, namely, the practical application of scientific research on cells. There is no evidence of any kind that any member of the relevant public would perceive the mark CELLTECH in that sense. Indeed, there is no reason to suppose that the average consumer would split up the mark applied for in order to regard it thus.

#### **Findings of the Court**

37 In the first place, contrary to OHIM's reading of the judgment under appeal, the Court of First Instance did not annul the contested decision for failure to state reasons, but on the ground that OHIM did not establish that the mark CELLTECH, understood as meaning 'cell technology', was descriptive of the goods and services referred to in the application for registration.

38 Under Article 74(1) of Regulation No 40/94, OHIM examiners and, on appeal, the Boards of Appeal of OHIM are required to examine the facts of their own motion in order to determine whether the mark applied for falls under one of the grounds for refusal of registration laid down in Article 7 of that regulation. It follows that the competent bodies of OHIM may be led to base their decisions on facts which have not been alleged by the applicant for the mark (Storck v OHIM, paragraph 50).

39 Whilst it is in principle the task of those bodies to establish in their decisions the accuracy of such facts, such is not the case where they allege facts which are well known (Storck v OHIM, paragraph 51).

40 In this case, in paragraph 12 of the contested decision, the Board of Appeal stated that 'the combination "CELLTECH" will immediately and unambiguously be perceived by the relevant consumer as designating activities in the field of cell technology and products, apparatus and equipment used in connection with or resulting from such activities'.

41 The Board of Appeal thus implicitly held, first, that cell technology is a well-known scientific fact and, second, that the activities forming part of that scientific method or applying it enable the production or manufacture of pharmaceutical, veterinary or sanitary preparations, compounds or substances, surgical, medical, dental or veterinary apparatus or instruments and/or that such activities require the use of such preparations, compounds or substances as well as such apparatus or instruments.

42 In so doing, the Board of Appeal based its decision on facts which it examined of its own motion.

43 The Court of First Instance noted, in paragraphs 36 to 38 of the judgment under appeal, that, by not furnishing any evidence that cell technology has the scientific meaning attributed to it in the contested decision, the Board of Appeal did not establish the correctness of the findings, summarised in paragraphs 40 and 41 of the present judgment, on the basis of which it held that the mark CELLTECH is descriptive. In fact, it must be observed that the Board of Appeal

made no attempt to establish the soundness of those findings, for example by referring to scientific literature.

44 OHIM argues that the expression ‘cell technology’ is sufficiently self-explanatory and, therefore, that any additional explanation and, in particular, a scientific explanation, was superfluous.

45 However, in deciding that the existence and nature of cell technology is not a well-known fact and that it was therefore for the Board of Appeal to establish the correctness of its findings in that regard, the Court of First Instance made a finding of fact which, save where the facts or evidence are distorted, is not subject to review by the Court of Justice on appeal (see, to that effect, *Storck v OHIM*, paragraph 53).

46 Accordingly, the Court of First Instance did not make an error of law by deciding that, by not establishing the scientific meaning of cell technology, the Board of Appeal did not show that the mark CELLTECH is descriptive of the goods and services referred to in the application for registration.

47 In the second place, there is nothing in the judgment under appeal to support OHIM’s alternative interpretation of paragraph 37 of that judgment, set out in paragraph 33 of the present judgment. Therefore, the Court of First Instance did not make the error of law of which OHIM complains in that regard.

48 The first ground of appeal must therefore be rejected.

#### **The third ground of appeal Arguments of the parties**

49 OHIM submits that the Court of First Instance made an error of law by holding, in paragraph 39 of the judgment under appeal, that, as a matter of principle, an area of use of goods or services does not fall within the characteristics of the goods or services whose description, by a mark for which registration is sought in respect of those goods or services, is prohibited under Article 7(1)(c) of Regulation No 40/94.

50 That provision does not lay down any distinction between, on the one hand, ‘intended purpose’ or ‘technical function’, which are characteristics of the goods and services, and, on the other, ‘area of use’, which is not. On the contrary, the reference in that provision to ‘other characteristics’ shows that all possible characteristics of the goods and services concerned fall within the prohibition which it lays down. That analysis is confirmed by the Court’s case-law, according to which it is immaterial whether or not the characteristics described are essential or ancillary (*Case C- 363/99 Koninklijke KPN Nederland [2004] ECR I- 1619*, paragraphs 101 and 102).

51 The Court of First Instance should therefore have examined whether the mark CELLTECH is such as to be immediately and unambiguously perceived by the relevant consumer as designating activities in the field of cell technology and/or products used in connection with such activities.

52 Celltech replies that the Court of First Instance did not hold that an area of use cannot fall within the characteristics of goods or services whose description

by a mark is prohibited under Article (7)(1)(c) of Regulation No 40/94. In paragraphs 39 and 40 of the judgment under appeal, the Court of First Instance merely held that the Board of Appeal had not established that the term ‘celltech’ is such as to be immediately and unambiguously perceived as designating the characteristics of the goods or services in respect of which registration is sought.

#### **Findings of the Court**

53 In paragraphs 36 to 38 of the judgment under appeal, the Court of First Instance criticises the Board of Appeal for having failed to establish the existence and nature of cell technology.

54 In those circumstances, that Court was not, a fortiori, in a position to determine whether the goods and services referred to in the application for registration can be used for functional purposes involving cell technology.

55 It was therefore by way of hypothesis that, in paragraph 39 of the judgment under appeal, the Court of First Instance assumed that such could be the case, as is shown by the use of the words ‘even supposing’ in the first sentence of that paragraph.

56 Accordingly, the third ground of appeal appears to be directed against a ground of the judgment under appeal that was stated purely for the sake of completeness and, therefore, even on the assumption that it is well founded, it cannot lead to that judgment’s being set aside.

57 Consequently, this ground of appeal must be rejected as ineffective.

#### **The fourth ground of appeal Arguments of the parties**

58 OHIM submits that the Court of First Instance failed to give reasons for its assertion, in paragraph 40 of the judgment under appeal, that the mark applied for is not such as to be immediately and unambiguously perceived as designating activities in the field of cell technology and products, apparatus and equipment connected with such activities. The judgment under appeal does not explain why the terms ‘celltech’ or ‘cell technology’ do not describe the characteristic consisting of the scientific method for obtaining the goods and services in question.

59 Celltech replies, first, that it is for OHIM to establish that the average consumer would regard the term ‘celltech’ (or even the expression ‘cell technology’) as describing such a characteristic. Secondly, the Court of First Instance gave proper reasons for its finding in paragraphs 35 to 41 of the judgment under appeal.

#### **Findings of the Court**

60 As is clear from the examination of the first ground of appeal, the Court of First Instance provided to the requisite legal standard, in paragraphs 35 to 38 of the judgment under appeal, the reasons for its finding, formulated in paragraph 40 of that judgment, that the Board of Appeal did not show that the mark applied for is descriptive of the goods and services in question.

61 The fourth ground of appeal must therefore be rejected.

### **The fifth ground of appeal**

#### **Arguments of the parties**

62 According to OHIM, the Court of First Instance made an error of law in denying that the designation of a scientific method for obtaining goods and services is descriptive for the purposes of Article 7(1)(c) of Regulation No 40/94.

63 The term ‘celltech’, taken as meaning ‘cell technology’, is perceived as relating to goods and services whose characteristics derive from improvements in the biosciences using or modifying cells, that is to say, in the ‘cell technology’ research sector. Therefore, the scientific method for the production of the goods or the supply of the services is perceived as being, from the relevant consumer’s viewpoint, an important, concrete and direct characteristic.

64 Celltech contends that the Court of First Instance was right to reject the proposition that ‘cell technology’ describes the scientific process for the production of the goods or the supply of the services in question. OHIM has been unable to find any reference to that expression in the scientific literature or otherwise, because it is not used by any scientist to describe anything at all. Therefore, it is not capable of conveying the slightest information about the products in question.

#### **Findings of the Court**

65 Contrary to OHIM’s submission, the Court of First Instance did not hold that a word or an expression designating a scientific method which enables the manufacture of pharmaceutical, veterinary or hygienic preparations, compounds or substances or the supply of services relating to the biological, medical and chemical sciences is not descriptive of the goods and services obtained by that method.

66 As was observed in the course of the examination of the first ground of appeal, the Court of First Instance annulled the contested decision on the ground that the Board of Appeal had not established, in particular, that cell technology is a method of production of the goods or of supply of the services referred to in the application for registration.

67 The fifth ground of appeal must therefore be rejected.

### **The second ground of appeal**

#### **Arguments of the parties**

68 OHIM submits that it is clear from paragraph 98 of the judgment in *Koninklijke KPN Nederland* that a word mark made up of a mere combination of elements, each of which is descriptive of the characteristics of the goods or services in respect of which registration is sought, is itself presumed to be descriptive of those characteristics for the purposes of Article 7(1)(c) of Regulation No 40/94, and that such presumption can be rebutted only where that combination introduces an unusual variation, in particular as to syntax or meaning.

69 The Court of First Instance should therefore have ascertained whether the terms ‘cell’ and ‘tech’, taken individually, were in themselves descriptive of the goods and services concerned and, if it had concluded that they were, it should have explained how the com-

ination of those two descriptive words introduced an unusual variation as regards the syntax or meaning of the term ‘celltech’ which enabled the latter term not to be itself descriptive of those goods and services. Therefore, it infringed Article 7(1)(c) of Regulation No 40/94 by failing to carry out such an examination.

70 OHIM adds that the Court of First Instance’s analysis cannot be vindicated on the basis of the judgment of the Court of Justice in [Case C- 329/02 P SAT.1 v OHIM \[2004\] ECR I-8317](#), referred to in paragraph 43 of the judgment under appeal. That judgment concerned the distinctive character of a mark constituted by the juxtaposition of a descriptive element and a non-distinctive element and not, as in this case, the descriptive character of a mark constituted by a combination of two elements each of which may be descriptive. Furthermore, that judgment concerns the interpretation of Article 7(1)(b) of Regulation No 40/94 and not of Article 7(1)(c).

71 Celltech disputes the assertion that the Court of Justice established a presumption of lack of distinctiveness for marks composed of a combination of two non-distinctive elements. In *Koninklijke KPN Nederland*, the Court of Justice merely stated that ‘as a general rule’ a mere combination of elements each of which is descriptive of characteristics of goods remains descriptive of those characteristics. However, it is clear from the Court’s settled case-law, and notably from *SAT.1 v OHIM*, that the mark must be considered as a whole, since the average consumer does not split it up into its various component parts.

72 The Court of First Instance was therefore correct to consider the mark CELLTECH as a whole.

#### **Findings of the Court**

73 Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service, are not to be registered.

74 It is appropriate to interpret the grounds for refusal of registration listed in Article 7(1) of Regulation No 40/94 in the light of the general interest underlying each of them (*C- 37/03 P BioID v OHIM [2005] ECR I- 7975*, paragraph 59 and the case-law there cited).

75 Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, which requires that signs or indications which may serve, in trade, to designate characteristics of the goods or services for which registration is sought, may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks ([Case C-173/04 P Deutsche SiSi-Werke v OHIM \[2006\] ECR I- 551](#), paragraph 62 and the case-law there cited).

76 In order for a mark consisting of a word produced by a combination of elements, such as the mark applied for, to be regarded as descriptive for the purposes of Article 7(1)(c) of Regulation No 40/94, it is

not sufficient that each of its components may be found to be descriptive. The word itself must be found to be descriptive (see, in respect of Article 3(1)(c) 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), a provision identical, in essence, to Article 7(1)(c) of Regulation No 40/94, Koninklijke KPN Nederland, paragraph 96, and Case C- 265/00 Campina Melkunie [2004] ECR I- 1699, paragraph 37).

77 As OHIM pointed out, it follows from the Court's case-law that, 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 7(1)(c) of Regulation 40/94 (Koninklijke KPN Nederland, paragraph 98, and Campina Melkunie, paragraph 39).

78 However, the Court added that such a combination may not be descriptive, within the meaning of that provision, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements (Koninklijke KPN Nederland, paragraph 99, and Campina Melkunie, paragraph 40).

79 Accordingly, whilst, as regards a trade mark comprising words, its distinctive character may be assessed, in part, in relation to each of its elements, taken separately, it must, in any event, depend on an appraisal of the whole which they comprise (see, by analogy, concerning Article 7(1)(b) of Regulation No 40/94, SAT.1 v OHIM, paragraph 28, and BioID v OHIM, paragraph 29).

80 It follows from the foregoing considerations that, contrary to OHIM's contention, it does not follow from the Court's case-law that the prior analysis of each of the elements of which a mark is composed is an essential step. On the contrary, OHIM's Boards of Appeal and, where an action is brought, the Court of First Instance are required to assess the descriptiveness of the mark, considered as a whole.

81 In this case, it must be held that the Court of First Instance properly assessed the descriptive character of the mark CELLTECH considered as a whole and concluded that it was not established that the mark, even understood as meaning 'cell technology', was descriptive of the goods and services referred to in the application for registration. Therefore, it did not infringe Article 7(1)(c) of Regulation No 40/94.

82 Accordingly, the second ground of appeal must be rejected and OHIM's appeal must therefore be dismissed.

#### Costs

83 Under Article 69(2) of the Rules of Procedure, applicable to the procedure on appeal by virtue of Article 118 thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since Celltech has applied for costs and OHIM has been unsuccessful, the latter must be ordered to pay the costs.

On those grounds, the Court (First Chamber) hereby:

1. Dismisses the appeal;
2. Orders the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) to pay the costs.

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## OPINION OF ADVOCATE GENERAL Sharpston

delivered on 14 December 2006 (1)

Case C-273/05 P

Office for Harmonisation in the Internal Market (Trade Marks and Designs)

v

Celltech R&D Ltd

1. The present appeal has been brought by the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('OHIM') against the judgment of the Court of First Instance in Celltech R&D v OHIM (2) annulling a decision of the Second Board of Appeal of OHIM ('the Board of Appeal'). The appeal concerns in particular the correct interpretation and application of the concepts of distinctiveness and descriptiveness for the purpose of, respectively, Article 7(1)(b) and (c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark ('the Regulation'). (3)

#### The Regulation

2. Article 7(1) of the Regulation lists what are known as the 'absolute' grounds for refusal of registration of a trade mark. Absolute grounds automatically preclude registration, in contrast to 'relative' grounds (such as similarity between the proposed mark and an existing mark) which may or may not preclude registration depending on the circumstances.

3. Article 7(1) provides in so far as is relevant: 'The following shall not be registered:

...

- (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.'

4. I shall refer to signs or indications falling within Article 7(1)(c) as 'descriptive'.

5. In interpreting Article 7(1)(b) and (c) of the Regulation, account should also be taken of the Court's case-law on the interpretation of the identically-worded Article 3(1)(b) and (c) of the Trade Marks Directive. (4)

6. Article 73 of the Regulation provides that decisions of the Office 'shall state the reasons on which they are based'.

#### Background to the present case

7. In June 2000, Celltech R&D Ltd ('the trademark applicant' or 'the applicant') filed an application to register the word mark CELLTECH as a Community

trade mark. Registration was sought for (i) pharmaceutical, veterinary and sanitary preparations, compounds and substances, falling within class 5 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, (ii) surgical, medical, dental and veterinary apparatus and instruments, falling within class 10 thereof, and (iii) research and development services and consultancy services, all relating to the biological, medical and chemical sciences, falling within class 42.

8. In June 2002, the OHIM examiner ('the Examiner') rejected the application for registration on the basis of Article 7(1)(b) and (c) of the Regulation. She took the view that the sign at issue consisted of the grammatically correct combination of the two terms 'cell' and 'tech' (an abbreviation of 'technical' or 'technology'). As a consequence, she found that the mark applied for could not serve as an indicator of origin for the goods and services in respect of which registration was sought, because all of them fell within the field of cell technology.

9. In May 2003, the Board of Appeal dismissed the applicant's appeal. It was of the opinion that the word CELLTECH would 'immediately and unambiguously be perceived by the relevant consumer as designating activities in the field of cell technology and products, apparatus and equipment used in connection with or resulting from such activities'. The connection between the goods and the mark was consequently not sufficiently indirect to endow the mark with the minimum level of inherent distinctiveness required under Article 7(1)(b) of the Regulation. The Board of Appeal added that, as the mark was barred from registration by Article 7(1)(b), it was not necessary to consider whether Article 7(1)(c) was applicable as well.

10. The trade-mark applicant appealed against that decision ('the contested decision') to the Court of First Instance. It raised 'a single plea in law alleging infringement of Article 7(1)(b)'. (5)

#### **The judgment of the Court of First Instance**

11. The Court of First Instance allowed the appeal.

12. Since the relevant passages of the judgment are set out in full in the appropriate sections below, I will merely give an outline at this point.

13. First, the Court of First Instance summarised the case-law of the Court of Justice and the Court of First Instance concerning the essential function of a trade mark and the correct interpretation of the various grounds for refusal to register listed in Article 7(1) of the Regulation. (6) It noted in particular that a word mark which is descriptive of characteristics of goods or services for the purposes of Article 7(1)(c) is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services for the purposes of Article 7(1)(b). (7)

14. The Court of First Instance then summarised paragraphs 10 to 12 of the contested decision, concluding that the Board of Appeal had 'found, in essence, that the sign CELLTECH was not distinctive within the meaning of Article 7(1)(b) of Regulation No 40/94 on

the ground that it would be perceived by the relevant public as descriptive of the type of goods and services concerned'. (8) It was therefore of the view that it was appropriate to consider whether the Board of Appeal had established that the mark was descriptive of the goods and services claimed. If so, the contested decision would have to be upheld on account of the case-law (9) holding that any descriptive sign is necessarily devoid of distinctiveness. If not, it would be necessary, following the SAT.1 judgment, (10) to ascertain whether the Board of Appeal had put forward other arguments in order to conclude that the sign was devoid of distinctiveness. (11)

15. The Court of First Instance thus turned to the question whether the Board of Appeal had established that the mark was descriptive. It confirmed the Board of Appeal's finding (12) that the target public consisted not only of specialist consumers from the medical field, who are knowledgeable about English-language scientific terms in their sphere of activity regardless of their mother tongue, but also of average consumers. (13) After reviewing the contested decision, the Court of First Instance concluded that the Board of Appeal had not established that the mark was descriptive of the goods and services in question. (14)

16. Next, the Court of First Instance considered whether the Board of Appeal had put forward other arguments showing that the mark was devoid of any distinctive character. It concluded that the Board of Appeal had failed to establish that the mark, taken as a whole, would not allow the target public to distinguish the applicant's goods and services from those having a different commercial origin. (15)

17. The Court of First Instance accordingly concluded that the Board of Appeal had not established that the mark was prevented from registration on the basis that it was descriptive and hence precluded by Article 7(1)(c) of the Regulation. Since the Board of Appeal had not set out any other grounds for a finding that the mark was none the less devoid of any distinctive character for the purposes of Article 7(1)(b), it had been wrong in holding that the mark was precluded from registration by Article 7(1)(b). The Court of First Instance therefore annulled the contested decision. (16)

18. OHIM has appealed against the judgment of the Court of First Instance on five grounds, claiming that that judgment 'violated Article 7(1)(b) and (c) ... and is vitiated by the failure to give proper reasons'.

#### **Admissibility of the appeal**

19. The trade-mark applicant argues that the appeal is inadmissible in so far as it concerns Article 7(1)(c) of the Regulation. It submits that the Board of Appeal made no finding on that provision, but rejected the CELLTECH mark on the basis of Article 7(1)(b) of the Regulation alone. Moreover OHIM did not argue before the Court of First Instance that the mark was unregistrable on the ground of Article 7(1)(c); on the contrary, it stated that CELLTECH 'is therefore not distinctive in relation to the goods and services and is not eligible for registration under Article 7(1)(b)'. (17)

In contrast, almost all of OHIM's appeal to the Court of Justice focuses on Article 7(1)(c).

20. At the hearing, counsel for the applicant elaborated on that argument. He referred to the Court's case-law establishing that each of the grounds for refusal to register listed in Article 7(1) is independent of the others and calls for separate examination, (18) that there is a clear overlap between the scope of the grounds for refusal set out in subparagraphs (b) to (d) of Article 7, (19) and that a word mark which is descriptive of characteristics of goods or services for the purposes of Article 7(1)(c) is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services for the purposes of Article 7(1)(b). (20) The need to distinguish firmly between 7(1)(b) and 7(1)(c) was most clearly dealt with in *BioID*, (21) in which the Court of Justice quashed the judgment of the Court of First Instance because the latter had not fully paid attention to the distinction between those provisions.

21. Counsel for the applicant stressed that the decision of the Court of First Instance in the present case was on 14 April 2005 and that the Court of Justice had decided *BioID* on 15 September 2005. He asserted that 'there is no doubt that, if the present appeal was before the [Court of First Instance] today, [that court] would have focused on Article 7(1)(b) and would not have digressed at all into 7(1)(c) – indeed it would have said "we approach the 7(1)(b) objection on the basis that the mark is free of objection under 7(1)(c)"'.

22. I am not convinced either by that submission or, more generally, by the argument that the appeal is inadmissible.

23. It seems to me that in *BioID* the Court simply applied the principles it had laid down exactly one year earlier in *SAT.1*. (22) In both cases the Court of Justice set aside the judgment of the Court of First Instance on the ground that that court had interpreted Article 7(1)(b) by reference to a criterion (namely that trade marks which are capable of being commonly used, in trade, for the presentation of the goods or services in question may not be registered) relevant in relation to Article 7(1)(c). (23) I do not therefore consider that any significance attaches to the relative dates of the judgments of the Court of Justice in *BioID* and of the Court of First Instance in the present case.

24. More specifically, the Court of Justice quashed the judgment of the Court of First Instance in *BioID* because that court had based its finding that the trade mark applied for fell within Article 7(1)(b) principally on the fact that it was likely to be commonly used in trade. The Court of Justice ruled that that criterion, although relevant in the context of Article 7(1)(c), was not the yardstick by which Article 7(1)(b) must be interpreted. (24) In the present case, in contrast, the Board of Appeal did not rely on the criterion of likely common use in trade.

25. What is more relevant to my mind is the fact that the judgment of the Court of Justice in *SAT.1* was delivered after the contested decision but before the judgment of the Court of First Instance in the present case. The Court of First Instance reviewed the contest-

ed decision in the light of the judgment of the Court of Justice in *SAT.1*. In that judgment, the Court of Justice held that where OHIM decides that a trade mark which does not fall foul of Article 7(1)(c) (because it is not purely descriptive) is none the less devoid of distinctive character within the meaning of Article 7(1)(b), it must set out the reasons for the latter view. (25)

26. Applying that dictum, the Court of First Instance in the present case took the view that, in the contested decision, the Board of Appeal had found, in essence, that the sign *CELLTECH* was not distinctive within the meaning of Article 7(1)(b) on the ground that it would be perceived by the relevant public as descriptive of the type of goods and services concerned. (26) Accordingly the Court of First Instance considered that it was appropriate to examine first whether the Board of Appeal had established that the sign was descriptive of those goods and services. (27)

27. The contested decision is based on the Board of Appeal's finding that the relevant consumer will view the mark first and foremost as an indication of the type of goods and services covered by the sign (i.e., as purely descriptive). (28) The Board of Appeal concluded from that finding that registration was barred by Article 7(1)(b). It could equally – and perhaps should preferably – have concluded that registration was barred by Article 7(1)(c). (29) It may also be, as counsel for the applicant seemed to accept at the hearing, that in those circumstances the Court of First Instance should have refrained from discussing Article 7(1)(c). However, both the Board of Appeal and the Examiner in fact dwelt solely on descriptiveness. In the light of the case-law holding that a word mark which is descriptive of characteristics of goods or services for the purposes of Article 7(1)(c) is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services for the purposes of Article 7(1)(b), (30) the fact that the Court of First Instance did focus on Article 7(1)(c) does not seem illogical or inappropriate. Even if one takes the view that the Court of First Instance should not have done so, that would primarily put in issue the correctness of the judgment of that court – which one might assume the applicant emphatically does not wish to do – rather than the admissibility of the appeal against it.

28. As it is, the Court of First Instance devoted paragraphs 27 to 40 of its judgment to analysing the Board of Appeal's findings as to whether the sign *CELLTECH* was descriptive. It concluded in paragraph 41 that 'the Board of Appeal did not demonstrate that the word mark *CELLTECH* was descriptive of the goods and services in respect of which registration was sought'. In contrast, the Court of First Instance devoted a mere two paragraphs (43 and 44) to analysing 'whether, in the contested decision, the Board of Appeal put forward other arguments showing that the word mark at issue was devoid of any distinctive character' (Article 7(1)(b)). (31) Finally, paragraph 45 of the judgment sets out the overall conclusion of the Court of First Instance that 'the Board of Appeal did not establish that the trade mark claimed was prevented

from registration on account of the ground for refusal set out in Article 7(1)(c)'.  
29. It would therefore seem to me perverse to dismiss the appeal as inadmissible because it focuses on whether the Court of First Instance was correct in its analysis of descriptiveness. To do so would in effect deny OHIM the possibility of challenging the judgment on the very grounds on which it is based.

30. I am accordingly of the view that the appeal is admissible.

#### **The grounds of appeal**

31. OHIM raises five specific grounds of appeal. I find it helpful to consider them by reference to the order of the paragraphs of the judgment to which they relate.

#### **Paragraphs 35 to 37 of the judgment of the Court of First Instance: the first and (in part) second grounds of appeal**

32. The first ground of appeal concerns paragraphs 36 and 37 of the judgment of the Court of First Instance while the second ground in part concerns paragraph 35. It is clear that paragraphs 35 to 37 together constitute a self-contained series of propositions. It seems artificial to dissect them. I shall therefore address the first and second (32) grounds of appeal together.

33. Since paragraphs 35 to 37 follow on from paragraphs 32 to 34, and paragraph 34 refers back to paragraph 12 of the contested decision, it is convenient to begin with that paragraph of the Board of Appeal's reasoning:

'It is the Board's opinion that the combination "CELLTECH" will immediately and unambiguously be perceived by the relevant consumer as designating activities in the field of cell technology and products, apparatus and equipment used in connection with or resulting from such activities. Consequently, the Board considers that the connection between the goods and the mark is not sufficiently indirect to endow the mark with the minimum level of inherent distinctiveness required under Article 7(1)(b) [of the Regulation].'

34. Paragraphs 32 to 37 of the judgment of the Court of First Instance read:

'32 ... CELLTECH is composed of two English-language nouns, the second of which takes the form of an abbreviation. It is undisputed that the component "cell" refers, in biology, to the smallest unit of an organism that is able to function independently. Similarly, the component "tech" is the usual abbreviation for the word "technology" and thus, as an abbreviation, does not depart from the lexical rules of the English language (see, to that effect, the SAT.1 judgment, paragraph 31).

33 Therefore, it must be held that at least one meaning of the word mark CELLTECH is "cell technology".

34 As to the nature of the relationship between the word mark CELLTECH and the products and services concerned, the Board of Appeal held, at paragraph 12 of the contested decision, that the term designated activities in the field of cell technology and products, apparatus and equipment used in connection with, or resulting from, such activities.

35 Thus, it is necessary to consider whether the Board of Appeal established that the word mark CELLTECH, taken to mean "cell technology", was descriptive of the goods and services concerned, which are in the pharmaceutical field.

36 In that regard, it must be noted that neither the Board of Appeal nor OHIM has given an explanation of the meaning in scientific terms of cell technology. OHIM merely produced as an annex to its response an extract from the Collins English Dictionary showing the definitions of the terms "cell" and "tech".

37 Neither the Board of Appeal nor OHIM explained in what way those terms give any information about the intended purpose and nature of the goods and services referred to in the application for registration, in particular about the way in which those goods and services would be applied to cell technology or how they would result from it.'

#### **The second ground of appeal (paragraph 35)**

35. By its second ground of appeal, OHIM submits that, when examining whether the word CELLTECH consists exclusively of signs or indications which may serve to designate characteristics of the goods or services concerned, the Court of First Instance erred in disregarding the individual meaning of the words 'cell' and 'tech'. The Court of First Instance instead focused exclusively on the meaning of the sign CELLTECH or 'cell technology' overall. In so doing, it incorrectly disregarded the principle that a mere combination of elements, each of which is descriptive of characteristics of the goods or services in question, without any unusual variations as to syntax or meaning, remains descriptive of those characteristics for the purposes of Article 7(1)(c) of the Regulation.

36. The mark CELLTECH is composed of a descriptive word ('cell') and a normal abbreviation of another descriptive word ('tech').

37. It is clear that if a mark which consists of a neologism produced by a combination of elements is to be regarded as descriptive within the meaning of Article 7(1)(c) of the Regulation (which is the same as Article 3(1)(c) of the Directive (33)), it is not sufficient that each of its components may be found to be descriptive: the word itself must be found to be so. (34)

38. Admittedly, as a general rule, the mere combination of elements, each of which is descriptive of characteristics of goods or services, itself remains descriptive of those characteristics within the meaning of those provisions even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, will not normally 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. (35)

39. However, the Court has made it clear that where such a combination creates an impression which is sufficiently far removed from that produced by the simple combination of those individual elements, namely where there is a perceptible difference between the ne-

ologism itself and the mere sum of its parts, the result may not be descriptive within the meaning of the legislation. (36)

40. It is thus clear that what is decisive is the overall impression created by the mark. That is hardly surprising. As the Court stated in its first judgment on the Trade Marks Directive (made in the context of assessing ‘the likelihood of confusion’ between similar marks within the meaning of Article 4(1)(b) of the Directive, but none the less accepted (37) as being of more general application): ‘The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.’ (38)

41. I therefore agree with the trade-mark applicant that the Court of First Instance was correct to consider whether the mark CELLTECH was descriptive as a whole.

42. I would accordingly dismiss the second ground of appeal in so far as it relates to paragraph 35 of the judgment of the Court of First Instance.

**The first ground of appeal: paragraphs 36 and 37**

43. By its first ground of appeal, OHIM submits that, although the Court of First Instance recognised ‘that at least one meaning of the word mark CELLTECH is “cell technology”’, (39) it erred in law in requiring the Board of Appeal, as a condition for refusing to register CELLTECH on the ground that it was descriptive, to give ‘an explanation of the meaning in scientific terms of cell technology’ (paragraph 36) and in particular to explain ‘in what way those terms give any information about the intended purpose and nature of the goods and services referred to in the application for registration, in particular about the way in which those goods and services would be applied to cell technology or how they would result from it’ (paragraph 37).

44. OHIM accepts that in order to justify refusing registration on the basis of Article 7(1)(c) it must give sufficient grounds, going beyond the mere assertion that a term is descriptive. However, it does not consider that it is obliged to give a scientific explanation.

45. The trade-mark applicant submits that it is common sense to require the Board of Appeal to explain the meaning of ‘cell technology’ before rejecting the proposed mark as descriptive. If a term is said to be descriptive, there must be an explanation of what it describes. The applicant accepts that it is not necessary for OHIM to provide evidence of meaning in every case. Where however a composite phrase is said to be descriptive (which would preclude its registration by virtue of Article 7(1)(c)) and it is not a standard description, there should be some evidence showing how it is used descriptively.

46. In my view it is clear that in paragraph 37 of its judgment the Court of First Instance was adjudicating on paragraph 12 of the contested decision.

47. In order to determine whether the Court of First Instance was wrong to criticise the Board of Appeal and OHIM for failing to give ‘an explanation of the meaning in scientific terms of cell technology’ or to explain ‘in what way those terms give any explanation

about ... the way in which the goods and services [concerned] would be applied to cell technology or how they would result from it’, it is necessary to consider the extent of a trade mark authority’s duty to give reasons when refusing an application to register a mark.

48. Article 73 of the Regulation requires decisions of OHIM to state the reasons on which they are based. The Court has ruled that that obligation has the same scope as that which derives from Article 253 EC. It is settled case-law that the statement of reasons required by Article 253 EC must disclose in a clear and unequivocal manner the reasoning followed by the institution which adopted the measure in question in such a way as to enable the persons concerned to ascertain the reasons for the measure and to enable the competent Community Court to exercise its power of review. It is not necessary for the reasoning to go into all the relevant facts and points of law, since the question whether the statement of reasons meets the requirements of Article 253 EC must be assessed with regard not only to its wording but also to its context and to all the legal rules governing the matter in question. (40)

49. Applying those principles, the Court has ruled that OHIM is required to provide ‘a full and precise statement of reasons’ for a decision refusing registration of a trade mark. (41) The Court of First Instance has accepted that a statement of reasons for such a decision may none the less be brief, provided that it enables the applicant to know the reasons for the rejection of its application for registration and to challenge the decision effectively. (42)

50. That requirement finds a parallel in the Court’s case-law which requires that there should be a right of judicial review of any decision by which a national trade mark authority refuses a right recognised by Community law. Since effective judicial review must be able to cover the legality of the reasons for the contested decision, a national trade mark office is required to give reasons for a decision refusing to register a mark. It is settled case-law, applied by the Court also in the field of trade marks, that the statement of reasons must disclose in a clear and unequivocal manner the reasoning followed by the institution which adopted the measure in question in such a way as to enable the persons concerned to ascertain the reasons for the measure and to enable the competent court to exercise its power of review. (43)

51. Where a proposed word mark does not consist solely of an unequivocal description of its characteristics as defined by Article 7(1)(c) of the Regulation, and hence is not self-evidently descriptive, a mere statement by OHIM that it is descriptive will clearly not satisfy that requirement. Thus in SAT.1 the Court annulled a decision of OHIM on the ground, inter alia, that OHIM had ‘merely stated in the contested decision that the elements “SAT” and “2” were descriptive ... without stating in what way the term “SAT.2”, taken as a whole, was not capable of distinguishing the services of the appellant from those of other undertakings’. (44)

52. In order to satisfy its obligation to state reasons when refusing registration of a trade mark, I consider that OHIM should produce a succinct statement of what it understands by the term sought to be registered. In the present case, the Court of First Instance imposed a significantly more stringent duty on OHIM in requiring the Board of Appeal, as a condition for refusing to register CELLTECH on the ground that it was descriptive, to give ‘an explanation of the meaning in scientific terms of cell technology’ (paragraph 36) and in particular to explain ‘in what way those terms [“cell” and “tech”] give any information about the intended purpose and nature of the goods and services referred to in the application for registration, in particular about the way in which those goods and services would be applied to cell technology or how they would result from it’ (paragraph 37).

53. I am accordingly of the view that OHIM’s first ground of appeal is well founded.

**Paragraph 39 of the judgment of the Court of First Instance: the third ground of appeal**

54. The third ground of appeal concerns paragraph 39 of the judgment of the Court of First Instance, which is best read in conjunction with paragraph 38:

‘38 Admittedly, it is the case that the goods and services to which the application for registration relates are in general terms pharmaceutical goods and services and, on that account, have a connection with bodies which are composed of cells. However, the Board of Appeal did not show that the relevant public would immediately and without further reflection make a definite and direct association between the pharmaceutical goods and services claimed and the meaning of the word mark CELLTECH (see, to that effect, Case T-359/99 DKV v OHIM (EuroHealth) [2001] ECR II-1645, paragraph 35).

39 Furthermore, even supposing that the goods and services concerned may be used for functional purposes involving cell technology, that fact would not be sufficient for a finding that the word mark CELLTECH may serve to designate their intended purpose. Such use of them constitutes at most one of many possible areas of use, but not their technical function ([Case T-356/00 DaimlerChrysler v OHIM (CARCARD) [2002] ECR II-1963], paragraph 40).’

55. OHIM submits that the Court of First Instance erred in law in stating that a finding of descriptiveness or of lack of distinctiveness requires a description of the ‘intended purpose’ of the goods and services. Although the Court of First Instance recognised that ‘cell technology’ is an ‘area of use’ for the goods and services in question, it wrongly held that the description of such an ‘area of use’ would be insufficient to establish that the sign CELLTECH was descriptive and therefore devoid of distinctiveness.

56. More specifically, the Court of First Instance erred in law in that it considered that the use of goods and services in connection with ‘cell technology’ was not the consequence of their inherent function but merely one possible field of application or ‘area of use’ among many others. Such an ‘area of use’ was consid-

ered by the Court of First Instance not to fall under Article 7(1)(c). The Court of First Instance thus distinguished between some characteristics, such as the ‘intended purpose’ or ‘technical function’, whose description falls within the ambit of Article 7(1)(c), and other characteristics such as the ‘areas of use’, whose description does not justify the application of Article 7(1)(c).

57. The trade-mark applicant submits that the Court of First Instance was saying simply that the Board of Appeal had not established that the term CELLTECH, even if taken to mean cell technology, would be immediately and unambiguously perceived as designating characteristics of the goods or services concerned.

58. I consider that a number of factors support a broad interpretation of the characteristics which fall within the scope of Article 7(1)(c) and whose presence (without more) will lead to a finding of descriptiveness and automatic refusal of registration.

59. First, the wording of the provision itself is clearly inclusive rather than exclusive, precluding the registration of ‘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’. The formulation ‘which may serve’, (45) the long list of characteristics most of which are general rather than specific concepts and the ‘sweep-up’ ‘other characteristics’ all support that interpretation.

60. Second, it is settled case-law that Article 3(1)(c) of the Directive, and hence by extension Article 7(1)(c) of the Regulation, (46) pursue an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Those provisions therefore prevent such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks. (47) The public interest underlying them implies that any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of those provisions must be freely available to all and not be registrable. (48) It must surely follow from an interpretation in the light of that public interest that possible ‘use[s] for functional purposes’, or an ‘area of use’, of the goods and services in question are to be regarded as such signs or indications.

61. The Court has always given a great deal of weight to that public interest and has, on that basis, interpreted Article 3(1)(c) of the Directive broadly. Thus it has recently stated that the public interest underlying that provision 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. The signs and indications composing the mark need not 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 that those signs and indications could be used for such purposes. A word mark must therefore be refused registration under Article 3(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned. 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. No distinction is drawn by reference to the characteristics which may be designated by the signs or indications of which the mark consists. Rather, in the light of the public interest underlying Article 3(1)(c), 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. (49)

62. The above considerations all support, in my view, a generous interpretation of the ‘characteristics’ which fall within the scope of Article 7(1)(c) of the Regulation or Article 3(1)(c) of the Directive.

63. In support of its view that an ‘area of use’ of a product or service is not such a ‘characteristic’, the Court of First Instance referred in paragraph 39 of its judgment in the present case to CARCARD. (50) The Court of First Instance had there stated:

‘[T]he word CARCARD does not appear to be capable of serving to designate any quality of those goods falling within the categories listed as stationary and transportable data processing equipment; programs on data carriers for data and/or text and/or image processing within Class 9. Furthermore, even if, here again, the goods might be used in a way that involves a card linked to a car, that is not sufficient to infer that CARCARD may serve to designate the intended use of the goods. Such use of the goods constitutes at most one of many possible areas of use thereof, but not a technical function.’

64. I am not convinced by the proposition, apparently originating in that judgment, that an area of use of the goods to be covered by a proposed trade mark would not constitute a characteristic of those goods within the meaning of Article 7(1)(c). Interestingly, the Court of First Instance has sought to distance itself from that paragraph in the only subsequent case citing it. (51)

65. For the above reasons I consider that in the present case the Court of First Instance was wrong to distinguish between some characteristics, such as the ‘intended purpose’ or ‘technical function’, whose description falls within the ambit of Article 7(1)(c), and other characteristics such as the ‘areas of use’, whose description does not justify the application of Article 7(1)(c). I accordingly consider that the third ground of appeal should be allowed.

#### **Paragraph 40 of the judgment of the Court of First Instance: the fourth and fifth grounds of appeal**

66. The fourth and fifth grounds of appeal concern paragraph 40 of the judgment of the Court of First Instance:

‘It follows from the foregoing considerations that the Board of Appeal did not establish that the term “celltech”, even taken as meaning cell technology, is such as to be immediately and unambiguously perceived as designating activities in the field of cell technology and products, apparatus and equipment used in connection with or resulting from such activities. Nor did it establish that the public targeted will view it purely as an indication of the type of goods and services designated by the sign.’

#### **The fourth ground of appeal**

67. I find the fourth ground of appeal particularly elusive. OHIM states variously that the Court of First Instance (i) incorrectly considered that the description of a process for the production or the supplying of the goods and services in question does not fall within the ambit of Article 7(1)(c) of the Regulation; (ii) infringed that provision in dismissing the proposition that ‘cell technology’ describes the scientific process for the production of the goods or the supplying of the services in question; (iii) failed to consider whether, as was stated by the Board of Appeal, ‘CELLTECH’ or ‘cell technology’ would be perceived as ‘designating activities in the field of cell technology and products, apparatus and equipment ... resulting from such activities’; (52) (iv) failed to verify whether ‘CELLTECH’ or ‘cell technology’ described in a sufficiently definite and direct manner the process for the production or the supplying of the goods and services in question; and (v) wrongly denied that the designation of a scientific method for obtaining the goods and services in question is ‘descriptive’ within the meaning of Article 7(1)(c).

68. It seems to me however that in paragraph 40 of its judgment the Court of First Instance does none of those things. It simply concludes that the Board of Appeal did not establish that CELLTECH ‘is such as to be immediately and unambiguously perceived as designating activities in the field of cell technology and products, apparatus and equipment used in connection with or resulting from such activities’. I have reservations about such review by the Court of First Instance of what is, essentially, a finding of fact by the Board of Appeal. (53) But I do not see how that statement by the Court of First Instance can be assailed on the grounds adduced by OHIM.

69. I would accordingly dismiss the fourth ground of appeal as unfounded.

#### **The fifth ground of appeal**

70. OHIM submits as its fifth ground of appeal that the judgment is vitiated in that it lacks any reasoning which would have enabled OHIM and third parties to understand why ‘CELLTECH’ or ‘cell technology’ does not describe the characteristic consisting of the scientific method for obtaining the goods and services in question.

71. Paragraph 40 of the judgment of the Court of First Instance is expressed as the conclusion of its reasoning (introduced by ‘It follows from the foregoing considerations’, which clearly comprise paragraphs 36 to 39). It asserts that ‘the Board of Appeal did not establish that the term “celltech” is such as to be immediately and unambiguously perceived ...’ etc. To my mind that assertion goes to the Board of Appeal’s assessment. As I have indicated, I am not convinced that the Court of First Instance had jurisdiction to interfere with that assessment. However, that point has not been taken. In any event, and as the trade-mark applicant submits, the Court of First Instance does appear to have given reasons (in paragraphs 36 to 39) explaining its conclusion in paragraph 40. I accordingly consider that the fifth ground of appeal should be dismissed as unfounded.

**Paragraph 43 of the judgment of the Court of First Instance: the second ground of appeal (in part)**

72. The second limb of the second ground of appeal concerns paragraph 43 of the judgment of the Court of First Instance, which must be seen in its context:

‘41 Consequently, (54) the Court must hold that the Board of Appeal did not demonstrate that the word mark CELLTECH was descriptive of the goods and services in respect of which registration was sought.

42 It is therefore necessary to consider whether, in the contested decision, the Board of Appeal put forward other arguments showing that the word mark at issue was devoid of any distinctive character.

43 It must be borne in mind on this point that whether a trade mark comprising words is distinctive may be assessed, in part, in relation to each of its terms or elements, taken separately, but must, in any event, depend on an appraisal of the whole which they comprise. The mere fact that each of those elements, considered separately, is devoid of distinctive character does not mean that their combination cannot present a distinctive character (see, to that effect, the SAT.1 judgment, paragraph 28).’

73. OHIM submits that paragraph 43 and the reference it contains to SAT.1 (55) are incorrect. It argues that the dictum of the Court of Justice in that case on which the Court of First Instance relied concerns the juxtaposition of a descriptive element and a non-distinctive element in such a way that the overall combination was not descriptive as such for the goods and services concerned. It is therefore not relevant to the present case, which concerns a combination of two descriptive elements.

74. I consider that SAT.1 is indeed authority for the proposition that it is cited to support. However, in paragraph 43 the Court of First Instance is manifestly (56) considering whether, in the contested decision, the Board of Appeal had put forward other arguments showing that the word mark at issue was devoid of any distinctive character. The Court of First Instance had already concluded its discussion of whether the mark was descriptive. (57) Its reliance on SAT.1 in that context was accordingly clearly appropriate.

75. I am therefore of the view that the second ground of appeal should be dismissed as unfounded in so far as it concerns paragraph 43 of the judgment of the Court of First Instance.

**Conclusion on the appeal**

76. For the reasons given above, I conclude that the judgment of the Court of First Instance should be set aside. First, in requiring the Board of Appeal, as a condition for refusing to register CELLTECH on the ground that it was descriptive, to give ‘an explanation of the meaning in scientific terms of cell technology’ (paragraph 36 of the judgment) and in particular to explain ‘in what way those terms give any information about the intended purpose and nature of the goods and services referred to in the application for registration, in particular about the way in which those goods and services would be applied to cell technology or how they would result from it’ (paragraph 37 of the judgment), the Court of First Instance imposed a more stringent obligation than that flowing from Article 73 of the Regulation. Second, in holding (in paragraph 39 of the judgment) that a description of an ‘area of use’ of goods or services was not a description of a ‘characteristic’ of such goods or services within the meaning of Article 7(1)(c) of the Regulation, the Court of First Instance misinterpreted that provision.

**Substance of the action at first instance**

77. Article 61 of the Statute of the Court of Justice provides that the Court of Justice may, where the decision of the Court of First Instance is quashed, itself give final judgment in the matter where the state of the proceedings so permits. That is the case here.

78. The trade-mark applicant contends in its action against the contested decision that the Board of Appeal’s assessment of the requirements of Article 7(1)(b) of the Regulation concerning distinctiveness was incorrect and that the contested decision should therefore be annulled in its entirety or, in the alternative, in part. (58)

79. The applicant’s principal submission is that the Board of Appeal did not correctly assess the mark as a whole.

80. In the relevant paragraphs of the contested decision, the Board of Appeal, having first noted that a trade mark should be evaluated in its entirety, found that the combination of the English word ‘cell’ and the English short-form ‘tech’, each of which lacked any distinctive character individually, was nothing more than the sum of its parts since no distinguishing feature resulted from those parts being conjoined. (59)

81. That statement appears to me correctly to reflect the case-law of the Court. It is clear that, while the distinctiveness of the individual elements of a compound mark may play a part in the assessment of the distinctive character of the mark as a whole, that assessment must in any event be based on the overall perception of that mark by the relevant public. (60)

82. In BioID the Court approved the reasoning of the Court of First Instance to the effect that, where it does not appear that there is concrete evidence, such as, for example, the way in which the various elements are

combined, to indicate that a compound trade mark, taken as a whole, is greater than the sum of its parts, such a trade mark is devoid of distinctive character. (61) Similarly in SAT.1 the Court suggested that aspects such as an element of imaginativeness would be relevant to assessing whether a mark comprising non-distinctive elements was in itself distinctive, (62) thus confirming the view that something additional is necessary to convert the combination of two non-distinctive components into a distinctive whole.

83. That approach is moreover consistent with the case-law on the assessment of the descriptiveness of a compound word mark comprising only non-descriptive elements, which may be regarded as analogous. (63) The Court has stated that such a mark may not be descriptive if it creates an impression which is sufficiently far removed from that produced by the simple combination of its elements. There must be a perceptible difference between the mark and the sum of its parts, which implies that, because of the unusual nature of the combination in relation to the goods or services, the mark creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the constituent elements. (64)

84. In the present case the Board of Appeal, having found that the list of goods and services in the application covered both specialist and non-specialist consumers, (65) then stated that it was ‘the Board’s opinion that the combination “CELLTECH” would immediately and unambiguously be perceived by the relevant consumer as designating activities in the field of cell technology and products, apparatus and equipment used in connection with or resulting from such activities’. (66)

85. The Court of Justice has recently stated that ‘the specific evaluation of the impact of a trade mark on consumers, clearly defined in relation to the goods and services for which registration of the sign is requested, amounts to a finding of fact’. (67) Although that statement was made in the context of the competence of the Court of Justice to review findings of fact by the Court of First Instance, it confirms me in my view that an appellate court should not interfere with such a finding by the Board of Appeal (itself already adjudicating on appeal from the decision of an OHIM examiner (68)) without good reason.

86. That approach is also supported by the wording of Article 63(2) of the Regulation, which provides that actions against decisions of the Boards of Appeal ‘may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application[,] or misuse of power’. To my mind, that wording strongly suggests that the jurisdiction of the Court of First Instance when reviewing such a decision is limited to points of law. It would follow that review by that court of a decision of the OHIM Board of Appeal ‘is confined to review of the legality of that decision, and is thus not intended to re-examine the facts which were assessed within OHIM’. (69) I accept, however, that that proposition

does not represent the settled practice of the Court of First Instance hitherto on appeals from decisions of OHIM Boards of Appeal.

87. In the present case, it seems to me that the Board of Appeal’s statement that CELLTECH would be perceived by the relevant consumer as designating activities in the field of cell technology is a finding of fact that cannot be challenged in the context of an action against the contested decision. More generally, it is clear to me from that decision that the Board of Appeal did not fail to assess the mark as a whole. The trade mark applicant’s principal submission in its action against the contested decision must therefore be dismissed.

88. The relevant public’s perception of the mark is however only one of the criteria for determining whether a trade mark is distinctive. In addition, distinctiveness must be assessed by reference to the goods or services in respect of which registration is sought. (70) That is the subject-matter of the trade mark applicant’s submission in the alternative in its action against the contested decision. The applicant submits that the Board of Appeal did not consider whether the mark CELLTECH would have distinctive character by specific reference to the goods or services for which registration is sought. It notes that those goods include ‘pharmaceutical, veterinary and sanitary preparations, compounds and substances’ and ‘surgical, medical, dental and veterinary apparatus and instruments’. The applicant considers that, even individually, the terms ‘cell’ and/or ‘tech’ are or would not be naturally used to describe such goods, and submits that the Board of Appeal did not consider that point.

89. That submission seems to me to have some weight.

90. Since registration of a mark is always sought in respect of the goods or services described in the application for registration, the question whether any of the absolute grounds for refusal apply to the mark must be assessed specifically by reference to those goods or services. (71) That assessment must be thorough and full. (72) Where registration of a mark is sought for a number of goods and services, I consider that it is not necessary for a decision refusing registration on the basis of an absolute ground of refusal to state its conclusion separately for each of those individual goods and services. However, where registration is refused on that basis for an entire group or category of goods or services, the decision must explain adequately why the mark is ineligible for registration for the group or category as such. (73)

91. To my mind, paragraph 12 of the contested decision does not provide such an explanation. As I have indicated, I do not consider that the Board of Appeal was required to give ‘an explanation of the meaning in scientific terms of cell technology’ or to explain in what way the terms ‘cell’ and ‘tech’ ‘give any information about the intended purpose and nature of the goods and services referred to in the application for registration, in particular about the way in which those goods and services would be applied to cell technology

or how they would result from it'. (74) I am, however, of the view that the Board was required to explain why it considers (as it apparently does) that 'pharmaceutical, veterinary and sanitary preparations, compounds and substances' and 'surgical, medical, dental and veterinary apparatus and instruments' are 'products, apparatus and equipment used in connection with or resulting from [activities in the field of cell technology]'. The contested decision contains no such explanation. I accordingly consider that it should be set aside.

#### Costs

2. Under Article 122 of the Rules of Procedure of the Court of Justice, where the appeal is well founded and the Court of Justice itself gives final judgment in the case, the Court is to make a decision as to costs. Under Article 69(2) of the Rules of Procedure of the Court of Justice, which applies to appeals by virtue of Article 118, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. At first instance, the trade mark applicant applied for costs against OHIM and the latter should in my view be unsuccessful. In the appeal, the appellant OHIM has applied for costs against the respondent trade-mark applicant and the latter should in my view be unsuccessful. Consequently I consider that OHIM should be ordered to pay the costs of the proceedings at first instance and the trade-mark applicant should be ordered to pay the costs of the proceedings on appeal.

#### Conclusion

93. I am accordingly of the view that the Court should:

- set aside the judgment of the Court of First Instance in Case T-260/03;
- set aside the decision of the Second Board of Appeal of 19 May 2003;
- order the Office for Harmonisation in the Internal Market to pay the costs at first instance and Celltech R&D Ltd to pay the costs on appeal.

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1 – Original language: English.

2 – Case T-260/03 [2005] ECR I-1215.

3 – OJ 1994 L 11, p. 1.

4 – 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). In the context of other substantially identical provisions of the Trade Marks Directive and the Regulation, the Court has made it clear that its interpretation of one provision must also apply to the other: Case C-425/98 *Marca Mode* [2000] ECR I-4861, paragraphs 26 to 28.

5 – Paragraph 9 of the judgment of the Court of First Instance.

6 – Paragraphs 19 to 24.

7 – Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 86, and Case C-265/00 *Campina Melkunie* [2004] ECR I-1699, paragraph 18.

8 – Paragraphs 25 and 26.

9 – Cited in footnote 7.

10 – Case C-329/02 P *SAT.1 SatellitenFernsehen v OHIM* [2004] ECR I-8317. The case is confusingly referred to both as SAT.1 and as SAT.2, the latter being the mark sought to be registered. I shall refer to it as SAT.1.

11 – Paragraph 27.

12 – Which appears to be common ground between the parties.

13 – Paragraphs 28 to 31.

14 – Paragraphs 32 to 42, many of which are the focus of the first to fourth grounds of appeal.

15 – Paragraphs 42 to 44, of which paragraph 43 is the target of the fifth ground of appeal.

16 – Paragraphs 45 and 46.

17 – The applicant's emphasis.

18 – See *Koninklijke KPN Nederland*, paragraphs 67 and 85, and *Campina Melkunie*, paragraph 18, both cited in footnote 7. The proposition in fact dates originally from Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 35.

19 – See *Koninklijke KPN Nederland*, paragraphs 67 and 85, and *Campina Melkunie*, paragraph 18.

20 – See *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19.

21 – Case C-37/03 P *BioID v OHIM* [2005] ECR I-7975.

22 – Cited in footnote 10.

23 – See paragraph 36 of SAT.1, cited by the Court of Justice in paragraph 62 of *BioID*, and paragraph 63 of *BioID*.

24 – Paragraphs 61 to 65.

25 – Paragraph 42.

26 – Paragraphs 24 to 26.

27 – Paragraph 27.

28 – Paragraph 11 of the contested decision.

29 – It may be noted however that the Court of Justice itself did not take that approach in *BioID*, holding that the abbreviation *BioID*, the dominant element of the sign sought to be registered ('*BioID*\*®'), was indistinguishable from the goods and services covered (which were in the field of biometric identification), was not of a character which could guarantee the identity of the marked product or service to the consumer or end-user from the viewpoint of the relevant public, and was accordingly devoid of any distinctive character within the meaning of Article 7(1)(b): paragraphs 70 to 75. Article 7(1)(c) formed no part of the Court of Justice's analysis or conclusion in that case, although that provision had (together with Article 7(1)(b)) been the basis of the decisions of the OHIM examiner and Board of Appeal and of the appeal to the Court of First Instance.

30 – See the cases cited in footnote 7.

31 – That is perhaps unsurprising. In the circumstances, it cannot have taken the Court of First Instance very long to examine the contested decision to see whether the Board of Appeal had identified grounds other than pure descriptiveness which would lead in law to the conclusion that the mark lacked distinctive character, and to record that the contested decision contained no such additional grounds.

- 32 – To the extent to which it concerns paragraph 35. In so far as it concerns paragraph 43 of the judgment of the Court of First Instance, it is considered at points 72 to 75 below.
- 33 – See footnote 4.
- 34 – Campina Melkunie, cited in footnote 7, paragraph 37.
- 35 – *Ibid.*, paragraph 39, emphasis added.
- 36 – *Ibid.*, paragraphs 40 and 41. Paragraphs 37 and 39 to 41 of Campina Melkunie repeat what was said in virtually identical terms in paragraphs 96 and 98 to 100 of KPN, delivered the same day. In my view Campina Melkunie is the more relevant authority here. Campina Melkunie concerned a neologism (BIOMILD) composed of elements each of which was held to be descriptive of characteristics of the goods or services concerned, whereas in KPN the word mark at issue ('postkantoor', or post office) was a word in its own right.
- 37 – See for example BioID, cited in footnote 21, paragraph 29.
- 38 – Case C-251/95 Sabel v Puma [1997] ECR I-6191, paragraph 23.
- 39 – Paragraph 33 of the judgment.
- 40 – Case C-447/02 P KWS Saat v OHIM [2004] ECR I-10107, paragraphs 63 to 65.
- 41 – *Ibid.*, paragraph 67.
- 42 – Case T-242/02 Sunrider v OHIM (TOP) [2005] ECR II-2793, paragraphs 72 to 75.
- 43 – See paragraph 40 of my Opinion delivered on 6 July 2006 in Case C-239/05 BVBA Management, Training en Consultancy.
- 44 – Paragraph 43.
- 45 – Emphasis added. That structure is echoed in other language versions: for example, the French is 'pouvant servir' and the German 'dienen können'.
- 46 – See footnote 4.
- 47 – Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] ECR I-2779, paragraph 25.
- 48 – Joined Cases C-53/01 to C-55/01 Linde [2003] ECR I-3161, paragraphs 74 and 75.
- 49 – Koninklijke KPN Nederland, cited in footnote 7, paragraphs 55, 97 and 102.
- 50 – See point 54 above.
- 51 – See Case T-222/02 HERON Robotunits v OHIM [2003] ECR II-4995, paragraph 47.
- 52 – Emphasis added.
- 53 – See point 85 below.
- 54 – Namely, in the light of paragraphs 35 to 40.
- 55 – Cited in footnote 10.
- 56 – See paragraph 42.
- 57 – Paragraph 41.
- 58 – The applicant submits in the alternative that registration of the mark in respect of the goods in class 5, in the further alternative in classes 5 and 10, should be permitted and the contested decision annulled in respect of those goods.
- 59 – Paragraph 10 of the contested decision.
- 60 – See SAT.1, cited in footnote 10, paragraph 28, and BioID, cited in footnote 21, paragraph 29.
- 61 – Paragraph 34.
- 62 – Paragraph 35.
- 63 – See SAT.1, paragraph 28, for recognition that the situations are analogous.
- 64 – Campina Melkunie, cited in footnote 7, paragraphs 40 and 41 (emphasis added).
- 65 – The trade-mark applicant does not appear to take issue with the Board of Appeal's assessment of the relevant consumer.
- 66 – Paragraphs 11 and 12.
- 67 – Paragraph 42 of the judgment in BioID, cited in footnote 21.
- 68 – Which decision, in the case of a proposal to refuse registration on the basis of an absolute ground for refusal, is itself only taken definitively once the trade-mark applicant has had an opportunity to submit observations: Article 38(3) of the Regulation.
- 69 – Case C-214/05 P Sergio Rossi, paragraph 50 of the judgment delivered on 18 July 2006.
- 70 – Case C-104/01 Libertel [2003] ECR I-3793, paragraph 75.
- 71 – Koninklijke KNP Nederland, cited in footnote 7, paragraph 33.
- 72 – Koninklijke KNP Nederland, cited in footnote 7, paragraph 123.
- 73 – See points 39 to 41 of my Opinion in Management, Training en Consultancy, cited in footnote 43.
- 74 – See points 47 to 52 above.