

OPINION OF ADVOCATE GENERAL  
JACOBS

delivered on 10 April 2003<sup>1</sup>

1. Following its judgment in the *Baby-Dry* case,<sup>2</sup> the Court is again asked to rule on appeal<sup>3</sup> on the correct interpretation of Article 7(1)(c) of the Community Trade Mark Regulation.<sup>4</sup> Under that provision, a brand name consisting exclusively of signs or indications which may serve in trade to designate characteristics of the product concerned may not be registered as a Community trade mark.

2. Specifically, it must be decided whether the name 'Doublemint', used of chewing gum, falls within that category. In considering that question the Court has an opportunity to clarify, refine and develop the indications it gave on the interpretation of that provision in *Baby-Dry*. Such an opportunity is perhaps all the more welcome since, in my view, the effect of that judgment has been widely misunderstood.

Relevant legislation<sup>5</sup>

3. Article 4 of the Community Trade Mark Regulation provides as follows:

'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.'

4. Article 7 provides:

'1. The following shall not be registered:

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

<sup>1</sup> — Original language: English

<sup>2</sup> — Judgment of 20 September 2001 in Case C-383/99 P *Procter & Gamble v OHIM* [2001] ECR I-6251

<sup>3</sup> — Against the judgment of 31 January 2001 in Case T-193/99 *Wm Wrigley Jr Company v OHIM (Doublemint)* [2001] ECR II-417 (the 'judgment under appeal').

<sup>4</sup> — Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, OJ 1994 L 11, p. 1.

<sup>5</sup> — See also paragraphs 4 to 15 of my Opinion in *Baby-Dry* for a slightly fuller account of the context of these provisions.

(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 char-  
acteristics of the goods or service;

(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;

...

...

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

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

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

#### **Application for registration and proceed- ings at first instance in the present case**

5. Article 12 of the Trade Mark Regulation  
provides:

6. On 29 March 1996 Wm Wrigley Jr  
Company (‘Wrigley’) applied to the Office  
for Harmonisation in the Internal Market  
(Trade Marks and Designs) (‘the Office’)  
for registration of the word ‘Doublemint’  
as a Community trade mark for goods, in

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

particular chewing gum, in several classes of the Nice Agreement.<sup>6</sup>

association of two kinds of mint, peppermint and spearmint, which in itself is a special flavour. The trade mark is descriptive for goods likely to be capable of having a doublemint flavour’.

7. Wrigley stated at the hearing in the present appeal that its application for a Community trade mark seeks to consolidate its ‘portfolio’ of national registrations for the same mark in the Member States, and that registration is sought essentially for chewing gum, the application in respect of other categories being in anticipation of possible extensions of its commercial activities.<sup>7</sup>

9. On 16 June 1999 the Office’s First Board of Appeal dismissed Wrigley’s appeal against the examiner’s refusal. It found that ‘Doublemint’ was a combination of two English words with no additional fanciful or imaginative element; that it was descriptive of certain characteristics of the goods in question, namely their composition and their mint flavour, immediately conveying to potential consumers the message that the goods contain twice the usual amount of mint or are flavoured with two varieties of mint; and that ‘Doublemint’ could therefore not be registered as a Community trade mark, by virtue of Article 7(1)(c) of Regulation No 40/94. The fact that there is no compound word ‘doublemint’ was irrelevant, since an arbitrarily coined term does not come into being whenever a common adjective is combined with a common noun.

8. The Office’s examiner refused the application. He found that the trade mark ‘consists exclusively of the word DOUBLE-MINT, which may serve in trade to designate the characteristics of the goods. The term doublemint can be defined as the

10. Nor did the Board accept the relevance of the alternative meanings for both ‘double’ and ‘mint’. When assessing whether a trade mark is descriptive, dictionary definitions cannot be applied mechanically without regard for commercial reality or for the context in which the mark is to be used. A consumer seeing the

6 — Nice Agreement concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957. As requested in the application, registration was to be for:

‘Class 3 – Cosmetics, dentifrices, including chewing gum for cosmetic purposes;

Class 5 – Pharmaceutical, veterinary and sanitary preparations, including chewing gum for medical purposes, chewing gum with medicinal additives;

Class 25 – Clothing, footwear, headgear;

Class 28 – Games and playthings, gymnastic and sporting articles (included in Class 28); decorations for Christmas trees.

Class 30 – Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, coffee substitutes, flour and preparations made from cereals, bread, biscuits, cakes, pastry and confectionery, caramels, ices; honey; treacle, yeast, baking powder, salt, mustard; pepper, vinegar, sauces (condiments), spices; ice; confectionery and chewing gum without medicinal additives, confectionery including chewing gum; sugar-coated chewing gum, chewing gum plain, non-medicated confectionery, chocolate, sugars, candy.’

7 — It may be noted that according to the Office, which has not been contradicted by Wrigley on this point, the present proceedings concern only the applications for registration in Classes 3, 5 and 30, and not in Classes 25 and 28.

expression ‘doublemint’ on a packet of chewing gum or in an advertisement for chewing gum would assume that the product contained a great deal of mint or the flavour of mint.

11. On 1 September 1999 Wrigley appealed to the Court of First Instance. In the judgment under appeal, that Court noted that Article 7(1)(c) of Regulation No 40/94 precludes the registration of signs which, by reason of their purely descriptive nature, are incapable of distinguishing the goods of one undertaking from those of another. By contrast, signs or indications whose meaning goes beyond the merely descriptive are capable of being registered as Community trade marks.<sup>8</sup>

12. The Court of First Instance held that the word ‘Doublemint’ was not exclusively descriptive. Used as a term of praise, the adjective ‘double’ was unusual when compared with other English words such as ‘much’, ‘strong’, ‘extra’, ‘best’ or ‘finest’. When combined with the word ‘mint’, it had two distinct meanings for the potential consumer: ‘twice the usual amount of mint’ or ‘flavoured with two varieties of mint’. ‘Mint’ was a generic term including spear-

mint, peppermint and other culinary herbs; there were therefore several ways of combining two sorts of mint, and various strengths of flavour were possible for each combination.<sup>9</sup>

13. The numerous meanings of ‘Doublemint’ were immediately apparent, at least by association or allusion, to an average English-speaking consumer, depriving it of any descriptive function for the purposes of Article 7(1)(c) of the Trade Mark Regulation, whereas for a consumer with insufficient knowledge of English the term would have a vague and fanciful meaning.<sup>10</sup>

14. The Court concluded that ‘Doublemint’, when applied to the goods referred to in the application for registration, had an ambiguous and suggestive meaning open to various interpretations and did not enable the public concerned immediately and without further reflection to detect the description of the characteristic of those goods.<sup>11</sup> Since it was not exclusively descriptive,<sup>12</sup> the term could not be refused registration. The Board of Appeal’s decision was therefore annulled, and it is against that annulment that the Office has brought the present appeal, lodged on 20 April 2001.

<sup>9</sup> — Paragraphs 23 to 28.

<sup>10</sup> — Paragraph 29.

<sup>11</sup> — Paragraph 30.

<sup>12</sup> — Paragraph 31.

<sup>8</sup> — At paragraph 20 of the judgment.

The case-law: *Chiemsee* and *Baby-Dry*

serious need to keep a term available for use by other traders.

15. Two previous decisions of the Court of Justice are of particular relevance in the present case: *Windsurfing Chiemsee*<sup>13</sup> and *Baby-Dry*.<sup>14</sup>

16. *Windsurfing Chiemsee* concerned Article 3(1)(c) of the Trade Marks Directive,<sup>15</sup> which is identical in wording to Article 7(1)(c) of the Regulation but which applies to national and not Community trade marks. One of the questions raised was whether the term ‘Chiemsee’, the name of a Bavarian lake, could be registered as a trade mark in relation to sportswear sold locally or whether, since it was a term of geographical origin, it was precluded from registration by Article 3(1)(c), in particular in the light of the German-law concept of *Freihaltebedürfnis* (literally, the need to keep free), under which registration must be refused only if there is a real, current or

17. At paragraph 25 of its judgment, the Court stated that ‘Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks.’ In paragraphs 29 to 35 however it concluded that the aim was broader than that of *Freihaltebedürfnis* in German law; application of Article 3(1)(c) does not depend on there being a real, current or serious need to leave a sign or indication free but rather on whether that sign or indication ‘may serve in trade’ to designate (in that case) geographical origin.

18. In *Baby-Dry*, the interpretation of Article 7(1)(c) of the Regulation was in issue in the context of a mark having features in some ways comparable to those of ‘Doublemint’. Following a refusal of registration as a Community trade mark, the Court of First Instance essentially confirmed the Board of Appeal’s view that since the words ‘baby’ and ‘dry’ can both be used to describe characteristics of babies’ nappies, a mark consisting of nothing other than those words cannot, by virtue of Article 7(1)(c), be registered for such goods.

13 — Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779.

14 — Cited above in note 2. See also the Opinions of Advocate General Ruiz-Jarabo in Case C-363/99 *Koninklijke KPN Nederland* (*‘Postkantoor’*), still awaiting judgment, and Case C-104/00 P *DKV Deutsche Krankenversicherung v OHIM* [2002] ECR I-7561 (*‘Companyline’*), referred to in paragraph 74 below.

15 — 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.

19. In my Opinion in the ensuing appeal to the Court of Justice, I took the view, first, that a Community trade mark may include descriptive terms but may not consist exclusively of them.<sup>16</sup> I then considered that the brand name ‘Baby-Dry’ contained elements additional to the descriptive terms ‘baby’ and ‘dry’: extreme ellipsis, unusual structure and resistance to any intuitive grammatical analysis that would make the meaning immediately clear. In addition, ‘Baby-Dry’ was an invented term and as such less likely to be used descriptively in trade and could moreover allude to many very different types of product, lessening its descriptiveness in relation to babies’ nappies. Failure to take such factors into account was an error in law.<sup>17</sup>

20. In its judgment the Court stated that the purpose of Article 7(1)(c) was to prevent registration of signs or indications which, being no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them.<sup>18</sup> Such signs and indications were those which may serve in normal usage from a consumer’s point of view to designate those goods or services, directly or by reference to an essential characteristic. A mark composed of such signs or indications should not be refused if

it included other signs or indications or if the purely descriptive signs or indications were presented or configured in a manner that distinguished the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.<sup>19</sup>

21. As regards trade marks composed of words, descriptiveness must be determined in relation not only to each word separately but also to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics might render the combination distinctive, enabling it to be registered as a trade mark.<sup>20</sup>

22. Since a combination of words cannot be registered as a Community trade mark if it is purely descriptive in one of the languages used in trade within the Community, the question was whether from the point of view of an English-speaking consumer a combination such as ‘Baby-Dry’ could be viewed as a normal way of referring to the goods or representing their

16 — Paragraphs 75 to 81.

17 — Paragraphs 82 to 97.

18 — Paragraph 37.

19 — Paragraph 39.

20 — Paragraph 40.

essential characteristics in common parlance. Whilst each of the two words might form part of expressions used in everyday speech to designate the function of babies' nappies, their syntactically unusual juxtaposition was not a familiar expression in English, either for designating nappies or for describing their essential characteristics. The Court of First Instance had thus erred in law and both its judgment and the Board of Appeal's decision were annulled.<sup>21</sup>

also rejects the suggestion that Article 12(b) is sufficient to protect fair use of descriptive terms where related terms are registered as trade marks; it is therefore necessary to screen out such marks at the registration stage.

### Main submissions in the present appeal

23. The appeal and response in the present case were both lodged between the delivery of the Opinion and that of the judgment in *Baby-Dry*. After the delivery of the judgment in that case, both Germany and the United Kingdom lodged statements in intervention (in support of the Office) in the present case.

24. In its appeal, the *Office* accepts that Article 7(1)(c) does not embrace the German concept of *Freihaltebedürfnis* but considers that the public-interest rationale behind it must be taken into account. It

25. When determining whether a mark falls within Article 7(1)(c), the first step is to determine whether it is immediately (normally, spontaneously) apparent to an ordinary consumer that the words used are descriptive of features of the relevant goods. The fact that a term may have several meanings is not relevant, as long as they are all descriptive. Moreover, a sign need not already be used descriptively in trade, or be factually descriptive, but need only be capable of being so used and of being perceived by the relevant consumer as describing one or another of the product's characteristics. The next step is to determine whether the mark consists *exclusively* of such descriptive elements – in other words, whether there are no other elements, particularly figurative, grammatical or semantic, which would render an otherwise descriptive sign distinctive.

26. The reasoning of the Court of First Instance is that (i) 'double' and 'mint' are both ambiguous, and even more so when combined; (ii) the numerous meanings of the composite term 'Doublemint' are immediately apparent to an average English-speaking consumer, and thus do not

<sup>21</sup> — Paragraphs 41 to 46.

enable him immediately and without further reflection to detect the description of a characteristic; (iii) consequently, the term cannot be characterised as exclusively descriptive.

27. That reasoning is wrong because (i) the ambiguity is less than suggested; (ii) an average consumer of chewing gum will not perceive such ambiguity as affecting the descriptive message of a mint flavour somehow doubled; and (iii) the question is not whether the composite term is itself exclusively descriptive, but whether it is composed exclusively of elements which are descriptive.

28. *Wrigley* submits that a combination of words is to be assessed under Article 7(1)(c) by considering whether in its exact setting it forms a sign which has exclusively descriptive features in relation to the relevant goods and services – a sign which is clearly and unambiguously, fully and exclusively, descriptive of certain characteristics. A proper test is whether the combination is used in ordinary language to refer to the products or any characteristics thereof. If not, that suggests that it does not consist exclusively of signs that may serve in trade to designate the kind, quality, quantity or any other character-

istics of the relevant products. It is irrelevant that each element of the composite term may itself appear as everyday language; the question is whether the combination has been or may be used as a product description and whether it would appear to any reasonably well-informed, observant and circumspect person, namely the average consumer, that the mark filed was merely and solely a description of a certain characteristic, or rather, in the context of everyday language and not analysed grammatically, an invented term that does not itself form part of the common language.

29. As regards chewing gum, the question is whether in the average consumer's view the trade mark in question would appear like a brand name on the packaging or a description of certain characteristics of the product. If it appears to be an invented term whose grammatical structure does not make the exact meaning immediately clear, or if any ambiguities remain as to the exact characteristics described, it is a suggestive rather than an exclusively descriptive term.

30. Whilst Article 7(1)(c) may not fully embrace the concept of *Freihaltebedürfnis* it does cover the need to keep descriptive terms freely available. However, that



applies only where there is a reasonably clear and foreseeable need for competitors to use the exact term to describe features of their products. In nearly a century since ‘Doublemint’ was first registered as a trade mark in the United States, including many years of registration in the Community, no competitor has sought to use the word descriptively – a good indication that the term is not solely descriptive and does not need to be kept in the public domain.

with regard to German-speaking consumers, who would be likely to assimilate ‘Doublemint’ to its German equivalent ‘Doppelminze’ – making only the objective statement that the products either have a double (especially strong) mint flavour or contain two different varieties of mint, and thus immediately describing their material composition. The term is in fact used in trade, with those meanings, to describe a variety of goods. The fact that there may be hesitation as to which of the two meanings is intended is irrelevant, since both describe characteristics of the goods.

31. Citing the judgment under appeal and the Opinion in *Baby-Dry*, Wrigley contends that the combination ‘doublemint’ is elliptical and resists intuitive grammatical analysis. It has a multiplicity of meanings which cannot be easily interpreted; there is no standard of ‘single mint’ against which it can be measured; the first impression of the average consumer is a brand name and not a description.

33. The *United Kingdom* submits that the purpose of Article 7(1)(c) is to prevent signs or indications that are descriptive of the characteristics, or which are simply suitable for such descriptive use in normal use by an average consumer, from being used as trade marks by one undertaking alone. In the public interest, they should be freely available for use – and Article 12 is not a sufficient safeguard, since it cannot prevent a trade mark owner from bringing unmeritorious infringement proceedings, at significant cost to competitors.

32. The *German Government* considers that ‘Doublemint’ is a compound term formed in accordance with linguistic rules – rules which are essentially the same in German, so that the question arises also

34. The *Baby-Dry* judgment is difficult to reconcile with that in *Windsurfing Chiemsee*. The Court may now wish to make it clear that a term does not have to be in current descriptive use to be precluded

from registration, but that a reasonable apprehension that it may be so used in the future suffices; and that, where more than one term is suitable for describing the characteristics of goods, each of those terms should be precluded from registration.

though not for ‘cake’ and ‘chocolate’, for which it also sought registration.

### Assessment

35. The judgment under appeal misinterpreted the Trade Mark Regulation in four ways: (i) the test of whether the term enables the public concerned immediately and without further reflection to detect the description of a characteristic of the goods in question is not in the Regulation and is excessively restrictive; (ii) the concept of ‘unusual’ should not have been used in relation to the adjective ‘double’ – the test in the Regulation is whether the sign is descriptive in normal use by the average consumer; (iii) ambiguity is not in itself sufficient – a term does not cease to be descriptive because it has more than one meaning; (iv) the Regulation does not require that the sign in question be exclusively descriptive – ‘exclusively’ qualifies ‘consists of’, and a sign which has a descriptive dimension, even if it is not exclusively descriptive, must be refused registration.

37. At one level, the course to be taken with regard to this appeal seems rather obvious. As has been pointed out in particular by the Office and the United Kingdom Government, there are two apparent flaws in the Court of First Instance’s reasoning which make it difficult to uphold the judgment under appeal.<sup>22</sup>

38. First, in paragraphs 31 and 32 of the judgment, that Court states that the contested decision must be annulled because the term ‘Doublemint’ ‘cannot be characterised as exclusively descriptive’, whereas the criterion in Article 7(1)(c) is that trade marks may not be registered which ‘consist exclusively of signs or indications which may serve, in trade, to designate... characteristics of the goods or service’ concerned.

36. Wrigley might however be entitled to registration on the basis of long and effective use of the sign under Article 7(3) of the Regulation, at least for chewing gum,

22 — I should draw attention at this point to a possible misunderstanding of my Opinion in *Baby-Dry*. Paragraph 95 of that Opinion summarises the Court of First Instance’s judgment in *Doublemint* and paragraph 96 begins ‘... that type of approach, with which I agree,...’. However, I was agreeing with a broader approach to Article 7(1)(c) exemplified in several decisions of the Boards of Appeal and the Court of First Instance set out in paragraphs 93 to 95, rather than endorsing the specific reasoning or result in any of those cases.

39. The word ‘exclusively’ in that provision qualifies the verb ‘consist’; it refers to the elements of which the mark is composed and not to their capacity to designate characteristics. In order for registration to be precluded under Article 7(1)(c) of the Trade Mark Regulation, all the elements must have such a descriptive capacity; it is not necessary on the other hand that they can have no other, non-descriptive, meaning. A decision on registrability which is based on the latter criterion in the context of Article 7(1)(c) is *prima facie* wrong in law.

40. It is none the less necessary to examine the judgment under appeal in greater depth before deciding that it must be annulled on that ground. The succinct formulation of paragraphs 31 and 32 might be simply an unfortunate telescoping of the correct criterion. What is more important is the reasoning by which the Court of First Instance arrived at its conclusion in those paragraphs.

41. That reasoning was essentially that ‘double’ is not a usual term of praise and that, combined with ‘mint’, it has two distinct meanings, while ‘mint’ itself covers different varieties of a particular herb. The multiple meanings of the two terms in combination are immediately apparent to an average English-speaking consumer, so that the combination cannot fulfil a descriptive function. Thus ‘Doublemint’ is ambiguous and suggestive and does not enable the public concerned immediately

and without further reflection to detect a description of characteristics of the relevant goods.

42. Therein lies the second and more serious flaw in the judgment under appeal. The fact that ‘double’ and ‘mint’ in combination give rise to a multiplicity of possible meanings – are ambiguous or suggestive – does not necessarily deprive that combination of its capacity to serve in trade to designate characteristics of a product (such as chewing gum).

43. It is immediately possible to think of many other instances of general characteristics which may require further definition before the consumer can be sure of what is referred to but which none the less quite clearly remain characteristics of the product in question. To take but one example, to qualify a product as ‘natural’ is undoubtedly to designate one of its characteristics, whilst leaving any consumer in considerable doubt as to the precise nature of that characteristic, unless further details are provided. Indeed, it is relatively difficult to find ‘indications which may serve to designate characteristics’ which do not call at some level for further precision.

44. And ‘double’, whilst perhaps not a usual term of praise, is far from unusual as an intensifying qualification of a characteristic of a product, in which context it

too may lack precision without conferring some different nature on the whole expression. If, for example, a consumer remains unsure whether a ‘double’ liqueur chocolate contains two different types of liqueur (and/or chocolate) or twice as much liqueur (and/or chocolate) as some other unspecified standard, he is none the less practically certain to apprehend that a characteristic of the product (its liqueur or chocolate ingredient) is being designated as in some way doubled or duplicated, even if not literally or precisely so. The term in question may thus serve in trade to designate such a characteristic.

45. The question whether any particular expression may serve in trade to designate a characteristic of any particular product is one of fact and this Court is not competent to quash a judgment of the Court of First Instance on a point of fact. There may moreover be cases in which the number of meanings which may be ascribed to a compound term is particularly vast, and the only one capable of designating product characteristics is particularly obscure and thus unlikely to be used.

46. However, the assumption on which the judgment under appeal is based is that any ‘multiplicity of possible semantic combina-

tions’ automatically makes it impossible for any (compound) term to designate a characteristic of the product(s) in respect of which registration is sought. That assumption is an interpretation of the legal rule in Article 7(1)(c) of the Trade Mark Regulation. It is in my view clearly wrong as a general proposition.

47. It may be noted that the Court of First Instance itself has considered it to be wrong in its judgment in *Truckcard*,<sup>23</sup> in which it stated that ‘... in order to come within Article 7(1)(c) of Regulation No 40/94, it is sufficient that at least one of the possible meanings of a word sign identifies a feature of the goods or services concerned’. Furthermore, the number of semantic combinations referred to by the Court of First Instance in the present case is limited and none of them is obscure as a designation of a characteristic of chewing gum.

48. The judgment under appeal may therefore be quashed on that ground.

49. If the judgment is quashed, it is still necessary to decide whether Wrigley’s original application to the Court of First Instance should be upheld or dismissed. In that context, it is appropriate to examine

23 — Case T-358/00 *DaimlerChrysler v OHIM (Truckcard)* [2002] ECR II-1993, at paragraph 31.

certain other arguments which have been raised and which, on some points, might call for a refinement of the *Baby-Dry* judgment.

52. That view is not universally shared. Although the Court of First Instance has tended to take the same approach, viewing the two sets of criteria as overlapping but independent,<sup>25</sup> the Court of Justice appeared to assimilate them to some extent at paragraphs 40 and 44 of the judgment in *Baby-Dry*.

### *The contours of 'descriptiveness'*

50. The term 'descriptiveness' is commonly used for the capacity of terms to designate product characteristics in trade, in the context of Article 7(1)(c) of the Trade Mark Regulation. It is a convenient shorthand for that notion, although it is perhaps preferable to keep the substance of the exact criterion in mind, as I shall endeavour to do.

53. It is true that a term which may serve in trade to designate product characteristics will almost certainly be devoid of distinctive character. I none the less still consider it preferable, in the legislative context of the Community Trade Mark Regulation, neither to conflate the two criteria nor to view them as inherently interdependent.

54. I shall not pursue the point, since in the present case there has been no question of refusing registration of 'Doublemint' on the basis of a lack of the distinctive character with which Article 7(1)(b) is concerned.

51. In my Opinion in *Baby-Dry*,<sup>24</sup> I took the view that Article 7(1)(c) of the Trade Mark Regulation, which precludes registration of signs consisting solely of elements which may be used in trade to designate products or their characteristics, should be viewed independently of Article 7(1)(b), which precludes registration of signs lacking any distinctive character.

55. Wrigley has, it is true, asserted that consumers in fact perceive the term as identifying a brand of chewing gum, not as describing its flavour. However, that argu-

25 — See, for example, Case T-345/99 *Harbinger Corporation v OHIM (Trustedlink)* [2000] ECR II-3525, paragraph 31 of the judgment, and Case T-34/00 *Eurocool Logistik v OHIM (Eurocool)* [2002] ECR II-683, at paragraph 25. See also the Opinion of Advocate General Ruiz-Jarabo in *Postkautoor*, cited above in note 14, at paragraph 40.

24 — At paragraphs 61 to 74.

ment as such is of little relevance to the question whether ‘Doublemint’ consists exclusively of terms which may serve in trade to designate one or more of the product’s characteristics. It could on the other hand be very relevant to the plausible but quite separate claim, not raised in the present proceedings, that ‘Doublemint’ has become distinctive in relation to Wrigley’s brand of chewing gum in consequence of the use which has been made of it, so that registration might well be possible by virtue of Article 7(3) of the Trade Mark Regulation.

56. A more relevant question in the present proceedings is whether, as Wrigley contends, the admittedly imprecise semantic content of ‘Doublemint’ might take it out of the realm of the descriptive (that is to say, of Article 7(1)(c)) and into the realm of the merely allusive or suggestive.

57. There is clearly a line to be drawn between terms which may be used to *designate* products or their characteristics and those which are merely suggestive of such characteristics. The latter may be registered and are obviously of great value to the trade mark owner.

58. Exactly where that line is to be drawn is however less clear. In each case, there

will come a point where an individual decision must be made. However, some general guidelines may be suggested.

59. First, it is important not to lose sight of the question which has to be answered: in relation to the product or products for which registration is sought, is this a sign or indication which may serve in trade to designate a characteristic covered by Article 7(1)(c)?

60. Next, if one looks at the case-law of the Court of First Instance and the decisions of the Boards of Appeal – and indeed at the case-law of many national courts – it becomes apparent that the criteria which have regularly been applied, although expressed in various forms of words, fall within a number of consistent categories. In what follows I do not seek to innovate, or to improve on those criteria, but rather to suggest a framework within which they may be placed with a view to facilitating the assessment.

61. It seems obvious that there is no clear-cut distinction between indications which designate a characteristic and those which merely allude suggestively to it. There is no precise point at which a term suddenly switches from one category to the other, but rather a sliding scale between two extremes and an element of subjective judgment will often be required in order to determine to which extreme a term is

closer. In the light of existing practice and case-law, and with a view to establishing a slightly greater degree of objectivity, I would suggest that a proposed trade mark should be assessed from three points of view, although I would not claim that list to be final or exhaustive.

to the product, in particular in the consumer's mind. Where the characteristic designated is essential or central to the product, or is of particular importance in a consumer's choice, then the case for refusing registration is compelling; where the designation is of a characteristic that is purely incidental or arbitrary, the case is considerably weaker.

62. The first point of view concerns the way in which a term relates to a product or one of its characteristics. The more factual and objective that relationship, the more likely it is that the term may be used as a designation in trade, so that registration will be precluded by Article 7(1)(c); conversely, the more imaginative and subjective the relationship the more acceptable the term will be for registration.

65. I would stress however that the question of precision, accuracy or factual correctness is not normally relevant to the examination from any of those points of view. As I have stated above, practically any designation of a product characteristic can be rendered more precise, and it is obvious that descriptions used in trade may be untruthful whilst still serving to designate product characteristics – indeed, it is for that very reason that misleading descriptions are generally prohibited.

63. The second point of view concerns the way in which a term is perceived: how immediately is the message conveyed? The more ordinary, definite and down-to-earth a term is, the more readily a consumer will apprehend any designation of a characteristic and the more likely the term thus is not to qualify for registration as a trade mark. Where at the other extreme the skills of a cryptic-crossword enthusiast are needed in order to detect any connection with the designated characteristic, the grounds for refusing registration are very weak indeed.

66. Once a proposed trade mark has been assessed separately from each of the three proposed points of view, a final decision must be taken. It is impossible to lay down absolute rules, but in general it would seem plausible that a mark should be refused registration under Article 7(1)(c) if, overall, it appears to be nearer the 'non-registrable' end of the scale taking the three points of

64. The third point of view concerns the significance of the characteristic in relation

view into account or if, from even one point of view, it is particularly near that end of the scale.<sup>26</sup>

67. Applying that approach to ‘Doublemint’, I find that Wrigley’s contention must fail. First, the compound term is a factual, objective reference to mint flavour in some way doubled; second, it is readily perceivable as such; and third, such a flavour is a salient feature of the product. The fact that neither the particular variety or varieties of mint involved nor the precise mode of doubling can be discerned in no way detracts from the fact that the term designates a characteristic of doubled mintiness.

*The phrase ‘consists exclusively of’ in Article 7(1)(c)*

68. Wrigley has further argued both at first instance and on appeal that, while both ‘double’ and ‘mint’ may be used to designate characteristics of chewing gum, the compound ‘Doublemint’ consists of more than just those elements. It stresses that the

26 — Such an approach must of course be tempered with common sense. For example, for chewing gum sold in strips, ‘Two-Inch’ might be a purely factual and readily understandable reference to the length of the strip, but that characteristic might be so peripheral as to override a high score on the first two scales.

term is not to be found in dictionaries but is Wrigley’s own ‘lexical invention’.<sup>27</sup> It also asserts that, like ‘Baby-Dry’, ‘Doublemint’ has an ‘elliptical nature’, an ‘unusual structure’ and a ‘resistance to any intuitive grammatical analysis’,<sup>28</sup> and comprises a ‘syntactically unusual juxtaposition’.<sup>29</sup> Those are in its view additional elements which form part of the term, with the result that it does not ‘consist exclusively of’ the descriptive items ‘double’ and ‘mint’.

69. Such features are, as I said in my Opinion in *Baby-Dry*, elements which should enter into the assessment of a mark for which registration is sought. However, the mere presence of one or more of them does not necessarily mean that registration must be granted. The degree of ellipsis, of unusualness and of resistance to intuitive analysis must also be taken into account.

70. In the case of ‘Doublemint’ those features are in my view very considerably less marked than in that of ‘Baby-Dry’.

27 — See the judgment in *Baby-Dry*, at paragraph 44.

28 — See the Opinion in *Baby-Dry*, at paragraph 90.

29 — See the judgment in *Baby-Dry*, at paragraph 43.



71. To an English-speaker, the most striking feature of 'Baby-Dry' is its inversion of usual word order<sup>30</sup> in such a way as to require its being placed in a longer phrase in order to acquire complete and immediate grammatical sense, only the longer phrase being suitable to designate a product such as nappies or a characteristic thereof.

72. 'Doublemint' however does not display such inversion. The placing of a qualifier such as 'double' before a characteristic such as 'mint' is not structurally or syntactically unusual. Nor, consequently, is the combination grammatically elliptical or does it resist intuitive grammatical analysis. Such limited ellipsis and resistance to analysis as it may display are essentially semantic rather than grammatical and, as I have pointed out above, certainly do not render the term unsuitable for designating a characteristic of the relevant goods. Finally, whilst 'doublemint' as such may be absent from dictionaries, the degree of lexical invention deployed in its creation is essen-

tially limited to removing the space between two words which may well be used together descriptively.

73. The Court's statement at paragraph 40 of its judgment in *Baby-Dry* is relevant here: 'Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.' The question which arises is the precise import of 'any perceptible difference', and it may be helpful for the Court to clarify that concept in the present case.

74. Advocate General Ruiz-Jarabo has suggested certain elucidatory criteria in two recent Opinions.<sup>31</sup> He points out that 'perceptible' is a relative term and must not be confused with 'minimal'.<sup>32</sup> For word marks, he proposes that 'a difference will be regarded as perceptible if it affects important components of either the form of the sign or its meaning. As regards form, a perceptible difference arises where, as a result of the unusual or imaginative nature of the word combination, the neologism

30 — It is, as the agent for the Office pointed out with great learning at the hearing, an anastrophe. I would however take issue with his perhaps playful contention that 'Advocate General' is similarly anastrophic. 'Advocate General' forms part of a familiar, well-defined series of compound terms in English in which a noun is followed by its qualifier. Only certain types of designation fall within that series, and 'baby dry' is not among them. Compare Dorothy Parker's legendary and caustically concise drama review in which she ridiculed an unusual inversion: '*The House Beautiful* is *The Play Lousy*' (cited in many sources in slightly different forms, apparently originally in *The New Yorker* in 1933). She would not, I venture to suggest, have chosen the same form of words to vent her scorn if the play had been called 'The Advocate General', however lousy it might have been.

31 — In *Postkantoor* and *Companyline*, both cited above in note 14

32 — Opinion in *Companyline*, at paragraph 50.

itself is more important than the sum of the terms of which it is composed. As regards meaning, a difference will be perceptible provided that whatever is evoked by the composite sign is not identical to the sum of that which is suggested by the descriptive components.’<sup>33</sup>

75. In a different though not unrelated context the Court has very recently held that, for the purposes of Article 5(1)(a) of the Trade Marks Directive, a sign may be considered identical to a trade mark where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.<sup>34</sup>

76. Similarly, any difference between terms used in the mark whose registration is sought and those which may serve in trade to designate characteristics of the relevant products must be more than minimal before registration can be accepted. If that were not so, it would be possible to register any mark which to all practical intents and purposes consisted exclusively of terms which may serve to designate a product’s characteristics, save for some insignificant discrepancy introduced solely in order to obtain registration. Such a situation would

clearly be contrary to the legislative intention of Article 7(1)(c) of the Trade Mark Regulation.

77. However, the degree of difference necessary to constitute an additional element in a trade mark, so that it no longer consists exclusively of terms which may serve in trade to designate characteristics of the relevant products, must in my view be greater than that which renders two marks similar rather than identical. Advocate General Ruiz-Jarabo’s reference to ‘important components’ of the form or meaning thus seems to me an appropriate formulation, and his further developments both helpful and apposite. From a slightly different point of view, I would suggest that the difference – the addition of at least one element, or the subtraction of some significant element – must be such that it is apparent to both traders<sup>35</sup> and consumers that the mark as a whole is not suitable, in the ordinary language of trade, as a designation of characteristics of the product in question.

78. The application of such criteria to any specific case is of necessity to a certain extent subjective, but it seems to me that the limit which they trace passes between the cases of ‘Baby-Dry’ and ‘Doublemint’. The unusual syntactical features of ‘Baby-

33 — Opinion in *Postkantoor*, at paragraph 70, referring to art 3(1)(c) of the Trade Marks Directive.

34 — Case C-291/00 *LTJ Diffusion* [2003] ECR I-2799.

35 — Since it would seem appropriate to view a term ‘which may be used in trade’ also from the trader’s point of view.

Dry' form a significant addition to the lexical terms used in its composition, whereas those of 'Doublemint' do not. The former is not, in the form in which registration was sought, suitable in the ordinary language of trade to designate the nature or characteristics of nappies, whereas the latter perceptibly lends itself to the designation of characteristics of mint-flavoured or mint-scented products.

well not appear unusual to a speaker of a Romance language, so that for such a consumer that feature would not constitute an additional element over and above the descriptive terms used. Under Article 7(2) of the Trade Mark Regulation an application must be refused even if the grounds of non-registrability obtain in only part of the Community. Thus – presumably – a sign should be assessed in the light of the perception of consumers in all Member States.

*The 'shoes of an English-speaking consumer'*

79. At paragraph 42 of the judgment in *Baby-Dry*, the Court stated that, in order to assess that word combination, it was necessary to put oneself 'in the shoes of an English-speaking consumer'. I have taken the same approach above in considering 'Doublemint' – as did the Court of First Instance in the judgment under appeal.

80. However, some doubt has been cast on the validity of that method.<sup>36</sup> For example, it has been suggested, the inversion of normal word order in 'Baby-Dry' might

81. In a slightly different vein, the German Government has submitted in the present appeal that consideration should be given to the effect of 'Doublemint' on a German-speaking consumer, who would be likely to assimilate it to the German coinage 'Doppelminze' and thus to view it as descriptive.

82. Those points are in fact not directly relevant to the approach I have taken in the present Opinion, since my analysis leads to the view that 'Doublemint' does consist exclusively of terms which, from the point of view of the English-speaker, may be used in trade to designate characteristics of the product concerned. By that token however they could have been more relevant if my analysis had led to the opposite view, and it may be useful to consider them briefly.

<sup>36</sup> — See in particular the Opinion of Advocate General Ruiz-Jarabo in *Postkantoor*, at paragraph 68 and note 46; and Annette Kur, 'Examining wordmarks after *Baby-Dry* – Still [a] worthwhile exercise?', *IPR-Info* 2001, p. 12, at p. 14.

83. First of all, it is clear that when an application is made to register a trade mark which consists of terms drawn from a language used in trade in the Community, the first stage of the assessment under Article 7(1)(c) must be from the standpoint of a native speaker of the language concerned. If at that stage it is clear that the terms may be used in trade to designate characteristics of the relevant products, it is unnecessary to consider the position of speakers of other languages.<sup>37</sup>

84. In both *Baby-Dry* and *Doublemint*, the Office (both the examiner and the Board of Appeal) reached a decision on the basis of the English language. In neither case did the Court of First Instance consider – nor was it asked to consider – the situation from the point of view of a speaker of any other language. In such circumstances, it does not appear appropriate for the Court of Justice on appeal to embark on an examination from such a point of view. Where relevant, it will be for the Office to do so when the case is remitted to it.

85. However, it may be necessary in some circumstances for a sign consisting of terms drawn from one language to be assessed

through the eyes (or ears) of a Community consumer whose language is different.

86. For example, the English word ‘handy’, meaning easy to handle, might be seen as a possible word mark, or part of a mark, for a mobile phone. Since however that word is commonly used in Germany to designate a mobile phone, it could not be registered as a Community mark. Similarly, a term derived from one language may acquire a different meaning or connotation in another: the English word ‘smoking’ does not in English designate any characteristic of formal evening dress for men, whereas in French, German or Italian it designates what would in English be known as a dinner jacket or (by those who refer to nappies as ‘diapers’) a tuxedo.

87. It is different, however, where (as has been suggested in relation to ‘Baby-Dry’) speakers of one language, knowing a term to belong to another language, might misapprehend its originality in that other language by imposing on it features of their own language. It seems inappropriate to take as a normal yardstick a consumer struggling with an imperfect knowledge of a foreign tongue.

37 — Compare, with regard to distinctiveness, paragraph 40 of the judgment in *Companyline*.

88. It is moreover an important consideration that the existence of a trade mark composed of terms from one language does not in fact deprive traders who use a different language of any terms by which they may wish to designate characteristics of their products in their own language – subject of course to what I have said above concerning terms which, at least in form, are common to more than one language.

grammatical or semantic structure of a mark must thus pass the test of innovativeness and unusualness in each of those parts.

*Availability for general use*

89. Regardless of how Italian-speakers may perceive the brand name ‘Baby-Dry’, for example, the range of Italian terms with which Italian purveyors of nappies may describe their goods is no more diminished by it than the range at the disposal of British or Irish nappy-makers would be by a brand name as purely descriptive (in Italian) as ‘Pannolino’. That is indeed why, as the agent for the Office pointed out at the hearing, many national trade mark offices take no account of the meaning of words from a foreign language when assessing an application for a national trade mark.

91. That last consideration leads me to the question of the extent to which Article 7(1)(c) of the Trade Mark Regulation must be interpreted in the light of the aim referred to in the *Windsurfing Chiemsee* judgment, namely that descriptive signs and indications should be freely available to be used by all traders in relation to the relevant goods.

90. Assessment under Article 7(1)(c) should thus not be based on the question whether a term in a language used in one part of the Community<sup>38</sup> might in another part of the Community be thought to designate product characteristics, so that any innovative or unusual feature in the

92. In my Opinion in *Baby-Dry*,<sup>39</sup> I took the approach that in the scheme of the Community Trade Mark Regulation a trade mark could include signs or indications designating product characteristics but could not consist exclusively of them. By virtue of Article 12(b), the trade mark cannot prevent other traders from using such signs for descriptive purposes. The aim of Article 7(1)(c) is to avoid the registration of descriptive brand names for

38 — And why stop at Community languages?

39 — At paragraphs 75 to 81.

which no protection could be available rather than to prevent any monopolising of ordinary descriptive terms. A very similar view was taken by the Court at paragraph 37 of its judgment.

against an alleged ‘infringer’ who merely seeks to use descriptive terms descriptively and honestly. In the real world, a defence under Article 12(b) might be worth rather less than its ostensible value in law.

93. In the present case, both the Office and the United Kingdom Government have expressed reservations about that approach, which has also been criticised in the literature.<sup>40</sup> It appears, they have pointed out, to represent a departure from the Court’s statement in *Windsurfing Chiemsee* that Article 3(1)(c) of the Trade Marks Directive ‘pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all’ and that Article 6(1)(b) (which corresponds to Article 12(b) of the Regulation) does not have a decisive bearing on that interpretation.

95. That danger cannot be ignored. A trade mark owner wishing to monopolise not only his trade mark but the area around it may threaten unmeritorious proceedings against a competitor, who may capitulate rather than incur the costs of litigation as well as risk an adverse outcome.

94. It may be feared that the approach in question is liable to shift the balance of power in favour of a trade mark owner with monopolistic ambitions who may assert, or threaten to assert, his rights

96. However, for the reasons already given, I do not think that the *Baby-Dry* case, properly understood, does shift the balance in the way that has been suggested. And the danger mentioned will be obviated if the criterion of ‘perceptible difference’ in paragraph 40 of the *Baby-Dry* judgment is applied as I have suggested above, so that a mark is accepted for registration only when it is apparent to both traders and consumers that as a whole it is not suitable, in the ordinary language of trade, as a design-

<sup>40</sup> — See, for example, Tim Pfeiffer, *Descriptive trade marks – The impact of the Baby-Dry case considered* [2002] E.I.P.R. 373.

nation of characteristics of the product in question.<sup>41</sup>

97. In any event, it seems clear that there was no intention, in the *Baby-Dry* judgment, to depart from the view in *Wind-surfing Chiemsee* that it is in the public interest that descriptive signs may be freely used by all. Very recently, in *Linde*,<sup>42</sup> the Court has expressly reaffirmed that position.

#### *National trade mark registrations and list of goods*

98. I turn finally to two arguments raised by Wrigley at first instance, which may be dealt with succinctly: the existence of

41 — Moreover, it should be borne in mind that a trade mark including elements which may be used in trade to designate product characteristics is excluded from registration by Article 7(1)(c) only if it consists exclusively of such elements. The Office has registered a number of word marks including the term 'mint' for products in Class 30, where it must be clear that the term refers to a characteristic of the product. It has also registered, as figurative marks, 'Wrigley's Spearmint Chewing Gum' and indeed 'Wrigley's Doublemint Chewing Gum'. In all those cases additional verbal and/or other elements are present, so that registration is possible. The presence of those additional elements and the fact that terms such as 'mint', 'spearmint' and 'chewing gum' are clearly suitable to designate product characteristics, so that any descriptive use by competitors will just as clearly be covered by Article 12(b), make it considerably less likely that the trade mark owner will indulge in intimidation of the kind described or that a competitor will capitulate in the face of such tactics.

42 — Judgment of 8 April 2003 in Joined Cases C-53/01 to C-55/01 *Linde and Others*, ECR I-3161, especially at paragraphs 73 and 74 of the judgment and point 2 of the operative part.

registrations for 'Doublemint' in the Member States, Australia and the United States of America, and the failure of the Office to examine the term in relation to the exact list of goods in respect of which the application was made.

99. As regards the first point, the Office does not deny that it must consider registration in Member States or non-member countries as evidence of registrability, particularly where the language of the country of registration is that of the mark for which registration is sought. It points out, however, that such evidence does not necessarily constitute proof that the criterion in Article 7(1)(c) is met.

100. In that regard, I note that all of the registrations adduced were granted either for figurative marks (containing elements in addition to the term 'Doublemint') or (at least originally) under national legislation not subject to harmonisation by the Trade Marks Directive (and thus not providing evidence that the criteria in Article 7(1)(c) of the Trade Mark Regulation were met).

101. Since moreover it is clear that the Board of Appeal did consider Wrigley's

argument regarding this first point, I find no difficulty in dismissing it at this stage.

102. As regards the second point, it is clear that the Board of Appeal considered 'Doublemint' in the light of its capacity to designate flavour as a characteristic of a

product. The Office has stated, without being contradicted, that the present proceedings do not concern the application for registration in respect of products in Classes 25 and 28, of which flavour is not normally a salient characteristic. As regards the remaining classes of products, it would seem that only 'cosmetics' in Class 3 might not normally have (mint) flavour as a characteristic. They may none the less have mint as another organoleptic characteristic, in respect of which the assessment would be the same.

## Conclusion

103. In view of all the above considerations, I am of the opinion that the Court should:

- (1) quash the judgment of the Court of First Instance in Case T-193/99;
- (2) dismiss the application in that case; and
- (3) order Wm Wrigley Jr Company to pay the costs at first instance and on appeal.