

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fifth Chamber)

9 July 2008*

In Case T-304/06,

Paul Reber GmbH & Co. KG, established in Bad Reichenhall (Germany),
represented by O. Spuhler, lawyer,

applicant,

v

Office for Harmonization in the Internal Market (Trade Marks and Designs)
(OHIM), represented by G. Schneider, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of OHIM, intervener
before the Court of First Instance, being

* Language of the case: German.

Chocoladefabriken Lindt & Sprüngli AG, established in Kilchberg (Switzerland),
represented by R. Lange and G. Hild, lawyers,

ACTION brought against the decision of the Second Board of Appeal of OHIM of
8 September 2006 (Case R 97/2005-2) concerning invalidity proceedings between
Chocoladefabriken Lindt & Sprüngli AG and Paul Reber GmbH & Co. KG,

THE COURT OF FIRST INSTANCE
OF THE EUROPEAN COMMUNITIES (Fifth Chamber),

composed of M. Vilaras (Rapporteur), President, M. Prek and V. Ciucă, Judges,

Registrar: K. Andová, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance
on 10 November 2006,

having regard to the response of OHIM lodged at the Registry of the Court of First
Instance on 12 March 2007,

having regard to the response of the intervener lodged at the Registry of the Court of
First Instance on 23 February 2007,

further to the hearing on 5 March 2008,

gives the following

Judgment

Background to the dispute

- 1 On 8 March 1996, the applicant, Paul Reber GmbH & Co. KG, filed an application for a Community trade mark with the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.
- 2 The trade mark in respect of which registration was sought is the word sign Mozart.
- 3 The goods in respect of which registration was sought fall within Class 30 of the Nice Agreement on the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description: 'Pastry and confectionery, chocolate products, sugar confectionery'.
- 4 The Community trade mark application was published in *Community Trade Marks Bulletin* No 25/98 of 6 April 1998.

- 5 On 27 May 2008, the intervener, Chocoladefabriken Lindt & Sprüngli AG, submitted written observations to OHIM as a third party, as provided for in Article 41 of Regulation No 40/94, explaining that, in its view, the mark at issue should not be registered, pursuant to Article 7(1)(c) of Regulation No 40/94, since that mark was descriptive of the goods covered by the application for registration.
- 6 The mark at issue was, however, registered on 26 January 2000 as Community trade mark number 21 071.
- 7 By letter of 21 September 2000, received by OHIM on 27 September 2000, the Landgericht München I (Munich Regional Court I, Germany), as a Community trade mark court within the meaning of Article 91 of Regulation No 40/94, informed OHIM in accordance with Article 96(4) of that regulation that, in proceedings before it between the applicant and Conditorei Coppenrath & Wiese GmbH & Co. KG ('Coppenrath'), a counterclaim for a declaration of invalidity of the trade mark at issue had been filed by the latter on 30 August 2000.
- 8 By letter of 17 November 2000, received by OHIM on 22 November 2000, the Landgericht München I sent OHIM a copy of its judgment of 15 November 2000, upholding the abovementioned counterclaim and declaring the mark at issue invalid.
- 9 On 14 November 2002, the intervener submitted an application to OHIM under Article 55 of Regulation No 40/94 for a declaration of invalidity of the mark at issue, on the ground that it had been registered in breach of Article 7(1)(c), read in conjunction with Article 51(1)(a), of that regulation.

- 10 By letter of 14 August 2003, OHIM informed the Landgericht München I that the filing before that court of the counterclaim for a declaration of invalidity of the mark at issue had been entered in the register of Community trade marks on 13 August 2003 and would be published shortly in the *Community Trade Marks Bulletin*.
- 11 By letter of 2 September 2003, received by OHIM on 8 September 2003, the Oberlandesgericht München (Higher Regional Court of Munich) sent OHIM a copy of its judgment of 26 July 2001 setting aside the judgment of 15 November 2000 of the Landgericht München I and dismissing the counterclaim for a declaration of invalidity of the disputed mark filed by Coppenrath. According to that letter, the judgment of 26 July 2001 had become final.
- 12 By decision of 21 December 2004, the Cancellation Division of OHIM allowed the intervener's application for a declaration of invalidity and, as a result, declared the disputed mark invalid.
- 13 First of all, the Cancellation Division stated that Article 55(3) of Regulation No 40/94, which provides that 'an application ... for a declaration of invalidity shall be inadmissible if an application relating to the same subject-matter and cause of action, and involving the same parties, has been adjudicated on by a court in a Member State and has acquired the authority of a final decision', did not preclude the filing of the contested application for a declaration of invalidity. Although the judgment of the Oberlandesgericht München of 26 July 2001 related to the same Community trade mark and the same cause of invalidity, the fact remained that the parties to that dispute were not the same as those in the present case, since the dispute adjudicated upon by the judgment in question was between the applicant and Coppenrath and not the intervener (paragraph 8 of the decision of the Cancellation Division).

14 On the substance, the Cancellation Division took the view that the mark at issue was descriptive, for the purpose of Article 7(1)(c) of Regulation No 40/94, of all the products covered since it consisted exclusively of an indication designating the kind and quality of those goods. Essentially, it took as its basis the fact, first, that, in Germany and Austria, the term ‘Mozartkugel’ was used to designate balls of marzipan and praline coated in chocolate and, secondly, that the name Mozart, taken in isolation, was still descriptive of that product, since the fact that it was a ‘Kugel’ (ball) was clearly and immediately apparent given its external shape. The Cancellation Division also declined to apply the solution adopted by the Oberlandesgericht München, cited above, and clarified the grounds on which it considered that the decision of the Third Board of Appeal of OHIM of 10 April 2002 (Case R 953/2001-3), relied on by the applicant, was not relevant to the present case. Further, it analysed the results of an opinion poll produced by the applicant and concluded that those results did not invalidate its conclusion regarding the descriptive character of the disputed trade mark.

15 On 25 January 2005, the applicant filed a notice of appeal at OHIM pursuant to Articles 57 to 62 of Regulation No 40/94 against the decision of the Cancellation Division.

16 By decision of 8 September 2006, notified to the applicant on 11 September 2006 (‘the contested decision’), the Second Board of Appeal dismissed the appeal. The Board of Appeal considered, essentially, that the mark applied for was ‘an objective indication that was purely descriptive of the products covered’. In that respect, it noted that ‘detailed reasons were stated’ for the Cancellation Division’s decision and that the Board of Appeal itself ‘agree[d] with its reasons and [had] little to add’ (paragraph 16 of the contested decision). Since the applicant acknowledged that ‘Mozartkugeln’ was generic and descriptive in Germany and Austria, it was ‘hard to imagine that German and Austrian consumers, confronted with the name Mozart on the packaging of a product in a confectioners or the chocolate section of a super-

market, would not assume that it was Mozartkugeln that were being offered for sale' (paragraphs 21 and 22 of the contested decision).

Forms of order sought

17 The applicant claims that the Court should:

— annul the contested decision;

— in the alternative, annul the contested decision in so far as is necessary to restrict the description of the goods for which the disputed mark is registered as follows: 'Pastry and confectionery, chocolate products, sugar confectionery, all the goods mentioned above with the exception of the speciality "Mozartkugeln", that is to say, balls of marzipan and praline coated in chocolate',

— order OHIM to pay the costs.

18 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

19 The intervener submits that the Court should dismiss the action.

Admissibility of the applicant's alternative claim

Arguments of the parties

20 OHIM, supported by the intervener, submits that the applicant's alternative claim is inadmissible. First, it changes the subject-matter of the proceedings and therefore infringes Article 135(4) of the Rules of Procedure of the Court of First Instance. Secondly, no application within the meaning of Article 44(1) of Regulation No 40/94 to restrict the list of goods covered by the mark at issue has been made to OHIM. Thirdly, where registration of a mark is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic.

21 The applicant takes the view that its claim in the alternative is admissible. First, it depends, ultimately, on a condition internal to the proceedings over which the parties have no influence, namely whether or not the Court upholds the contested decision. Secondly, the proprietor of the Community trade mark may, at any time, restrict the list of goods covered by its mark. Accordingly, since the claim in the alternative was put forward in the application, it cannot be considered to be too late.

Findings of the Court

- 22 It should be noted that Article 26(1)(c) of Regulation No 40/94 provides that an application for a Community trade mark is to contain a list of the goods or services in respect of which the registration is requested. According to Rule 2(2) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 (OJ 1995 L 303, p. 1), the list of goods and services is to be worded in such a way as to indicate clearly the nature of the goods and services. Finally, Article 44(1) of Regulation No 40/94 provides that the applicant may at any time withdraw his Community trade mark application or restrict the list of goods or services contained therein.
- 23 It is clear from the provisions cited above that it is for the person requesting registration of a sign as a Community trade mark to give, in the application, a list of the goods or services in respect of which the registration is requested and to provide, for each of those goods or services, a description clearly indicating their nature. OHIM, for its part, must examine the application in relation to all the goods or services on the list concerned, taking into account, if necessary, restrictions to that list within the meaning of Article 44(1) of Regulation No 40/94. If the list of goods or services covered by a Community trade mark application includes one or more categories of goods or services, OHIM is not under any obligation to make an assessment of each of the goods or services coming within each category, but must direct its examination to the category in question, as such (see, to that effect, the order of 15 November 2006 in Case T-366/05 *Anheuser-Busch v OHIM — Budějovický Budvar (BUDWEISER)* (not published in the ECR), paragraph 35).
- 24 It must also be pointed out that the Court of First Instance may annul or alter a decision of a board of appeal of OHIM only if, at the time the decision was adopted, it was vitiated by one of the grounds for annulment or alteration referred to in Article 63(2) of Regulation No 40/94. It may not, however, annul or alter that decision on grounds

which come into existence subsequent to its adoption (Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237, paragraph 55).

- 25 It follows that, in principle, a restriction within the meaning of Article 44(1) of Regulation No 40/94 to the list of goods or services contained in a Community trade mark application made after the adoption of the decision of the Board of Appeal challenged before the Court cannot affect the legality of that decision, which is the only decision being challenged before the Court (see, to that effect, the order in *BUDWEISER*, cited in paragraph 23 above, paragraphs 40 to 48, and Case T-458/05 *Tegometall International v OHIM — Wuppermann (TEK)* [2007] ECR II-4721, paragraph 23).
- 26 It must also be noted, however, that the decision of a board of appeal of OHIM can be challenged before the Court in relation solely to some of the goods or services in the list given in the Community trade mark application concerned. In such a case, that decision becomes final in respect of the other goods or services on the same list.
- 27 Having regard to that possibility, the Court has interpreted a statement made to it by a trade mark applicant, and therefore subsequent to the decision of the Board of Appeal, that it was withdrawing its application in respect of some of the goods covered by its initial application, as a statement that the contested decision was being challenged only in so far as it covered the remainder of the goods concerned (see, to that effect, Case T-289/02 *Telepharmacy Solutions v OHIM (TELEPHARMACY SOLUTIONS)* [2004] ECR II-2851, paragraphs 13 and 14), or as a partial withdrawal, where the statement was made at an advanced stage of the proceedings before the Court (see, to that effect, Case T-194/01 *Unilever v OHIM (Ovoid tablet)* [2003] ECR II-383, paragraphs 13 to 17).

28 Such an interpretation of a restriction, before the Court, of the list of the goods and services covered by a Community trade mark application is possible only if the applicant confines itself to withdrawing one or more goods or services from the list, or one or more categories of goods or services which were included, as such, in that list. In such a case, it is clear that the Court is in fact being asked to review the legality of the Board of Appeal's decision not in so far as it relates to the goods or services withdrawn from the list but only in so far as it relates to the other goods or services remaining on that list.

29 That situation should be distinguished from a restriction, before the Court, of the list of goods or services contained in a Community trade mark application, the object of that restriction being to change, in whole or in part, the description of those goods or services. In the latter case, it is possible that the alteration might have had an effect on the examination of the trade mark in question carried out at various stages by OHIM in the course of the administrative procedure. Accordingly, to allow that alteration at the stage of the action before the Court would amount to changing the subject-matter of pending proceedings, which is prohibited by Article 135(4) of the Rules of Procedure (see, to that effect, *TEK*, cited in paragraph 25 above, paragraph 25).

30 In the present case, the applicant had sought registration of the disputed trade mark for four categories of goods, namely goods denoted as 'Pastry and confectionery, chocolate products, sugar confectionery'. The restriction set out in the applicant's alternative claim does not provide for withdrawal of one or more of those four categories from the list of goods covered by the mark at issue, but is intended to alter the description of all of the categories of goods concerned, by specifying that the goods falling within those categories are not to be presented in the form of balls of marzipan and praline coated in chocolate, called 'Mozartkugeln' — in German. As stated above, to hold that claim admissible at the stage of the action before the Court would amount to changing the subject-matter of the proceedings, which is prohibited (see, to that effect, *TEK*, cited in paragraph 25 above, paragraph 27).

31 The applicant's alternative claim must therefore be rejected as inadmissible.

Substance

32 In support of its action, the applicant relies on two pleas in law. The first plea alleges infringement of the first sentence of Article 73 and the first phrase of Article 74(1) of Regulation No 40/94, and of the principles of the protection of legitimate expectations, equal treatment and legality. The second plea alleges infringement of Article 7(1)(c) of Regulation No 40/94.

The first plea: infringement of the first sentence of Article 73 and the first phrase of Article 74(1) of Regulation No 40/94 and of the principles of protection of legitimate expectations, equal treatment and legality

Arguments of the parties

33 The applicant claims, first of all, that the Board of Appeal infringed the first sentence of Article 73 of Regulation No 40/94 since it provided only an insufficient statement of reasons in the contested decision.

34 First, although the Board of Appeal recognised the relevance of the state of the law in Austria, it did not give any reasons for its decision not to take into account the decision of the Österreichisches Patentamt (Austrian Patent Office) of 12 September 1985, relied on by the applicant at various stages of the procedure before OHIM, according to which the sign Mozart may be protected as a trade mark.

35 Secondly, the Board of Appeal also failed to give reasons for its decision not to take into account the decision of the Bundespatentgericht (Federal Patents Court) in Case 32 W (pat) 265/01, in which that court concluded that the sign Wolfgang Amadeus Mozart-MOZART-KUGELN could be protected as a trade mark, on the ground that the addition of the name of the famous composer did not convey any objective information. In the fifth indent of paragraph 12, the contested decision merely referred to that argument of the applicant, without however examining it as to the merits or setting out its reasons for rejecting it.

36 The applicant acknowledges that the decisions of the competent authorities of the Member States for the registration of trade marks or national courts are merely a source of guidance for the application of Regulation No 40/94. However, the Boards of Appeal of OHIM have previously sent cases back for re-examination when a decision of a national authority had been ignored. The applicant takes the view that such a decision ought also to have been adopted in the present case by the Board of Appeal.

37 Thirdly, the applicant notes that it had also cited at the various stages of the procedure before OHIM the decision of the Third Board of Appeal of 10 April 2002 (see paragraph 14 above). The Board of Appeal stated, in that decision, that despite the existence in German-speaking countries of several terms descriptive of confectionery that include the word 'Mozart', such as 'Mozartkugeln', that word, taken in isolation, was not descriptive. Since the contested decision constitutes a radical reversal of its legal position in the decision of 10 April 2002, cited above, the Board of Appeal

ought, at least, to have stated in the contested decision the grounds which led it to depart from that legal position.

38 Fourthly, the applicant claims that the contested decision did not undertake a differentiated, precise and specific analysis of the allegedly descriptive character of the mark in question in relation to each of the four categories of goods covered by that mark. In addition, it did not state in which of those categories the Mozartkugeln product belongs, which in its view is decisive. According to settled case-law, reasons must be given for the rejection of a Community trade mark application in respect of each of the goods and services concerned. Since the contested decision did not carry out that analysis, it is vitiated by failure to state reasons or insufficient reasons.

39 Fifthly, the applicant submits that the contested decision merely repeated in a purely mechanical fashion the reasons for the decision of the Cancellation Division challenged before it, without correcting the errors made in that decision highlighted by the applicant. Accordingly, the contested decision did not make the numerous additional points needed to comply with the requirements of a proper statement of reasons and even aggravated the inadequacy of the statement of reasons for the Cancellation Division's decision.

40 In the second place, the applicant claims that, by failing to take into consideration the decisions of the Österreichisches Patentamt, the Bundespatentgericht and the Third Board of Appeal of OHIM, cited above, the Board of Appeal also infringed the first phrase of Article 74(1) of Regulation No 40/94, which states the principle that OHIM is to examine the facts of its own motion.

41 Lastly, the applicant claims that the Third Board of Appeal's decision of 10 April 2002 recognised clearly and unequivocally that the 'Mozart' word element, taken on its own, was capable of constituting a trade mark and therefore created a legitimate expectation to that effect. By departing from that decision in disregard of the duty to state reasons and by declaring the invalidity of the mark at issue, the Board of Appeal therefore infringed the principle of the protection of legitimate expectations and the principles of equal treatment and legality.

42 OHIM and the intervener challenge the applicant's arguments.

Findings of the Court

43 Under the first sentence of Article 73 of Regulation No 40/94, the decisions of OHIM are to state the reasons on which they are based. It is settled case-law that that duty has the same scope as that laid down by Article 253 EC and its purpose is, first, to allow interested parties to know the justification for the measure so as to enable them to protect their rights and, second, to enable the Community judicature to review the legality of the decision (see Case T-16/02 *Audi v OHIM (TDI)* [2003] ECR II-5167, paragraphs 87 and 88, and Joined Cases T-124/02 and T-156/02 *Sunrider v OHIM — Vitakraft-Werke Wührmann (VITATASTE and METABALANCE 44)* [2004] ECR II-1149, paragraphs 72 and 73 and the case-law cited).

44 According to the same case-law, whether a statement of reasons satisfies those requirements is a question to be assessed by reference not only to its wording but also to its context and the whole body of legal rules governing the matter in question

(*VITATASTE and METABALANCE 44*, cited in paragraph 43 above, paragraph 73 and the case-law cited).

45 As regards the legal rules applicable in Community trade mark matters, it should be noted that decisions concerning registration of a sign as a Community trade mark which the Boards of Appeal are called on to take under Regulation No 40/94 are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the question whether a sign may be registered as a Community trade mark must be assessed solely on the basis of that regulation, as interpreted by the Community Courts, and not on the basis of a previous practice of the Boards of Appeal. Moreover, since the Community trade mark regime is an autonomous system, neither OHIM nor, as the case may be, the Community Courts are bound by a decision adopted in a Member State finding the same sign to be registrable as a national trade mark. Registrations already made in the Member States are therefore a factor which may only be taken into consideration, without being given decisive weight. Those considerations apply a fortiori to the registration of other marks (see Case T-127/02 *Concept v OHIM (ECA)* [2004] ECR II-1113, paragraphs 70 and 71 and the case-law cited).

46 It follows from the preceding considerations that, when OHIM refuses registration of a sign as a Community trade mark, it must, in order to state the reasons for its decision, indicate the ground for refusal, absolute or relative, which precludes that registration and the provision from which that ground is drawn, and set out the facts which it found to be proved and which, in its view, justify application of the provision relied on. Such a statement of reasons is, in principle, sufficient to satisfy the requirements set out in paragraphs 43 and 44 above.

47 In addition, the Court would point out that, when the Board of Appeal confirms a lower-level decision of OHIM in its entirety, that decision, together with its statement of reasons, forms part of the context in which the Board of Appeal's decision was adopted, which is known to the parties and enables the Court to carry out fully

its judicial review as to whether the Board of Appeal's assessment was well founded (see, to that effect, the judgment of 21 November 2007 in Case T-111/06 *Wesergold Getränkeindustrie v OHIM — Lidl Stiftung (VITAL FIT)* (not published in the ECR), paragraph 64).

48 Also, more generally, it can be considered that sufficient reasons have been given for a decision where the decision refers expressly to another document that has been communicated to the applicant (see, to that effect, Joined Cases T-551/93 and T-231/94 to T-234/94 *Industrias Pesqueras Campos and Others v Commission* [1996] ECR II-247, paragraphs 142 to 144; Case T-137/01 *Stadtsportverband Neuss v Commission* [2003] ECR II-3103, paragraphs 55 to 58; and Case T-146/04 *Gorostiaga Atxalandabaso v Parliament* [2005] ECR II-5989, paragraphs 135 and 136).

49 It is in the light of those considerations that the Court will examine whether this plea is well founded.

50 As regards, first, the complaint alleging infringement of the obligation to state reasons, a preliminary point to be noted is that it is clear from paragraph 16 of the contested decision that the Board of Appeal adopted as its own the grounds of the Cancellation Division's decision, which thus make up an integral part of the reasons for the contested decision. Having regard to the case-law referred to in paragraphs 47 and 48 above, that reference to the grounds of the Cancellation Division's decision, which had been previously transmitted to the applicant and with which the applicant was perfectly well acquainted, was not at all improper, in particular because a sufficiently detailed summary of the Cancellation Division's decision appears in paragraph 5 of the contested decision. Consequently, and contrary to the applicant's submission, that reference is not sufficient, by itself, to establish the existence of failure to state reasons or insufficient reasons for the contested decision. It is therefore necessary to examine whether the statement of reasons for the contested decision is sufficient when the grounds for the Cancellation Division's decision are also taken into account.

51 When those two decisions are read in conjunction with each other, it is apparent that the Board of Appeal considered that the disputed mark had been registered in disregard of the absolute ground for refusal referred to in Article 7(1)(c) of Regulation No 40/94. That conclusion was based on the fact, which is not disputed and proven by references to dictionaries, that, at least as far as the average German-speaking consumer is concerned, the term ‘Mozartkugel’ is descriptive of a delicacy in the form of a ball of marzipan and praline coated in chocolate (third indent of paragraph 5 and paragraph 21 of the contested decision). Since, of the two constituents of ‘Mozartkugel’, the second (‘Kugel’, ball) clearly refers to the shape of the delicacy concerned, the Board of Appeal concluded that it was hard to imagine that that public, confronted with the name ‘Mozart’ on the packaging of a product in a confectioners or the chocolate section of a supermarket, would not assume that ‘Mozartkugeln’ were being offered for sale (seventh indent of paragraph 5, and paragraph 22 of the contested decision).

52 That statement of reasons is sufficient to attain the twofold objective of the duty to state reasons specified in the case-law (see paragraph 43 above). Moreover, contrary to the applicant’s submissions, it is clear from the Cancellation Division’s decision (paragraph 38), the grounds for which were adopted by the Board of Appeal, that the absolute ground for refusal applied, namely that referred to in Article 7(1)(c) of Regulation No 40/94, relates to all the goods covered by the mark at issue ‘since general categories are involved, which include Mozartkugeln’. It follows that the applicant’s argument that the Board of Appeal did not give reasons for its decision in relation to each of the goods covered by the mark at issue must be rejected.

53 The applicant also submits that the Board of Appeal ought to have given specific reasons for the fact that it departed from decisions of the Österreichisches Patentamt and the Bundespatentgericht and the decision of the Third Board of Appeal of 10 April 2002. In that regard, it must be borne in mind that, according to the case-law referred to in paragraph 45 above, the decisions of the national authorities and courts and the decision-making practice of OHIM itself are merely factors which may be taken into consideration, without being given decisive weight, in assessing whether a sign is suitable for registration as a Community trade mark.

54 It is true that the context in which the decision was taken, which is characterised, in particular, by exchanges between the author of the decision and the party concerned, may make the requirements imposed by the duty to state reasons more stringent in certain circumstances (*TDI*, cited in paragraph 43 above, paragraph 89). Accordingly, the possibility remains, in certain cases, that the arguments put forward by one of the parties to the procedure before OHIM, including those based on the existence of a national or OHIM decision in a similar case, will require a specific answer, going beyond the requirements set out in paragraph 46 above.

55 However, the Boards of Appeal cannot be required to provide an account that follows exhaustively and one by one all the lines of reasoning articulated by the parties before them. The reasoning may therefore be implicit, on condition that it enables the persons concerned to know the reasons for the Board of Appeal's decision and provides the competent Court with sufficient material for it to exercise its power of review (see, by analogy, Joined Cases C-204/00 P, C-205/00 P, C-211/00 P, C-213/00 P, C-217/00 P and C-219/00 P *Aalborg Portland and Others v Commission* [2004] ECR I-123, paragraph 372, and Case C-3/06 P *Groupe Danone v Commission* [2007] ECR I-1331, paragraph 46).

56 It follows that OHIM is not, as a general rule, required to provide in its decision a specific answer to each argument regarding the existence in other similar cases of decisions of its own at various stages in the procedure, or those of national courts which go in a particular direction, if the reasons for the decision adopted by OHIM in a specific case pending before it at any stage show, at the very least implicitly but clearly and unequivocally, why those other decisions were not relevant or were not taken into consideration in its assessment.

57 In the present case, the Board of Appeal, by adopting as its own the reasons for the Cancellation Division's decision, clearly set out not only the reasons why the absolute ground for refusal in Article 7(1)(c) of Regulation No 40/94 precluded registration of the disputed mark, but also why it arrived at a conclusion different from

that reached by the Oberlandesgericht München in its decision of 26 July 2001. The reason given in that decision for rejecting Coppenrath's counterclaim for a declaration of invalidity of the mark at issue, namely the statement that the sign Mozart calls to mind the famous composer and not a given recipe (14th indent of paragraph 5 of the contested decision) is, essentially, the same as those given in the decisions of the Österreichisches Patentamt and the Bundespatentgericht cited by the applicant and, moreover, simply negates the descriptive character of the mark at issue for the goods covered. In those circumstances and having regard to the autonomy of the Community trade mark system, it cannot be complained that the Board of Appeal failed to explain further and in detail why it decided not to follow those decisions.

58 The same considerations are a fortiori valid so far as concerns the applicant's argument based on the decision of the Third Board of Appeal of 10 April 2002. First, that argument also constitutes a mere denial that the mark at issue is descriptive for the goods covered.

59 On the other hand and above all, in paragraph 29 of its decision the Cancellation Division expressly referred to the decision of the Third Board of Appeal in question and set out the reasons why it did not consider itself bound by the reasoning in that decision relating to the registrability of the sign MOZART-BONS in the *inter partes* case pending before it. In those circumstances and irrespective of the lack of relevance of the earlier administrative practice of OHIM, since the Board of Appeal adopted the reasons for the Cancellation Division's decision there cannot, in any event, be any question of a failure to give reasons on that point.

60 It follows from all of the foregoing that, contrary to the applicant's submissions, sufficient reasons were given for the contested decision as a matter of law.

- 61 As regards, secondly, the applicant's argument that the Board of Appeal infringed the first phrase of Article 74(1) of Regulation No 40/94 by failing to take into account the decisions of the Österreichisches Patentamt and the Bundespatentgericht and the Third Board of Appeal's decision of 10 April 2002, it must be stated that, according to the case-law and the considerations referred to in paragraphs 45 and 53 above respectively, those three decisions do not constitute facts which can be examined by OHIM at any stage of its own motion.
- 62 In any event, the applicant relied on the first two decisions in its observations before the Board of Appeal, so there can be no question of their examination by OHIM of its own motion. As regards the third, it was referred to and examined in the Cancellation Division's decision. Furthermore, as has already been pointed out, it appears implicitly but clearly from the statement of reasons in the contested decision that the Board of Appeal examined and rejected the argument which the applicant sought to draw from those three decisions.
- 63 Lastly, the applicant's complaints alleging infringement of the principles of the protection of legitimate expectations, equal treatment and legality also cannot succeed.
- 64 According to case-law, the principle of the protection of legitimate expectations extends to any individual in a situation where it is clear that the Community administration has, by giving him precise, unconditional and concordant assurances, emanating from authorised and reliable sources, led him to entertain justified hopes (see Case T-203/97 *Forvass v Commission* [1999] ECR-SC I-A-129 and II-705, paragraph 70 and the case-law cited, and Case T-319/00 *Borremans and Others v Commission* [2002] ECR-SC I-A-171 and II-905, paragraph 63). However, such assurances must comply with the applicable provisions and rules, since promises which do not take account of those provisions cannot give rise to a legitimate expectation on

the part of the person concerned (see Case T-205/01 *Ronsse v Commission* [2002] ECR-SC I-A-211 and II-1065, paragraph 54, and Case T-329/03 *Ricci v Commission* [2005] ECR-SC I-A-69 and II-315, paragraph 79 and the case-law cited; see also, to that effect, Case 162/84 *Vlachou v Court of Auditors* [1986] ECR 481, paragraph 6).

⁶⁵ Likewise, observance of the principle of equal treatment must be reconciled with observance, specifically, of the principle of legality, also relied on by the applicant. According to the latter principle, no person may rely, in support of his claim, on an unlawful act committed in favour of another (Case 134/84 *Williams v Court of Auditors* [1985] ECR 2225, paragraph 14; see also, to that effect, Case 188/83 *Witte v Parliament* [1984] ECR 3465, paragraph 15).

⁶⁶ In the present case, the applicant did not indicate clearly in its application if it took the view that the considerations in the decision of the Third Board of Appeal of 10 April 2002, relied on in its arguments, were compatible or not with the criteria for the application of Article 7(1)(c) of Regulation No 40/94.

⁶⁷ In so far as the applicant's argument must be understood as meaning that, having regard to the considerations set out in the Third Board of Appeal's decision of 10 April 2002, the Board of Appeal was required, in this case, not to apply Article 7(1)(c) of Regulation No 40/94, although its application was justified, such an argument cannot be accepted. According to the case-law set out in paragraphs 64 and 65 above, if, in an earlier case, one of OHIM's Boards of Appeal has committed an error of law in accepting the registrability of a sign as a Community trade mark, none of the principles relied on by the applicant preclude the adoption, in a later case comparable to the previous one, of a contrary decision (see, to that effect, Case T-106/00 *Streamserve v OHIM (STREAMSERVE)* [2002] ECR II-723, paragraph 67, and the judgment of 30 November 2006 in Case T-43/05 *Camper v OHIM — JC (BROTHERS by CAMPER)* (not published in the ECR), paragraph 95).

68 Consequently, in such a case, the applicant's arguments alleging infringement of the principles of the protection of legitimate expectations, equal treatment and legality must be rejected, without there being any need to examine whether the decisions of OHIM's Boards of Appeal in earlier cases may be considered to have given assurances, emanating from OHIM, within the meaning of the case-law referred to in paragraph 64.

69 In so far as the applicant's arguments must be understood as meaning that in this case it was necessary to adopt the same position as that adopted by the Third Board of Appeal in its decision of 10 April 2002, since the latter complied with the criteria for the application of Article 7(1)(c) of Regulation No 40/94, those arguments are invalid. In such a case, which is that contemplated in the applicant's second plea examined below, the contested decision should be annulled for breach of the aforesaid provision, without there being any need to examine whether the abovementioned principles, relied on by the applicant, were also infringed (see, to that effect, *STREAMSERVE* and *BROTHERS by CAMPER*, both cited in paragraph 67 above, paragraphs 67 and 94 respectively).

70 In the light of all of the foregoing, the first plea must be rejected.

The second plea: infringement of Article 7(1)(c) of Regulation No 40/94

Arguments of the parties

71 The applicant claims that the contested decision is based on a misapplication of Article 7(1)(c) of Regulation No 40/94, since the mark at issue cannot serve, in trade,

to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods covered or other characteristics of the goods.

72 According to the applicant, the Board of Appeal considered, in the contested decision, that that article applied to the mark at issue since, in Germany and Austria, ‘Mozartkugel’ was a generic term which described a chocolate speciality. That reasoning disregarded the fact that the mark at issue is composed of the word ‘Mozart’ and not the word ‘Mozartkugel’.

73 The applicant notes that the contested decision did not set out its own reasons to explain the descriptive character of the mark at issue, but merely referred to the Cancellation Division’s decision. The latter took the view that if the mark at issue was used to designate a Mozartkugel of the usual shape, it would be perceived as a descriptive indication, since it would be clear from the shape of the product concerned that it was a ball.

74 According to the applicant, that premiss does not stand up to legal analysis. The relevant public — average consumers who are reasonably well informed and circumspect — does not establish a direct link between the mark at issue and the goods covered without further thought or reflection.

75 Signs consisting of the names of famous persons, such as Mozart, are capable of being Community trade marks as provided for in Article 4 of Regulation No 40/94, and no other provision of that regulation precludes their registration. Since those names have, accordingly, distinctive character in the abstract, their registration cannot be refused on the basis of the absolute ground for refusal referred to in Article 7(1)(c) of Regulation No 40/94 except in obvious cases, a condition which is not fulfilled in

the present case. Moreover, according to settled case-law, a minimum degree of distinctive character is sufficient for registration of a sign as a Community trade mark.

- 76 According to the applicant, it is necessary in this case to examine specifically whether the mark in question constitutes a descriptive indication in respect of each of the goods covered. Consequently, that mark can be cancelled only if the goods referred to in the contested decision, namely Mozartkugel, may be considered to belong to one of the four categories of goods for which that mark was registered. However, the contested decision did not even state under which category of goods Mozartkugeln fall.
- 77 In any event, even in the case of Mozartkugeln, no descriptive character can be attributed to the mark in question. The applicant notes that, in the minds of the public concerned, the mark at issue will evoke images relating to the famous composer of the same name and his musical works. It cannot, on the other hand, be accepted that that same public, confronted with that mark, would think directly and immediately of Mozartkugeln. To accept otherwise would be tantamount to denying that the Community public has any elementary musical knowledge.
- 78 At the very most, the disputed mark might convey some suggestion, evocation or allusion as regards Mozartkugeln which does not, however, prevent its registration.
- 79 The contested decision adopted as its own paragraph 27 of the Cancellation Division's decision, which confirmed the preceding considerations. It is therefore common ground that the disputed mark will evoke, for the public concerned, above all the composer Mozart rather than confectionery. However, by then accepting

that the disputed mark was descriptive of those products, the contested decision contradicted itself.

80 The existence in German-speaking countries of a considerable number of marks registered for goods in Class 30 and including the word Mozart also confirms that that word, taken in isolation, is not regarded as descriptive of such products in those countries. A Mozart trade mark has even been registered in Austria. All of that is apparent from the documents already produced by the applicant during the proceedings before OHIM.

81 The judgment of the Oberlandesgericht München of 26 July 2001 also confirmed that the mark at issue is not perceived as being descriptive of the goods covered. The applicant agrees with part of the grounds for that judgment, cited verbatim in the application. According to those grounds, Mozart is, first of all, a family name used in everyday language to designate the famous composer of that name and is not, in German, in any way descriptive of the goods covered by the mark at issue, either originally or even after the invention by the Salzburg confectioner Paul Fürst in 1890 of the delicacy named Mozartkugeln. It is true that, when Mozart is used to designate goods such as those covered by the mark at issue, in particular on their packaging, the relevant public will recall images of Mozartkugeln. However, even in that case, the word 'Mozart' is not perceived as obviously or exclusively descriptive of those goods or as a purely generic name, since the use of the designation 'Mozart' in isolation for such purposes is altogether unusual.

82 The applicant considers that paragraphs 37 and 39 of the decision of the Third Board of Appeal of OHIM of 10 April 2002 also confirm the argument that the disputed mark is not descriptive of the goods covered.

83 Finally, the applicant refers to the opinion poll carried out in February 2001 by the Ipsos institute. According to that poll, only 18.2% of the public concerned would see 'Mozart' as indicating a particular recipe, which shows that, for the great majority of German consumers (81.8%), that is not the case. The applicant considers that those results are also valid for the other German-speaking country of the European Union, Austria, which explains the registration in that country of the word mark Mozart, for goods within Class 30.

84 OHIM and the intervener challenge the applicant's arguments.

Findings of the Court

85 Article 51(1)(a) of Regulation No 40/94 provides that a Community trade mark is to be declared invalid where it has been registered in breach of the provisions of Article 7 of the regulation. Article 7(1)(c) of that regulation states that inter alia the following are not to be registered: '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'. In addition, Article 7(2) of Regulation No 40/94 provides that '[p]aragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community'.

86 According to settled case-law, Article 7(1)(c) of Regulation No 40/94 prevents the signs or indications to which it refers from being reserved to one undertaking alone

because they have been registered as trade marks. That provision pursues an aim that is in the public interest, which requires that such signs and indications may be freely used by all (see *TEK*, cited in paragraph 25 above, paragraph 77 and the case-law cited).

⁸⁷ The signs referred to by that provision are thus regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services, thus enabling the consumer who acquired the product or service to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (see Case T-348/02 *Quick v OHIM (Quick)* [2003] ECR II-5071, paragraph 28 and the case-law cited).

⁸⁸ The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are those which may serve in normal usage from the point of view of the relevant public to designate, either directly or by reference to one of their essential characteristics, goods or services in respect of which registration is sought (Case C-383/99 P *Procter & Gamble v OHIM* [2001] ECR I-6251, paragraph 39, and Case T-19/04 *Metso Paper Automation v OHIM (PAPERLAB)* [2005] ECR II-2383, paragraph 24).

⁸⁹ In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, 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 (Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 32).

- 90 It follows from the foregoing considerations that, for a sign to be caught by the prohibition set out in Article 7(1)(c) of Regulation No 40/94, there must be a sufficiently direct and specific relationship between the sign and the goods or services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods or services in question or one of their characteristics (see *TEK*, cited in paragraph 25 above, paragraph 80).
- 91 Accordingly, a sign's descriptiveness can only be assessed, first, in relation to the goods or services concerned and, second, to the way in which it is understood by the section of the public targeted which is composed of the consumers of those products or services (Case T-356/00 *DaimlerChrysler v OHIM (CARCARD)* [2002] ECR II-1963, paragraph 25, and Joined Cases T-367/02 to T-369/02 *Wieland-Werke v OHIM (SnTEM, SnPUR, SnMIX)* [2005] ECR II-47, paragraph 17).
- 92 In that respect, it must be pointed out that the fact that a sign is descriptive in relation to only some of the goods or services within a category listed as such in the application for registration does not preclude that sign being refused registration (*TEK*, cited in paragraph 25 above, paragraph 94; see also, to that effect, Case T-359/99 *DKV v OHIM (EuroHealth)* [2001] ECR II-1645, paragraph 33, and Case T-355/00 *DaimlerChrysler v OHIM (TELE AID)* [2002] ECR II-1939, paragraph 40). If, in such a case, the sign in question was registered as a Community trade mark for the category covered, nothing would preclude its proprietor from also using it for the goods or services of that category in respect of which it is descriptive.
- 93 In this case, it should be noted, first, that both the Cancellation Division and the Board of Appeal correctly based their assessment on the perception of the mark in question on the section of the general public at which the goods covered by that mark are clearly directed. The applicant too, in its line of argument, took into account that public's perception of the disputed mark.

94 Secondly, as has already been pointed out in paragraphs 50 and 51 above, the contested decision, in adopting as its own the grounds of the Cancellation Division's decision, concluded that, for German speakers, the mark at issue was descriptive of confectionery and pastry, chocolate products and sugar confectionery, for which it was registered, since it constituted an indication as to how the goods were manufactured and therefore designated their kind and quality. That conclusion is based on the existence, duly proven by references to dictionaries, of the generic German term 'Mozartkugel', used for a chocolate delicacy described in paragraph 51 above.

95 'Mozartkugel' is a compound word following the usual rules of the German language and formed of two words 'Mozart' and 'Kugel' (ball). Unlike other languages, in particular French, German requires the combination of those two words to be written as one word. Nevertheless, when confronted with the compound word 'Mozartkugel', any German speaker will, without any particular mental effort, identify the two words of which it is composed and immediately understand them.

96 Since Mozartkugeln are spherical, the second constituent of the term designating them will be perceived by German speakers as a description of the shape of the goods concerned. Mozartkugeln are made according to a specific recipe which distinguishes them from any other delicacy in the form of a ball coated in chocolate. A delicacy of that shape made according to a different recipe could also be described, in German, as a 'Kugel' (ball), but it would not be a Mozartkugel. It follows that the German-speaking public necessarily perceives the word 'Mozart' as a reference to the characteristic recipe of the delicacy called a Mozartkugel.

97 As has already been noted in the examination of the first plea, both the Cancellation Division and the Board of Appeal, which adopted the grounds of the Cancellation Division's decision, considered that Mozartkugeln fell within all four categories of

the goods covered by the mark at issue. In that respect, it must be stated that a typical Mozartkugel, as described in paragraph 51 above, is confectionery made, in particular, from chocolate and sugar and, in that sense, is at the same time confectionery, a chocolate product and sugar confectionery.

98 On the other hand, it is less clear that it could also be classified as 'pastry'. Although it does contain marzipan, which is an almond paste, it is not baked, as suggested by the German expression 'feine Backwaren', used in the application for registration of the disputed mark. Nevertheless, a pastry baked in the form of a ball coated in chocolate which includes marzipan and praline in its ingredients is perfectly conceivable and could, in German-speaking countries, also be described as a Mozartkugel.

99 It is apparent from those considerations that, at least for 'pastry and confectionery, chocolate products and sugar confectionery' which are presented in the form of a chocolate ball, namely for some of the goods falling within the categories mentioned in the application for registration of the disputed mark, that mark can be used in a part of the Community, namely in German-speaking countries (Germany and Austria), for descriptive purposes. The average consumer in those two countries, confronted with a ball coated in chocolate called a 'Mozart', will see in that term a reference to the characteristic recipe for Mozartkugeln, rather than information as to the commercial origin of the goods concerned. Omission of the word 'Kugel' cannot lead to a different conclusion, since that word is a reference not to the recipe but to the shape of the goods in question, which is evident, given the external shape of the goods.

100 That conclusion cannot be invalidated by the arguments put forward by the applicant. First of all, the applicant incorrectly relies on Article 4 of Regulation No 40/94 to submit that registration of the mark at issue can be refused only in entirety

obvious cases. Registration of a sign which does not comply with Article 4 of Regulation No 40/94 would already be caught by the absolute ground for refusal referred to in Article 7(1)(a) of the same regulation and it would not be necessary to examine its possibly descriptive character. It follows that the absolute ground for refusal referred to in Article 7(1)(c) of Regulation No 40/94 relates only to signs which comply with Article 4 of that regulation. Accordingly, and contrary to what is claimed by the applicant, the fact that a sign complies with that article is irrelevant for the purposes of the assessment of its possibly descriptive character.

101 Moreover, the applicant was wrong to rely on case-law to the effect that a minimum degree of distinctive character suffices for a sign to be registered as a Community trade mark, since in the present case it is not a question of the disputed mark's lack of distinctive character, for the purpose of Article 7(1)(b) of Regulation No 40/94, but of the possibly descriptive character of that mark within the meaning of Article 7(1)(c).

102 Secondly, the fact, relied on by the applicant, that the public concerned will see in the word 'Mozart', above all, a reference to the famous composer Wolfgang Amadeus Mozart does not prevent that word from being, for the goods concerned, an indication of a descriptive character.

103 It must be pointed out, in that regard, that such character is not to be assessed in the abstract, but in relation to the goods which the word in question will designate as a Community trade mark. Even in such a context it is indeed likely that the public concerned, when it sees the word 'Mozart', will think of the composer of the same name. However, since the goods covered bear no relationship to music, that reference to a famous composer is, apart from evoking the latter, completely irrelevantly, able to convey other information relating to the goods in question. The applicant has itself implicitly admitted that such was the case, since it has applied for registra-

tion of the sign Mozart as a Community trade mark, namely as an indication giving information relating to those goods as to their commercial origin.

104 The question which arises is therefore what information relating to the goods at issue the consumers in question will draw from the reference, in the context of the goods covered by the disputed mark, to the composer, Mozart. For the reasons set out above, what is involved is information relating to the recipe for those products rather than their commercial origin.

105 Thirdly, as has already been stated in the examination of the first plea, neither the fact that another Board of Appeal of OHIM, in another case, reached a different conclusion regarding the descriptive character of the sign Mozart in respect of similar goods, nor the judgment of the Oberlandesgericht München of 26 July 2001, which dismissed a counterclaim for a declaration of invalidity of the trade mark at issue, precluded the Board of Appeal from granting the disputed application for a declaration of invalidity.

106 In any event, the Oberlandesgericht München did not reach a conclusion any different from that set out in paragraph 99 above regarding the perception which the German public will have of the disputed mark. On the contrary, that court also accepted that when that mark is used to designate the goods in question in this case, in particular on their packaging, it will call to mind on the part of the relevant public images of Mozartkugeln (see paragraph 81 above). The dismissal by that same court of the counterclaim for a declaration of invalidity of the disputed mark is therefore based only on the fact that the use, for descriptive purposes, of the word 'Mozart' in isolation is unusual.

107 According to the case-law of the Court referred to in paragraph 89 above, in order for the absolute ground for refusal in Article 7(1)(c) of Regulation No 40/94 to apply,

it is not necessary that the term concerned should actually or usually be employed in a way that is descriptive. It is sufficient that such a use is possible.

108 Lastly, as regards the opinion poll cited by the applicant, it is apparent from the results of that poll, which was produced by the applicant before OHIM and included in the file on the proceedings before the Board of Appeal sent to the Court, that in reply to a spontaneous, open question, that is to say, without any suggestion of possible answers, two thirds of those polled associated the name Mozart, in the context of the goods covered by the disputed mark, with Mozartkugeln.

109 Those same results show that when the persons polled were asked to choose from several possible answers, almost three quarters (73.4%) chose the answer that, in the context of those goods, they would associate 'Mozart' with 'a praline in the form of a ball, the Mozartkugel'. A lower proportion of those polled (18.2%) chose to reply to the same question that they associated 'Mozart' with a particular recipe. It is to that result that the applicant refers in its arguments.

110 However it is clear that when all of the results of the opinion poll in question are examined they do not in any way invalidate the conclusion drawn in paragraph 99 above but, on the contrary, confirm it, in so far as a large majority of the persons polled associate the word 'Mozart', when it is used in relation to the goods covered by the disputed mark, either with Mozartkugeln or with a particular recipe. Accordingly, in both cases, the obvious conclusion is that, in relation to those goods, that term is descriptive.

111 It follows from all of the foregoing that the contested decision correctly concluded that the mark at issue had been registered contrary to the provisions of Article 7(1)(c) of Regulation No 40/94 and that it had to be declared invalid pursuant to

Article 51(1)(a) of that regulation. Accordingly, the second plea must be rejected as unfounded, as well as the action in its entirety.

Costs

¹¹² Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

¹¹³ In this case, since the applicant has been unsuccessful, it must be ordered to pay its own costs and those of OHIM in accordance with the form of order sought by the latter. Since the intervener has not applied for costs, it must be ordered to bear its own costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Fifth Chamber)

hereby:

1. Dismisses the action;

- 2. Orders Paul Reber GmbH & Co. KG to pay its own costs and those of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM);**

- 3. Orders Chocoladefabriken Lindt & Sprüngli AG to bear its own costs.**

Vilaras

Prek

Ciucă

Delivered in open court in Luxembourg on 9 July 2008.

E. Coulon

M. Vilaras

Registrar

President