

**Court of Justice EU, 17 May 2017, EUIPO v Deluxe Entertainment**



**TRADEMARK LAW**

**The General Court erred in law by stating that the goods and services covered by the application for registration of the sign ‘Deluxe’ displayed such differences as regards their nature, their characteristics, their intended use and the way in which they are marketed that they could not be considered a homogenous category enabling the Board of Appeal to adopt a general reasoning with respect to the absolute grounds of refusal:**

- [the General Court failed to have regard to the possibility that, despite their differences, all the goods and services at issue could have a common characteristic that could justify their placement within a single homogenous group](#)

It follows from the foregoing considerations that it cannot be ruled out a priori that the goods and services covered by an application for registration all present a relevant characteristic for the analysis of an absolute ground for refusal and that they can be placed, for the purposes of examining the application for registration at issue in relation to that absolute ground for refusal, in a sufficiently homogenous single category or group, for the purposes of the case-law cited in paragraph 31 of the present judgment.

**Claim of superior quality as common characteristic**

- [that the Board of Appeal, in essence, considered that all the goods and services covered by the application for registration under examination presented a characteristic which was relevant to the analysis of the absolute ground for refusal under Article 7\(1\)\(b\) of Regulation No 207/2009, namely the fact that they could be presented as having or providing superior quality and that, therefore, they were all part of a sufficiently homogenous single category or group, for the purposes of the analysis of that absolute ground for refusal.](#)

35. In the present case, it is apparent from paragraph 26 of the judgment under appeal that, in relation to all the goods and services covered by the application for

registration at issue, the Board of Appeal indicated that all the goods, without exception, can be presented as being of superior quality, and all the services, without exception, can be presented as providing superior quality. It follows from that consideration that the Board of Appeal, in essence, considered that all the goods and services covered by the application for registration under examination presented a characteristic which was relevant to the analysis of the absolute ground for refusal under Article 7(1)(b) of Regulation No 207/2009, namely the fact that they could be presented as having or providing superior quality and that, therefore, they were all part of a sufficiently homogenous single category or group, for the purposes of the analysis of that absolute ground for refusal. The relevance, according to the Board of Appeal, of that common characteristic of the goods and services at issue for the purposes of the analysis that it had to carry out is demonstrated by the finding in the decision at issue that the mark applied for consisted of a ‘claim of superior quality’.

36. The Board of Appeal’s failure, mentioned in paragraph 22 of the judgment under appeal, to expressly indicate that the goods and services at issue had such a sufficiently direct and specific link to each other to the point that they form a homogenous category cannot lead to a different conclusion, since such an indication was implicit from the Board’s consideration referred to in paragraph 26 of the judgment under appeal.

37. It was for the General Court, in order to check observance of the Board of Appeal’s obligation to carry out to the specific assessment required by Article 7(1)(b) of Regulation No 207/2009 and to give sufficient reasons to the requisite standard, to examine, in the context of a factual assessment, the merits of the Board of Appeal’s considerations noted in paragraph 35 of the present judgment.

38. In particular, it was for the General Court, first, to check whether the mark applied for, which is composed of a word element and a figurative element, was indeed capable of being perceived, directly and immediately, as a claim of superior quality or a laudatory message by the relevant public rather than as an indication of the commercial origin of the goods and services it designates.

39. Second, it was for the General Court to check, in the context of the analysis of the word element of the mark applied for, whether the term ‘deluxe’ did actually convey the concept of ‘superior quality’ as claimed by the Board of Appeal, given that that word element amounts to a direct reference to the concept of ‘luxury’. If the term ‘deluxe’ were to have a meaning distinct to that of ‘superior quality’, as considered by the Advocate General in paragraph 54 to 55 of his Opinion, the General Court would then have to examine whether or not, in the light of that meaning, the goods and services covered by the mark at issue constitute a homogenous group justifying recourse to a general reasoning.

40. However, the General Court ruled out generally the possibility of finding the goods and services at issue to be homogenous and it did not take into account, in that regard, the specificity of the mark applied for or, in particular, of its perception by the relevant public.

41. Indeed, as is apparent from paragraph 21 of the judgment under appeal, the General Court merely found that the goods and services covered by the application for registration at issue displayed such differences as regards their nature, their characteristics, their intended use and the way in which they are marketed that they could not be considered a homogenous category enabling the Board of Appeal to adopt a general reasoning with respect to them. The General Court therefore failed to have regard to the possibility that, despite their differences, all the goods and services at issue could have a common characteristic, relevant to the analysis that the Board of Appeal had to carry out, which, in accordance with the considerations set out in paragraphs 33 and 34 of the present judgment, could justify their placement within a single homogenous group and the use by the Board of Appeal of a general reasoning in relation to them.

42. For the same reasons, the Court's assertion, in paragraph 27 of the judgment under appeal, that 'the fact that the term "deluxe" amounts to a laudatory and promotional term capable of applying to all the goods and services at issue is without consequence' is also erroneous.

43. It follows from the foregoing that the General Court erred in law in interpreting Article 7(1)(b) and Article 75 of Regulation No 207/2009, with the result that the judgment under appeal must be set aside.

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### Court of Justice EU, 17 May 2017

(L. Bay Larsen, M. Vilaras, J. Malenovský, M. Safjan and D. Šváby (Rapporteur))

JUDGMENT OF THE COURT (Third Chamber)

17 May 2017 (\*)

(Appeal — EU trade mark — Figurative mark containing the word element 'deluxe' — Refusal of registration by the examiner)

In Case C-437/15 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 10 August 2015,

European Union Intellectual Property Office (EUIPO), represented by S. Palmero Cabezas, acting as Agent, appellant,

the other party to the proceedings being:

Deluxe Entertainment Services Group Inc., formerly Deluxe Laboratories, Inc., established in Burbank (United States of America), represented by L. Gellman, advocate, and M. Esteve Sanz, abogada, applicant at first instance,

THE COURT (Third Chamber),

composed of L. Bay Larsen, President of the Chamber, M. Vilaras, J. Malenovský, M. Safjan and D. Šváby (Rapporteur), Judges,

Advocate General: M. Campos Sánchez-Bordona, Registrar: M. Ferreira, Principal Administrator, having regard to the written procedure and further to the hearing on 9 November 2016,

after hearing [the Opinion of the Advocate General](#) at the sitting on 25 January 2017,

gives the following

#### Judgment

1. By its appeal, the European Union Intellectual Property Office (EUIPO) asks the Court to set aside the judgment of the General Court of the European Union of 4 June 2015, *Deluxe Laboratories v OHIM (deluxe)* (T-222/14, EU:T:2015:364, 'the judgment under appeal'), by which the Court annulled the decision of the Second Board of Appeal of EUIPO of 22 January 2014 (R 1250/2013-2), having dismissed the action brought by Deluxe Laboratories, Inc., which subsequently became Deluxe Entertainment Services Group, Inc. ('Deluxe'), against the decision of the examiner who had refused to register the figurative sign 'deluxe' as an EU trade mark ('decision at issue').

#### Legal context

2. Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1) provides in Article 7, which is headed '*Absolute grounds for refusal*':

'1. The following shall not be registered:

...

(b) trade marks which are devoid of any distinctive character;

...

2. Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Union'.

3. Article 75 of that regulation provides:

'Decisions of [EUIPO] 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'.

#### Background to the dispute

4. The General Court summarised in paragraphs 1 to 7 of the judgment under appeal the facts giving rise to the dispute as follows:

'1. On 10 October 2012, the applicant, [Deluxe], filed an application for registration of a Community trade mark at [EUIPO] pursuant to ... Regulation No 207/2009...

2. The mark [applied for] is the following figurative sign:



3. The goods and services for which registration was sought are in Classes 9, 35, 37, 39 to 42 and 45 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond, for each of those classes, to the following description:

- Class 9: “Motion picture and television films featuring music videos, action/adventure, comedy, drama, horror, family, children, anime, sports, documentaries, commercials, science fiction, history, education, live action, computer-generated, animated, 2D, 3D, trailers, public service announcements, fiction, non-fiction, reality, and thrillers; digital media, namely, pre-recorded DVDs, HD DVDs, and pre-recorded optical discs featuring music videos, action/adventure, comedy, drama, horror, family, children, anime, sports, documentaries, commercials, science fiction, history, education, live action, computer-generated, animated, 2D, 3D, trailers, public service announcements, fiction, non-fiction, reality, and thrillers, and downloadable audio and video recordings featuring motion picture films, television shows, and video programs”;
- Class 35: “Inventory control and computerized tracking and tracing of packages in transit; advertising and marketing of motion pictures, television shows, and advertisements; preparing audio-visual displays in the fields of music, motion pictures, television shows, and advertisements; preparing audio-visual presentations for use in advertising; post-production editing services for video and audio commercials; product merchandising; business services, namely, outsourcing in the field of translation services, namely, providing the transfer of information relating to captions and subtitles for audio-visual works; business management of assets in the nature of television programs, motion picture films and commercials, and commercial, industrial and corporate audio-visual media content; arranging and conducting tradeshow exhibitions for commercial or advertising purposes in the fields of entertainment, television, software and video games;

- organizational services, namely, indexing files representing film, video, audio, picture and document content, for post-production industries; display arrangement services of digital files representing film, video, audio, picture and document content, for post-production industries; inventory management, namely, locating digital files representing film, video, audio, picture and document content, for post-production industries; business management services, namely, digital and intellectual property asset management”;
- Class 37: “Rejuvenation services for film, tape, DVD, HD DVD, pre-recorded optical discs and other recorded, digital, downloadable, and online media, namely, cleaning of film, tape, DVD, HD DVD, pre-recorded optical discs and other recorded, digital, downloadable, and online media”;
- Class 39: “Deposit and transport of cameras, film, video, digital media, data processing and accessories thereto; storage and warehousing of film, digital and video media, and promotional material related to movies, television shows, and advertisements, namely, clothing, posters, and movie, television show, and advertisement cut-outs; electronic storage of digital and video images, digital cinema and sound recordings; storage of motion pictures, television shows, advertisements, digital cinema, DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, and online media; storage of master video discs, audio tapes, and CD-ROMs of music and images; media management, namely, moving, archiving, and transporting digital files representing film, video, audio, picture and document content, for post production industries; packing articles for transportation; delivery of goods by truck; warehouse storage; and warehousing services; merchandise packaging for others, merchandise packaging for others, namely, packaging music, videos, DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, downloadable, and online media and custom packaging services for sound, video, and data recordings, to the order and specification of others”;
- Class 40: “Duplication and replication of motion picture films, television shows, advertisements, and video programs on film, videotape, DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, downloadable, and online media; mastering and duplication of positive and negative motion picture prints to videotape, DVD, HD DVD, pre-recorded optical discs and other recorded, digital, downloadable, and online media; cutting of negatives; rental of printing machines and apparatus for industrial development and printing in the photographic, cinema and television industries; color enhancement of black and white cinematic film; closed captioning of films and videos; digital correction services of videos, and digital video transfer, namely, providing color correction and conversion of motion picture, television, and advertising film to video film; film and any other video media reproduction, namely, remastering of films from one format to another; and contract manufacturing in the field of digital versatile



discs; duplication of video-tape, DVD, HD DVD, pre-recorded optical discs and other recorded, digital, downloadable, and online media in all professional formats; video services, namely, mastering and duplication of professional video tape, DVD, HD DVD, pre-recorded optical discs and other recorded, digital, downloadable, and online media formats; film development services; film to videotape, DVD, HD DVD, pre-recorded optical discs and other recorded, digital, downloadable, and online media transfer services, namely, conversion of motion picture, television, and advertising film to videotape, DVD, HD DVD, pre-recorded optical discs and other recorded, digital, downloadable, and online media; film and other video media back-up services, namely, digital preservation and restoration of cinematic films; printing services for sound, video, and data recordings; processing and printing of motion picture, television and advertising films; conversion of motion picture, television, and advertising film from 2D to 3D; operation of laboratories for the processing of motion picture, television, and advertising films; formatting and conversion of media and digital data; digital conversion of motion picture, television, and advertising films to videotapes, DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, and online media; film to tape digital transfer services, namely, transferring film to DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, downloadable, and online media”;

– Class 41: “Motion picture, television, and advertising film, videotape and digital video laboratory and post-production services, namely, high-resolution scanning of film, digital color timing, laser film recording of digital video and high definition images to film; digital and video mastering services for motion pictures, television shows, and advertisements; digital imaging; digital and electronic manipulation of images for motion pictures, television shows, and advertisements; recording digital images onto film; video and audio media production, namely, production of video cassettes and DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, downloadable, and online media for others; production of visual, optical and digital special effects for others, for television, motion pictures, advertisements, DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, downloadable, and online media, namely, digital cinema; audio recording and production; film editing services; electronically producing motion picture, television, and advertising film from videotape, DVD, HD DVD, pre-recorded optical discs and other recorded, digital, downloadable, and online media recordings; producing special visual effects for videotapes, DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, downloadable, and online media; production and distribution of motion pictures, television shows, and advertisements; providing voice-overs for videotapes, records, DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, downloadable, and online

media; consulting services in connection with film production and distribution; production of master video discs, audio tapes, and CD-ROMS of music and images; arranging for distribution or syndication of motion pictures, television shows, and advertisements. distribution services for film, tape, DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, downloadable, and online media; video editing services; dubbing services and film editing; video and sound track for cinema, television and advertisements”;

– Class 42: “Design and development of computer software; product research and development; hosting the websites of others; website design services for others; digital watermarking; graphic design services for print media in the field of entertainment; DVD menu packaging and design for others; design for others of music, video, DVD, and digital media packaging; quality control for others of the duplication, replication and distribution of digital film and video; content creation services, namely, authoring and development of interactive computer software and media content; design and development of multimedia products, namely, DVD menu design for others; retrieving digital files representing film, video, audio, picture and document content, for post-production industries; conversion of data or documents from physical to electronic media; authoring services for DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, downloadable, and online media; digital data compression; digital compression of audio and video data; film and video data digital compression; providing digital compression of media and digital data”;

– Class 45: “Product security consultation services in the motion picture, television, and advertising industries, namely, product authentication, detection of product piracy, and the recording and tracking of digital data; security printing, namely, encoding of media and digital data for use in tracking the source of unauthorized copies thereof and providing encoding and transcoding of media and digital data; encoding of motion picture, television, and advertising films for use in tracking the source of unauthorized copies thereof; providing content security for recorded media; anti-piracy rights management, namely, product security services in the motion picture, television, and advertising industries; security related technology and services, namely, tracking and tracing services used to secure, track, and trace encoded film against fraud, piracy, and counterfeiting; electronic content protection services; research and development in connection with the illegal downloading and storing of unauthorized digital motion picture, television, and advertising files”.

...

5. By decision of 13 June 2013, the examiner refused the application in relation to all the goods and services referred to in paragraph 3 above, in accordance with Article 7(1)(b) and (c) of Regulation No 207/2009, on the grounds that the mark applied for, first, lacked

*distinctive character and, second, informed consumers about the quality of the goods and services concerned.*

6. On 3 July 2013, [Deluxe] filed a notice of appeal with [EUIPO], pursuant to Articles 58 to 64 of Regulation No 207/2009, against the examiner's decision.

7. By [the decision at issue], the Second Board of Appeal of [EUIPO] ('the Board of Appeal') upheld the examiner's decision. It held, *inter alia*, that, in the parts of the European Union where English is understood, the word element 'deluxe' is not on its own capable of distinguishing the applicant's goods and services from those of its competitors, for it is a form of commonplace promotional tag and merely consists of a "claim of superior quality". It added that the term 'deluxe' falls within the category of terms that must be excluded from trade mark monopoly and that the figurative element at issue was not sufficient to confer distinctive character on the mark applied for. On those same grounds, the Board of Appeal upheld the examiner's decision in so far as he had held that the mark applied for informs consumers about the quality of the goods and services concerned. The Board of Appeal also held that that mark had not acquired distinctive character through use in the European Union.'

#### **The procedure before the General Court and the judgment under appeal**

5. By application lodged at the Registry of the General Court on 10 April 2014, Deluxe brought an action for the annulment of the decision at issue.

6. In support of its action, Deluxe raised five pleas in law, alleging infringement of the duty to state reasons, Article 7(1)(b), (c) and (3) of Regulation No 207/2009, as well as the principle of protection of legitimate expectations, acquired rights and the lawfulness of Community acts, respectively.

7. Deluxe argued that the Board of Appeal had not given reasons for the refusal to register the mark at issue in the light of each of the goods and services at issue. It stated *inter alia* that that Board had taken no account of the characteristics of each of those goods and services, although it was an essential factor in order to determine the fanciful, suggestive or allusive nature of the word 'deluxe'.

8. EUIPO contended that it followed from the expression 'without exception', used in the decision at issue, that the Board of Appeal had carried out an individual assessment of the goods and services at issue, and that it was able to rely on a general statement of reasons since all those goods and services concerned the audiovisual sector.

9. The General Court upheld Deluxe's action.

10. After having referred, in paragraphs 15 to 18 of the judgment under appeal, to the case-law of the Court of Justice, the General Court noted, in paragraphs 20 to 22 of that judgment, that, in the present case, having regard to the description of over 90 goods and services, included in eight different classes and relating to different fields, those goods and services display such differences given their nature, their characteristics, their

intended use and the way in which they are marketed that they cannot be considered as a homogenous category making it possible for the Board of Appeal to adopt a general reasoning. The Board of Appeal did not indicate that the goods and services at issue had a sufficiently direct and specific link to each other so as to form a homogenous category ('the required link').

11. As the General Court noted in paragraph 23 of the judgment under appeal, the Board of Appeal refers, in general terms, to 'the goods and services', 'all the goods and services' and to 'the goods and services at issue', but it does not refer specifically to any of the goods and services in the classes concerned, or to categories or groups thereof. Accordingly, the General Court held, in paragraph 24 of the judgment under appeal, that, by omitting to consider the distinctive character of the mark applied for, for each of the goods and services at issue, the Board of Appeal did not carry out the specific assessment required in Article 7(1)(b) of Regulation No 207/2009 in relation to the goods and services in the classes concerned and did not state reasons to the requisite legal standard in relation to the decision at issue in that respect.

12. In the context of considering EUIPO's arguments, the General Court stated, in paragraph 26 of the judgment under appeal, that it does not follow, even indirectly, from the expression 'without exception' that the Board of Appeal assessed the distinctive character of the mark applied for in the light of all the goods and services at issue. As the Court observed, the Board of Appeal merely indicated in the decision at issue that all the goods, without exception, can be presented as being of superior quality and that all the services, without exception, can be presented as providing such quality. It did not indicate that the goods and services in the classes concerned have the required link and, accordingly, did not mention any element of such a kind as to explain the recourse to a general reasoning.

13. As for EUIPO's argument that the goods and services at issue were directly linked to the audiovisual sector, the General Court noted, in paragraph 27 of the judgment under appeal, that that finding does not appear in the decision at issue. Moreover, the General Court denied the existence of the required link between certain goods and services, such as motion pictures, delivery of goods by truck, warehouse storage and warehousing services, product research and development services as well as hosting and design of websites for others. It found that, in any event, the existence of such a link is not apparent from the wording of the decision at issue. Finally, the General Court considered that the fact, supposing it were established, that the word 'deluxe' amounts to a laudatory and promotional term capable of applying to all the goods and services at issue has no bearing in that regard.

14. Consequently, the General Court annulled the decision at issue.

#### **The forms of order sought**

15. By its appeal, EUIPO claims that the Court should: – set aside the judgment under appeal;

– order the applicant before the General Court to pay the costs of the proceedings.

#### **The appeal**

16. By its appeal, EUIPO raises a single ground for appeal, alleging infringement of the first sentence of Article 75 of Regulation No 207/2009, in conjunction with Article 7(1)(b) and (2) of that regulation. This ground is divided into two parts.

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

17. By the first part of its single ground for appeal, EUIPO complains that the General Court erred in law by restricting the possibility of adopting a general reasoning only to the situation in which the goods and services form homogenous categories. EUIPO considers that the General Court cannot rule out the possibility of carrying out a general reasoning in relation to diverse goods and services where the perception of the sign in respect of each of them is uniform and, therefore, the reasoning which applies to them remains invariable.

18. Thus, according to EUIPO, it is sufficient that the goods and services designated by the application for registration have a common characteristic for a general reasoning to be allowed in respect to them. That common characteristic is that, for each of the goods and services covered, the suggestion of high quality is perceived as a mere sales argument. In the present case, the sign ‘*deluxe*’ conveys, in the same way for all those goods and services, a laudatory and promotional message incapable of allowing the public to identify the origin of those goods and services. In support of its line of argument, EUIPO relies on the reasoning adopted by the Court in the order of 11 December 2014, *FTI Touristik v OHIM* (C-253/14 P, not published, EU:C:2014:2445), in which the Court recognised that there was a sufficiently direct and specific link between the goods and services concerned in the light of a common feature which consisted of the fact that all the goods and services could be the subject of discounts or special benefits.

19. Therefore, EUIPO considers that the finding in paragraph 24 of the judgment under appeal that the Board of Appeal did not carry out the concrete assessment required, having failed to identify homogeneity between all the goods and services, is erroneous.

20. Similarly, EUIPO argues that the Court made an error in law by dismissing, in paragraph 27 of the judgment under appeal, as irrelevant, the Board of Appeal’s finding that the term ‘*deluxe*’ is a laudatory and promotional term capable of applying to all the goods and services at issue.

21. Deluxe contends that EUIPO relied to a large extent on the *BigXtra* case which gave rise to the order of 11 December 2014, *FTI Touristik v OHIM* (C-253/14 P, not published, EU:C:2014:2445), in which the registration of the mark ‘*BigXtra*’ had been refused on the ground that the term was clearly laudatory. Deluxe argues that that case is not relevant because it is distinguishable from the present case. The term ‘*deluxe*’ can be descriptive or laudatory only in relation

to the goods themselves and not in relation to the way in which they are sold, since there is no ‘*deluxe*’ way of selling a product, especially if the relevant public is taken into account.

22. By the second part of its single ground for appeal, EUIPO submits that the General Court’s interpretation of a requirement of sufficient homogeneity, in paragraphs 20 to 22 and 26 of the judgment under appeal, which allows the Board of Appeal to adopt a general reasoning for refusing the application for registration of the mark at issue, does not comply with the case-law, in particular the order of 18 March 2010, *CFCMCEE v OHIM* (C-282/09 P, EU:C:2010:153). By establishing a correlation between the existence of a ‘*homogeneous category*’ and the description of the goods and services, the General Court erroneously interprets the concept of ‘*sufficiently homogeneous category*’ or ‘*group*’ of goods or services within the meaning of that case-law and, consequently, the concept of ‘*a sufficiently direct and specific link*’ that must exist between the goods and services.

23. According to EUIPO, the requirement of sufficient homogeneity should be understood in a broader way so that it is sufficient that the goods and services all display a common characteristic, which could also exist between goods or services in different sectors.

24. EUIPO claims that, in the present case, the decision at issue indicates clearly that the common characteristic of the goods and services at issue is that all the goods, without exception, can be presented as being of superior quality and all the services, without exception, can be presented as providing such quality.

25. Deluxe challenges EUIPO’s assertion that the goods and services at issue are sufficiently homogenous and can, thereby, be considered a single group.

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

26. Given that EUIPO disputes the General Court’s assessments referred to in paragraphs 10 to 13 of the present judgment and that the two parts of the single ground for appeal allege infringement of Article 7(1)(b) and Article 75 of Regulation No 207/2009, these parts should be examined together.

27. As a preliminary point, it is apparent from settled case-law that the competent authority cannot merely carry out a minimal assessment of an application for registration, but it must, on the contrary, carry out a stringent and full examination in order to prevent trade marks from being improperly registered ([judgment of 6 May 2003, \*Libertel\*](#), C-104/01, EU:C:2003:244, paragraph 59).

28. Since registration of a mark is always sought for goods or services specified in the application for registration, the question whether registration can be refused on one of the absolute grounds must be assessed on the facts by reference to those goods or services (judgment of 15 February 2007, *BVBA Management, Training en Consultancy*, C-239/05, EU:C:2007:99, paragraph 31).

29. It must be recalled that, according to the Court’s case-law, first, the examination of the absolute grounds



for refusal must be carried out in relation to each of the goods or services for which trade mark registration is sought and, secondly, that the decision by which the competent authority refuses registration of a mark must, in principle, state reasons in respect of each of those goods or services (judgment of 15 February 2007, BVBA Management, Training en Consultancy, C-239/05, EU:C:2007:99, paragraph 34, and order of 18 March 2000, CFCMCEE v OHIM, C-282/09 P, EU:C:2010:153, paragraph 37).

30. However, as regards that last requirement, the Court has stated that the competent authority may use only general reasoning for all of the goods and services concerned where the same ground for refusal is given for a category or group of goods or services (judgments of 15 February 2007, BVBA Management, Training en Consultancy, C-239/05, EU:C:2007:99, paragraph 37, and of [17 October 2013, Isdin v Bial-Portela, C-597/12 P, EU:C:2013:672](#), paragraph 26).

31. The Court then made clear that such a power extends only to goods and services which are interlinked in a sufficiently direct and specific way, to the point where they form a sufficiently homogeneous category or group of goods or services ([judgment of 17 October 2013, Isdin v Bial-Portela, C-597/12 P, EU:C:2013:672](#), paragraph 27).

32. In order to determine whether the goods and services covered by an application for registration of an EU mark are interlinked in a sufficiently direct and specific way and can be placed in sufficiently homogeneous categories and groups, for the purposes of the case-law cited in the previous paragraph, account must be taken of the fact that the objective of that exercise is to enable and facilitate the assessment in concreto of the question whether or not the mark concerned by the application for registration comes under one of the absolute grounds for refusal, in accordance with the case-law cited in paragraph 28 of the present judgment.

33. Accordingly, the placement of the goods and services at issue in one or more groups or categories must be carried out in particular on the basis of the characteristics which are common to them and which are relevant for the analysis of whether or not a specific absolute ground for refusal may apply to the mark applied for in respect of those goods and services. It follows that such an assessment must be carried out in concreto for the examination of each application for registration and, as the case may be, for each of the different absolute grounds for refusal which may apply.

34. It follows from the foregoing considerations that it cannot be ruled out a priori that the goods and services covered by an application for registration all present a relevant characteristic for the analysis of an absolute ground for refusal and that they can be placed, for the purposes of examining the application for registration at issue in relation to that absolute ground for refusal, in a sufficiently homogeneous single category or group, for the purposes of the case-law cited in paragraph 31 of the present judgment.

35. In the present case, it is apparent from paragraph 26 of the judgment under appeal that, in relation to all the goods and services covered by the application for registration at issue, the Board of Appeal indicated that all the goods, without exception, can be presented as being of superior quality, and all the services, without exception, can be presented as providing superior quality. It follows from that consideration that the Board of Appeal, in essence, considered that all the goods and services covered by the application for registration under examination presented a characteristic which was relevant to the analysis of the absolute ground for refusal under Article 7(1)(b) of Regulation No 207/2009, namely the fact that they could be presented as having or providing superior quality and that, therefore, they were all part of a sufficiently homogeneous single category or group, for the purposes of the analysis of that absolute ground for refusal. The relevance, according to the Board of Appeal, of that common characteristic of the goods and services at issue for the purposes of the analysis that it had to carry out is demonstrated by the finding in the decision at issue that the mark applied for consisted of a *'claim of superior quality'*.

36. The Board of Appeal's failure, mentioned in paragraph 22 of the judgment under appeal, to expressly indicate that the goods and services at issue had such a sufficiently direct and specific link to each other to the point that they form a homogeneous category cannot lead to a different conclusion, since such an indication was implicit from the Board's consideration referred to in paragraph 26 of the judgment under appeal.

37. It was for the General Court, in order to check observance of the Board of Appeal's obligation to carry out to the specific assessment required by Article 7(1)(b) of Regulation No 207/2009 and to give sufficient reasons to the requisite standard, to examine, in the context of a factual assessment, the merits of the Board of Appeal's considerations noted in paragraph 35 of the present judgment.

38. In particular, it was for the General Court, first, to check whether the mark applied for, which is composed of a word element and a figurative element, was indeed capable of being perceived, directly and immediately, as a claim of superior quality or a laudatory message by the relevant public rather than as an indication of the commercial origin of the goods and services it designates.

39. Second, it was for the General Court to check, in the context of the analysis of the word element of the mark applied for, whether the term *'deluxe'* did actually convey the concept of *'superior quality'* as claimed by the Board of Appeal, given that that word element amounts to a direct reference to the concept of *'luxury'*. If the term *'deluxe'* were to have a meaning distinct to that of *'superior quality'*, as considered by the [Advocate General in paragraph 54 to 55 of his Opinion](#), the General Court would then have to examine whether or not, in the light of that meaning, the goods and services covered by the mark at issue

constitute a homogenous group justifying recourse to a general reasoning.

40. However, the General Court ruled out generally the possibility of finding the goods and services at issue to be homogenous and it did not take into account, in that regard, the specificity of the mark applied for or, in particular, of its perception by the relevant public.

41. Indeed, as is apparent from paragraph 21 of the judgment under appeal, the General Court merely found that the goods and services covered by the application for registration at issue displayed such differences as regards their nature, their characteristics, their intended use and the way in which they are marketed that they could not be considered a homogenous category enabling the Board of Appeal to adopt a general reasoning with respect to them. The General Court therefore failed to have regard to the possibility that, despite their differences, all the goods and services at issue could have a common characteristic, relevant to the analysis that the Board of Appeal had to carry out, which, in accordance with the considerations set out in paragraphs 33 and 34 of the present judgment, could justify their placement within a single homogenous group and the use by the Board of Appeal of a general reasoning in relation to them.

42. For the same reasons, the Court's assertion, in paragraph 27 of the judgment under appeal, that *'the fact that the term "deluxe" amounts to a laudatory and promotional term capable of applying to all the goods and services at issue is without consequence'* is also erroneous.

43. It follows from the foregoing that the General Court erred in law in interpreting Article 7(1)(b) and Article 75 of Regulation No 207/2009, with the result that the judgment under appeal must be set aside.

44. In accordance with the first paragraph of Article 61 of the Statute of the Court of Justice, the latter may, after setting aside the decision of the General Court, itself give final judgment in the matter, where the state of the proceedings so permits, or refer the case back to the General Court for judgment. In the present case, the state of the proceedings does not permit the Court to give final judgment.

45. The case should therefore be referred back to the General Court and the costs reserved.

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

1. Sets aside the judgment of the General Court of the European Union of 4 June 2015, *Deluxe Laboratories v OHIM (deluxe)* (T-222/14, not published, EU:T:2015:364);
  2. Refers the case back to the General Court of the European Union;
  3. Reserves the costs.
- [Signatures]

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**OPINION OF ADVOCATE GENERAL**

**CAMPOS SÁNCHEZ-BORDONA**

delivered on 25 January 2017 (1)

Case C-437/15 P

European Union Intellectual Property Office (EUIPO)

v

Deluxe Laboratories Inc.,

Deluxe Entertainment Services Group Inc.

(Appeal — European Union trade mark — Figurative mark containing the word element *'deluxe'* — Refusal of registration by the examiner)

1. Deluxe Entertainment Service Group Inc. ('Deluxe Inc.')(2) sought to register as an EU trade mark (3) the term *'deluxe'*, framed by a graphic device, to identify a significant number (more than 90) of goods and services. Its application was refused by the examiner and by the Board of Appeal of the European Union Intellectual Property Office (EUIPO) on the grounds that the trade mark applied for lacked distinctive character in relation to all those goods and services.

2. The General Court, to which Deluxe Inc. appealed against the decision of the Board of Appeal, annulled that decision by judgment of 4 June 2015 ('the judgment under appeal'), (4) finding that the Board of Appeal had erred in its reasoning because — according to the General Court — it had not conducted the prescribed examination of the distinctive character of the trade mark in relation to all the goods and services, or, at least, in relation to the categories which those goods and services might constitute.

3. EUIPO has brought an appeal against the judgment of the General Court, arguing, in essence, that the reasoning in the annulled decision was correct.

4. The appeal raises questions of various kinds relating to the distinctive character of the sign *'deluxe'*, which is imbued with certain promotional (5) or laudatory (6) overtones in relation to at least some of the goods and services it is intended to protect, and to the possibility that, when an absolute ground for refusal exists, EUIPO has the right not to conduct a detailed analysis of the relationship between the mark applied for and those goods and services.

5. In its appeal, EUIPO claims only that there has been an infringement of Article 75, in conjunction with Article 7(1)(b), of Regulation (EC) No 207/2009. (7) It does not, therefore, address in the appeal the difficulties that could arise in connection with the absolute ground for refusal of EU trade marks set out in Article 7(1)(c), a matter to which I shall return.

**I. Legislative framework**

**Regulation No 207/2009**

6. According to Article 4:

*'[An EU] trade mark may consist of any signs capable of being represented graphically ..., provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.'*

7. Under the heading 'Absolute grounds for refusal', Article 7 provides:

*'1. The following shall not be registered:*

*(a) signs which do not conform to the requirements of Article 4;*

*(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;

...

2. Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community.

...

8. Under the heading 'Statement of reasons on which decisions are based', Article 75 provides:

*'Decisions of the Office 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.'*

## II. Background to the dispute

### 1. The facts of the proceedings

9. On 10 October 2012, Deluxe Inc. lodged a Community trade mark application under Regulation No 207/2009 to register the following figurative sign:

10. That application (8) referred to the following goods and services in Classes 9, 35, 37, 39 to 42 and 45 of the Nice Agreement, (9) namely: (10)

– Class 9: *'Motion picture and television films featuring music videos, action/adventure, comedy, drama, horror, family, children, animated cartoons, sports, documentaries, commercials, science fiction, history, education, live action, computer-generated, animated, 2D, 3D, trailers, public service announcements, fiction, non-fiction, reality, and thrillers; digital media, namely, pre-recorded DVDs, HD DVDs, and pre-recorded optical discs featuring music videos, action/adventure, comedy, drama, horror, family, children, animated cartoons, sports, documentaries, commercials, science fiction, history, education, live action, computer-generated, animated, 2D, 3D, trailers, public service announcements, fiction, non-fiction, reality, and thrillers, and downloadable audio and video recordings featuring motion picture films, television shows, and video programs.'*

– Class 35: *'Inventory control and computerized tracking and tracing of packages in transit; advertising and marketing of motion pictures, television shows, and advertisements; preparing audio-visual displays in the fields of music, motion pictures, television shows, and advertisements; preparing audio-visual presentations for use in advertising; post-production editing services for video and audio commercials; product merchandising; business services, namely, outsourcing in the field of translation services, namely, providing the transfer of information relating to captions and subtitles for audio-visual works; business management of assets in the nature of television programs, motion picture films and commercials, and commercial, industrial and corporate audio-visual media content; arranging and conducting tradeshow exhibitions for commercial or advertising purposes in the fields of entertainment, television, software and video games; organizational services, namely, indexing files representing film, video, audio, picture and document content, for post-production industries; display*

*arrangement services of digital files representing film, video, audio, picture and document content, for post-production industries; inventory management, namely, locating digital files representing film, video, audio, picture and document content, for post-production industries; business management services, namely, digital and intellectual property asset management.'*

– Class 37: *'Rejuvenation services for film, tape, DVD, HD DVD, pre-recorded optical discs and other recorded, digital, downloadable, and online media, namely, cleaning of film, tape, DVD, HD DVD, pre-recorded optical discs and other recorded, digital, downloadable, and online media.'*

– Class 39: *'Deposit and transport of cameras, film, video, digital media, data processing and accessories thereto; storage and warehousing of film, digital and video media, and promotional material related to movies, television shows, and advertisements, namely, clothing, posters, and movie, television show, and advertisement cut-outs; electronic storage of digital and video images, digital cinema and sound recordings; storage of motion pictures, television shows, advertisements, digital cinema, DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, and online media; storage of master video discs, audio tapes, and CD-ROMs of music and images; media management, namely, moving, archiving, and transporting digital files representing film, video, audio, picture and document content, for post-production industries; packing articles for transportation; delivery of goods by truck; warehouse storage; and warehousing services; merchandise packaging for others ..., namely, packaging music, videos, DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, downloadable, and online media and custom packaging services for sound, video, and data recordings, to the order and specification of others.'*

– Class 40: *'Duplication and replication of motion picture films, television shows, advertisements, and video programs on film, videotape, DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, downloadable, and online media; mastering and duplication of positive and negative motion picture prints to videotape, DVD, HD DVD, pre-recorded optical discs and other recorded, digital, downloadable, and online media; cutting of negatives; rental of printing machines and apparatus for industrial development and printing in the photographic, cinema and television industries; colour enhancement of black and white cinematic film; closed captioning of films and videos; digital correction services of videos, and digital video transfer, namely, providing colour correction and conversion of motion picture, television, and advertising film to video film; film and any other video media reproduction, namely, remastering of films from one format to another; and contract manufacturing in the field of digital versatile discs; duplication of video-tape, DVD, HD DVD, pre-recorded optical discs and other recorded, digital, downloadable, and online media in all professional*

formats; video services, namely, mastering and duplication of professional video tape, DVD, HD DVD, pre-recorded optical discs and other recorded, digital, downloadable, and online media formats; film development services; film to videotape, DVD, HD DVD, pre-recorded optical discs and other recorded, digital, downloadable, and online media transfer services, namely, conversion of motion picture, television, and advertising film to videotape, DVD, HD DVD, pre-recorded optical discs and other recorded, digital, downloadable, and online media. film and other video media back-up services, namely, digital preservation and restoration of cinematic films; printing services for sound, video, and data recordings; processing and printing of motion picture, television and advertising films; conversion of motion picture, television, and advertising film from 2D to 3D; operation of laboratories for the processing of motion picture, television, and advertising films; formatting and conversion of media and digital data; digital conversion of motion picture, television, and advertising films to videotapes, DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, and online media; film to tape digital transfer services, namely, transferring film to DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, downloadable, and online media.'

– Class 41: 'Motion picture, television, and advertising film, videotape and digital video laboratory and post-production services, namely, high-resolution scanning of film, digital colour timing, laser film recording of digital video and high definition images to film; digital and video mastering services for motion pictures, television shows, and advertisements; digital imaging; digital and electronic manipulation of images for motion pictures, television shows, and advertisements; recording digital images onto film; video and audio media production, namely, production of video cassettes and DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, downloadable, and online media for others; production of visual, optical and digital special effects for others, for television, motion pictures, advertisements, DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, downloadable, and online media, namely, digital cinema; audio recording and production; film editing services; electronically producing motion picture, television, and advertising film from videotape, DVD, HD DVD, pre-recorded optical discs and other recorded, digital, downloadable, and online media recordings; producing special visual effects for videotapes, DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, downloadable, and online media; production and distribution of motion pictures, television shows, and advertisements; providing voice-overs for videotapes, records, DVDs, HD DVDs, prerecorded optical discs and other recorded, digital, downloadable, and online media; consulting services in connection with film production and distribution; production of master video discs, audio tapes, and CD-ROMS of music and images;

arranging for distribution or syndication of motion pictures, television shows, and advertisements. distribution services for film, tape, DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, downloadable, and online media; video editing services; dubbing services and film editing; video and sound track for cinema, television and advertisements.'

– Class 42: 'Design and development of computer software; product research and development; hosting the websites of others; website design services for others; digital watermarking; graphic design services for print media in the field of entertainment; DVD menu packaging and design for others; design for others of music, video, DVD, and digital media packaging; quality control for others of the duplication, replication and distribution of digital film and video; content creation services, namely, authoring and development of interactive computer software and media content; design and development of multimedia products, namely, DVD menu design for others; retrieving digital files representing film, video, audio, picture and document content, for post-production industries; conversion of data or documents from physical to electronic media; authoring services for DVDs, HD DVDs, pre-recorded optical discs and other recorded, digital, downloadable, and online media; digital data compression; digital compression of audio and video data; film and video data digital compression; providing digital compression of media and digital data.'

– Class 45: 'Product security consultation services in the motion picture, television, and advertising industries, namely, product authentication, detection of product piracy, and the recording and tracking of digital data; security printing, namely, encoding of media and digital data for use in tracking the source of unauthorized copies thereof and providing encoding and transcoding of media and digital data; encoding of motion picture, television, and advertising films for use in tracking the source of unauthorized copies thereof; providing content security for recorded media; anti-piracy rights management, namely, product security services in the motion picture, television, and advertising industries; security related technology and services, namely, tracking and tracing services used to secure, track, and trace encoded film against fraud, piracy, and counterfeiting; electronic content protection services; research and development in connection with the illegal downloading and storing of unauthorized digital motion picture, television, and advertising files.'

11. By decision of 13 June 2013, the examiner refused the application in relation to all the goods and services referred to therein, on the grounds that, in accordance with Article 7(1)(b) and (c) of Regulation No 207/2009, the trade mark 'deluxe' lacked distinctive character and informed consumers about the quality of the goods and services concerned.

12. In an appeal before OHIM against the examiner's decision, the Second Board of Appeal of OHIM, in its decision of 22 January 2014 ('the contested decision'),

upheld the examiner's decision on the basis of Article 7(1)(b) of Regulation No 207/2009, and also accepted the examiner's arguments in relation to Article 7(1)(c).

13. Inter alia other points, the Board of Appeal held that, in the parts of the European Union where English is understood, the word element '*deluxe*' is not on its own capable of distinguishing the applicant's goods and services from those of its competitors, for it is a form of commonplace promotional tag and merely consists of a '*claim of superior quality*'. The Board of Appeal further held that the term '*deluxe*' falls within the category of terms that must be exempt from trade mark monopoly and that the accompanying graphic element was not sufficient to confer distinctive character on the mark applied for. On those grounds, the Board of Appeal upheld the examiner's decision in relation to the declaration that that mark informs consumers about the quality of the goods and services concerned. Finally, the Board of Appeal rejected the claim that the mark had acquired distinctive character through use in the European Union.

## **2. The judgment under appeal**

14. Disagreeing with the decision of the Board of Appeal, Deluxe Inc. brought an action against it before the General Court on 10 April 2014.

15. The action was formulated in terms of five infringements which Deluxe Inc. attributed to the contested decision and on which it based five pleas for annulment. Deluxe Inc. claimed that the Board of Appeal had infringed the following provisions of Regulation No 207/2009: (1) Article 75, which obliges EUIPO to state reasons for its decisions; (2) Article 7(1)(b), in relation to the distinctive character of the sign; (3) Article 7(1)(c), in relation to the descriptiveness of the sign; (4) Article 7(3), in relation to the possible acquisition of distinctive character through use; and (5) the principles of protection of legitimate expectations, protection of acquired rights and the lawfulness of Community measures.

16. The General Court conducted a joint examination of only the first two pleas in law; (11) in upholding those pleas, the General Court annulled the contested decision and ordered EUIPO to bear the costs.

17. The judgment under appeal drew attention to the case-law of the Court of Justice pursuant to which, when it is sought to register a mark for various goods or services, the Board of Appeal must specifically determine that none of the grounds for refusal of registration listed in Article 7(1) of Regulation No 207/2009 applies to the mark in question, in relation to each of those goods or services claimed, and may reach conclusions that differ, depending upon the goods or services in question. Therefore, when refusing registration of a trade mark, the Board of Appeal is obliged to state in its decision its conclusion for each of the goods and services specified in the application for registration, regardless of the manner in which that application was formulated. However, where the same ground for refusal is given for a category or group of goods or services, the competent authority may limit

itself to using general reasoning for all of the goods or services concerned. (12)

18. According to the General Court, the Board of Appeal examined the distinctiveness of the sign '*deluxe*' without referring to each of the goods and services included in the application in relation to classes 9, 35, 37, 39 to 42 and 45. The General Court found, therefore, that the Board of Appeal had used general reasoning for all those goods and services without indicating that they had such a sufficiently direct specific link to each other as to form a uniform category, which was contrary to the case-law.

III. Proceedings before the Court of Justice and the forms of order sought by the parties

19. The appeal lodged by EUIPO was received at the Registry of the Court on 10 August 2015 and the defence lodged by Deluxe Inc. was received on 25 April 2016.

20. EUIPO claims that the Court should set aside the judgment under appeal and order Deluxe Inc. to pay the costs

21. Deluxe Inc. claims that the Court should dismiss the appeal and order EUIPO to pay the costs of Deluxe Inc. in both sets of proceedings.

22. At the request of Deluxe Inc., in accordance with Article 76(1) of the Rules of Procedure, a hearing was held on 9 November 2016, at which both parties presented oral argument.

## **IV. Arguments of the parties**

23. The appeal is based on a single ground divided into two parts. In the first part, EUIPO complains that the General Court erred in law, by limiting the Office's right to provide a general statement of reasons for its decisions, by restricting it solely to the case in which the goods and services form uniform categories. EUIPO contends that when a sign like '*deluxe*' directly conveys a laudatory message applicable to all the industry and service sectors, a general statement of reasons is acceptable for rejecting that sign. That statement of reasons enables the person to whom it is addressed to counter the reasons relied upon and the General Court to exercise its powers of judicial review.

24. Nor, according to EUIPO, does the uniformity of the goods and services constitute a *sine qua non*: the existence of a common feature is sufficient in order for a general statement of reasons to be accepted for all of them. In this case, the common feature is that every one of the goods and services, without exception, could be of high or low quality, with the result that the indication of superior quality, inherent in the term '*deluxe*', will be perceived in respect of all of them as a mere selling point.

25. EUIPO relies for support upon the Court's reasoning in *BigXtra*, (13) in which the Court recognised that there was a sufficiently direct and specific link between the goods and services concerned (14) (in that they could all be the subject of discounts or special benefits), which allowed a general statement of reasons. In the light of that common feature, the sign '*BigXtra*' would be construed as an indication of the



high quality of those goods and services; in other words, it would be regarded as an advertising pledge.

26. In EUIPO's view, in finding that the contested decision was vitiated by a lack of reasoning, (15) the judgment under appeal diverges from the case-law of the Court. The General Court erred in law in denying the importance of the laudatory and promotional nature of the sign '*deluxe*', applicable to all the goods and services at issue.

27. EUIPO maintains that the Board of Appeal gave a sufficient explanation of the reasons why '*deluxe*' lacks distinctive character in relation to every one of the goods and services. Those reasons enabled (16) Deluxe Inc. to dispute that the sign claimed had necessarily to be perceived as a mere indication of excellence or as promotional praise for its superior quality.

28. EUIPO submits that to require the Board of Appeal to make a detailed examination of goods and services (including by category) would lead to systematic formal repetition of the basic ground for refusal, namely, that the sign lacks distinctive character in relation to each and every one of them. That repetition would add nothing new to the argument on which the refusal to register the mark is based (its lack of distinctive character).

29. Lastly, EUIPO claims that, in a series of judgments, the General Court recognised the lack of distinctive character of certain slogans in relation to a variety of goods and services when the perception of the sign as an ordinary advertising message was immediately applicable without exception to all those goods and services. (17)

30. In the second part of the single ground of appeal, EUIPO puts forward a broad definition of uniformity for the purposes of the general statement of reasons. It is sufficient that the goods and services concerned should have a common feature, which could also exist between goods and services belonging to completely different sectors, without necessarily being derived from the similarity of the goods and services according to their nature or purpose. EUIPO disputes that it is necessary to establish, as the judgment under appeal did, (18) a correlation between the existence of a '*uniform category*' and the description of the goods and services.

31. EUIPO submits that, although the case-law (19) requires a sufficiently direct and specific link between the goods and services in order to form a sufficiently uniform category (which enables a general statement of reasons), it does not state what the nature of the link must be, but simply that there must be such a link. In that connection, EUIPO further contends that it cannot be inferred from the case-law (20) that the relevant criteria for assessing uniformity are exhaustively predetermined or that they are cumulative.

32. In requiring, in the judgment under appeal, the criterion of uniformity to be derived from the description of the goods and services for which Deluxe Inc. sought trade mark protection, the General Court misinterpreted the concept of a '*sufficiently uniform*' category of goods or services, used in the case-law,

and, consequently, the concept of '*sufficiently direct and specific link*', which is necessary for the formation of such a category of goods.

33. However, even though it is not inferred directly from the description of the goods and services, the common feature identified in this case by the Board of Appeal (namely, that '*all the goods can be advertised as possessing "superior" quality, while all the services can be advertised as providing "superior quality"*'), (21) in the sense of being an exclusive feature defining those goods and services, constitutes a sufficient criterion for finding that they all form a uniform category so that a general statement of reasons is permitted. The General Court did not explain the reasons why that common feature did not represent a sufficiently direct and specific link.

34. Deluxe Inc. rejects EUIPO's arguments. In particular, Deluxe Inc. denies that its mark is laudatory in relation to the goods and services concerned, from the point of view of the relevant public.

35. As regards the first part of the ground of appeal, Deluxe Inc. argues that the Office incorrectly relied upon the order in *BigXtra*, (22) a case which cannot be treated as similar to the present case, given that it was found in it that the sign *BigXtra* praised the methods of selling the goods. Deluxe Inc. also rejects the applicability of the judgments relating to slogans, cited by EUIPO, (23) because they deal with situations different from that now in issue.

36. As regards the second part of the ground of appeal, Deluxe Inc. contends that the goods and services for which it sought to register the sign are not homogenous and that, in any event, EUIPO has at no time given any reason why they would be. Because it believes that the real key to this dispute lies in the laudatory character of the sign at issue, Deluxe Inc. provides examples of services and goods in respect of which the word '*deluxe*' does not have a laudatory connotation.

37. At the hearing, Deluxe Inc. complained that EUIPO had merely applied a too general presumption to all the goods and services claimed, to the effect that the term '*deluxe*' does not have distinctive effect.

38. In order to substantiate its argument that, in this case, a detailed examination ought to have been made of the meaning of the word '*deluxe*' in relation to at least some of the goods and services, Deluxe Inc. observed that: (a) on the one hand, those goods and services include some that lack a sufficient quality spectrum to suggest that, where they are claimed for the mark, that term is capable of evoking their high quality or luxury; (24) and (b) on the other hand, the consumers likely to purchase those goods and services comprise specialist professionals who have a high level of attention and who would not regard the word '*deluxe*' as a reference to the high quality of the goods and services concerned. Deluxe Inc. submits that, in those circumstances, it was not open to the General Court to reject indiscriminately the claim that the mark had distinctive character without examining that character in relation to the goods and services concerned.

## V. Legal analysis

39. It seems to me more appropriate to deal jointly with the two errors of law alleged in the single ground of appeal. To separate them is too artificial, because, strictly speaking, they constitute the same legal complaint and the dispute concerns a quite specific issue: whether or not the general statement of reasons on which the decision adopted by EUIPO is based is apt in this case. The interpretation of a '*sufficiently uniform category [of goods or services]*', to which that statement of reasons could be applied, is simply another (secondary) aspect of that debate.

40. The case-law principles laid down by the Court in this area are explained — correctly, to my mind — in the judgment under appeal. (25) I shall use them as the starting-point for tackling the examination of the appeal, after summarising their essential features.

41. When, for the purposes of Article 7(1)(b) of Regulation No 207/2009, EUIPO examines the distinctive character of a sign for which registration has been sought for various goods or services: (a) it checks whether the sign serves to identify those goods or services as coming from a particular undertaking and to distinguish them from those of other undertakings; (26) (b) if the sign does have distinctive character, EUIPO must examine this in relation to the goods and services claimed and may reach different conclusions for each one; (27) and (c) if registration is refused, the decision must, in principle, state reasons in respect of each and every one of those goods or services. (28)

42. However, those rules permit an important exception: if EUIPO finds that the same ground of refusal may be extended to a category or group of goods or services, it may confine itself to purely general reasoning for all of the goods or services concerned. (29)

43. Admittedly, the case-law stresses the necessity of assessing distinctiveness by reference to the perception of the relevant public, (30) a point which, although of lesser importance, may have a bearing on the dispute.

44. EUIPO submits that, in requiring a statement of reasons for the refusal of the mark '*deluxe*' in relation to each of the goods and services claimed, the General Court erred in law, for the laudatory nature of the word warranted a general assessment. In that connection, EUIPO criticises the application of the concept of a '*sufficiently uniform*' category of goods or services in the judgment under appeal, which it considers contrary to case-law.

45. Expressed in those terms, the difficulty can best be understood if its placed, within the chronology of the proceedings, at the time at which EUIPO examines the sign for which registration is sought.

46. As I have already observed, at that initial stage, EUIPO has to check specifically that the sign is not caught by any of the grounds for refusal laid down in Article 7(1) of Regulation No 207/2009, in relation to goods and services. The examination of whether a sign is distinctive must be rigorous and full, in other words, not restricted to a minimal examination, (31) which would be contrary to the principles of legal certainty

and good administration, which preclude the improper registration of marks that do not fulfil the legal criteria. (32)

47. A specific case is that of marks claimed which are composed '*of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by that mark*'. The Court does not categorically prohibit their registration. (33)

48. The Court has held that '*the laudatory connotation of a word mark does not mean that it cannot be appropriate for the purposes of guaranteeing to consumers the origin of the goods or services which it covers. Thus, such a mark can be perceived by the relevant public both as a promotional formula and as an indication of the commercial origin of goods or services. It follows that, in so far as the public perceives the mark as an indication of that origin, the fact that the mark is at the same time understood, perhaps even primarily understood, as a promotional formula has no bearing on its distinctive character.*' (34)

49. Those quotations are from case-law relating to applications for word marks composed of indications or signs used as slogans or indications of quality. Although the Court acknowledged the '*difficulties in establishing distinctiveness which may be associated with word marks consisting of advertising slogans ... — difficulties which it is legitimate to take into account*', it found no justification for analysing such marks using '*specific criteria supplementing or derogating from*' the general criteria. (35)

50. If that is so, then a fortiori the general criteria must be applied in order to assess the distinctive character of marks that, in addition to word elements, contain graphic, that is to say, figurative, elements. That is precisely the situation at issue in the instant case, in which registration was sought of a mark composed of one phonetic or word element (the word '*deluxe*') and another graphic element (a circle with a background in the colour red fading at the rim and the word inside it).

51. Naturally, there may be signs that are completely devoid of distinctive character. These are likely enough to include some slogans and even more likely to include certain laudatory indications. It is logical that, if such slogans and indications are vitiated by clear incapacity, or inherent inaptness, to produce distinctive effects, the competent authorities are to reject them without any subsequent — and pointless — checks relating to the goods and services for which protection was sought.

52. I believe that EUIPO is right to argue, in the abstract, that that approach is valid, for once a complete lack of distinctive character has been established, applicable generally to all types of goods and services, it is impossible to see what reasons there would be for requiring a subsequent assessment of that (lack of) distinctive character, this time in relation to certain individual goods or services. From that same perspective, refusal of the new mark would be sufficiently substantiated and a decision finding that the

mark applied for clearly and fully (*'universally'*) lacked distinctive character would be sufficiently reasoned.

53. The case-law cited in the judgment under appeal should be qualified, therefore, when it is so certain that a sign cannot distinguish the goods and services of one undertaking from those of another that this may be classified, without risk of error, as a clear lack of distinctive character, regardless of the goods or services concerned.

54. However, those conditions are not satisfied in the case of the mark *'deluxe'*, for two reasons. The first (perhaps more important) reason is that, in this case, what the public might perceive as an indication of high quality is a mixed or figurative sign which, by its very nature, requires a sensory or intellectual effort in addition to the mere reception of the laudatory message. That effort may constitute one of the factors which tip the balance in favour of the mark *'deluxe'* having distinctive character, at least in relation to some of the goods or services for which protection was claimed.

55. The second reason relates to the meaning of the word *'deluxe'*, which specifically (and in some countries only) denotes sumptuousness or ostentatiousness, qualities which may be attributed to certain goods or services (36) but not to others, whose use is in itself inherently different. (37) That is why it was logical to presume that the sign for which registration as a Community trade mark was sought could have distinctive character, at least as regards some of those goods or services.

56. This was, furthermore, accepted by several national offices of EU Member States (and of other countries) (38) and by EUIPO itself with regard to the trade mark *'deluxe'* (39) and other similar marks, in relation to various goods and services. It is true that those precedents are not binding, but they may be assessed as evidence that the sign applied for did not warrant the initial, all-encompassing refusal by EUIPO (which did not take account of the sign's relationship with particular goods and services), based on the sign's total lack of distinctive character. (40)

57. Indeed, the case-law has accepted that the practice in a given Member State, in so far as it may be relevant for the purposes of assessment at EU level, is no more than a helpful indication to which the Office may have regard when assessing a sign's distinctiveness. (41)

58. More specifically, as the Court has acknowledged, in opposition proceedings, *'nor is it possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of [the directives (42) to approximate the laws of the Member States relating to trade marks]'*. (43)

59. The considerations set out above are, in my view, sufficient to exclude the hypothesis leading to the subsequent development of the ground of appeal. That is based on a premiss (that the sign *'deluxe'* is completely devoid of distinctive character in relation to

any goods or services) (44) that simply cannot be regarded as established. Failing that fundamental condition, the appeal is, in itself, bound to fail, because when a sign may serve to identify goods and services, EUIPO, in its review prior to registration of the mark, must check (stating reasons) whether there is distinctive character in respect of those goods and services, separately or grouped into categories.

60. I shall therefore deal, in the alternative, (45) with EUIPO's criticism of the judgment under appeal specifically in relation to the reasoning set out in the decision adopted by the Board of Appeal and in relation to the concept of *'uniform category'*, while also noting that I find a certain lack of coherence in its position, because: either the term *'deluxe'* lacks minimum distinctive character, in which case it is irrelevant whether or not the goods and services covered by it may fall into one or more groups or categories and what the defining element of those groups or categories is, or, on the contrary, if that term can have distinctive character in some cases, it is essential to examine (separately or by categories) the relevant goods and services, which EUIPO did not do.

61. The General Court found that the laudatory and promotional character of the term *'deluxe'* (*'supposing this to have been established'* [free translation]) (46) did not justify the general statement of reasons provided by the Board of Appeal. (47) In that finding I discern no error of law, for, on the one hand, according to the case-law cited above, a laudatory or promotional sign may not per se be found to lack distinctive character, and, on the other, the General Court did not deny that EUIPO has the right to provide a general statement of reasons, but rather held that, in order to do so, EUIPO must declare that a sign lacks distinctive character for reasons in addition to the mere fact that the sign falls within the category of advertising and laudatory messages.

62. Moreover, when it analysed the goods and services in the application lodged by Deluxe Inc., (48) the General Court found that these could be grouped into at least seven categories, as a reading of their description revealed that there were considerable differences between those goods and services as regards their nature, their characteristics, their intended use and the way in which they are marketed. (49) Next, (50) the General Court found that the examination had not been carried out in respect of each and every one of the goods and services (or the possible categories comprised by them) and that the Board of Appeal had not held that there was such a sufficiently direct and specific link between those goods and services that they formed a uniform category.

63. The Court set out the relevant criteria for determining whether goods and services are homogenous in paragraph 46 of the order in *CFCMCEE v OHIM*, (51) where it analysed and confirmed that the criteria which the General Court had taken into account, namely, the characteristics, the essential qualities and the purposes of those goods and services, were appropriate and correct.



64. The ruling of the General Court in the judgment under appeal simply relies on the criteria confirmed by the Court of Justice in the order in CFCMCEE v OHIM; (52) in other words, it takes into account the characteristics, the essential qualities and the purposes of those goods and services in order to draw attention to the differences between them. (53) In short, it follows the guidelines in the case-law referred to and commits no error of law in that connection.

65. It is true that for the Board of Appeal, the reason why the sign lacked distinctiveness in relation to the goods and services was that all those goods and services, *'without exception'*, (54) could be advertised as possessing superior quality. EUIPO submits that it is not an essential requirement that the feature common to all the goods and services should be apparent from their description: a sufficient and direct link, capable of forming the different goods and services into a *'sufficiently uniform category'*, will be enough.

66. Therefore, the real aim of the appeal is actually to extend that case-law so that it accepts as a criterion also the common feature to which EUIPO refers, that is to say: that all the goods and services could be advertised as possessing *'superior quality'*.

67. I do not agree with that suggestion by EUIPO which, to my mind, confuses the two stages of the procedure for examination of distinctive character. When the perception of the public is assessed, the point is to determine whether that public would identify, in the laudatory message, the commercial origin of the goods and services or whether it would instead perceive the laudatory message as a mere indication of quality. However, in order to establish categories of products in respect of which the distinctive character of the mark may be identified, it is essential that the link must be derived from those goods themselves, that is to say, from their common qualities, their particular characteristics and their functions.

68. In other words, it is necessary, first, to identify and, where appropriate, to classify the intrinsic elements and links which group the different goods and services into categories, and then to compare these categories with the sign whose distinctive character is under examination. Only if a common element is identified in those goods and services, which enables them to be regarded as having a certain degree of uniformity, will it be possible to make the general assessment of the distinctive character of the mark in relation to the uniform category, so determined, of those goods and services. (55)

69. The allegedly common feature of the goods and services which the mark *'deluxe'* is intended to protect is, in EUIPO's submission, inferred from the laudatory message itself. However, that conclusion does not, I stress, follow from the analysis of the goods and services but on the analysis of the sign in relation to the relevant public. In order to create uniform categories of goods and services, regard must of necessity be had to the characteristics of the goods and services for which protection is sought, for the intrinsic elements that may be compared in order to establish similarities and

differences can come from those goods and services alone. Finally, that approach is more objective and, therefore, provides economic operators with greater legal certainty.

70. Therefore, I do not agree with the arguments put forward by EUIPO, seeking to extend, in the manner set out above, the method of identifying direct concrete links making various goods and services homogenous so that these can be the subject of a general assessment for the purposes of the examination of distinctive character. Having rejected that possibility, since it used the criteria confirmed by the order in CFCMCEE v OHIM (56) (the characteristics, the essential qualities and the purposes of the goods and services) to draw attention to the differences between those goods and services, the General Court to that extent followed the case-law referred to above, without committing any error of law.

71. EUIPO also relies in support of its appeal upon the order of the Court in the case concerning the mark *'BigXtra'*. (57) However, paragraphs 48 and 49 of that order do not refer to the essential requirement of a sufficiently direct and specific link between the goods and services at issue in that case, but rather to the complaint that, according to the appellant in that case, the General Court had reversed the burden of proof in order to establish that no absolute ground for refusal existed.

72. In the judgment under appeal in that case, (58) the General Court merely rejected the appellant's argument claiming that the Board of Appeal had failed to examine whether the sign was distinctive in relation to the goods and services claimed. In the subsequent appeal, the question was not, therefore, put before the Court whether the fact that all the goods and services were eligible for large price reductions, substantial benefits or a special allowance would suffice as a link between those goods and services, but only the claim regarding the distribution of the burden of proof, which it did not uphold, thereby confirming the judgment under appeal. Accordingly, the order of the Court of Justice in *BigXtra* (59) may not be extrapolated to the instant case.

73. Nor do I agree with the argument that not accepting the proposal to extend the case-law, in the terms suggested by EUIPO, would lead to unnecessary repetition in its decisions of the basic grounds for refusal for all of the goods and services. That consequence is not obligatory or inevitable, given that it is not required by the judgment under appeal, nor is it inconceivable that the same grounds for refusal will be valid for different categories of goods and services, in which case common reasoning could simply be expounded regarding that validity.

74. Finally, I would like to return briefly, as I indicated I should at the beginning of this Opinion, (60) to subparagraph (c) of Article 7(1) of Regulation No 207/2009. It is that subparagraph, rather than subparagraph (b) (the only subparagraph relied upon in the appeal), that sets out the absolute grounds for refusal relating to descriptive signs; that is to say, the

case of trade marks that *'consist exclusively of signs or indications which may serve, in trade, to designate the ... quality ... or other characteristics of the goods or service'*.

75. As I pointed out above, the General Court exercised the right it has not to examine the other pleas for annulment when it accepts one of those pleas (in this case, the plea relating to Article 7(1)(b)), for which reason the General Court did not examine the plea alleging infringement of Article 7(1)(c). Admittedly, the Court of Justice has also acknowledged that there is a partial overlap between the scope of Article 7(1)(b) and the scope of Article 7(1)(c), drawing attention to the difference between the two subparagraphs, which is that the former covers all the circumstances in which a sign is not apt to distinguish the goods or services of one undertaking from those of other undertakings, (61) which could support the decision taken in the judgment under appeal not to examine the plea for annulment relating to subparagraph (c).

76. However, in the interests of the correct application of Article 7(1) of Regulation No 207/2009, the same case-law qualified that finding by stressing the necessity of the ground for refusal set out in Article 7(1)(c) continuing to be applied only to the situations specifically covered by that ground for refusal. (62) That assertion must be viewed in conjunction with the underlying public interest that trade marks consisting exclusively of a sign or indication that may serve to designate the characteristics of goods or a service, within the meaning of that provision, must be freely available to all and not be registrable. (63)

77. I believe, however, that if a decision is challenged in reliance upon the two grounds for refusal in Article 7(1)(b) and (c), the overlapping of the scope of those two subparagraphs makes it preferable for the General Court to deal with both grounds, even if it upholds only one of them. As other Advocates General have done, I propose too that the examination should begin with subparagraph (c), (64) regard being had to the fact that it is preferable, in the legislative context of the EU Trade Mark Regulation, neither to conflate the two criteria nor to view them as inherently interdependent. (65)

78. Although the existence of one absolute ground for refusal will be enough for registration to be refused, (66) an examination of, and a ruling on, the other grounds relied upon may, in cases of annulment, prevent its being necessary to embark on a new challenge.

79. At all events, the arguments put forward by EUIPO regarding the lack of distinctive character of the sign at issue being based on its constituting an expression of superior quality, the considerations set out above are applicable for the purposes of both Article 7(1)(b) and Article 7(1)(c) (*'indication of quality'*) of Regulation No 207/2009.

80. In summary, I believe that the sole ground of appeal cannot be upheld, for the errors in law imputed to it by EUIPO are not to be found in the judgment under appeal, and that the appeal must be dismissed.

## VI. Conclusion

81. In the light of the foregoing considerations, I propose that the Court should:

- (1) dismiss the appeal brought by the European Union Intellectual Property Office (EUIPO) against the judgment of the General Court of 4 June 2015 in Case T-222/14 *Deluxe Laboratories v OHIM (deluxe)*;
- (2) order EUIPO to bear the costs of Deluxe Entertainment Services Group Inc.

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1. Original language: Spanish.
  2. Successor to Deluxe Laboratories Inc.
  3. The term *'EU trade mark'* complies with Article 1(2) of Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonisation in the Internal Market (Trade marks and Designs) (OJ 2015 L 341, p. 21). I shall use the terms *'European Union trade mark'* and *'EU trade mark'* interchangeably.
  4. Judgment of 4 June 2015, *Deluxe Laboratories v OHIM (deluxe)*, T-222/14, not published, EU:T.2015:364.
  5. There is a substantial body of case-law of the Court of Justice on trade marks which include advertising slogans. See, inter alia, judgments of 21 October 2004, *OHIM v Erpo Möbelwerk*, C-64/02 P, EU:C:2004:645, paragraph 35, and of 21 January 2010, *Audi v OHIM*, C-398/08 P, EU:C:2010:29, paragraph 45.
  6. Of the case-law on laudatory signs, see judgment of 13 January 2011, *Media-Saturn-Holding v OHIM*, C-92/10 P, not published, EU:C:2011:15, paragraph 51, and order of 11 December 2014, *FTI Touristik v OHIM*, C-253/14 P, not published, EU:C:2014:2445, *'BigXtra'*, paragraph 35.
  7. Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1). Regulation No 2015/2424 is not applicable *ratione temporis*.
  8. The application was published in Community Trade Marks Bulletin No 2009/044 of 16 November 2009.
  9. Concerning the International Classification of Goods and Services for the purposes of the Registration of Marks of 15 June 1957, as revised and amended.
  10. [Translator's note: footnote not relevant to English translation].
  11. See paragraphs 22 to 24 of the judgment under appeal.
  12. The General Court cited, inter alia, the order of 18 March 2010 in *CFCMCEE v OHIM*, C-282/09 P, EU:C:2010:153, paragraphs 37 and 38, and, by analogy, also the judgment of 15 February 2007, *BVBA Management, Training en Consultancy*, C-239/05, EU:C:2007:99, paragraphs 32, 34 and 38.

13. Order of 11 December 2014, C-253/14 P, not published, EU:C:2014:2445, paragraphs 48 and 49.
14. In that case, the goods and services for which trade mark protection was claimed belonged to Classes 16, 35, 39, 41, 42 and 43 of the Nice Agreement.
15. See, in particular, paragraphs 23 and 24 of the judgment.
16. Thereby fulfilling the obligation to state reasons.
17. Judgments of 12 March 2008, *Suez v OHIM* (Delivering the essentials of life), T-128/07, not published, EU:T:2008:72, paragraph 33; of 25 March 2014, *Deutsche Bank v OHIM* (Leistung aus Leidenschaft), T-539/11, not published, EU:T:2014:154, paragraph 16; and of 12 December 2014, *Wilo v OHIM* (Pioneering for You), T-601/13, not published, EU:T:2014:1067, paragraph 37.
18. In paragraphs 20 and 21 thereof.
19. Paragraph 17 of the judgment under appeal, which refers to the order of 18 March 2010, *CFCMCEE v OHIM*, C-282/09 P, EU:C:2010:153, paragraph 40, and to the judgments of 2 April 2009, *Zuffa v OHIM* (ULTIMATE FIGHTING CHAMPIONSHIP), T-118/06, EU:T:2009:100, paragraph 28, and of 23 September 2009, *France Télécom v OHIM*, T-396/07, not published, EU:T:2009:353, paragraph 28.
20. Referring to the order of 18 March 2010, *CFCMCEE v OHIM*, C-282/09 P, EU:C:2010:153, paragraph 46.
21. Paragraph 23 of the contested decision.
22. Order of 11 December 2014, C-253/14 P, not published, EU:C:2014:2445.
23. See point 29 of this Opinion and the associated footnote.
24. Deluxe Inc. cited the following by way of example: digital and intellectual property asset management (Class 35); deposit and transport of cameras (Class 39); operation of laboratories for the processing of motion picture, television and advertising films (Class 40); retrieving digital files representing film content (Class 42); and research and development in connection with the illegal downloading and storing of unauthorised digital motion picture, television and advertising files (Class 45).
25. In particular, in paragraphs 15 to 18 thereof.
26. Judgment of 8 May 2008, *Eurohypo v OHIM*, C-304/06 P, EU:C:2008:261, paragraph 59.
27. Judgment of 15 February 2007, *BVBA Management, Training en Consultancy*, C-239/05, EU:C:2007:99, paragraph 32 and the case-law cited.
28. Order of 18 March 2010, *CFCMCEE v OHIM*, C-282/09 P, EU:C:2010:153, paragraph 37 and the case-law cited.
29. Order of 18 March 2010, *CFCMCEE v OHIM*, C-282/09 P, EU:C:2010:153, paragraph 38 and case-law cited.
30. The General Court correctly makes this observation at paragraph 18 of the judgment under appeal.
31. The Court has implicitly rejected that the competent authority may carry out a review of distinctive character limited to the minimum expression of that concept, which would allow it to register any sign provided that it was able even slightly to differentiate it from the signs of competitors. See the judgment of 19 September 2002, *DKV*, C-104/00 P, EU:C:2002:506, paragraphs 13 and 20.
32. Judgment of 6 May 2003, *Libertel*, C-104/01, EU:C:2003:244, paragraph 59 and the case-law cited.
33. Judgment of 21 October 2004, *OHIM v Erpo Möbelwerk*, C-64/02 P, EU:C:2004:645, paragraph 41.
34. Judgment of 21 January 2010, *Audi v OHIM*, C-398/08 P, EU:C:2010:29, paragraph 45.
35. Judgment of 21 January 2010, *Audi v OHIM*, C-398/08 P, EU:C:2010:29, paragraph 38.
36. EUIPO has attempted to equate luxury with superior quality but that semantic association is neither clear nor inevitable. There may be goods, including everyday consumer goods, which are of high quality (for example, water) but are not necessarily luxury goods. On the other hand, it is possible to imagine luxury goods or services (especially, by reference to their rarity or unusualness) which are not necessarily of exceptional quality.
37. It would be difficult to refer, for example, to a 'luxury' system for digital data compression or a 'luxury' system for tracking pirated digital content, to mention just two of the services which the disputed mark was intended to protect.
38. At the hearing, Deluxe Inc. confirmed the claim it had already made before the Board of Appeal of EUIPO, without being contradicted, namely that the sign at issue in the dispute has been registered in Spain, Italy, Australia, Canada, the United States and the United Kingdom and that these registrations are proof of its '*inherent distinctiveness*'.
39. This is the figurative mark '*deluxe*', No 006891949, composed of that word framed by a circle in the colour red. Registration of the mark was granted by EUIPO, at the request of Deluxe Entertainment Services Group Inc., for goods in classes 35, 39, 40, 41, 42 and 45, similar to those covered by the sign at issue in these proceedings.
40. Those considerations do not preclude the mark '*deluxe*' from lacking distinctive character when applied to certain specific goods. That was the ruling of the General Court in its earlier judgment of 17 December 2014, *Lidl Stiftung v OHIM* (Deluxe), T-344/14, not published, EU:T:2014:1097, paragraph 28.
41. Opinion of Advocate General Ruiz-Jarabo Colomer in *DKV*, C-104/00 P, EU:C:2002:288, point 91, which the judgment of 19 September 2002 adopted almost verbatim in paragraph 39 (EU:C:2002:506).
42. Council Directive 89/104/EEC of 21 December 1988 (OJ 1989 L 40, p. 1) and Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 (OJ 2008 L 299, p. 25).
43. Judgments of 24 May 2012, *Formula One Licensing v OHIM*, C-196/11 P, EU:C:2012:314, paragraph 41, and of 8 November 2016, *BSH v EUIPO*, C-43/15, EU:C:2016:837, paragraph 66. In the first of



those cases, the dispute concerned the finding of the General Court that the sign 'FI' lacked distinctive character despite its prior registration as a national mark. Although the facts of that appeal differed from those of the present appeal, the wording of the judgment in Formula One Licensing v OHIM can be extrapolated to the instant case.

44. At the hearing, EUIPO stated that, in its opinion, the word 'deluxe' completely lacks the capacity to distinguish any goods or services.

45. Also at the hearing, in reply to questions from the Court, EUIPO acknowledged that its principal argument was based on the sign 'deluxe' being quite incapable of identifying goods and services, and that its alternative argument was based on the fact that, having regard to those goods and services, it is necessary to examine whether they have any common features enabling them to fit into one or more categories.

46. Paragraph 27, in fine, of the judgment under appeal.

47. Although that argument is set out at the end of the judgment under appeal, it is appropriate to refer to it at this juncture because I believe that it best explains the ratio decidendi of the judgment.

48. Paragraphs 20 and 21 of the judgment under appeal.

49. According to the General Court, *'the mark applied for covers more than 90 goods and services, which are included in eight different classes and relate to areas as diverse as the cinema, advertising, storage and transport of goods, product research and development, security, leisure and information technology'* [free translation] (paragraph 20 of the judgment under appeal).

50. Ibid., paragraph 22.

51. Order of 18 March 2010, C-282/09 P, EU:C:2010:153.

52. Order of 18 March 2010, C-282/09 P, EU:C:2010:153.

53. *'The existence of such a link between, for example, motion picture films, delivery of goods by truck, warehouse storage, product research and development and hosting and designing the websites of others is not obvious and, at all events, cannot be inferred from the wording of the contested decision'* [free translation] (paragraph 27 of the judgment under appeal).

54. Point 2[3] of the contested decision.

55. Acceptance of a common feature arising from the 'message' of the mark would be tantamount to reversing the process of logical deduction which leads to the search for a sufficiently direct and specific link between goods and services.

56. Order of 18 March 2010, C-282/09 P, EU:C:2010:153.

57. Order of 11 December 2014, BigXtra, C-253/14 P, not published, EU:C:2014:2445. See point 25 of this Opinion.

58. Judgment of 21 March 2014, FTI Touristik v OHIM (BigXtra), T-81/13, not published, EU:T:2014:140, paragraphs 43 to 47.

59. Order of 18 March 2010, C-282/09 P, EU:C:2010:153.

60. See point 5 of this Opinion.

61. Judgment of 10 March 2011, Agencja Wydawnicza Technopol v OHIM, C-51/10 P, EU:C:2011:139, paragraph 47.

62. Judgment of 10 March 2011, Agencja Wydawnicza Technopol v OHIM, C-51/10 P, EU:C:2011:139, paragraph 48.

63. Judgment of 8 April 2003, Linde and Others, C-53/01, EU:C:2003:206, paragraph 74. There is no doubt that the sign 'deluxe' is complex but since both the examiner and the Board of Appeal emphasised the 'banal' character of the figurative element, minimising any importance of that element for the purposes of the examination of distinctive character, they should, in the interests of consistency, have treated that sign as one composed exclusively of a possible indication of the quality of the goods.

64. See the Opinion of Advocate General Ruiz-Jarabo Colomer in Mag Instrument v OHIM, C-136/02, EU:C:2004:151, point 20.

65. Opinion of Advocate General Jacobs in OHIM v Wrigley, C-191/01 P, EU:C:2003:225, points 51 and 53.

66. Order of 13 February 2008, Indorata-Serviços e Gestão v OHIM, C-212/07 P, not published, EU:C:2008:83, paragraph 27 and the case-law cited.