

OPINION OF ADVOCATE GENERAL

LÉGER

delivered on 2 June 2005¹

1. This case concerns the appeal brought by BioID AG² against the judgment of the Court of First Instance of the European Communities (Second Chamber) of 5 December 2002 in *BioID v OHIM*³ dismissing the action brought against the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs),⁴ of 20 February 2001 (Case R 538/1999-2),⁵ refusing registration as a Community trade mark of the figurative mark reproduced below.

which must be taken into account in order to decide whether a sign composed, as in this case, of a word element and figurative elements is devoid of any distinctive character and must therefore be refused registration as a trade mark in accordance with Article 7(1)(b) of Council Regulation (EC) No 40/94.⁶



I — Legal framework

2. The questions raised in connection with this appeal relate in the main to the criteria

3. 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.

1 — Original language: French.

2 — Hereinafter 'BioID'.

3 — Case T-91/01 *BioID v OHIM* [2002] ECR II-5159, hereinafter 'the contested judgment'.

4 — Hereinafter 'the Office'.

5 — Hereinafter 'the contested decision'.

6 — Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (hereinafter 'the regulation').

4. Article 7 of the regulation concerns the absolute grounds for refusal to register. It 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;

(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;

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.’

II — Background to the dispute

5. On 8 July 1998, the appellant filed an application for a Community trade mark at the Office in respect of the mark reproduced above.

6. Registration of the mark was sought in respect of goods and services falling under various classes of the Nice Agreement,⁷ consisting of computer software, computer hardware and other apparatus designed to monitor user passwords by identifying human beings by means of specific biometric characteristics, and of telecommunications

7 — 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.

...

services in connection with those identification systems.⁸

7. By decision of 25 June 1999 the examiner refused the application in accordance with Article 7(1)(b) of the regulation, on the ground that the mark applied for was devoid of any distinctive character.

8. The appeal brought by the appellant was dismissed by the Office's Second Board of Appeal on the same ground for refusal. It based its decision on the definitions of the word 'bio' in German and English and of the abbreviation 'ID' contained in on-line telecommunications and computer technology dictionaries. It concluded from those definitions that the abbreviation 'BioID' constitutes a shortened form of the words 'bio-

metric identification' and thus a description of the kind and intended purpose of the goods and services covered by the application for registration. It stated that a consumer confronted with goods and services, while searching for a security system, designated by the term 'BioID' would automatically realise that it relates to the identification of the features of live organisms.

9. The Board also declared that, in the light of the expressions used by the appellant's competitors, they had an interest in being able to use the abbreviation 'BioID' to advertise their own goods and services.

10. Finally, it considered that the graphic elements which make up the sign in question do not endow the mark with any distinctive character and do not in any way alter its purely descriptive nature.

11. The appellant brought an action against the contested decision before the Court of First Instance.

8 — More specifically, they were the following goods and services:

- 'Computer software, computer hardware and parts therefor, optical, acoustic and electronic apparatus and parts therefor, all the aforesaid goods in particular for and in connection with the monitoring of user passwords, for computer intercommunication and for the computer-aided identification and/or verification of live organisms based on one or more specific biometric characteristics', in Class 9.
- 'Telecommunications; security services in connection with computer communications, access to databases, electronic payment transactions, the checking of user passwords and the computer-aided identification and/or verification of live organisms based on one or more specific biometric characteristics', in Class 38.
- 'Providing of software on the internet and other communications networks, on-line maintenance of computer programs, computer programming, all the aforesaid services in particular for and in connection with the monitoring of user passwords, computer intercommunication and the computer-aided identification and/or verification of live organisms based on one or more specific biometric characteristics; technical development of systems for monitoring user passwords, for computer intercommunication, and of systems for the computer-aided identification and/or verification of live organisms based on one or more specific biometric characteristics' in Class 42.

III — The contested judgment

12. In support of its action, the appellant put forward two pleas, alleging infringement of Article 7(1)(b) and of Article 7(1)(c) of the regulation.

13. The Court of First Instance dismissed the action. It held that the plea alleging infringement of Article 7(1)(b) of the regulation had to be rejected with regard to all the categories of goods and services referred to in the application for registration of the mark, and that it was therefore unnecessary to consider the plea alleging infringement of Article 7(1)(c) of the regulation.

14. The Court held that the sign in question and the elements of which it is composed, that is to say, the abbreviation 'BioID' and its figurative elements, consisting in the typeface used to reproduce that abbreviation, the full-stop and the element °, were all devoid of distinctive character.

15. It also rejected the appellant's arguments based on decisions of the Boards of Appeal

allowing registration of other marks containing the element 'Bio', such as the word mark 'Bioid'.

IV — The appeal

16. The appellant claims that the Court should set aside the contested judgment, annul the contested decision 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.

A — *Grounds of appeal*

18. The appellant explains that its appeal is based on two grounds. First, it complains that the Court of First Instance interpreted incorrectly and too broadly the absolute ground for refusal contained in Article 7(1)(b) of the regulation. Secondly, it claims that, had the Court interpreted that provision correctly, it would have had to examine the ground for refusal set out in Article 7(1)(c) of the regulation and reach the conclusion that it likewise did not apply in the present case.

19. In connection with the second ground of appeal, the appellant states, principally, that it considers that the state of the proceedings permits the Court of Justice itself to give final judgment and to hold that the sign in question is not of a descriptive nature within the meaning of Article 7(1)(c) of the regulation. It states, in the alternative, that, if the Court of Justice considers that it is unable to rule on the applicability of that ground for refusal because the Court of First Instance has not made sufficient findings of fact on that point, it should refer the case back to that Court.

20. Like the Office, I find it rather difficult to understand what infringement of Community law the appellant alleges, in the second ground of appeal, is contained in the contested judgment. It does not dispute that the Court, in so far as it held that registration of the mark in question was caught by the absolute ground for refusal set out in Article 7(1)(b) of the regulation, was fully entitled not to examine the ground alleging infringement of Article 7(1)(c), because it is evident from the wording of Article 7(1) that it is sufficient that one of the absolute grounds for refusal listed in that provision applies for the sign at issue not to be registrable.⁹

21. As a matter of fact, by its arguments in support of this ground of appeal, all that BioID seeks is for the Court of Justice, if the

first ground of this appeal is declared well founded, itself to rule on the second plea raised before the Court of First Instance against the contested decision, as it is permitted to do by Article 61 of the Statute of the Court of Justice,¹⁰ which provides that, if the appeal is well founded, the Court of Justice is to quash the decision of the Court of First Instance and may itself give final judgment in the matter, where the state of the proceedings so permits.

22. I conclude that the grounds of appeal invoked by the appellant in support of its claim for the annulment of the contested judgment in fact amount to a single plea, alleging infringement by the Court of First Instance of Article 7(1)(b) of the regulation.

23. In this one ground of appeal, the appellant puts forward four heads of claim. First, it complains that the Court of First Instance did not base its assessment of whether the sign in question could be distinctive on the impression created by that sign considered as a whole. Secondly, it complains that the Court did not take account of its argument that it could not be proved that the sign in question was actually used by the public or by competitors. Thirdly, it maintains that the Court

⁹ — Case C-104/00 P *DKV v OHIM* [2002] ECR I-7561, paragraph 29.

¹⁰ — As the appellant lodged the appeal on 3 February 2003, after the Treaty of Nice came into force on 1 February 2003, I am using the numeration of the articles as shown in that Treaty.

committed a legal error of assessment by holding that similar marks which had been registered were not evidence of the distinctive nature of the sign in question, and therefore infringed the principle of equal treatment.

24. At the hearing the appellant also claimed that the Court based its assessment on the criterion that marks which could commonly be used for the presentation of the goods or services concerned are not registrable, even though, as the Court of Justice held in its judgment in *SAT.1 v OHIM*,¹¹ that criterion is irrelevant to an examination of the ground for refusal laid down in Article 7(1)(b) of the regulation.

25. The Office pointed out that the appellant had not raised that argument in its appeal application, but did not dispute its admissibility. I would also note that the argument in question was not expressly mentioned in the appeal. However, I do not believe either that it is a new plea within the meaning of Article 42 of the Rules of Procedure, applicable to appeals by virtue of Article 118, pursuant to which pleas which are raised for the first time in the reply or the rejoinder or during

the oral procedure must be declared inadmissible.¹² I believe that they are considerations on the basis of which the appellant seeks to show the true nature and relevance of the plea alleging infringement of Article 7(1)(b) of the regulation, raised in its appeal. It is therefore an argument put forward in support of that plea,¹³ which may therefore properly be raised during the proceedings, provided that the *audi alteram partem* rule is observed. I should point out, in that regard, that the Office was able to reply to that complaint during the oral procedure. Furthermore, it cannot be claimed that the argument alters the subject-matter of the proceedings brought before the Court of First Instance, since it criticises the Court's response to the plea raised before it, alleging infringement of Article 7(1)(b) of the regulation. I therefore see no reason why the argument cannot be examined.

26. Before considering the various heads of claim, I shall refer briefly to the case-law which I consider useful for interpreting the grounds for refusal set out in Article 7(1) of the regulation that are relevant to the present case, and for determining the method of analysing those grounds for refusal if the sign in respect of which registration is sought is composed of several elements. I shall also mention the inferences which the Court of Justice drew from that case-law in *SAT.1 v*

12 — Case C-219/95 P *Ferriere Nord v Commission* [1997] ECR I-4411, paragraph 56, and Case C-299/98 P *CPL Imperial 2 and Unifrigo v Commission* [1999] ECR I-8683, paragraph 54.

13 — See inter alia Case 2/57 *Compagnie des Hauts Fourneaux de Chasse v High Authority* [1958] ECR 199 and Case C-153/96 P *De Rijk v Commission* [1997] ECR I-2901, paragraph 19.

11 — Case C-329/02 P *SAT.1 v OHIM* [2004] ECR I-8317.

OHIM, cited above, in which it ruled on the appeal brought against the judgment of the Court of First Instance of 2 July 2002 in *SAT.1 v OHIM (SAT.2)*,¹⁴ the grounds of which are similar to those of the contested judgment.

exclusively of signs or indications which may serve, in trade, to designate those goods or services or their characteristics, are considered unsuitable for constituting a trade mark, unless they have acquired a distinctive character through use.

B — The relevant case-law and the judgment in SAT.1 v OHIM

27. The presentation of the relevant case-law must take as its starting point the essential function of the mark, which is to guarantee the identity of the origin of the marked product or service 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.¹⁵

28. The aim of Article 7(1) of the regulation is to prevent registration as a trade mark of signs which are considered, owing to their nature, unsuitable for fulfilling that function. Accordingly, under Article 7(1)(b) and (c), trade marks which are devoid of any distinctive character so far as concerns the goods and services for which registration is sought, and trade marks which consist

29. According to the case-law, the grounds for refusal set out in Article 7(1)(b), (c) and (d) respectively of the regulation overlap in scope. In the light of the content of each of those grounds for refusal, I am even inclined to think that the signs referred to in Article 7(1)(c) and (d) constitute subsets of the broader category of signs devoid of any distinctive character within the meaning of Article 7(1)(b). Accordingly, it has been held, in relation to the signs and indications covered by Article 7(1)(c) of the regulation, that a word mark which is descriptive of the characteristics of the goods and services referred to in the application for registration within the meaning of that provision is, on that account, necessarily devoid of any distinctive character within the meaning of Article 7(1)(b) of the regulation.¹⁶

30. None the less, the circumstances required for a sign to fall within that subset are specific and must be interpreted in accordance with the general interest inherent in that ground for refusal. This is what the Court is saying when it describes the general scheme of Article 7(1) of the regulation,

¹⁴ — Case T-323/00 *SAT.1 v OHIM* [2002] ECR II-2839.

¹⁵ — See inter alia Case 102/77 *Hoffmann-La Roche* [1978] ECR 1139, paragraph 7, and Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 30.

¹⁶ — Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 86.

stating that each of the grounds for refusal listed in that provision is independent of the others, calls for separate examination¹⁷ and must be interpreted in the light of the general interest underlying each of them. That general interest may, or even must, reflect different considerations according to the ground for refusal in question.¹⁸

31. It is settled case-law that the ground for refusal set out in Article 7(1)(c) of the regulation is that the signs or indications concerned may be freely used by all. It is a question of preventing such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks. That general interest therefore requires that all signs or indications which may serve to designate the characteristics of the products or services in respect of which registration is sought shall be freely available to undertakings in order that they too may use them to designate the same characteristics of their own products.¹⁹

32. Furthermore, it is not necessary that the signs and indications composing the mark referred to in that article should actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provisions itself indicates, that such signs and indications could be used for such purposes. A word sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.

33. The aim of Article 7(1)(c) is therefore to leave freely available to all economic operators signs which may be used to designate the goods or services referred to in the application for registration or characteristics of those products or services. Consequently, the requirement of availability which underlies that provision relates to signs and indications which have a descriptive value

17 — Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 39.

18 — Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraphs 45 and 46.

19 — See, inter alia, the judgment in Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 31, and the order in Case C-326/01 P *Telefon & Buch v OHIM* [2004] ECR I-1371, paragraph 27. See, with regard to the identical provisions of Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 p. 1), Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 25; Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 73; Case C-104/01 *Libertel* [2003] ECR I-3793, paragraph 52; and *Koninklijke KPN Nederland*, cited above, paragraphs 54 and 55.

34. Article 7(1)(b) of the regulation pursues a different general interest, in respect of all the signs to which it refers, which is separate from the interest in ensuring that they are available to all economic operators.

35. Admittedly, in the judgment in *Libertel*, cited above, the Court held that, so far as concerns the registration of a colour per se, not spatially delimited, as a trade mark, the subject of the general interest underlying Article 3(1)(b) of Directive 89/104, the provisions of which are identical to those of Article 7(1)(b) of the regulation, is the need not unduly to restrict the availability of colours for the other traders who offer for sale goods or services of the same type as those in respect of which registration is sought.²⁰

36. However, as the judgment in *SAT.1 v OHIM*, cited above, has confirmed, that interpretation of Article 7(1)(b) of the regulation contained in the judgment in *Libertel*, cited above, according to which that ground for refusal also pursues the aim of availability, must not be extended to all the kinds of sign which fall within its scope. So far as concerns colours, that aim of availability, which must therefore be taken into account in assessing their potential distinctiveness in relation to the goods and services covered by the application for registration, was justified by the Court's finding in that judgment that the number of different colours that are in fact available to economic operators is very limited.²¹

37. In the judgment in *SAT.1 v OHIM*, cited above,²² the Court stated that the general interest underlying that provision is indissociable from the essential function of a trade mark referred to above. The point is not to register as a trade mark and not to grant the protection afforded by such registration to signs which are incapable of fulfilling the function of a trade mark for the goods and services concerned. The Court consequently concluded that the criterion that trade marks which are capable of being commonly used, in trade, for the presentation of the goods or services in question may not be registered is irrelevant to the assessment of whether a sign has a distinctive character for those goods or services.²³

38. It cannot therefore be inferred from the fact that a non-descriptive sign may be used, in trade, for the presentation of the goods and services concerned that it is necessarily devoid of any distinctive character for those goods and services. In other words, provided that a sign is not descriptive and does not fall within the scope of Article 7(1)(c) of the regulation, the fact or the mere possibility that it may be used for the presentation, in trade, of the goods and services concerned does not mean that it is devoid of any

20 — Paragraph 60

21 — *Ibid.*, paragraph 47

22 — Paragraph 27.

23 — Paragraph 36

distinctive character in relation to those goods and services.²⁴

39. Finally, with regard to the method which should be used to assess whether a sign composed of several elements falls within the scope of one of the grounds for refusal set out in Article 7(1)(b) and (c) of the regulation, it is also settled case-law that that assessment must consider the overall impression conveyed by the sign.²⁵ This requirement reflects the finding that the average consumer usually perceives a trade mark as a whole and does not examine its various details.

40. However, it is conceded that this rule does not prevent a separate examination of each of the elements making up the sign in question. Such an examination is in accordance with the content of Article 7(1)(c) of the regulation, which, I repeat, precludes registration of trade marks ‘which consist exclusively of [descriptive] signs or indications’. It will also meet the requirements of a

statement of reasons and legal certainty needed by economic operators, especially those who face problems presented by the creation of a trade mark at international level, in particular in connection with the appraisal of a sign’s potential distinctiveness, which has a greater degree of subjectivity than the other grounds for refusal.

41. However, it is common ground that it is not enough, for registration of the sign in question to be refused, to find that the ground for refusal under consideration applies to each of the elements of which it is composed.

42. Accordingly, even if a mark is composed of several elements which each describe characteristics of the goods or services covered by the application for registration, it must still be established that the mark as a whole has a descriptive character.²⁶ Although, as a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics, since merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other

24 — Thus, it has been held, for example, that registration of a trade mark which consists of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by that mark is not excluded as such by virtue of such use (Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 40). It is only if such signs or indications have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark, thereby falling under the ground for refusal set out in Article 7(1)(d) of the regulation, that they must be refused registration in accordance with that provision.

25 — See, as regards the appraisal of distinctive character, the judgment in *DKM v OHIM*, cited above, paragraph 24, and, as regards the appraisal of descriptive character, Case C-265/00 *Campina Melkunie* [2004] ECR I-1699, paragraph 37, and *Koninklijke KPN Nederland*, cited above, paragraph 96.

26 — *Koninklijke KPN Nederland*, cited above, paragraph 96.

than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned, the fact remains that, in certain circumstances, such a combination may not be descriptive.²⁷

sign 'SAT.2' in respect of the services referred to in the registration application, which were connected to satellite broadcasting. The Court of First Instance held that, having regard to its constituent elements, the term 'SAT.2' was devoid of distinctive character within the meaning of Article 7(1)(b) of the regulation in relation to those services.

43. Similarly, the Court held, in *SAT.1 v OHIM*, cited above, that an appraisal of whether a composite mark is devoid of any distinctive character with regard to the goods and services concerned must, in any event, depend on an appraisal of the whole which they comprise, and that 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.²⁸

46. In its judgment in *SAT.1 v OHIM* (*SAT.2*), the Court of First Instance examined the various elements composing the word sign 'SAT.2'. It held, first, that the element 'SAT' was devoid of distinctive character in relation to the services in question because it was the usual abbreviation, in German and in English, for the word 'satellite'; moreover, that term, as an abbreviation, did not depart from the lexical rules of those languages and it designated a characteristic of most of the services concerned.

44. It is now necessary to consider how the Court of Justice applied that case-law in the judgment in *SAT.1 v OHIM*.

47. The Court then pointed out that the elements '2' and '.' were commonly used or capable of being used, in trade, for the presentation of the services concerned and that they were therefore devoid of any distinctive character.

45. In that case, an appeal was brought against the judgment in *SAT.1 v OHIM* (*SAT.2*), by which the Court of First Instance confirmed the refusal to register the word

48. It inferred from these findings that, generally, the fact that a compound trade mark like 'SAT.2' consists only of elements

²⁷ — *Ibid.*, paragraphs 99 and 100.

²⁸ — Paragraph 28.

devoid of distinctive character justified the conclusion that that trade mark, considered as a whole, was also capable of being commonly used, in trade, for the presentation of the goods or services concerned.

49. Finally, it held that 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. It held that the term 'SAT.2' was composed in a customary way and that the applicant's argument that the trade mark applied for, considered as a whole, had an element of imaginativeness, was irrelevant.

50. In the light of those considerations, the Court of Justice held, first, 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. It had based itself on the presumption that elements individually devoid of distinctive character cannot, on being combined, present such character, and not, as it should have done, on the overall perception of that term by the average consumer. It had examined only as a secondary consideration the overall impression conveyed by the term, 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.

51. The Court of Justice held, secondly, that the criterion taken into account by the Court of First Instance, 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, is relevant in the context of Article 7(1)(c) of the regulation but it is not the yardstick by which Article 7(1)(b) thereof should be interpreted.

52. It is in the light of these preliminary observations that I shall examine the complaints put forward in support of the plea alleging that the Court of First Instance infringed Article 7(1)(b) of the regulation. First, I shall examine the first complaint — that the Court of First Instance did not take into consideration the overall impression conveyed by the sign — together with the fourth complaint — that the Court took into consideration an irrelevant criterion — because, in those two complaints, the appellant criticises the same grounds of the contested judgment.

C — Failure to take into consideration the overall impression conveyed by the sign and the taking into consideration of an irrelevant criterion

1. Arguments of the parties

53. BioID claims, first, that the Court of First Instance erred in its assessment of whether

the sign in question had a distinctive character by holding that the consumers concerned by the goods and services referred to in the registration application are usually well-informed persons, whereas those goods and services are intended for the general public.

54. The appellant also maintains that although the Court of First Instance stated that whether a compound sign has a distinctive character must be assessed in the light of the overall impression it conveys, it failed to carry out such an examination. According to the appellant, the Court merely examined the different elements of which the sign in question is composed, namely the abbreviation 'BioID' and the figurative elements.

55. BioID claims, finally, that the criterion on which the Court of First Instance based its finding that the sign in question was devoid of distinctive character has been held to be irrelevant.

56. The Office points out, in essence, that the appellant cannot obtain, in appeal proceedings, a review of the assessment of the facts carried out by the Court of First Instance.

57. It also maintains that the Court set out the rules which govern the examination of

the various elements of a compound mark and that it applied them without erring in law. According to the Office, the Court rightly indicated that a compound mark composed of elements devoid of distinctive character in respect of the goods and services concerned will not acquire distinctive character when considered as a whole if there is no concrete evidence to indicate that the compound trade mark is greater than the sum of its parts. The Court therefore clearly conducted an overall assessment in accordance with the rules set out.

58. Finally, as regards the conclusions to be drawn from the judgment in *SAT.1 v OHIM*, cited above, in respect of the criterion taken into account in the contested judgment, the Court of First Instance did not err in law, because it held that the relevant public was, in this case, a limited public. The fact that the sign in question may be used for the presentation of the goods and services concerned therefore confirms that it does not have a distinctive character in relation to those goods and services.

2. Assessment

59. As the Office points out, the statement by the Court of First Instance of the rules governing the examination of whether a sign has distinctive character within the meaning of Article 7(1)(b) of the regulation is clearly not vitiated by any error of law. The Court

therefore rightly stated that the distinctiveness of a mark must be assessed by reference to the goods or services for which registration of the mark has been requested and to the perception of the public targeted.

60. The Office is also justified in maintaining that the assessment of the Court of First Instance that the relevant public, in this case, means 'one with experience' in the sector of the goods and services covered by the application for registration, is a finding of fact falling within the exclusive jurisdiction of that Court and therefore does not, save where the clear sense of the evidence in the case has been distorted, constitute a point of law which is subject to review by the Court of Justice on appeal.²⁹

61. The Court of First Instance, after pointing out that the sign in question is composed of a word element and figurative elements, then correctly stated that the assessment of its distinctiveness requires an examination of the sign as a whole. However, I agree with the appellant that the Court did not carry out such an examination in the contested judgment.

62. It stated, in paragraphs 28 and 29 of the contested judgment, that the abbreviation 'BioID' is composed of two elements, 'Bio' and 'ID', which constitute respectively, in English, a standard abbreviation of the noun 'identification', and either an abbreviation of the adjectives 'biological' or 'biometrical' or the abbreviation of the noun 'biology'. It concluded that, since the abbreviation 'BioID' is composed of abbreviations which are part of the vocabulary of the reference language, it does not represent an exception to the lexical rules of that language and is therefore not unusual in its structure. It considered that, in the light of the goods and services referred to in the application for registration, the relevant public understands the abbreviation 'BioID' as meaning 'biometrical identification'.

63. The Court then stated, in paragraphs 30 to 32 of the contested judgment, that biometric identification is one of several technical functions of the goods covered by the application for registration and refers directly to one of the qualities of the services mentioned in the application or has a close functional link with them.

64. From those findings of fact, which it is not for the Court of Justice to call in question on appeal, it concluded, in paragraph 34, that the abbreviation 'BioID' is devoid of distinctive character as regards the goods and services referred to in the application for registration.

²⁹ — *DKV v OHIM*, cited above, paragraph 22, and the case-law cited therein.

65. The Court then examined the figurative elements of the sign in question. It stated, with regard to the typographical characteristics of the abbreviation 'BioID', as represented in the sign in question, that the Arial typeface and characters of different boldness are commonly used, in trade, for the presentation of all types of goods and services. It explained that the same is true of the full stop, since that element is commonly used as the last of several elements in a word mark, indicating that the mark is an abbreviation.

above are likely to be used, in trade, to present the goods and services claimed and are therefore devoid of distinctive character in respect of those goods and services.

66. Finally, with regard to the graphic element⁴⁰, the Court considered that the Office rightly stated at the hearing, that its function is limited to indicating that the mark has been registered for a specific territory and that, in the absence of such registration, the use of that element would be misleading for the public. It also found that that element, in combination with one or more other signs, is commonly used, in trade, in presenting all types of goods and services.

41 It follows that the mark applied for is composed of a combination of elements each of which is likely to be used, in trade, to present the goods and services claimed and is therefore devoid of distinctive character in respect of those goods and services.

67. The Court of First Instance continued this argument in paragraphs 40 to 44 of the contested judgment on the following grounds:

42 Furthermore, the case-law shows that if a compound mark is composed only of elements devoid of distinctive character in respect of the goods and services concerned the overall mark is likewise likely to be commonly used in trade to present those goods and services. That would only not be the case if concrete evidence, such as, for example, the way in which the various elements are combined, were to indicate that the compound trade mark, taken as a whole, is greater than the sum of its parts (see, to that effect, the Opinion of Advocate General Ruiz-Jarabo Colomer in ... *Koninklijke KPN Nederland* [cited above], paragraph 65).

⁴⁰ Accordingly, the graphic elements referred to in paragraphs 38 and 39

43 Contrary to what the applicant claims, there appears to be no such evidence in the present case. The structure of the mark applied for — consisting, essentially, of the combination of a descriptive abbreviation with the typographical features described in paragraph 37 above and the graphic elements referred to in paragraphs 38 and 39 above — does not preclude the conclusion that the overall mark is likely to be commonly used in trade to present the goods and services in the categories referred to in the application for registration of the mark.

44 The trade mark applied for is therefore devoid of distinctive character in respect of the categories of goods and services concerned.'

68. In my opinion, consideration of these grounds reveals that, as in the judgment in *SAT.1 v OHIM (SAT.2)*, cited above, the Court of First Instance assessed the distinctiveness of the sign at issue merely by carrying out a separate appraisal of the various elements of which it is composed. In almost identical terms to those of paragraph 49 of that judgment, it took as a basis, in paragraph 42 of the contested judgment, the presumption that elements which, individually, are devoid of distinctive character cannot, once combined, have a distinctive character, rather than the overall perception of that sign in the eyes of the relevant public,

as it should have done. As in the judgment in *SAT.1 v OHIM (SAT.2)*, it examined only as a secondary consideration the overall impression conveyed by the sign at issue.

69. I therefore conclude that, in the contested judgment, the Court of First Instance adopted the same method for assessing the distinctiveness of the sign in question as that applied in the judgment in *SAT.1 v OHIM (SAT.2)*, cited above.

70. Furthermore, in this case, Court of First Instance was confronted not with a word mark, as in *SAT.1 v OHIM (SAT.2)*, but with a figurative mark, composed of a word element and several figurative elements. It found, as we have seen, that the word element 'BioID' was descriptive of the goods and services referred to in the application for registration or of their characteristics. It rightly concluded that that element of the sign in question was devoid of distinctive character.

71. On the other hand, in paragraphs 35 and 36 of the contested judgment, it challenged the analysis of the Second Board of Appeal in the contested decision, according to which such a mark is devoid of distinctive character where the word element is descriptive and the relative importance of the figurative element is 'minimal' in comparison with that of the word element.

72. Thus, in paragraph 36 of the contested judgment, the Court held *inter alia*:

'In that regard, it should be noted that the absence of distinctive character of a compound mark cannot be determined solely by reference to the relative importance of certain elements of which it is composed as compared with that of other elements of the mark, in respect of which an absence of distinctive character has been established. A compound mark cannot fall under Article 7 (1)(b) of [the regulation] if one of its composite elements is distinctive in respect of the goods and services concerned. That is true even if the sole distinctive element of the compound mark is not dominant in relation to the other composite elements of the mark. ...'

73. I have some doubts as to the validity of the analysis of the Court of First Instance in these last two sentences. First, what matters, according to the case-law, is, as we have seen, that the sign in question, considered as a whole, may, for the relevant public, have a distinctive character in relation to the goods and services referred to in the application for registration. Consequently, just as it cannot be presumed that a sign composed of elements which, individually, are devoid of distinctive character is itself devoid of that character, I think it is difficult to presume that the presence, in the compound sign, of

an element which, in itself, may have a distinctive nature is sufficient to attribute that character to the sign as a whole.

74. Accordingly, where the figurative sign in respect of which registration has been applied for is composed of a word element which, like the abbreviation 'BioID', is entirely descriptive, because that word element does not contain any additional non-descriptive word, it is hard to see how that sign, considered as a whole, may be regarded as having a distinctive character if that word element is dominant in relation to the figurative elements of the sign. In that situation, there is every reason to think that it is the word element which will attract the attention of the relevant public and prevent it from perceiving the overall sign as an indication of origin.

75. I therefore consider that a figurative sign composed of a wholly descriptive word element cannot be regarded as having a distinctive character unless it contains figurative elements which are individually distinctive and have a sufficient impact on the minds of the relevant public to keep their attention instead of that word element, or figurative elements capable of 'overriding' the meaning of that word element, and bestowing a distinctive effect on the overall sign.

76. I am fully aware that it is difficult for those conditions to be regarded as satisfied,

because it is usually easier to remember a word element than figurative elements. Nevertheless, even though it follows that registration as a trademark of figurative signs of that type might prove to be difficult in practice or limited to exceptional cases, I think such stringency is necessary in order to avoid registration of those marks having the effect, in accordance with the usual criteria applied for assessing whether there is a likelihood of confusion, of granting their proprietor exclusive rights over a word element which is wholly descriptive of the characteristics of the goods and services concerned.

77. Finally, as the appellant has rightly maintained, the Court of First Instance based its assessment on an irrelevant criterion in connection with the applicability of Article 7 (1)(b) of the regulation.

78. The Court thus inferred the lack of distinctiveness of the elements composing the sign in question from the fact that they may be used, in trade, for the presentation of the goods and services referred to in the application for registration.

79. However, as we have seen, although that criterion is relevant in respect of an element descriptive of the goods or services covered by the application for registration or of their characteristics, as is the word element

‘BioID’ in this case, it is not relevant with regard to figurative elements like letters written in the Arial typeface; a simple full-stop or the element⁶⁰. The fact that those elements, which are not in themselves descriptive of the goods and services concerned, may be used for their presentation in trade does not, in itself, mean that they are devoid of any distinctive character in relation to those goods and services.

80. Similarly, in paragraph 43 of the contested judgment, I believe that the Court misinterpreted Article 7(1)(b) of the regulation by basing its conclusion, that the sign in question is devoid of distinctive character, on its finding that ‘the overall mark is likely to be commonly used in trade to present the goods and services’ referred to in the application for registration.

81. I conclude that the contested judgment is vitiated by the same errors of law as the judgment in *SAT.1 v OHIM (SAT.2)*, cited above. I therefore suggest that the Court of Justice draw the same conclusions as in *SAT.1 v OHIM (SAT.2)*, and set aside the contested judgment.

82. In the light of that proposal, I shall consider only in the alternative the other two submissions made by the appellant in sup-

port of the ground of appeal alleging infringement of Article 7(1)(b) of the regulation.

(b) to be applicable, that evidence be adduced of the actual use of that abbreviation to designate the goods or services referred to in the application for registration.

D — Failure to take into account the appellant's argument that it has not been proved that the sign in question was actually used by the public or by competitors

83. BioID alleges that the Court of First Instance did not take account of its argument that it could not be proved that the sign in question was actually used by the public or by its competitors. Nor did it take account of the fact that the sign in question does not appear in dictionaries and is not a technical term.

84. BioID also maintains that the Court incorrectly assessed the facts by holding that 'Bio' is an abbreviation whereas it is a prefix, and by holding that the abbreviation 'BioID' does not have an unusual structure.

85. As regards the abbreviation 'BioID', I do not believe that the Court erred in law when it considered that it was not necessary, for the ground for refusal set out in Article 7(1)

86. Indeed, as the Court held in *OHIM v Wrigley*, cited above,³⁰ for the ground for refusal set out in Article 7(1)(b) to apply it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A word sign must therefore be refused registration under that provision if at least one of its *possible* meanings designates a characteristic of the goods or services concerned.

87. Next, as regards the analysis of the Court of First Instance of the public's perception of the elements 'Bio' and 'ID', these are findings of fact and the appellant does not establish that the Court distorted the clear sense of that evidence.

30 — Paragraph 32. Emphasis added.

88. Finally, the argument concerning evidence of the use of the sign as it appears as a whole to present goods and services in trade essentially overlaps with the fourth plea examined above and I have already proposed that the Court declare that such a criterion is irrelevant for assessing the distinctiveness of a mark composed of several elements which are not all descriptive of the goods and services referred to in the application for registration.

E — The claim that the Court of First Instance committed an error of assessment by holding that comparable marks which had been registered were not evidence of the distinctive character of the sign in question, and infringed the principle of equal treatment

89. BioID alleges that the Court of First Instance committed an error of assessment by not considering that the word marks containing the prefix 'bio' registered by the Office were evidence of the distinctive character of the sign in question. BioID also disputes that Court's finding, in paragraph 47 of the contested judgment, that the appellant did not rely on grounds contained in those decisions adopted by the Office which might call into question the finding that the sign in question is devoid of distinctive character.

90. BioID also calls in question the findings of the Court of First Instance in relation to the registration by the Office of the word mark 'Bioid' for goods and services identical to those referred to in the application for registration at issue. According to the appellant, the Court of First Instance erred in law by holding that that word mark had a meaning different from that of the figurative sign in question because, in that word mark, the letters 'id' were written in lower case characters. The Court thus disregarded the fact that a word mark is protected by virtue of being registered, irrespective of the written form used. Furthermore, the Court of First Instance infringed the principle of equal treatment, because it is unacceptable for the Office to allow registration of the word mark 'Bioid' but to refuse registration of the figurative sign in question, which is pronounced in identical fashion and contains additional graphic elements.

91. The question whether decisions of the Office authorising registration of marks identical or comparable to the sign in question may, as a rule, be taken into consideration when assessing the distinctiveness of that sign is, in my view, a point of law and may therefore be reviewed by the Court of Justice on appeal.

92. On that point, I do not believe that the Court of First Instance erred in law in the

contested judgment, since, in paragraph 47, it stated that 'factual or legal grounds contained in a previous decision may certainly constitute arguments supporting a plea alleging infringement of a provision of Regulation No 40/94'. In using that wording, the Court of First Instance, contrary to what the appellant intimated in its arguments, did not therefore preclude the grounds of decisions of the Office authorising registration of marks identical or comparable to the sign in question from being taken into consideration for the purpose of assessing the distinctive character of that sign.³¹ The appellant's argument on this point is therefore the product of a misreading of the contested judgment.

Court. Therefore, the Court of First Instance has sole jurisdiction to assess the value to be attributed to the evidence submitted to it, provided that it does not distort the clear sense of that evidence.³² In the observations it has submitted to the Court of Justice, the appellant has not furnished any evidence to establish the existence of such distortion.

93. As for the statement, in paragraph 47 of the contested judgment, that, in that case, the applicant had not relied on grounds contained in decisions of the Office which might call into question the finding that the sign in question was devoid of distinctive character, this, in my view, is the appraisal by the Court of First Instance of the evidence adduced by the appellant. It should be pointed out that Article 225 EC and Article 58 of the Statute of the Court of Justice make it clear that an appeal is to be limited to points of law. The aim of that legal remedy is to enable parties to obtain not another judgment on the whole of the case before the Court of First Instance, but only review of the legality of the decision given by that

94. Finally, as regards the appellant's complaints in respect of the conclusions which the Court of First Instance should have drawn from the decision of the Office authorising registration of the word mark 'Bioïd' for goods and services described as 'printing products', 'telecommunications' and 'computer programming', they likewise are not well founded. With regard, first, to the finding, in paragraph 48 of the contested judgment, that 'the fact that ... in the word mark 'Bioïd' the letters 'id' are in lower case characters distinguishes it, as regards its semantic content, from the abbreviation 'BioID' as it appears in the mark applied for', I do not believe that this proves that the Court of First Instance disregarded the fact that a word mark does not contain figurative elements or that the application for registration and the protection afforded by registration relate to the word stated in the

31 — These might include, for example, grounds relating to the meaning of a word element in relation to certain goods or services in the mind of the relevant public.

32 — See, to this effect, Case C-136/92 P *Commission v Brazzelli Lualdi and Others* [1994] ECR I-1981, paragraphs 49 and 66; Joined Cases C-238/99 P, C-244/99 P, C-245/99 P, C-247/99 P, C-250/99 P to C-252/99 P and C-254/99 P *Limburgse Vinyl Maatschappij and Others v Commission* [2002] ECR I-8375, paragraph 194; and Joined Cases C-24/01 P and C-25/01 P *Glencore and Compagnie Continentale v Commission* [2002] ECR I-10119, paragraph 65.

application, not to the way in which it is written therein.

95. In my view, the Court of First Instance merely wished to state that the word 'boid', as it is written in the application for registration, is not pronounced, in principle, in the same way as the abbreviation 'BioID', which is clearly composed of the two elements 'Bio' and 'ID', which, in relation to the goods and services concerned, may be understood by the relevant public to be the abbreviations of 'biometrical identification'.

96. Furthermore, that part of the grounds of the contested judgment could be regarded as superfluous to the Court's assessment that, in essence, that registration by the Office does not affect the finding that the figurative sign at issue is devoid of distinctive character, since the Court also found that that sign and the word mark 'Boid' are not interchangeable. Therefore, the appellant's argument challenging paragraph 48 of the contested judgment on the basis of the written form of the word mark registered by the Office could be regarded as futile.³³

97. Next, I do not believe that the Court of First Instance disregarded the principle of

equal treatment by not concluding from that registration that the sign in question does have a distinctive character. Even if that principle could be relevant in such a situation,³⁴ I would point out that the Court of First Instance found that the sign in question and the registered word mark are not interchangeable. The appellant has not established that that finding is based on a distortion of the facts. In that regard, I would point out that, in the figurative sign 'BioID', the representation of the two last letters in upper case characters which are less thick, and the full stop which follows the abbreviation, show that the word element is composed of two distinct elements which can be understood by the relevant public as the abbreviations of 'biometrical identification'; that is not necessarily so in the case of the word 'boid' registered as a word mark.

98. It should also be added that the designation of the goods and services for which the word mark was registered is different from the description of the goods and services for which registration of the figurative sign in question is sought. It was made clear at the hearing that that word mark was registered to designate computer software recorded on media of all kinds, telecommunications

34 — According to the case-law of the Court of First Instance, the principle is not relevant to such a situation, because we are faced with the following alternative: either the conflicting decision taken by the Office authorising registration of a mark comparable to the sign in question is in accordance with the regulation and, if so, the Court of First Instance must logically find that the decision refusing registration of that sign has infringed the relevant provisions of the regulation, or the conflicting decision taken by the Office is not lawful and no person may rely, in support of his claim, on an error committed in favour of another (*SATI v OHIM* (*SATI.2*), cited above, paragraphs 60 to 62; see also Case T-127/02 *Concept v OHIM* (*ECA*) [2004] ECR I-1113, paragraph 71, and the case-law cited therein).

33 — See, to that effect, Case C-496/99 P *Commission v CAS Succhi di Frutta* [2004] ECR I-3801, paragraph 68.

products and computer programming, with no further details as to the nature of those goods and services. However, in the application for registration of the figurative sign in question, it is specified that the goods and services concerned are, in particular, those which are used for monitoring user passwords through identification of human beings by means of specific biometric characteristics and which are therefore connected with biometric identification.

F — The consequences of setting aside the contested judgment

99. The only question which remains to be settled is whether the figurative sign in question, considered as a whole, is devoid of distinctive character in relation to the goods and services referred to in the application for registration, within the meaning of Article 7(1)(b) of the regulation.

100. The overall impression conveyed by the sign at issue has been the subject of dispute between the parties, particularly during the oral procedure before the Court of Justice. I consider therefore that the state of the proceedings permits the Court to give final judgment, in accordance with Article 61 of the Statute of the Court of Justice, and that it

would be contrary to economy of procedure to refer the case back to the Court of First Instance. I therefore propose that the Court of Justice itself give judgment, as it did in *SAT.1 v OHIM*, cited above.

101. We have seen that the figurative sign in question is composed of a word element, formed by the abbreviation 'BioID', and by figurative elements relating to the typographical characteristics of that abbreviation and to the graphic elements placed after it, namely a full stop and the sign ®.

102. So far as concerns the abbreviation 'BioID', it has been found that this may be perceived by the relevant public, which is made up of persons with experience in the sector of the goods and services concerned, as the combination of the two abbreviations 'Bio' and 'ID' meaning 'biometrical identification'. We also know that biometrical identification is one of the technical functions of the goods referred to in the application for registration and that it refers directly to one of the qualities of the services mentioned in the application or has a close functional link with them. It is therefore established that the abbreviation 'BioID' is, as a word element wholly descriptive of a characteristic of the goods and services referred to in the application for registration, devoid of distinctive character in relation to those goods and services.

103. As regards the figurative elements of the sign in question, and with regard, first, to the written form used for the abbreviation 'BioID', it has been noted that characters in the Arial typeface are commonly used in trade. It also emerged from the hearing that the full-stop inserted after the abbreviation 'BioID' is usually used as the last element in a word mark to indicate that it is an abbreviation. As regards the element[®], this normally indicates that the sign which it accompanies has been registered as a trade mark for a specific territory.

the word element 'BioID' is clearly the dominant element to emerge from an overall examination of the sign in question. The typeface in which it is written is unremarkable. As for the full stop and the element[®], their importance in the sign in relation to the word element 'BioID' is minimal.

104. We may conclude from these findings that none of the figurative elements which compose the sign in question has in itself a specific distinctive character in relation to the goods and services covered by the application for registration. The sign in question is therefore made up of a word element which is descriptive of the characteristics of the goods and services concerned and of figurative elements which, considered individually, are also devoid of distinctive character in relation to those goods and services.

106. The inevitable conclusion therefore is that the figurative elements which make up the sign in no way reduce the potential significance of the abbreviation 'BioID' for the relevant public and, consequently, its descriptive character. On the contrary, we could say that they accentuate or contribute to that significance. Thus, we have seen that the last two letters of the abbreviation 'BioID' are written in upper case characters, whereas the preceding two letters are written in lower case. Similarly, the last two letters 'ID' are less thick than the three preceding letters. This difference in form reinforces the impression that the abbreviation 'BioID' is indeed composed of two distinct elements, 'Bio' and 'ID'. Similarly, the full stop which follows the abbreviation, in the light of its usual significance in the domain of trade marks, confirms that the overall term 'BioID' corresponds to abbreviations.

105. When we examine the impression conveyed by the overall mark, we find that the interaction of those various elements does not give it a distinctive character. First,

107. I therefore conclude that the sign in question is devoid of distinctive character in relation to the goods and services concerned. BioID's appeal against the contested decision should therefore be dismissed.

108. Under the first paragraph of Article 122 of the Rules of Procedure of the Court of Justice, where the appeal is well founded and the Court itself gives final judgment in the case, it is to make a decision as to costs. Under Article 69(2) of the Rules of Procedure, applicable 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 Office has asked for costs to be awarded against the appellant and the appellant has been unsuccessful, it must be ordered to pay the costs.

V — Conclusion

109. In the light of the foregoing considerations, I propose that the Court of Justice:

- (1) set aside the judgment of the Court of First Instance of the European Communities of 5 December 2002 in Case T-91/01 *BioID v OHIM*;
- (2) dismiss the appeal against the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 20 February 2001 (Case R 538/1999-2);
- (3) order the appellant to pay the costs of the proceedings both at first instance and on appeal.