

Case T-215/06

American Clothing Associates SA

v

**Office for Harmonisation in the Internal Market
(Trade Marks and Designs) (OHIM)**

(Community trade mark — Application for a figurative Community trade mark representing a maple leaf — Absolute ground for refusal — Service mark — Article 7(1)(h) of Regulation (EC) No 40/94 — Article 6ter of the Paris Convention — Matters of law brought before the departments of OHIM and before the Court)

Judgment of the Court of First Instance (Fifth Chamber), 28 February 2008 . . . II - 308

Summary of the Judgment

1. *Community trade mark — Appeals procedure — Appeals before the Community judicature — Legality of a decision of a Board of Appeal (Council Regulation No 40/94, Arts 7(1)(h) and 63(2))*

2. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Marks to be refused pursuant to the Paris Convention (Council Regulation No 40/94, Art. 7(1)(h))*
3. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Marks to be refused pursuant to the Paris Convention (Council Regulation No 40/94, Art. 7(1)(h))*
4. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Marks to be refused pursuant to the Paris Convention (Council Regulation No 40/94, Art. 7(1)(h))*

1. The issue of the applicability of Article 6ter(1)(a) of the Paris Convention for the Protection of Industrial Property to service marks is a preliminary matter which must be resolved in order to ensure that Regulation No 40/94 on the Community trade mark is properly applied having regard to a plea alleging infringement of Article 7(1)(h) of that regulation. In order to establish whether a mark which is applied for, in so far as it covers services, is a mark whose registration may be contrary to Article 6ter(1)(a) of the Paris Convention, it is necessary to establish whether that provision applies to service marks. If that is not the case, then the refusal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) to register such a mark in respect of the services actually constitutes infringement of Article 7(1)(h) of Regulation No 40/94, without the need to examine whether the mark sought includes the elements referred to

by Article 6ter(1)(a) of the Paris Convention .

Therefore, the matters of law in the dispute brought before the Board of Appeal include the issue of the applicability of Article 6ter of the Paris Convention to service marks, even if the applicant for the mark did not put forward a view on that matter and even if the Board of Appeal omitted to rule on that aspect. That issue may therefore be raised for the first time before the Court of First Instance. That issue is also one of the matters of law in the dispute brought before the Court and must be examined by the Court, as that examination is necessary to deal with the plea alleging infringement of Article 7(1)(h) of Regulation No 40/94. Although it must rule

only on the application of the parties, whose task it is to define the scope of the dispute, the Court cannot be bound merely by the arguments relied upon by the parties in support of their claims, since it would otherwise be forced, in some circumstances, to base its decisions on erroneous legal considerations.

on registration and use established by that provision does not affect service marks.

(see paras 22-25)

2. Under Article 7(1)(h) of Regulation No 40/94 on the Community trade mark, 'trade marks which have not been authorised by the competent authorities and are to be refused pursuant to Article 6*ter* of the Paris Convention [for the Protection of Industrial Property]' must not be registered. The wording of Article 6*ter* refers only to 'trade marks'. It is clear from Article 1(2), Article 6(1) and Article 6*sexies* of the Paris Convention that the Convention establishes a distinction between, on the one hand, 'trade marks' which, as is apparent from Article 7 thereof, are registered for goods and, on the other hand, 'service marks'. As Article 6*ter* refers only to trade marks, that is to say to marks for goods, the conclusion must be that the prohibition

Article 7(1)(h) of Regulation No 40/94 merely refers to Article 6*ter* of the Paris Convention, by stating that 'the following shall not be registered: trade marks which ... are to be refused pursuant to Article 6*ter* of the Paris Convention'. As Article 6*ter* of the Paris Convention does not concern service marks, they cannot be marks which 'are to be refused' under that provision and cannot, therefore, be covered by the absolute ground for refusal established by Article 7(1)(h) of Regulation No 40/94. The mere fact that Article 7 of that regulation makes no distinction between marks for goods and service marks is not sufficient to result in the contrary conclusion, as that distinction is established by Article 6*ter* of the Paris Convention to which Article 7(1)(h) of Regulation No 40/94 refers. If the Community legislature had also intended to prohibit the registration of marks containing 'armorial bearings, flags, and other State emblems' in respect of services, it would not merely have referred to Article 6*ter* of the Paris Convention, but would have inserted in the wording of Article 7 of Regulation No 40/94 a prohibition against the registration, either as a

Community trade mark or as an element of such a mark, 'of armorial bearings, flags, and other State emblems ... and any imitation from a heraldic point of view' without distinguishing, implicitly but necessarily, by the mere fact of referring to Article 6*ter* of the Paris Convention, between marks for goods and service marks.

Lastly, it may be assumed that, when it adopted Regulation No 40/94 relatively recently, the Community legislature was aware of the importance, in modern commerce, of service marks and could, therefore, also have extended the protection granted to State emblems by Article 6*ter* of the Paris Convention to that category of marks. As the legislature did not see fit to extend the scope of the relevant provisions in such a way, it is not for the Community judicature to take the place of the Community legislature and apply an interpretation *contra legem* of those provisions, whose meaning is in no way ambiguous.

authorised by the competent authorities and are to be refused pursuant to Article 6*ter* of the Paris Convention [for the Protection of Industrial Property]' must not be registered. Article 6*ter* prohibits not only the registration of marks which consist solely of a State emblem or an imitation thereof 'from a heraldic point of view', but also the registration or the use of a State emblem or an imitation of such an emblem 'from a heraldic point of view' as an element of a compound mark. Therefore, for the purpose of assessing a complex mark from the perspective of that provision, regard must be had to each of the elements of that mark and it is sufficient that one of them is a State emblem or an imitation thereof 'from a heraldic point of view' to preclude registration of the mark concerned, irrespective of its overall perception.

(see paras 64, 65)

(see paras 26, 28, 29, 32)

3. Under Article 7(1)(h) of Regulation No 40/94 on the Community trade mark, 'trade marks which have not been
4. Under Article 7(1)(h) of Regulation No 40/94 on the Community trade mark, 'trade marks which have not been authorised by the competent authorities and are to be refused pursuant to

Article 6*ter* of the Paris Convention [for the Protection of Industrial Property] must not be registered. The aim of that provision is to preclude the registration and use of trade marks which are identical to State emblems or which are to a certain degree similar to them.

As regards, in that context, a figurative sign representing a maple leaf without specification of any colours, in respect of which registration was sought for 'Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery' and 'Clothing, footwear, headgear' in Classes 18 and 25 respectively of the Nice Agreement, the average consumers at whom the articles of everyday consumption are directed

and who do not pay particular attention to the details of emblems and marks will perceive that mark essentially as an imitation of the Canadian emblem, in spite of the slight difference between the width of the stems of the two leaves. It is true that a comparison of the maple leaf notified as the emblem of the State of Canada and the maple leaf in the mark applied for reveals some differences in design regarding the stem of both leaves, as the two serrations on either side of the central third of the leaf are deeper in the case of the maple leaf in the Canadian emblem. However, a detail such as the exact depth of those serrations would never appear in the heraldic description of the emblem in question but, if need be, in a much more detailed geometric description, which is, however, of no relevance to the comparison 'from a heraldic point of view'.

(see paras 59, 74, 75)