

## Case T-304/06

**Paul Reber GmbH & Co. KG**

**v**

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

(Community trade mark — Invalidity proceedings — Community word mark Mozart — Subject-matter of the dispute — Absolute ground for refusal — Descriptive character — Obligation to state the reasons on which a decision is based — Legitimate expectations — Equal treatment — Principle of legality — Article 7(1)(c), Article 51(1)(a), Article 73, first sentence, and Article 74(1), first sentence, of Regulation (EC) No 40/94)

Judgment of the Court of First Instance (Fifth Chamber), 9 July 2008 . . . . . II - 1931

#### Summary of the Judgment

1. *Community trade mark — Appeal proceedings — Proceedings before the Community judicature*  
(*Rules of Procedure of the Court of First Instance, Art. 135(4); Council Regulation No 40/94, Art. 44(1)*)

2. *Community trade mark — Procedural provisions — Statement of reasons for decisions*  
(Art. 253 EC; Council Regulation No 40/94, Art. 73)
3. *Community trade mark — Surrender, revocation and invalidity — Absolute grounds of invalidity*  
(Council Regulation No 40/94, Arts 7(1)(c) and 51(1)(a))

1. The decision of a board of appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) 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.

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asked to review the legality of the Board of Appeal's decision not in so far as it relates to the goods or services withdrawn from the list but only in so far as it relates to the other goods or services remaining on that list.

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, or as a partial withdrawal, where the statement was made at an advanced stage of the proceedings before the Court.

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 paras 26-29)

2. Under the first sentence of Article 73 of Regulation No 40/94 on the Community trade mark, the decisions of the Office for Harmonization in the Internal Market (Trade Marks and Designs) are to state the reasons on which they are based. 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. 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.

As regards the legal rules applicable in Community trade mark matters, whether a sign may be registered must

be assessed solely on the basis of Regulation No 40/94, as interpreted by the Community Courts. 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. Thus, 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 those requirements.

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. 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 those requirements. 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. 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.

(see paras 43-46, 53-56)

chocolate products, sugar confectionery' in Class 30 of the Nice Agreement, on the basis of the absolute ground for refusal referred to in Article 7(1)(c) of Regulation No 40/94 on the Community trade mark, in so far as, at least for such products 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 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.

3. The word mark Mozart should not have been registered as a Community trade mark for 'pastry and confectionery,

(see para. 99)