

European Court of Justice, 16 September 2004, SAT1



## TRADEMARK LAW

### Distinctive character

- [A separate analysis of each of its elements instead of on the overall perception of that word by the average consumer.](#)

It is clear from paragraphs 31 to 34 of the present judgment that the Court of First Instance assessed whether the term 'SAT.2' had a distinctive character essentially by means of a separate analysis of each of its elements. To that end, it based itself on the presumption that elements individually devoid of distinctive character cannot, on being combined, present such a character instead of, as it should have done, on the overall perception of that word by the average consumer. It examined the impression as a whole produced by the term only secondarily, refusing to give any relevance to aspects such as the existence of an element of imaginativeness, which ought to be taken into account in such an analysis.

### Use in sector

[The frequent use of trade marks consisting of a word and a number in the telecommunications sector indicates that that type of combination cannot be considered to be devoid, in principle, of distinctive character.](#)

### General interest art. 7(1)(b) Regulation No 40/94

- [General interest requires that the signs they refer to may be freely used by all.](#)

Secondly, the contested judgment relies on a criterion according to which trade marks which are capable of being commonly used, in trade, for the presentation of the goods or services in question may not be registered. That criterion is relevant in the context of Article 7(1)(c) of the regulation but it is not the yardstick against which Article 7(1)(b) thereof should be judged. By considering, in particular, at paragraph 36 of the contested judgment, that the later provisions pursued an aim which is in the public interest, which requires that the signs they refer to may be freely used by all, the Court of First Instance deviated from taking into account the public-interest criterion referred to in paragraphs 25 to 27 of the present judgment.

Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the gen-

eral interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P Henkel v OHIM [2004] ECR I-0000, paragraphs 45 and 46).

As regards the registration as trade marks of colours per se, not spatially delimited, the Court has already ruled, in *Libertel*, paragraph 60, that the public interest underlying Article 3(1)(b) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), a provision which is identical to Article 7(1)(b) of the regulation, is aimed at the need not to restrict unduly the availability of colours for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought.

Furthermore, in view of the extent of the protection afforded to a trade mark by the regulation, the public interest underlying Article 7(1)(b) of the regulation is, manifestly, indissociable from the essential function of a trade mark, as observed in paragraph 23 above.

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### European Court of Justice, 16 September 2004

(C.W.A. Timmermans, J.-P. Puissechet, R. Schintgen, F. Macken and N. Colneric)

JUDGMENT OF THE COURT (Second Chamber)

16 September 2004 (1)

*(Appeals – Community trade mark – Absolute grounds for refusal to register – Article 7(1)(b) and (c) of Regulation (EC) No 40/94 – ‘Sat.2’)*

In Case C-329/02 P,

APPEAL under Article 56 of the Statute of the Court of Justice,

lodged at the Court on 12 September 2002,

SAT.1 SatellitenFernsehen GmbH, established in Mayence (Germany) represented by R. Schneider, Rechtsanwalt, with an address for service in Luxembourg,

appellant,

the other party to the proceedings being:

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by D. Schennen, acting as Agent, with an address for service in Luxembourg,

defendant at first instance,

THE COURT (Second Chamber),

composed of: C.W.A. Timmermans, President of the Chamber, J.-P. Puissechet (Rapporteur), R. Schintgen, F. Macken and N. Colneric, Judges,

Advocate General: F.G. Jacobs,

Registrar: H. von Holstein, Deputy Registrar

having regard to the written procedure and further to the hearing on 8 January 2004,

after considering the observations submitted on behalf of the parties,

after hearing the [Opinion of the Advocate General](#) at the sitting on 11 March 2004, gives the following

**Judgment**

1 By its appeal, SAT.1 SatellitenFernsehen GmbH ('the appellant') is seeking that the judgment of the Court of First Instance of the European Communities of 2 July 2002 in Case T-323/00 SAT.1 v OHIM (SAT.2) [2002] ECR II-2839, 'the contested judgment', in which it dismissed its application, be set aside insofar as the Court of First Instance found that the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('the Office') had not infringed Article 7(1)(b) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1, 'the regulation') or failed to observe the principle of non-discrimination by refusing, by its decision of 2 August 2000 (Case R 312/1999-2, 'the contested decision'), to register as a Community trade mark the term 'SAT.2' in respect of services which, in the registration application, are connected with satellite broadcasting.

**The legal framework**

2 Under Article 4 of the regulation:

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

3 Article 7 of that regulation 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.

3. Paragraph 1(b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it.'

4 According to Article 12 of the regulation:

'A Community trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade:

...

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

...

provided he uses them in accordance with honest practices in industrial or commercial matters.'

5 Article 38(1) of the regulation provides:

'Where, under Article 7, a trade mark is ineligible for registration in respect of some or all of the goods or services covered by the Community trade mark application, the application shall be refused as regards those goods or services.'

**Background to the dispute**

6 On 15 April 1997, the appellant applied to the Office to register the term 'SAT.2' as a Community trade mark in respect, first, of various goods coming within Classes 3, 9, 14, 16, 18, 20, 25, 28, 29 and 30 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, secondly, of services coming within Classes 35, 38, 41 and 42 of that agreement.

7 When that application was rejected, so far as concerned the services within Classes 35, 38, 41 and 42, by a decision of 9 April 1999 of the examiner at the Office, the appellant appealed to the Office.

8 By the contested decision, the Second Board of Appeal of the Office dismissed the appeal on the ground that Article 7(1)(b) and (c) of the regulation precluded registration of the term SAT.2 for services falling within the abovementioned classes.

**Procedure before the Court of First Instance and the contested judgment**

9 By application lodged at the Registry of the Court of First Instance on 16 October 2000, the appellant brought an action seeking the annulment of the contested decision.

10 The Court, in the contested judgment, upheld the application in part only.

11 First, it observed that the Second Board of Appeal of the Office had failed to rule on the appellant's claims regarding the Class 35 services set forth in the registration application. It then annulled the contested decision to that extent.

12 Secondly, the Court of First Instance annulled the contested decision so far as concerns the services within Classes 38, 41 and 42, but only inasmuch as it refused to register the term 'SAT.2' for the services falling within those classes as set out in paragraph 42 of the contested judgment.

13 In annulling the decision, the Court of First Instance, first, upheld the plea of the appellant alleging that the contested decision had been wrongly based on Article 7(1)(c) of the regulation. By basing itself on the relevant meaning of the trade mark, established not only on the basis of its various components but also on its meaning as a whole, accepting only such characteristics of the goods or services as are likely to be taken into account by the relevant public when making its choice, the Court found that the term 'SAT.2' was not descriptive of the services coming within Classes 38, 41 and 42, within the meaning of Article 7(1)(c). In its view, the term relates to no specific characteristic of the services concerned which is likely to be taken into account by the relevant public when making its choice.

14 On the other hand, the Court of First Instance dismissed, so far as concerns part of the services coming within Classes 38, 41 and 42, the appellant's plea in law alleging that the contested decision could not refuse registration of the term 'SAT.2' on the basis of Article 7(1)(b) of the regulation. It found that, in view of its constitutive elements, the term was devoid of any distinctive character within the meaning of that provision in relation to services which, in the application registration, are connected with satellite broadcasting, that is to say the services referred to in paragraph 3 of the contested judgment to which the Court of First Instance does not refer in paragraph 42 of that judgment.

15 Finally, it rejected the appellant's plea in law alleging that the refusal to register the term in question was contrary to the principle of equal treatment since signs which were, according to the appellant, altogether similar, had been registered as Community trade marks by the Office.

#### **The appeal**

16 The appellant claims that the Court should set the contested judgment aside insofar as the Court of First Instance dismissed the remainder of the heads of claim it submitted before it and order the Office to pay the costs.

17 The Office contends that the Court should dismiss the appeal and order the appellant to pay the costs.

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

18 By its first ground of appeal, the appellant argues that the interpretation by the Court of First Instance of Article 7(1)(b) of the regulation is vitiated by an error of law in two respects.

19 First, contrary to what the Court of First Instance states at paragraph 36 of the contested judgment, that provision did not pursue an aim which is in the public interest, which requires that the signs they refer to may be freely used by all. Its aim is in fact to enable the final consumer or user to distinguish without any possible confusion the origin of goods or services, in accordance with the view which the Community legislature and the Court have of the main function of trade marks. The Court of First Instance thus applied a test which is appropriate in the context of Article 7(1)(c) and (e) of the regulation rather than in that of Article 7(1)(b) thereof and it accordingly failed to ascertain exactly in what way the term in question was capable of fulfilling that function of a trade mark.

20 Secondly, the appellant claims that, after observing, correctly, that it was necessary to examine the overall impression made by the term 'SAT.2' on the consumers concerned in order to assess whether the sign had a distinctive character, the Court of First Instance did not apply that rule of analysis correctly in the present case. Instead it broke down the term into its constituent elements in order to found its refusal to register. However, such a breakdown is not the way in which consumers appraise and interpret the trade mark when they perceive it. Moreover, the Court of First Instance wrongly based the absence of distinctive character on the fact that the term was composed of elements commonly used, in trade, for the presentation of the goods or ser-

vices concerned, whereas that kind of element can be taken into consideration only when applying Article 7(1)(c) of the regulation.

21 The Office responds to that ground of appeal by stating that Article 7(1)(b) of the regulation pursues an aim which is in the public interest, namely to ensure that the signs concerned are freely available. The case-law of the Court of Justice shows that the grounds for refusal laid down in Article 7(1)(b) and (c) of the regulation do indeed pursue such an aim since they preclude non-distinctive signs from being covered by the protection afforded by registration as a trade mark.

22 The Office shares the argument of the appellant that the term concerned must be assessed as a whole and that 'distinctive character' must be understood to mean the ability of a trade mark to identify the goods and services which it designates according to their origin. It considers, however, that the term 'SAT.2' is devoid of any distinctive character because it consists of elements which are not distinctive combined in a customary way and that the Court of First Instance has not misapplied Article 7(1)(b) of the regulation when carrying out the relevant assessment. Furthermore, the contested judgment did not confuse the respective scopes of that provision and that of Article 7(1)(c) of that regulation. Neither is it contradictory, since the Court of First Instance was able to observe, without committing an error of law, that the term was not descriptive within the meaning of Article 7(1)(c) and that it was not, by the same token, distinctive within the meaning of Article 7(1)(b).

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

23 First, the essential function of a trade mark is to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see, in particular, [Case 102/77 Hoffmann-La Roche \[1978\] ECR 1139](#), paragraph 7, and [Case C-299/99 Philips \[2002\] ECR I-5475](#), paragraph 30). Article 7(1)(b) of the regulation is thus intended to preclude registration of trade marks which are devoid of distinctive character which alone renders them capable of fulfilling that essential function.

24 Secondly, in order to determine whether a sign presents a characteristic such as to render it registrable as a trade mark, it is appropriate to take the viewpoint of the relevant public. Where the goods or services with which the registration application is concerned are intended for all consumers, the relevant public must be deemed to be composed of the average consumer, reasonably well-informed and reasonably observant and circumspect (see [Case C-342/97 Lloyd Schuhfabrik Meyer \[1999\] ECR I-3819](#), paragraph 26, and [Case C-104/01 Libertel \[2003\] ECR I-3793](#), paragraph 46).

25 Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The gen-

eral interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P Henkel v OHIM [2004] ECR I-0000, paragraphs 45 and 46).

26 As regards the registration as trade marks of colours per se, not spatially delimited, the Court has already ruled, in *Libertel*, paragraph 60, that the public interest underlying Article 3(1)(b) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), a provision which is identical to Article 7(1)(b) of the regulation, is aimed at the need not to restrict unduly the availability of colours for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought.

27 Furthermore, in view of the extent of the protection afforded to a trade mark by the regulation, the public interest underlying Article 7(1)(b) of the regulation is, manifestly, indissociable from the essential function of a trade mark, as observed in paragraph 23 above.

28 Finally, as regards a trade mark comprising words or a word and a digit, such as that which forms the subject-matter of the dispute, the distinctiveness of each of those terms or elements, taken separately, may be assessed, in part, but must, in any event, depend on an appraisal of the whole which they comprise. Indeed, the mere fact that each of those elements, considered separately, is devoid of distinctive character does not mean that their combination cannot present a distinctive character (see, by analogy, Case C-265/00 *Campina Melkunie* [2004] ECR I-0000, paragraphs 40 and 41, and C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-0000, paragraphs 99 and 100).

29 However, in the present case, the manner in which the Court of First Instance applied Article 7(1)(b) of the regulation reflects a misinterpretation of that provision.

30 First, although it was correctly observed in paragraph 39 of the contested judgment that assessment of the distinctive character of a compound trade mark calls for it to be considered as a whole, the Court of First Instance did not, in fact, base its decision on such an examination.

31 It considered, first of all, in paragraph 41 of the contested judgment, that the Office had proved to the requisite legal standard that the element ‘SAT’ is the usual abbreviation, in German and in English, for the word ‘satellite’ and that, as an abbreviation, it did not depart from the lexical rules of those languages. In the same paragraph of that judgment, the Court took the view, furthermore, that it designated a characteristic of most of the services concerned which was likely to be taken into account by the relevant public when making its choice, namely the fact that they have to do with broadcasting via satellite. On the basis of those findings, which it is not for the Court of Justice to call in question in the context of an appeal other than where the clear sense of the evidence is distorted, the Court of

First Instance held that the element ‘SAT’ was devoid of any distinctive character in relation to those services. 32 The Court of First Instance next pointed out, in paragraphs 46 and 47 respectively of the contested judgment, by means of assessments which also do not fall within the purview of the Court of Justice in the context of an appeal, provided that there is no distortion of the clear sense of the evidence, that the element ‘2’ and the element ‘.’ were or could be commonly used, in trade, for the presentation of the goods or services concerned and that those elements were thus devoid of any distinctive character.

33 It concluded from those findings, in paragraph 49 of the contested judgment that ‘the fact that a compound trade mark [such as “SAT.2”] consists only of elements devoid of distinctive character generally justify[ed] the conclusion that that trade mark, considered as a whole, is also capable of being commonly used, in trade, for the presentation of the goods or services concerned’.

34 Finally, the Court of First Instance considered, in paragraphs 49 and 50 of the contested judgment, that that conclusion would be invalidated only if concrete evidence, such as, for example, the unusual way in which the various elements are combined, were to indicate that the compound trade mark was greater than the sum of its parts. The Court of First Instance held that the term ‘SAT.2’ was not combined in an unusual fashion and that ‘the appellant’s argument that the trade mark applied for, considered as a whole, has an element of imaginativeness, [was] irrelevant’.

35 It is clear from paragraphs 31 to 34 of the present judgment that the Court of First Instance assessed whether the term ‘SAT.2’ had a distinctive character essentially by means of a separate analysis of each of its elements. To that end, it based itself on the presumption that elements individually devoid of distinctive character cannot, on being combined, present such a character instead of, as it should have done, on the overall perception of that word by the average consumer. It examined the impression as a whole produced by the term only secondarily, refusing to give any relevance to aspects such as the existence of an element of imaginativeness, which ought to be taken into account in such an analysis.

36 Secondly, the contested judgment relies on a criterion according to which trade marks which are capable of being commonly used, in trade, for the presentation of the goods or services in question may not be registered. That criterion is relevant in the context of Article 7(1)(c) of the regulation but it is not the yardstick against which Article 7(1)(b) thereof should be judged. By considering, in particular, at paragraph 36 of the contested judgment, that the later provisions pursued an aim which is in the public interest, which requires that the signs they refer to may be freely used by all, the Court of First Instance deviated from taking into account the public-interest criterion referred to in paragraphs 25 to 27 of the present judgment.

37 In those circumstances, the appellant is justified in arguing that the contested judgment is vitiated by an

error of law in its interpretation of Article 7(1)(b) of the regulation.

38 It follows from the foregoing, without there being any need to examine the other ground of appeal alleging disregard for the principle of equal treatment, that the contested judgment must be set aside insofar as the Court of First Instance held that the Second Board of Appeal of the OHIM had not infringed Article 7(1)(b) of the regulation in refusing, by the contested decision, to register as a Community trade mark the term 'SAT.2' in respect of services which, in the registration application, are connected with satellite broadcasting, that is to say the categories mentioned in paragraph 3 of the contested judgment to which the Court of First Instance does not refer in paragraph 42 thereof.

39 According to the second sentence of the first paragraph of Article 61 of the Statute of the Court of Justice, the latter may, where the decision of the Court of First Instance is quashed, itself give final judgment in the matter, where the state of the proceedings so permits. That is the case here.

40 Although the way in which the term 'SAT.2' is made up is not unusual, in particular as regards the perception which the average consumer may have of services falling within the communications industry, and the juxtaposition of a verbal element such as 'SAT' with a digit such as '2', separated by a '.' does not reflect a particularly high degree of inventiveness, those facts are not sufficient to establish that such a word is devoid of distinctive character within the meaning of Article 7(1)(b) of the regulation.

41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings.

42 Where a trade mark which does not fall foul of the ground of refusal laid down in Article 7(1)(c) of the regulation is none the less devoid of distinctive character within the meaning of Article 7(1)(b) thereof, the Office must also set out the reasons why it considers that that trade mark is devoid of distinctive character.

43 However, in this case, the Office merely stated in the contested decision that the elements 'SAT' and '2' were descriptive and in current usage in the sector of media-related services, without stating in what way the term 'SAT.2', taken as a whole, was not capable of distinguishing the services of the appellant from those of other undertakings.

44 The frequent use of trade marks consisting of a word and a number in the telecommunications sector indicates that that type of combination cannot be considered to be devoid, in principle, of distinctive character.

45 Moreover, as the appellant has stated, the Office did not rely on that ground for refusal to register laid down in Article 7(1)(b) of the regulation against applications to register trade marks comparable in their structure to

the term 'SAT.2', namely by their use of the element 'SAT'.

46 The fact that the element associated with 'SAT' is in this case the digit '2' and a point, rather than another verbal element has, contrary to the Office's contention, no bearing on that analysis. Furthermore, the Office did not, at any stage in the proceedings, give as a reason for the difference in the treatment afforded to the appellant's application the likelihood of confusion between the sign which the latter sought to register and any previously registered trade mark.

47 It follows from all the foregoing considerations that the grounds on which the Second Board of Appeal of the OHIM considered that the term 'SAT.2' is devoid of character within the meaning of Article 7(1)(b) of the regulation are unfounded.

48 In those circumstances, the contested decision must be annulled insofar as the Second Board of Appeal of the OHIM rejected, on the basis of Article 7(1)(b) of the regulation the application to register the term 'SAT.2' as a Community trade mark. Since the Court of First Instance has already held, in the contested judgment, that the contested decision could not be based on Article 7(1)(c) of that provision and, secondly, that the Second Board of Appeal of the OHIM had, in the aforementioned decision, failed to rule in the appeal brought before it so far as concerns the services falling within Class 35, the contested decision must be annulled as a whole.

#### Costs

49 Under Article 122 of the Rules of Procedure of the Court of Justice, where the appeal is well founded and the Court of Justice itself gives final judgment in the case, the Court is to make a decision as to costs.

50 Under Article 69(2) of the Rules of Procedure of the Court of Justice, which applies to appeals by virtue of Article 118, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the appellant has applied for costs against the Office and the Office has been unsuccessful, the latter party must be ordered to pay the costs both at first instance and on appeal.

On those grounds the Court (Second Chamber) hereby:

1. Sets aside the judgment of the Court of First Instance of the European Communities of 2 July 2002 in Case T-323/00 SAT.1 v OHIM (SAT.2) [2002] ECR II-2839 inasmuch as the Court of First Instance found that the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) had not infringed Article 7(1)(b) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark by refusing, by its decision of 2 August 2000 (Case R 312/1999-2), to register as a Community trade mark the term 'SAT.2' in respect of services which, in the registration application, are connected with satellite broadcasting, that is to say the services referred to in paragraph 3 of the contested judgment to which the Court of First Instance does not refer in paragraph 42 of the contested judgment;

2. Annuls the decision of 2 August 2000 of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs);
3. Orders the Office for Harmonisation in the Internal Market (Trade Marks and Designs) to pay the costs incurred in these proceedings and in those before the Court of First Instance.

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**OPINION OF ADVOCATE GENERAL  
JACOBS**

delivered on 11 March 2004 (1)  
Case C-329/02 P  
SAT.1 SatellitenFernsehen GmbH  
v

Office for Harmonisation in the Internal Market (trade marks and designs)

1. This is an appeal against a judgment (2) partially annulling a refusal to register ‘SAT.2’ as a Community trade mark for various categories of services. Issues raised are: (i) whether Article 7(1)(b) of the Community Trade Mark Regulation (3) pursues the aim of keeping signs which lack distinctiveness free for general use; (ii) the way in which the overall assessment of the distinctiveness of a sign composed of several elements is to be carried out; and (iii) the way in which the principle of non-discrimination is to be applied when a refusal to register a particular trade mark is alleged to conflict with previous practice.

**Legislation**

2. Article 4 of the Trade Mark Regulation provides: ‘A Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.’

3. Under Article 7, headed ‘Absolute grounds for refusal’:

‘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;
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;
- (e) signs which consist exclusively of:
  - (i) the shape which results from the nature of the goods themselves; or

- (ii) the shape of goods which is necessary to obtain a technical result; or
- (iii) the shape which gives substantial value to the goods;  
...’ (4)

4. Under Article 7(3), ‘Paragraph 1(b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it.’

**Outline of the procedure**

5. On 15 April 1997, SAT.1 SatellitenFernsehen GmbH (‘SAT.1’), a satellite television company, applied to the Office for Harmonisation in the Internal Market (trade marks and designs) (‘the Office’) to register ‘SAT.2’ as a Community trade mark for goods in several classes, and for services in Classes 35, 38, 41 and 42, of the Nice Agreement. (5) According to their headings, the latter classes cover essentially: advertising and business or office management; telecommunications; education, training, entertainment, sporting and cultural activities; and services not classified elsewhere. The application was in respect of a detailed list of services under each of those headings. The examiner refused the application in respect of all the services mentioned, ‘in so far as they refer to satellites or to satellite television, in the widest sense’. The Second Board of Appeal dismissed SAT.1’s objection to that refusal in so far as it concerned services in Classes 38, 41 and 42, holding, essentially, that the sign was descriptive and that it lacked distinctive character, thus falling within both Article 7(1)(b) and (c) of the Trade Mark Regulation.

6. In SAT.1’s further challenge before the Court of First Instance, that Court annulled the Board of Appeal’s decision in so far as it had failed to rule on the applicant’s claims with regard to services in Class 35 (6) and in so far as it concerned certain types of service listed in the application but not connected with satellite broadcasting. (7)

7. The Court of First Instance also accepted, in respect of all the relevant services, the applicant’s argument under Article 7(1)(c) of the Trade Mark Regulation: it held that the combination ‘SAT.2’ was not exclusively descriptive for the purposes of the provision. (8)

8. It none the less dismissed the challenge with regard to all of the services listed which ‘have to do with broadcasting via satellite’, on the ground that ‘SAT.2’, although not descriptive, lacked any distinctive character in relation to those services, within the meaning of Article 7(1)(b). In reaching that view, the Court of First Instance reasoned essentially as follows. (9)

9. The absolute grounds for refusal in Article 7(1)(b) to (e) of the Trade Mark Regulation pursue an aim in the public interest, of ensuring that the signs they refer to may be freely used by all. Article 7(1)(b) thus covers in particular marks which are or can be commonly used in trade for the presentation of the goods or services concerned. Distinctiveness must be assessed by reference both to those goods or services

and to the way the mark is perceived by the relevant public. Here, the relevant public consisted of film and media professionals or of average consumers, depending on the specific type of service.

10. As a compound trade mark, 'SAT.2' was to be considered as a whole when assessing its distinctiveness. However, each feature could be examined in turn. First, 'SAT' had been established to be a usual German and English abbreviation designating a characteristic (a link to satellite broadcasting) of most of the services concerned. It was thus devoid of any distinctive character in relation to those services. Next, numbers such as '2' were commonly used in trade for the presentation of the services concerned, and were therefore devoid of distinctive character in that regard. Finally, the element '.' was commonly used in trade for the presentation of all sorts of goods and services. 'SAT.2' as a whole thus consisted of a combination of elements each of which was capable of being commonly used in trade for the presentation of the services concerned, and was consequently devoid of any distinctive character in relation to them.

11. The fact that a compound trade mark consists only of elements devoid of distinctive character generally justifies the conclusion that, considered as a whole, it is also capable of being commonly used in trade for the presentation of the goods or services concerned. Such a conclusion could be negated only if there were evidence – lacking in the present case – that the compound mark was greater than the sum of its parts.

12. With regard to SAT.1's remaining plea, alleging breach of the principle of equal treatment in that the Office had departed from its own previous decisions with regard to trade marks consisting of numbers and letters, the Court of First Instance reasoned essentially as follows. (10) If a sign was correctly accepted for registration in one case but a contrary decision adopted in a later, similar case, the second decision must be annulled for infringement of the relevant provisions of the Trade Mark Regulation; no plea alleging breach of the principle of non-discrimination could validly be raised. If, on the other hand, a sign was wrongly accepted for registration and again a contrary decision adopted in a later, similar case, the first decision could not successfully be relied on in annulment of the later decision. The principle of equal treatment must be reconciled with that of legality, and no person may rely, in support of his claim, on unlawful acts committed in favour of another. In either event, no ground for annulment of the second decision can lie in an alleged breach of the principle of non-discrimination.

13. SAT.1 submits that the Court of First Instance misinterpreted Article 7(1)(b) of the Trade Mark Regulation, essentially in three respects: it was wrong to consider that Article 7(1)(b) pursues the public-interest aim of keeping certain signs available to be freely used by all; in assessing the distinctiveness of 'SAT.2' it applied a criterion not to be found in the provision, namely likelihood of use in trade for the presentation of the relevant products; and in doing so it failed to assess the distinctiveness of the mark as a whole but merely

examined each part separately. In the alternative, SAT.1 argues that the Court of First Instance misapplied the principle of non-discrimination by wrongly treating its plea as referring to previous individual decisions, whereas it was the Office's consistent practice with regard to marks containing numerals and abbreviations which was in issue.

### **Principal ground of appeal: misinterpretation of Article 7(1)(b)**

#### **The concept of distinctiveness**

14. Before examining the specific arguments put forward in the appeal, it may be helpful to consider briefly the concept of distinctiveness as used in Article 7(1)(b) of the Trade Mark Regulation.

15. That notion has given rise to some difficulty because the ban on registration of trade marks which are 'devoid of any distinctive character' appears to repeat, in different terms, the requirement that a trade mark must be 'capable of distinguishing the goods or services of one undertaking from those of other undertakings', contained in Article 4 and, by reference, Article 7(1)(a). Is this mere repetition, or do the concepts differ?

16. The simplest answer appears to be that indicated by Article 7(3), under which Article 7(1)(b), (c) and (d) – but not (a) – do not apply if the trade mark has, through use, become distinctive in relation to the goods or services for which registration is requested. In that light, it seems sensible to assume that Articles 4 and 7(1)(a) refer to a general, absolute, abstract capacity to distinguish products of different origins, whereas Article 7(1)(b) is intended to connote distinctiveness in relation to the class of product in question.

17. Thus, in the present case, if separate registration were sought for each of the individual elements, the element '.' – for which no distinctiveness is in fact claimed – might be seen to lack any distinguishing capacity whatever, whereas the distinctiveness or otherwise of 'SAT' might have to be assessed in the context of the relevant services. If that were the case, registration of the former would be precluded – for all goods or services – by both Article 7(1)(a) and (b), whereas the latter might be viewed, in the context of Article 7(1)(b) alone, as distinctive in relation to some products but not in relation to others.

#### **The aim of Article 7(1)(b)**

##### **Argument**

18. SAT.1 accepts that it follows from *Windsurfing Chiemsee* (11) that Article 7(1)(c) of the Trade Mark Regulation seeks to ensure that signs or indications descriptive of goods or services may be freely used by all in relation to those goods or services. The Court has however never held Article 7(1)(b) to have the same aim; it has stressed rather that the essential function of a trade mark is to distinguish between products of different origins and to guarantee, in a system of undistorted competition, that all the products bearing it originated under the control of a single undertaking which is responsible for their quality and which must be in a position to keep its customers by virtue of that quality. (12) It is for that reason that non-distinctive

signs may not be registered as trade marks, and not in order to keep them free for general use.

19. The Office submits that it is clearly in the public interest for signs which lack distinctive character not to be registered as trade marks. In Canon (13) the Court stressed that for reasons of legal certainty and sound administration it is necessary to ensure that trade marks whose use could successfully be challenged before the courts are not registered. Signs comprising simply one of a limited series of elements in common use – such as letters, numerals or basic colours – could provide only limited distinctiveness, and numerals in particular must remain available to designate quantities.

#### **Assessment**

20. It is established that each ground for refusing registration must be interpreted in the light of the public interest which underlies it. (14)

21. The interest underlying Article 7(1)(c) is that ‘descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all’. That was first stated, with regard to the identically-worded Article 3(1)(c) of the Trade Marks Directive, in *Wind-surfing Chiemsee*, (15) recently reaffirmed in *Linde*. (16) It has been even more recently reiterated in the context of Article 7(1)(c) of the Regulation in *Doublemint*. (17)

22. It is not difficult to understand why that is so. To allow one trader to monopolise a term which may serve to designate a product’s characteristics would be to accord him an unfair advantage over competitors who have a legitimate interest in being able to use the term descriptively.

23. Such reasoning can be transposed to Article 7(1)(d) and (e), respectively for terms which have become customary for a product and for shapes which are in some way closely bound up with its nature. (18)

24. I do not however consider that it can be transposed without qualification to Article 7(1)(b). There is no obvious reason why signs which simply lack any distinctive character – even if that lack is not absolute but relates only to the goods or services concerned – should be kept free for general use unless the signs themselves also have some close relationship with the relevant products, in particular one of the types of relationship specified in subparagraphs (c) to (e). No relationship of that kind is implied simply by the fact that a sign lacks distinctive character.

25. It is true that in *Libertel*, (19) which concerned an application for the registration of a colour per se as a trade mark, and involved interpreting Article 3(1)(b) of the Trade Marks Directive (identical in wording to Article 7(1)(b) of the Regulation), the Court held that, in assessing the potential distinctiveness of a given colour as a trade mark, regard must be had to the general interest in not unduly restricting the availability of colours for other traders providing goods or services of the type in respect of which registration is sought.

26. However, that interest is not identical to the one underlying Article 7(1)(c). The *Libertel* judgment speaks not of keeping signs available to be ‘freely used

by all’ but rather of ‘not unduly restricting’ their availability. It does so, moreover, in the specific context of signs of which there is a limited range, the number of colours which the average consumer is capable of distinguishing being limited. (20) In the context of the present case, the probability that such a consumer can recognise as distinctive a much wider range of numbers seems relevant.

27. It may further be borne in mind that (if one includes black and white as colours) it is impossible to conceive of a visual trade mark, a product get-up or any visual advertising which does not use at least one, and in the overwhelming majority of cases at least two, colours from the limited range available, whereas it will be a matter of choice whether to use any element at all from other types of limited range, such as numbers or punctuation marks. Moreover, the registration of a colour per se, as opposed to a specific shape or form bearing that colour, might be likened, if transposed for example to the field of numbers, to the registration of any expression of duality (‘2’, ‘II’, ‘ii’, ‘two’, ‘deuce’, ‘twain’, ‘twin’, ‘double’ etc., and their equivalents in other languages), as opposed to the specific digit ‘2’.

28. The statement at paragraph 36 of the judgment under appeal, to the effect that the aim of Article 7(1)(b) is to keep the signs to which it refers available to be freely used by all, thus goes appreciably further than what I consider to be a correct interpretation of the law. Although perhaps not decisive in itself, that statement is likely to have influenced the final assessment of the registrability of ‘SAT.2’; the application of a test whose aim is to keep signs available to be freely used by all will inevitably be more severe than that of a test aimed simply at not unduly restricting the availability of other types of sign whose range is limited.

#### **Approach to assessment of the mark as a whole Argument**

29. SAT.1 submits that the Court of First Instance should have considered whether ‘SAT.2’ allowed the relevant sector of the public to distinguish the services designated from those of a different trade origin. To say that ‘SAT’ is a usual abbreviation for ‘satellite’ and that ‘.’ and ‘2’ are commonly used in trade for the presentation of such services is not relevant in that regard. Whether an element may be used in that way is a criterion not for Article 7(1)(b) but for Article 7(1)(c) or (e). Article 7(1)(b) is not intended as a residual ground for refusal of signs which are not exclusively descriptive.

30. What matters moreover is the overall perception by the consumer, who does not analyse a trade mark into its constituent elements. ‘SAT.2’, taken as a whole, is not descriptive of any of the types of service in question but is an easily memorised invention, and thus capable of distinguishing products according to their origin. SAT.1 cites the *Baby-Dry* judgment (21) to the effect that innovative, non-descriptive terms are capable of distinctiveness.

31. The Office notes that ‘SAT.2’ as a whole is not descriptive and thus cannot be refused on the basis of Article 7(1)(c) but that, according to the findings of fact made by the Court of First Instance and not challenge-

able on appeal, it comprises an element ‘SAT’, which is descriptive (and thus non-distinctive), and an element ‘2’, which is neither descriptive nor distinctive (there being no need to take account of the element ‘.’). Each mark must certainly be assessed as a whole, and what counts is whether it is capable of distinguishing products according to their origin; however, the mere addition of a non-distinctive element to a descriptive element cannot create a mark which is distinctive as a whole unless the manner of combination creates a whole greater than the sum of the parts, which is not the case here.

32. SAT.1’s implication that any sign which is not descriptive must have the capacity to distinguish is illogical, and wrong; such reasoning would deprive Article 7(1)(b) of any independent scope. Nor does Article 7(1)(c) cover merely a subset of the situations caught by Article 7(1)(b). The Baby-Dry judgment does not support SAT.1’s view, since it concerns the descriptiveness of an inventive and syntactically unusual juxtaposition of two descriptive elements, not the distinctiveness of the addition of a non-distinctive element to a descriptive one. In any event, the criterion of ‘any perceptible difference’ (22) cannot be satisfied by the addition of a banal element such as a numeral or, say, an italic typeface.

#### **Assessment**

33. At paragraph 39 of the judgment under appeal, the Court of First Instance stated: ‘Since what is involved is a compound trade mark, appraisal of its distinctive character calls for it to be considered as a whole. However, that is not incompatible with an examination of each of the trade mark’s individual features in turn.’

34. It then considered, in the course of paragraphs 41 to 47, that ‘SAT’ ‘designates a characteristic of most of the services concerned which is likely to be taken into account by the relevant public when making its choice, namely the fact that they have to do with broadcasting via satellite’ and is thus devoid of any distinctive character in relation to those services, whereas the elements ‘2’ and ‘.’ are commonly used in trade for the presentation of such services and therefore devoid of distinctive character in the same regard.

35. At paragraphs 49 and 50, it went on to say that: ‘the fact that a compound trade mark consists only of elements devoid of distinctive character generally justifies the conclusion that that trade mark, considered as a whole, is also capable of being commonly used, in trade, for the presentation of the goods or services concerned. The conclusion would not apply only if concrete evidence, such as, for example, the way in which the various elements were combined, were to indicate that the compound trade mark was greater than the sum of its parts.

In the present case, there does not appear to be such evidence. ... [T]he applicant’s argument that the trade mark applied for, considered as a whole, has an element of imaginativeness, is irrelevant.’

36. The Court of First Instance thus concluded that ‘SAT.2’ was devoid of distinctive character with regard

to those of the relevant products which ‘have to do with broadcasting via satellite’.

37. SAT.1 criticises, essentially, two aspects of that reasoning: the assessment of the individual elements ‘SAT’ and ‘2’, and the assessment of the mark as a whole.

38. When considering those criticisms, it should be noted that the Court of First Instance was correct to state that assessment in the light of Article 7(1)(b) must be of the mark as a whole. It is established case-law that, in general, trade marks must be assessed in the light of the overall impression which they make on the relevant consumer, since the consumer, although deemed to be reasonably well-informed, observant and circumspect, ‘normally perceives a mark as a whole and does not proceed to analyse its various details’. (23)

39. It may none the less be helpful, as an intermediate stage in that overall assessment, to examine in turn each of the mark’s component parts, and the Court of First Instance cannot be criticised for having done so.

40. With regard to the examination of the element ‘SAT’, I can find no fault with the conclusion, from the premiss that ‘SAT’ is descriptive in relation to services connected with satellite broadcasting, that it also lacks distinctiveness in relation to the same products. Whilst Article 7(1)(b) and (c) provide separate grounds for refusal of registration, there is a degree of overlap between the different situations which they cover, and a term which may be used in trade to designate characteristics of a product is likely to lack distinctive character in relation to that product; (24) here the conclusion is manifestly correct.

41. As regards the examination of the element ‘2’, the appellant’s criticism is in my view more compelling. The Court of First Instance, it submits, introduced a new criterion, not to be found in Article 7(1)(b), when it said that ‘numbers in general and the number “2” in particular are commonly used, in trade, for the presentation of the services concerned’ and therefore lack distinctive character in that regard. (25)

42. It does indeed seem to me that the conclusion is faulty. Whilst a descriptive element commonly used in trade for the presentation of goods or services is very likely also to lack distinctiveness, that reasoning cannot be extended automatically to non-descriptive elements. Numbers in particular are commonly used in many and varied areas – administrative forms, golf clubs and bus routes to name but three – to distinguish between categories of items, goods or services, (26) and they appear to perform that function well. There is no inherent reason why numerals – which are expressly included in the list in Article 4 of the Regulation – should not also distinguish between the products of different suppliers. The approach taken by the Court of First Instance appears however to conflate the criterion of distinctiveness in Article 7(1)(b) with that of descriptiveness in Article 7(1)(c).

43. Finally and most importantly, the nature of each component is in any event merely a factor to be taken into consideration when assessing the whole. As a re-

ductio ad absurdum, it might be pointed out that, if one were to consider that each letter of the alphabet individually lacked distinctiveness, (27) one could draw no conclusion from that as to the distinctiveness of a word mark necessarily made up of such letters.

44. The fact that a mark consists exclusively of elements which individually lack distinctive character in relation to the relevant products therefore cannot give rise to an automatic presumption that the mark as a whole also lacks distinctive character, which can be rebutted only by evidence of an additional factor, such as a particular mode of combination of the elements, and which in the absence of such evidence renders unnecessary any assessment of the mark as a whole.

45. On the contrary, since the mark as a whole may or may not be 'greater than the sum of its parts', a separate examination of the whole is always required. Yet the Court of First Instance in paragraphs 49 and 50 of the judgment under appeal did not carry out that examination.

46. I am thus of the view that the Court of First Instance erred in its application of Article 7(1)(b) of the Trade Mark Regulation: first, in concluding, from the fact that numbers in general and the number '2' in particular are commonly used in trade for the presentation of the services concerned, that they lack distinctive character in that regard; second, in failing to assess the distinctive character of the mark 'SAT.2' as a whole and in considering irrelevant the applicant's argument that the mark as a whole possessed an element of imaginativeness.

#### **Alternative ground of appeal: breach of the principle of non-discrimination**

##### **Argument**

47. SAT.1 submits that the Court of First Instance's reasoning is relevant where there are conflicting individual decisions but not when, as alleged both at first instance and in the course of the registration proceedings, the Office has followed a consistent and clearly identifiable practice in the past, comparable to the examination guidelines which it issues. Marks which have been accepted by the Office include, for telecommunications, 'T-SAT', 'One Tel', 'One.Tel' and 'MEDIA 4'.

48. The Office objects that the ground of appeal concerns an alleged breach of the principle of equal treatment by the Office and not by the Court of First Instance. SAT.1 is thus seeking a re-examination by the Court of Justice of its plea at first instance concerning the Office's practice, which is not admissible in an appeal.

##### **Assessment**

49. Having reached the conclusion that the main ground of appeal should succeed, I shall comment only briefly on the alternative ground.

50. First, it seems clear to me that SAT.1 is alleging here that the Court of First Instance's assessment of its original plea concerning unequal treatment by the Office was based on an error in law. In dismissing that plea, SAT.1 alleges, the Court of First Instance applied legal reasoning appropriate to a comparison between

individual cases, not to a comparison between an individual decision and a consistent practice. The ground of appeal is therefore admissible.

51. Second, the approach taken by the Court of First Instance seems in principle unimpeachable. If a previous decision of the Office was wrong, it cannot be relied on to support annulment of a subsequent correct decision – no person may rely, in support of his claim, on unlawful acts committed in favour of another. (28) Where – as I consider to be the case here – the situation is reversed, the second decision must be annulled in any event, and the principle of non-discrimination does not come into play.

52. Third, that reasoning is postulated in particular on the statement that the Boards of Appeal exercise circumscribed, not discretionary, powers when they decide on registrability. However, whilst any discretion is indeed limited, a degree of subjectivity is inevitable when assessing the distinctiveness of a mark, even within the correct application of the law. It seems particularly important to maintain consistency in such a context. Indeed, the Office's own Examination Guidelines (29) state that 'there must be consistency in decision making so that all applicants are treated equally. Examiners have a responsibility to keep up to date with decisions by their colleagues, particularly by the Boards of Appeal and by the Court of First Instance and the European Court of Justice.'

##### **Substance of the action at first instance**

53. The only issue which remains to be determined is whether the mark 'SAT.2' as a whole lacks distinctive character, within the meaning of Article 7(1)(b) of the Trade Mark Regulation, in relation to services connected with satellite broadcasting.

54. Pursuant to Article 61 of the Court's Statute, that matter may be decided either by the Court of Justice, if the state of the proceedings permits, or by the Court of First Instance on referral back. In the present case, the point has been sufficiently argued, and it would not be in the interests of procedural economy to refer the case back to the Court of First Instance. Indeed, in view of the considerations which I have set out above, little further analysis is required.

55. 'SAT.2' is a compound sign of a format very common in the field of broadcasting. The long list of comparable examples in various European countries would include 'BBC 1', 'Kanaal 2', 'MTV 3', 'TV4', 'Tele 5', 'M6', 'RTL 7' and so on. In some cases, the non-numerical element is distinctive in its own right, in others, it is descriptive in the same way as the Court of First Instance held 'SAT' to be descriptive in relation to satellite broadcasting services, and may therefore be regarded as lacking distinctiveness in that regard.

56. However, the presence of a numerical identifier is clearly designed to ensure distinctiveness. The very commercial use of these signs to designate television channels and associated products seems ample proof of the success of that approach. If the average consumer of television programmes and spin-offs had difficulty in identifying such signs as differentiating between products and their origins, they would not be used, par-

ticularly since the commercial pressures of advertising revenue and audience ratings create a powerful need for product loyalty. (30)

57. Nor does the aim of ‘not unduly restricting’ the availability of certain signs, which is one of the aims of Article 7(1)(b), appear relevant here. Where a mark consists of a numerical and a non-numerical element, the latter may or may not be descriptive; in either event, the choice is not particularly restricted. There is of course a practical limit to the range of numbers which may realistically be used, but it is high. When the two types of element are put together, the number of distinctive and distinguishable combinations is very high indeed. If consumers can identify, for example, a satellite television channel by means of a sign such as ‘SAT.2’, they can clearly distinguish it from other combinations involving different letters and/or numbers which other broadcasters might wish to register as trade marks. (31)

58. Consequently, I take the view that the Board of Appeal was wrong to consider that ‘SAT.2’, viewed as a whole, was devoid of distinctive character in relation to the relevant services.

#### Conclusion

59. I am therefore of the opinion that the Court should:

- quash the judgment of the Court of First Instance in Case T-323/00 in so far as it dismissed the application in that case on the ground that registration of ‘SAT.2’ as a Community trade mark for services connected with satellite broadcasting was precluded by Article 7(1)(b) of the Trade Mark Regulation;
- annul Decision R 312/1999-2 of the Second Board of Appeal in so far as it has not already been annulled by the judgment in Case T-323/00; and
- order the Office to pay the costs both at first instance and on appeal.

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1 – Original language: English.

2 – Case T-323/00 SAT.1 SatellitenFernsehen v OHIM [2002] ECR II-2839.

3 – Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, OJ 1994 L 11, p. 1.

4 – The remaining subparagraphs (f) to (j) prohibit the registration of, in summary: marks contrary to public policy or accepted morality; deceptive marks; marks making unauthorised use of emblems, badges or hallmarks; and geographical indications for wines or spirits not having that origin.

5 – 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.

6 – Paragraphs 18 to 21 of the judgment under appeal.

7 – *Ibid.*, paragraphs 42 to 44.

8 – *Ibid.*, paragraphs 24 to 28.

9 – *Ibid.*, paragraphs 34 to 57.

10 – *Ibid.*, paragraph 61, citing Case 188/83 Witte v Parliament [1984] ECR 3465, paragraph 15 of the

judgment, and Case 134/84 Williams v Court of Auditors [1985] ECR 2225, paragraph 14.

11 – Joined Cases C-108/97 and C-109/97 [1999] ECR I-2779, in particular at paragraph 25 of the judgment, with regard to Article 3(1)(c) of the Trade Marks Directive (First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, OJ 1989 L 40, p. 1), which is identical in wording to Article 7(1)(c) of the Trade Mark Regulation but which concerns national, rather than Community, trade marks.

12 – See Case C-39/97 Canon [1998] ECR I-5507, paragraph 28 of the judgment; Case C-10/89 CNL-SUCAL v HAG GF (HAG II) [1990] ECR I-3711, paragraph 13; Case C-299/99 Philips v Remington [2002] ECR I-5475, paragraph 30.

13 – Cited in note 12, paragraph 21 of the judgment.

14 – See for example Philips, cited in note 12, paragraph 77 of the judgment.

15 – Cited in note 11, paragraph 25 of the judgment.

16 – Joined Cases C-53/01 to C-55/01 Linde and Others [2003] ECR I-3161, paragraph 73 of the judgment and paragraph 2 of the operative part.

17 – Case C-191/01 P OHIM v Wrigley, judgment of 23 October 2003, at paragraph 31.

18 – With regard to Article 3(1)(e) of the Directive (identical to Article 7(1)(e) of the Regulation), see Philips, cited in note 12, paragraphs 78 to 80 of the judgment. The aims pursued by subparagraphs (f) to (j) are different but clear from their content: see note 4.

19 – Case C-104/01 Libertel Groep [2003] ECR I-3793, judgment delivered after the appeal and response were lodged in the present case; see in particular, in the present context, paragraphs 44 to 60.

– Paragraph 47 of the judgment. See also paragraph 81 of Advocate General Ruiz-Jarabo’s Opinion of 6 November 2003 in Joined Cases C-456/01 P and C-457/01 P Henkel v OHIM, Joined Cases C-468/01 P to C-472/01 P Procter & Gamble v OHIM and Joined Cases C-473/01 P and C-474/01 P Procter & Gamble v OHIM (the ‘Multicoloured detergent tablets’ cases).

21 – Case C-383/99 P Procter & Gamble v OHIM [2001] ECR I-6251, paragraphs 40 and 42 to 45.

22 – *Baby-Dry*, paragraph 37 of the judgment.

23 – See, for example, with regard to various types of assessment, Case C-251/95 SABEL [1997] ECR I-6191, paragraph 23 of the judgment; *Baby-Dry*, paragraph 40; Case C-291/00 LTJ Diffusion [2003] ECR I-2799, paragraph 52.

24 – See, for example, Case C-265/00 Campina Melkunie, judgment of 12 February 2004, at paragraphs 18 and 19.

25 – Paragraph 46 of the judgment under appeal.

26 – These are cases where the number is used as an identification, as opposed to indications of size, for example, where it is clearly descriptive.

27 – But see William Cornish and David Llewelyn, *Intellectual Property* (5th edition 2003), at paragraph 17-32, p. 663, and the case-law cited there.

28 – Paragraph 61 of the judgment under appeal.

29 – Of 26 March 1996, paragraph 2.2.

30 – In a rather different field, one might compare ‘Pastis 51’ and ‘VAT 69’ as clearly distinctive brand names comprising only a descriptive element and a distinctive number.

31 – The question here, it must be remembered, concerns one of the absolute grounds for refusal under Article 7 of the Regulation; in this context, considerations which might be relevant in the context of an opposition or an infringement action based on a relative ground of invalidity such as the prior existence of a similar mark for similar products do not necessarily come into play.

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