



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Second Chamber)

14 May 2013 *

(Community trade mark — Application for the Community word mark fluege.de — Absolute grounds for refusal — Descriptive character — No distinctive character — Distinctive character acquired through use — Article 7(1)(b) and (c) and Article 7(2) and (3) of Regulation (EC) No 207/2009)

In Case T-244/12,

Unister GmbH, established in Leipzig (Germany), represented by H. Hug and A. Kessler-Jensch, lawyers,

applicant,

v

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

defendant,

ACTION brought against the decision of the First Board of Appeal of OHIM of 14 March 2012 (Case R 2149/2011-1) concerning an application for registration of the word sign fluege.de as a Community trade mark,

THE GENERAL COURT (Second Chamber),

composed of N.J. Forwood, President, F. Dehousse (Rapporteur) and J. Schwarcz, Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Registry of the General Court on 30 May 2012,

having regard to the response lodged at the Registry of the General Court on 6 September 2012,

having regard to the fact that no application for a hearing was submitted by the parties within the period of one month from notification of closure of the written procedure, and having therefore decided, acting upon a report of the Judge-Rapporteur, to give a ruling without an oral procedure, pursuant to Article 135a of the Rules of Procedure of the General Court,

gives the following

* Language of the case: German.

Judgment

Background to the dispute

- 1 On 27 January 2011, the applicant, Unister GmbH, filed an application for registration of a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).
- 2 Registration as a trade mark was sought for the word sign fluege.de.
- 3 The goods and services in respect of which registration of the mark was sought are in Classes 25, 28, 35, 39, 41 and 43 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.
- 4 Among those goods and services, only the services falling within Classes 35, 39 and 43 and corresponding to the following descriptions ('the services at issue') form the subject of the present action:
 - Class 35: 'Advertising; business management; business administration; office functions';
 - Class 39: 'Transport; packaging and storage of goods; travel arrangement';
 - Class 43: 'Services for providing food and drink; accommodation services'.
- 5 By decision of 22 August 2011, the examiner refused the trade mark application under Article 7(1)(b) and (c) and Article 7(2) of Regulation No 207/2009, in respect of the services at issue, on the ground that the mark applied for was descriptive and devoid of any distinctive character.
- 6 On 17 October 2011, the applicant lodged an appeal under Articles 58 to 64 of Regulation No 207/2009 against the examiner's decision.
- 7 By decision of 14 March 2012 ('the contested decision'), the First Board of Appeal of OHIM dismissed the appeal on the ground that the trade mark applied for was descriptive and devoid of any distinctive character.

Forms of order sought

- 8 The applicant claims that the Court should:
 - annul the contested decision;
 - order OHIM to pay the costs.
- 9 OHIM contends that the Court should:
 - dismiss the action;
 - order the applicant to pay the costs.

Law

- 10 In support of its action, the applicant raises, in essence, three pleas seeking annulment, alleging, first, infringement of Article 7(1)(c) of Regulation No 207/2009, secondly, infringement of Article 7(1)(b) of that regulation and, thirdly, the distinctive character acquired through the use of the trade mark applied for.

The first plea, alleging infringement of Article 7(1)(c) of Regulation No 207/2009

- 11 The applicant disputes the finding of the Board of Appeal that the trade mark applied for is descriptive. The term ‘fluege’, it submits, is a verbal composition alien to the German language, the latter featuring only the word ‘Flüge’, in which the letter ‘ü’ appears, with the result that, by reason of the unusual spelling of the term ‘fluege’, the average consumer will identify an indication of commercial origin in the trade mark applied for.
- 12 The applicant takes the view that the average consumer is accustomed to finding, including under a second-level domain constituted from a generic term, an internet portal operated by a single commercial provider. In the present case, the term ‘fluege’ is not even generic, in view of its unusual spelling. OHIM, the applicant argues, did not take into account the fact that, since 2004, it has been possible to register domain names with special characters such as the letter ‘ü’.
- 13 Even if the relevant public were to understand the trade mark applied for as being a domain name referring to a German internet address containing offers of flights, the applicant argues that the services at issue have no connection, or do not have any sufficient connection, with an offer of flights. In the present case, there is no requirement that the term be available for the purposes of Article 7(1)(c) of Regulation No 207/2009.
- 14 OHIM contests the position adopted by the applicant.
- 15 It must be recalled that, under Article 7(1)(c) of Regulation No 207/2009, ‘trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’ may not be registered. In addition, Article 7(2) of Regulation No 207/2009 states that ‘[p]aragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community’.
- 16 According to the case-law, Article 7(1)(c) of Regulation No 207/2009 prevents the signs or indications to which it refers from being reserved to one undertaking alone because they have been registered as trade marks. That provision thus pursues an aim that is in the public interest, which requires that such signs and indications may be freely used by all (Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 31; Case T-219/00 *Ellos v OHIM (ELLOS)* [2002] ECR II-753, paragraph 27; and judgment of 7 July 2011 in Case T-208/10 *Cree v OHIM (TRUEWHITE)*, not published in the ECR, paragraph 12).
- 17 Furthermore, signs or indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Article 7(1)(c) of Regulation No 207/2009, regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services, in order thereby to enable the consumer who acquired the goods or service designated by the mark to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (see *OHIM v Wrigley*, paragraph 16 above, paragraph 30, and *TRUEWHITE*, paragraph 16 above, paragraph 13).

- 18 It follows that, in order for a sign to be caught by the prohibition set out in that provision, there must be a sufficiently direct and specific relationship between the sign and the goods or services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see *TRUEWHITE*, paragraph 16 above, paragraph 14 and the case-law cited).
- 19 It should also be noted that a sign's descriptive nature can only be assessed, first, by reference to the way in which it is understood by the relevant public and, second, by reference to the goods or services concerned (Case T-34/00 *Eurocool Logistik v OHIM (EUROCOOL)* [2002] ECR II-683, paragraph 38, and *TRUEWHITE*, paragraph 16 above, paragraph 17).
- 20 So far as the relevant public is concerned, and as it was correctly stated, essentially, at paragraphs 12 and 13 of the contested decision, the services at issue are intended both for average consumers and for professionals, and it is with regard to the German-speaking public that the assessment of the descriptive nature of the trade mark applied for is the most relevant, account being taken of the features of that mark. The descriptive nature of the trade mark applied for must therefore be assessed from the perspective of the average German-speaking consumer in the European Union, a fact which the applicant, moreover, does not dispute.
- 21 As the Board of Appeal has observed, the trade mark applied for consists of the joined elements 'fluege' and '.de', the first of those elements being a variant, written in lower case and with the group of letters 'ue' in place of the letter 'ü', of the German word 'Flüge' (flights) and the second of those elements being a top-level domain associated with a country or an independent territory (country code Top-Level Domain (ccTLD)), in this case Germany.
- 22 The Board of Appeal held that it was necessary to take account, in the analysis of the element 'fluege', of the fact that the relevant public is used to certain particular features of the writing of internet addresses. Among those particular features, it observed that those internet addresses were normally written in lower case letters, that special characters such as the letters 'ä', 'ü', 'ö' and 'ß' were often replaced by the groups of letters 'ae', 'ue', 'oe' and 'ss' and that, for technical reasons, it had not been, or was not, possible to use those special characters. It found that, as a consequence, the relevant public, being aware of those particular features, would not perceive them as diverging from common linguistic practice.
- 23 The applicant has been unable to cast any serious doubt on that finding. In particular, its claim that the Board of Appeal failed to take into account the fact that it has, since 2004, been possible to use accented characters (such as the letter 'ü') in internet addresses does not contradict the fact, noted by the Board of Appeal, that accented characters are often replaced by groups of letters and the assessment of that Board that, essentially, the term 'fluege' is liable to be spontaneously perceived by the relevant public as being a mere spelling variant, not unusual in the context of the internet, of the German word 'Flüge'.
- 24 The fact that the term 'fluege' is followed by the top-level domain '.de' in the trade mark applied for does not, contrary to what the applicant suggests, imply a heightened level of attention of the relevant public with regard to that term.
- 25 On the contrary, the fact that the sign applied for may, in the light of its '.de' ending, be perceived at the outset by the relevant public as a domain name, and therefore as a reference to an internet address, is instead likely to suggest that that public will pay less attention to the fact that the term 'fluege' is formed with a first letter in lower case and the group of letters 'ue'.
- 26 It must be added that the fact of joining an element corresponding to a top-level domain (for example, the top-level domain '.de') to a descriptive term devoid of distinctive character does not have the effect of conferring on the resulting sign – which is then spontaneously identifiable by the relevant public as

a domain name and, therefore, as a reference to an internet address – a distinctive character. The distinctive part of such a domain name is not the top-level domain, which may consist of a dot and a group of letters corresponding to the national extension, but, at most, the second-level domain to which the top-level domain is joined.

- 27 With regard to the claim, essentially put forward by the applicant, that a trade mark consisting of a domain name should, even where the term is descriptive, be entitled to protection on the ground that any user of the internet would know that, even behind a domain name formed from a descriptive term, he will find the portal of a single commercial provider, such an argument must be rejected.
- 28 A domain name, as such, refers, at most, only to an internet address, and not to the commercial origin of goods or services of a specific producer or supplier. The practice in regard to the attribution of domain names and the use of domain names do not determine whether a domain name is, or is not, suitable for registration as a Community trade mark in the light of the absolute grounds for refusal set out in Regulation No 207/2009.
- 29 It is appropriate, in this connection, to bear in mind the need to draw a distinction between the rights derived from the registration of a domain name, on the one hand, and the rights derived from the registration of a sign as a Community trade mark, on the other hand. Thus, the fact that a party possesses a domain name, such as the domain name 'fluege.de', does not mean that that domain name can, by reason of that fact, be registered as a Community trade mark. In order for this to be the case, that domain name must fulfil all of the conditions laid down by Regulation No 207/2009 in that regard (judgment of 12 December 2007 in Case T-117/06 *DeTeMedien v OHIM (suchen.de)*, not published in the ECR, paragraph 44).
- 30 Thus, any argument which could be linked to the absence of a requirement that the term be available by reason of an alleged exclusive right acquired over the domain name at issue is therefore irrelevant (see, to that effect, *suchen.de*, paragraph 29 above, paragraph 44).
- 31 It follows from all of the foregoing considerations that the Board of Appeal did not err in forming the view, essentially, that the trade mark applied for might be perceived spontaneously by the relevant public as a domain name referring to the address of an internet page in the aviation and air-travel field.
- 32 The applicant submits that, even if the relevant public were to understand the trade mark applied for as being a domain name referring to a German internet address offering flights, the services at issue have no connection, or do not have any sufficient connection, with the offer of flights.
- 33 The applicant argues that the mark applied for cannot be perceived as having any descriptive significance with regard to the services of 'advertising', 'business administration' and 'office functions' (in Class 35), which are relevant to any commercial activity, or so far as concerns the 'services for providing food and drink' and 'accommodation services' (in Class 43), or even, having regard to its activity as a mere intermediary for the sale of flights, so far as concerns the services of 'transport', 'packaging and storage of goods' and 'travel arrangement' (in Class 39).
- 34 In the contested decision, the Board of Appeal held that the trade mark applied for was descriptive with regard to all of the services at issue.
- 35 In paragraph 21 of the contested decision, the Board of Appeal observed, in particular, that 'advertising' also included advertising for flights and air-transport undertakings, that 'business administration' and 'office functions' could be of a special nature, directed towards the particular requirements of air-transport undertakings, that 'transport' included transport by plane, that 'packaging and storage of goods' could refer to the secondary objective of transport of goods by plane, that 'travel arrangement'

and “services for providing food and drink’ encompassed the organisation of journeys by air and the provision of food and drink to air passengers and, lastly, that the ‘accommodation services’ could take account of the particular requirements of air travellers, as, for example, in the case of airport hotels.

- 36 The Board of Appeal found that the trade mark applied for therefore conveyed to the relevant public clear and direct information as to the nature of the services at issue (paragraphs 22 and 23 of the contested decision) and that that mark was, by virtue of that fact, descriptive of those services within the terms of Article 7(1)(c) of Regulation No 207/2009.
- 37 Contrary to what the applicant claims, that finding by the Board of Appeal is not incorrect.
- 38 First of all, the trade mark applied for, in so far as it is liable to be spontaneously perceived by the relevant public as a domain name referring to an internet page address in the field of aviation and air travel, is descriptive, within the terms of Article 7(1)(c) of Regulation No 207/2009, of the ‘transport’ services falling within Class 39 and, more specifically within those services, of air transport services.
- 39 In this connection, the applicant’s claim that its specific activity is not an air transport activity, but the activity of an intermediary in respect of the sale of flights, is entirely irrelevant. The assessment as to whether a mark is capable of being registered, regard being had to the absolute ground for refusal derived from Article 7(1)(c) of Regulation No 207/2009, does not in any way depend on the actual activity of the trade mark applicant, but solely on whether that mark is descriptive of the goods and services as they are indicated in the trade mark application.
- 40 It must be added that the fact that a word sign is descriptive in relation to only some of the goods or services within a category listed as such in the application for registration does not mean that that sign cannot be refused registration. If, in such a case, the sign in question was registered as a Community trade mark for the category covered, there would be nothing to preclude its proprietor from also using it for the goods or services of that category in respect of which it is descriptive (see judgment in Case T-304/06 *Reber v OHIM - Chocladefabriken Lindt & Sprüngli (Mozart)* [2008] ECR II-1927, paragraph 92 and the case-law cited, and *TRUEWHITE*, paragraph 16 above, paragraph 27).
- 41 As regards, secondly, the question whether the trade mark applied for is, in addition to ‘transport’ services, also descriptive of the other services at issue referred to in the trade mark application, it must be stated, as the Board of Appeal did and for the reasons set out in paragraph 35 above, that those other services, defined very widely in the trade mark application, may all be provided in the field of, and in close connection with, air transport and flights.
- 42 Since the applicant did not limit its trade mark application in order to exclude from the scope of that application those other services at issue in so far as they might be provided in the field of air transport and flights, the Board of Appeal was fully entitled to conclude, on the grounds expressed, inter alia, in paragraphs 20 to 22 of the contested decision, that the trade mark applied for was descriptive, within the meaning of Article 7(1)(c) of Regulation No 207/2009, of those other services at issue referred to in the trade mark application (Case T-315/03 *Wilfer v OHIM (ROCKBASS)* [2005] ECR II-1981, paragraph 70; see, by analogy, judgment of 11 February 2010 in Case T-289/08 *Deutsche BKK v OHIM (Deutsche BKK)*, not published in the ECR, paragraph 49).
- 43 It follows from all of the foregoing considerations that the present plea, alleging infringement of Article 7(1)(c) of Regulation No 207/2009, must be rejected as unfounded.

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

- 44 The applicant claims that, in view of the unusual nature of the term ‘fluege’ in German and of the particular attention paid by the relevant public as a result of the unique character of the registration of an internet domain, the trade mark applied for has the minimum distinctive character required to justify its registration.
- 45 OHIM contests the position adopted by the applicant.
- 46 The overlap between the absolute grounds for refusal implies, in particular, that a word mark which is descriptive of characteristics of goods or services may, on that account, be devoid of any distinctive character in relation to those goods or services, without prejudice to other reasons why it may be devoid of distinctive character (see order in Case C-282/09 P *CFCMCEE v OHIM* [2010] ECR I-2395, paragraph 52 and the case-law cited).
- 47 In the present case, it has been found that the Board of Appeal did not err in concluding that the trade mark applied for was descriptive in regard to the services at issue. In that context, it was, in particular, observed that the fact of joining a descriptive term devoid of distinctive character to a dot and a group of letters corresponding to a top-level domain does not have the effect of conferring on the resulting sign, which is then readily identifiable by the relevant public as a domain name referring to an internet address, a distinctive character.
- 48 It follows that the present plea, alleging infringement of Article 7(1)(b) of Regulation No 207/2009, must be rejected as unfounded.

The third plea, concerning the distinctive character acquired through use of the trade mark applied for

- 49 The applicant submits that the trade mark applied for has acquired a distinctive character through the use which has been made of it in Germany and in the other German-speaking territories of the European Union. It produces documents in that connection and infers from these that the trade mark applied for must be registered and the contested decision annulled.
- 50 OHIM submits that the distinctive character acquired through use has been invoked out of time before the General Court and that, in any event, it has not been established.
- 51 It should be noted that the purpose of actions before the General Court is to secure review of the legality of decisions of the Boards of Appeal of OHIM within the terms of Article 65 of Regulation No 207/2009. Moreover, Article 135(4) of the Rules of Procedure of the General Court provides that the parties’ pleadings may not change the subject-matter of the proceedings before the Board of Appeal.
- 52 In the present case, it is apparent from the case-file that the applicant did not argue, in the proceedings before OHIM, that the trade mark applied for had acquired a distinctive character through the use made of it, within the meaning of Article 7(3) of Regulation No 207/2009. Consequently, the issue of the distinctive character following the use allegedly made of the word sign at issue was not the subject of discussion before OHIM.
- 53 In that regard, it must be noted that the reliance, in *ex parte* proceedings as in *inter partes* proceedings, on distinctive character acquired as a result of use is a question of law which is independent of the issue of the intrinsic distinctive character of the mark in question. Therefore, where the party does not rely before OHIM on the distinctive character acquired by its mark, OHIM

is not required to examine of its own motion whether that distinctive character exists (see judgment of 10 March 2010 in Case T-31/09 *Baid v OHIM (LE GOMMAGE DES FACADES)*, not published in the ECR, paragraph 41 and the case-law cited).

54 Accordingly, it is not for the General Court to rule on that issue, which did not form part of the subject-matter of the proceedings before the Board of Appeal.

55 The third plea must therefore be rejected.

56 It follows from all of the foregoing considerations that the action must be dismissed.

Costs

57 Under Article 87(2) of the Rules of Procedure, 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 applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by OHIM.

On those grounds,

THE GENERAL COURT (Second Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Unister GmbH to bear its own costs and to pay the costs incurred by the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM).**

Forwood

Dehousse

Schwarcz

Delivered in open court in Luxembourg on 14 May 2013.

[Signatures]