



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Second Chamber)

17 April 2013 *

(Community trade mark — Application for Community word mark CONTINENTAL — Absolute ground for refusal — Descriptive character — Article 7(1)(c) of Regulation (EC) No 207/2009)

In Case T-383/10,

Continental Bulldog Club Deutschland eV, established in Berlin (Germany), represented initially by S. Vollmer, and subsequently by U. Rühl, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented initially by S. Schäffner, and subsequently by D. Walicka, acting as Agents,

defendant,

ACTION brought against the decision of the First Board of Appeal of OHIM of 23 June 2010 (R 300/2010-1), concerning an application for registration of the word mark CONTINENTAL as a Community trade mark,

THE GENERAL COURT (Second Chamber),

composed of N. J. Forwood, President, F. Dehousse and J. Schwarcz (Rapporteur), Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Registry of the General Court on 7 September 2010,

having regard to the response of OHIM lodged at the Registry on 17 December 2010,

having regard to the letter by which the applicant waived the application for a hearing and having therefore decided, upon hearing the Judge-Rapporteur and in accordance with Article 135a of the Court's Rules of Procedure, to give a ruling without an oral procedure,

gives the following

* Language of the case: German.

Judgment

Background to the dispute

- 1 On 7 September 2009, the applicant, Continental Bulldog Club Deutschland eV, filed an application for registration of a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), under Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).
- 2 The mark for which registration was sought is the word mark CONTINENTAL.
- 3 The goods and services in respect of which registration was sought are in Classes 31 and 44 of 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, and correspond, for each of those classes, to the following description:
 - Class 31: ‘live animals, i.e. dogs’;
 - Class 44: ‘the keeping and breeding of dogs, i.e. puppies and animals for breeding’.
- 4 By decision of 9 February 2010, the examiner refused registration of the trade mark applied for in relation to all the goods and services at issue, in accordance with Article 7(1)(b) and (c) of Regulation No 207/2009.
- 5 On 1 March 2010, the applicant lodged an appeal with OHIM against the examiner’s decision.
- 6 By decision of 23 June 2010 (‘the contested decision’), the First Board of Appeal of OHIM rejected the appeal on the ground that the word mark CONTINENTAL was, for the goods and services claimed, descriptive within the meaning of Article 7(1)(c) of Regulation No 207/2009, as well as devoid of any distinctive character, within the meaning of Article 7(1)(b) of that regulation.

Forms of order sought

- 7 The applicant claims that the Court should:
 - annul the contested decision;
 - in the alternative, annul the contested decision in so far as it relates to ‘goods and services’ in Class 44;
 - order OHIM to pay the costs.
- 8 OHIM contends that the Court should:
 - dismiss the action;
 - order the applicant to pay the costs.

Law

- 9 In support of its action, the applicant puts forward two pleas in law, respectively alleging infringement of Article 7(1)(c) of Regulation No 207/2009 and of Article 7(1)(b) thereof.

The first plea

- 10 According to the applicant, the Board of Appeal erred in finding that the word mark CONTINENTAL was descriptive of the goods and services concerned.
- 11 OHIM disputes the applicant's arguments.
- 12 It should be noted in that regard that Article 7(1)(c) of Regulation No 207/2009 prohibits the registration of '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'.
- 13 According to settled case-law, Article 7(1)(c) of Regulation No 207/2009 pursues an aim which is in the public interest, which requires that the signs or indications which are descriptive of the characteristics of the goods or services in respect of which registration is sought may be freely used by all (see judgment of 12 June 2007 in Case T-339/05 *MacLean-Fogg v OHIM (LOKTHREAD)*, not published in the ECR, paragraph 27 and the case-law cited).
- 14 In addition, signs or indications which serve, in trade, to designate the characteristics of the product or service for which registration is sought are, under Article 7(1)(c) of Regulation No 207/2009, 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, at the time of making a subsequent purchase (see *LOKTHREAD*, paragraph 13 above, paragraph 28 and the case-law cited).
- 15 It follows that, for a sign to fall under the prohibition laid down by that provision, there must be a sufficiently direct and specific link between the sign and the goods and services in question to enable the relevant public immediately to perceive, without further thought, a description of the goods and services in question or of one of their characteristics (see *LOKTHREAD*, paragraph 13 above, paragraph 29 and the case-law cited).
- 16 It should also be noted that a sign's descriptiveness can only be assessed, first, by reference to the way in which it is understood by the relevant public and, second, by reference to the goods or services concerned (see *LOKTHREAD*, paragraph 13 above, paragraph 32 and the case-law cited).
- 17 In light of those considerations, it is appropriate to assess whether, as claimed by the applicant, OHIM breached Article 7(1)(c) of Regulation No 207/2009 in finding that the trade mark applied for would be perceived, by the relevant public, as being descriptive.

The relevant public and its level of attention

- 18 It should be noted, as the Board of Appeal has done (paragraph 12 of the contested decision), that the goods and services at issue are targeted in equal part at average consumers in general, such as animal lovers who are interested in dog keeping services, and to professional environments, such as dog breeders or pet shop owners. In relation to the level of attention of the relevant public, account should be taken of the definition put forward by the Board of Appeal at paragraph 14 of the contested decision, according to which that level of attention is 'higher', given that the public pays particular attention to pedigree, to the method of breeding and to the characteristics of the dogs and, in addition, because of the fact that these are 'goods' which are not purchased every day or services which are not sought after on a daily basis. Even though the applicant refers, in its application, only

to ‘average consumers reasonably well informed, observant and circumspect’, the fact remains that it does not advance any argument in support of a limitation of the relevant public, which must therefore be set aside as unfounded.

- 19 In addition, the Court considers that in order to evaluate whether the Board of Appeal correctly decided that the trade mark applied for is descriptive, it is necessary to take account of its perception by the relevant public in the whole of the European Union, since an application for a Community trade mark must be rejected, in accordance with Article 7(1) and (2) of Regulation No 207/2009, if a ground for refusal exists in at least part of the European Union. The examiner thus correctly found that it was appropriate to refer to all relevant consumers in the Union, assessment which is taken up by the Board of Appeal at paragraph 3 of the contested decision.

The descriptiveness of the word ‘continental’

- 20 It is necessary to check whether the Board of Appeal correctly decided that, for a relevant public thus defined, there was a direct and specific link between the word mark CONTINENTAL and the goods and services referred to in the trade mark application.
- 21 In that regard, firstly, it should be noted that the applicant did not dispute the Board of Appeal’s assessment, set out at paragraph 16 of the contested decision, according to which the word ‘continental’ referred to ‘adjectives such as “European, continental, non insular”’.
- 22 Secondly, it appears from the contested decision, inter alia its paragraph 17 et seq., that, in order to determine the descriptiveness of the term referred to in the trade mark application, the Board of Appeal found to be decisive the fact that it would be understood as designating a breed of bulldogs. In that regard it relied inter alia on several internet websites including those of the applicant. Essentially, the Board of Appeal found that it was clear to the requisite legal standard that the term ‘continental bulldog’ (referred to in English on those websites), referred to a breed of dog, already recognised in Switzerland by the Schweizerische Kynologische Gesellschaft (SKG), and the creation and breeding of which were the goal of the applicant’s association. On the basis also of the applicant’s internet websites, the Board of Appeal asserted, firstly, that the above term had been chosen for a new breed of dog so as to be able to clearly distinguish the latter from the ‘English Bulldog’ breed, secondly, that it emerged that the applicant was considering, as soon as the various conditions laid down by the Federation cynologique internationale (the World Canine Organisation, FCI) were fulfilled, making an application for recognition of the new breed to that organisation (paragraphs 20 and 23 of the contested decision).
- 23 Thereafter, the Board of Appeal concluded that the term ‘continental’ was evocative of the name of a breeding kennel, or of a breed of bulldogs. According to the Board, where the breeder of a new breed gives a name to that breed, that name becomes the name of that type of dog. The board regarded that situation as presenting certain similarities with the designation of plant varieties. The Board of Appeal asserted, in addition, that it was not important that the applicant had wanted to practise ‘closed breeding’, inasmuch as, according to it, from a biological point of view, even dogs who do not directly come from that breeding kennel could nonetheless remain dogs from that ‘breed’ or ‘species’. For that same reason, the board regarded it as of little importance that the internet sites of certain ‘continental bulldog’ breeders refer to the applicant (paragraphs 24 to 27 of the contested decision).
- 24 Finally, the Board of Appeal held that the trade mark applied for should also be denied registration in relation to dog keeping and breeding services, i.e. of puppies and animals for breeding, on the ground that they include specialised services which are more specifically referred to by the name of the dog breeding kennel (paragraph 28 of the contested decision).

- 25 The applicant disputes the findings of the Board of Appeal. Firstly, it submits, essentially, that the Board made a mistake in comparing the trade mark applied for to the term ‘continental bulldog’. Secondly, the legislature contemplated allowing trade mark holders, by means of their registration, to protect indications of origin and even expressly provided for ‘live animals’ that they enjoy the protection conferred by a trade mark. Indeed, in the past, the Board of Appeal has accepted registration, as a Community trade mark, of the breed of dog referred to as ‘Elo’. Thirdly, the Board of Appeal has taken account of an absolute ground for refusal of registration not provided for by Community trade mark law, that is the use, before registration, of the sign applied for to prevent registration as a result of the fact that it risks that sign being held in future to be descriptive. Fourthly, the applicant submits that it is not possible to proceed by analogy with what is provided for in the field of the designation of plant varieties, their protection being based on *lex specialis*. In that context, the Board of Appeal also erred in relation to the hierarchy of concepts. Finally, the applicant submits that its application for registration does not constitute an attempt to register a trade mark on an existing breed.
- 26 As a preliminary point, the Court notes that it emerges from the application that the applicant did not dispute the existence of a link between the term ‘continental bulldog’ and a breed of dog ‘in the making’, which is a breed for which the recognition process has not yet been completed. In that regard, it is appropriate to refer to that part of the application in which the applicant asserts that, if the relevant public wanted to designate a breed of dog, it would not use the term ‘continental’, but rather the term ‘continental bulldog’, which is proved, according to it, by the extracts of the internet websites supplied for the proceedings before OHIM. In the same way, the applicant asserts in the application that the relevant public referred to the services which are the subject of the application as the ‘keeping and breeding services of the “Continental Bulldog” club’. Those assertions are merely confirmed by the statement made by the applicant in the application, in the context of its second plea, according to which, in seeking registration of the trade mark in dispute, its aim was ‘to set itself apart from the other bulldog breeders’ associations which seek, in the long term, to establish a breed’, including, inter alia, the Allgemeiner Club für Englische Bulldogs eV, the Bulldog Club für American Bulldogs or the Internationaler Klub für Französische Bulldoggen eV (IFKB).
- 27 In addition, in the application, the applicant uses the term ‘continental bulldog’ to refer to the specific pedigree of a dog, vouching that that dog comes from ‘closed breeding’. According to the applicant, that term allows for the presentation of a dog’s origins and genealogy.
- 28 Nonetheless, the applicant submits, in essence, that the recognition process for a breed of dog by organisations such as the FCI could last for decades without necessarily being completed and, in any event, that registration was sought as a Community trade mark of the word ‘continental’ rather than of the above term.
- 29 In that regard, firstly, it should be noted that it is indeed apparent from the various extracts of internet websites, to which the Board of Appeal referred in the contested decision, inter alia at paragraph 3 and at paragraphs 19 to 22 thereof, that the term ‘continental bulldog’ could designate a breed of dog which was recognised at least in Switzerland, that is, by the SKG association. In addition, that recognition, dating already from 2004, is even classified as ‘official’.
- 30 Secondly, it also emerges from the aforementioned extracts of internet pages that the breeders of dogs known as ‘continental bulldogs’ considered them as representatives of a breed ‘in its own right’ which is, or at least tends to be, constantly improving. The characteristics of the new breed of dog are set out therein, as well as a comparison with the recognised breed of ‘English bulldogs’; the new Swiss race brings, according to the information mentioned on the above internet websites, ‘a noticeable improvement in terms of health and resistance’. In addition, the above term is used, in those extracts, also to designate dog ‘breeding’ services.

- 31 Thirdly, it is also necessary to note that the internet websites state, amongst the various objectives to be attained by the aforementioned breeders, ‘the recognition [of the breed] by the FCI’ (paragraph 3 of the contested decision, last internet website quoted, *in fine*).
- 32 Furthermore, it should be noted that it has already been held, firstly, that the examination of trade mark applications must not be minimal, but must be stringent and full, in order to prevent trade marks from being improperly registered and, for reasons of legal certainty and good administration, to ensure that trade marks whose use could be successfully challenged before the courts are not registered (see, by analogy, Case C-104/01 *Libertel* [2003] ECR I-3793, paragraph 58 and 59).
- 33 Secondly, in order for OHIM to refuse registration of a trade mark under Article 7(1)(c) of Regulation No 207/2009, it is not necessary that the signs and indications composing the trade mark at issue 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 (see, to that effect, Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 32).
- 34 In the present case, in order to apply the above case-law, it should be noted that two of the five extracts of the internet websites taken into consideration by the examiner, to which the Board of Appeal also refers, in its assessment of the perception of the term ‘continental’ by the relevant public, are websites with a ‘.ch’ domain name suffix, which target, firstly, the Swiss public. In so far as the Swiss confederation is not a member of the EU or of the European Economic Area (EEA), the relevance of that evidence must be assessed as part of the analysis of the descriptiveness of the trade mark applied for within the meaning of Article 7(1)(c) of Regulation No 207/2009.
- 35 In that regard, firstly, it is necessary to make clear that Regulation No 207/2009, whilst a ‘text with EEA relevance’, constitutes, in accordance with recital 2 thereof, an instrument for the promotion of a harmonious development of economic activities ‘throughout the Community’, inter alia through trade marks enabling the products and services of undertakings to be distinguished regardless of frontiers. That regulation provides a system for Community trade marks ‘to which uniform protection is given and which produce their effects throughout the entire area of the Community’.
- 36 Secondly, Article 7(2) of Regulation No 207/2009 sets out that ‘[p]aragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community’.
- 37 Thus, the potentially descriptive character of the trade mark applied for must be assessed in relation to the relevant public in the European Union, with those considerations relating to evidence from a country which is not a member thereof being relevant only in so far as they have a direct impact on their perception by the relevant public.
- 38 In those circumstances, the Court notes, firstly, that even EU consumers can access internet websites with a ‘.ch’ domain name suffix, referred to at paragraph 34 above, and thus, inter alia, during various searches made by means of search engines relating to breeds of dog or, more specifically, on ‘bulldogs’. Those websites cannot be considered to be irrelevant in the assessment of the understanding, by the relevant public, of the meaning of the word constituting the trade mark applied for.
- 39 Further, it should be noted that the suffix of three of the internet websites taken into consideration by the examiner and, thereafter, by the Board of Appeal, is ‘.de’ and targets in this way, therefore, the German public. An analysis of these three websites leads to the conclusion that they contain, substantially, all of the relevant references set out at paragraphs 29 to 31 above and, in particular, that they set out that the ‘continental bulldog’ breed was already recognised in Switzerland by the SKG,

about which it is also specified that it is a member of the FCI. In addition, the Board of Appeal refers also, at paragraph 20 of the contested decision, to an extract from the applicant's internet webpage with the domain name suffix '.eu', directed, inter alia, to all of the relevant public of the EU. This contains, in essence, detailed information on the particular characteristics of the dogs designated as 'continental bulldogs'.

- 40 Therefore, the Board of Appeal correctly found, in the context of a stringent and full examination of the application for registration in accordance with *Libertel*, paragraph 32 above, that, both in Germany and in the rest of the European Union, the term 'continental bulldog' could be used, as early as the date of the application for registration, at least by that part of the relevant public made up of professionals, such as dog breeders or pet shop owners, as the designation of a breed of dog recognised in Switzerland.
- 41 Account should be taken, in that regard, of the higher level of attention and of scientific and linguistic knowledge of that public; it must be regarded as being aware of new developments in the field of the recognition of new breeds of dog and of the procedures underway before the competent organisations. It should also be noted that the 'official' recognition of the breed of dog in Switzerland, to which the German and European internet websites at issue also referred, already took place in 2004, that is five years before the date of the application for registration of the Community trade mark. In addition, it should be noted that the internet websites, written in German and some also in English, on the basis of which the Board of Appeal reached its decision, always contain pictures of dogs belonging to the new breed of dog, displayed adjacent to the name of that breed, which facilitates the perception of the link between those dogs and the term 'continental bulldog'. It is therefore reasonable to consider that the information relating to the very existence of the 'continental bulldog' breed, and to that relating to the activities of breeders aiming for constant development of those dogs' breeding kennels, may have been largely disseminated in the professional environments at issue.
- 42 Therefore, the Court considers that the applicant's arguments, according to which the recognition of the new breed before the FCI was not a 'fait accompli' at the date of the application for registration of the Community trade mark, that it was not established that an application made, where applicable, for that purpose before that federation would necessarily result in its recognition and, finally, that, in any event, the process leading to the definitive recognition of a breed could take many years, cannot succeed. Aside from whether the breed at issue will be recognised by the FCI, the other evidence on which the Board of Appeal based its decision, inter alia the recognition by the SKG and the information relating to the description of the characteristics of 'continental bulldog[s]' emerging from the internet websites cited, constitute, in the present case, sufficient evidence to substantiate the finding that at least part of the relevant public perceives the term 'continental bulldog' as referring to a breed of dog (see paragraph 40 above).
- 43 Furthermore, it is appropriate to review the scope of the applicant's argument, according to which the breed of dog is referred to in any event by the whole of the above term and not only by the first word thereof, whilst taking account of settled case-law, according to which the assessment of the descriptiveness of a sign can only be carried out, firstly, in relation to the perception that the public concerned has thereof and, secondly, in relation to the goods and services concerned (see paragraph 16 above).
- 44 In that regard, it should be noted that, in the case where the trade mark applied for in the present case is registered, the relevant public would perceive it principally in circumstances where it designated either the goods 'live animals, i.e. dogs', or services relating to the 'keeping and breeding of dogs, i.e. puppies and animals for breeding'. In that context, for an informed professional public, made up of connoisseurs of the field at issue, who are used to the systems of recognition of dog breeds, the term 'continental' is directly and without further thought perceived as a reference to the 'continental bulldogs' breed, that is as a description of the goods and services at issue or of their characteristics. It must also be noted that even certain animal lovers would understand the word 'continental' in that

way, inter alia where they are looking for dog keeping services for their dogs of that same breed or where they have the intention of buying a 'bulldog'. As noted by the Board of Appeal at paragraph 35 of the contested decision, it is reasonable to consider that dog lovers or potential buyers generally know the dogs they wish to purchase.

- 45 Nor does the Court consider it proven, despite the applicant's assertions, that the relevant public would not understand, without an indication of 'type', which breed of dogs is at issue when confronted with terms such as 'Jack Russell Terrier', 'Airedale Terrier', 'Cocker Spaniel', or, in the present case, 'continental bulldog'. The above circumstances, in which the terms 'Jack Russell', 'Airedale', 'Cocker' or 'continental' are perceived, manifestly makes it easier for that public to establish a sufficiently direct link between those terms and the canine breeds at issue.
- 46 It should be further noted that, even though the word 'continental' has various meanings, such as those set out at paragraph 21 above, that fact cannot be considered as making it impossible or more difficult for the relevant public to make a link between one of the possible meanings of that word and the designation of the 'continental bulldog' breed at issue. In particular, since it emerges from the extracts of the internet websites cited in the contested decision that the new breed was thus named specifically in order to set itself apart from the well-known 'English bulldog' breed, at least part of the public made up of professionals, whose sound knowledge of the field at issue, as well as their linguistic knowledge, must be taken into account, could perceive the terminological conflict between 'continental' and 'English' and discern all the more easily a reference to the new breed of dog in the word constituting the trade mark for which registration is sought, which seeks to designate dogs and breeding or keeping services thereof. In those circumstances, the applicant's argument according to which the Board of Appeal did not correctly apply the hierarchy of concepts designating the animals, the species, their types and breeds or had put them in the same category, should also be rejected as irrelevant.
- 47 The applicant's assertion that the Board of Appeal erred in law in comparing the circumstances of the determination of a new name for a breed of dog on the one hand and the designation of a plant variety on the other cannot be upheld either; the applicant alleges inter alia that the system of recognition of dog breeds, in which breeders of 'continental bulldogs' participate or envisage participating, falls within the scope of acts of private associations without binding legal effect, in the absence of any system of protection or recognition laid down by the national or EU legislature.
- 48 Without it being necessary to make a finding on the possible comparisons which exist between the plant varieties' protection system and the present case, it is sufficient to note that it is apparent from the applicant's arguments and from the supporting documents relied on by the Board of Appeal in the contested decision that both national and international cynological federations, such as the SKG or the FCI, and the canine breeds recognised by those organisations are respected by many dog breeders, professional or amateur.
- 49 In that regard, firstly, the applicant itself refers in the application to many breeds of dog recognised by those organisations. Secondly, the internet websites on which the Board of Appeal relies in the contested decision make it possible, to the requisite legal standard, to note that 'continental bulldog' breeders granted definite importance to the recognition of that breed by the organisations cited, in so far as, firstly, they referred to the recognition by the SKG by designating it as 'official', secondly, they made clear that that organisation was a member of the FCI, thirdly, they invoked tests for reproductive aptitude completed before an "FCI" judge', that is Mr N., in order for a dog to be considered as emanating from the breed at issue, and, finally, they put forward the 'not inconsiderable' importance that FCI recognition of the breed of dog represented.
- 50 In the same way, the various references by the applicant to 'difficulties' related to the recognition procedure, by the FCI, of a breed having a sufficiently stable taxon, as well as the length of time which may elapse before an application to that end is successful should again be noted, as additional elements demonstrating that the procedures for the recognition of canine breeds by the cynological

federations are considered, by the relevant public, either as official, or as sufficiently officialised for their relevant public to grant real value thereto, which the Court cannot disregard in the context of the assessment of the descriptiveness of the trade mark applied for. Those references make apparent the importance granted to those procedures.

- 51 In those circumstances, it would be purely artificial to assess the effects of the recognition of a breed of dog by organisations such as the SKG or the FCI having regard only to potentially ‘binding’ legal effects attributed thereto by various national laws or EU law, as the applicant seems to suggest without, in fact, demonstrating, in the present case, the absence of those legal effects. On the contrary, it is for the Board of Appeal and, in the event of an appeal against its decision, for the Court, within the meaning of the case-law cited at paragraph 16 above, to assess what the actual perception is, by the relevant public, of the word ‘continental’, registration of which has been sought as a trade mark; that assessment requires an evaluation of all the relevant items in that regard, which may include taking into account situations where that perception is influenced by the fact that the relevant public takes account of circumstances or information even if unofficial, without taking into consideration their legal effects. In that regard, it should again be noted that, in particular in the voluntary sector or that of sports and hobbies, it is not unusual for some recognition to be granted to the actions of non-governmental organisations. In the present case, the items set out in the two paragraphs above, as well as at paragraph 26 above, are sufficient to show that the actions of the various cynological federations in question, such as those relating to the recognition of canine breeds, may have real effects on the perception of that sector by the relevant public.
- 52 Therefore, it must be accepted that, once the recognition process of a breed of dog by one or more of the above federations is completed, the name of that breed designates, in a generic manner, the dogs belonging to it, at least in the eyes of part of the relevant public.
- 53 In the light of the foregoing, and taking account of the decision in *OHIM v Wrigley*, paragraph 33 above, according to which it is enough for a word sign to designate a characteristic of the goods or services concerned in at least one of its potential meanings in order for it to be refused registration under Article 7(1)(c) of Regulation No 207/2009, the conclusion must be that the Board of Appeal did not err in finding that the trade mark applied for, comprising the word ‘continental’, is directly understood by the relevant public as a description of a breed of bulldogs or, in relation to the services targeted, as a specification in so far as it concerns dogs of that same breed.
- 54 The applicant’s other claims do nothing to invalidate that conclusion.
- 55 First of all, in the present case, the Court must dismiss as irrelevant, firstly, the applicant’s assertion that the legislature intended specifically to allow registered trade mark holders to protect for their benefit geographical indications, secondly, the applicant’s assertion that the legislature expressly provided that ‘live animals’ may enjoy the protection conferred by a trade mark and, thirdly, the applicant’s assertion that a registered trade mark protecting an animal cannot be used, in accordance with the [applicable] law, except to refer to the animals coming from the lineage which is the subject of that protection and that it had itself the intention of keeping its canine breeding kennel ‘closed’.
- 56 Firstly, it must be noted that Article 7(1)(c) of Regulation No 207/2009, read in combination with recital 7 of that regulation, specifically constitutes an exception laid down by the legislature to the objective pursued by the regulation, which is, having regard in particular to recitals 2, 3 and 8, to allow undertakings and other holders to distinguish their products and services through a Community trade mark and to ensure, inter alia, their origin.
- 57 Secondly, though it cannot be excluded, generally, that ‘live animals’ may actually, under certain conditions, be conferred protection by way of a Community trade mark, which OHIM does not deny, the fact remains that the question which is asked, in the present case, is only whether the Board of Appeal was correct in dismissing an application for registration relating to a term designating an

existing breed of dog. As has been assessed at paragraphs 20 to 53 above, in the specific circumstances of the present case, consisting, inter alia, in the breed of dogs at issue having already been recognised in Switzerland in 2004 and in that it emerges from the different internet websites cited in the contested decision that the ‘continental bulldog’ is presented to the relevant public as constituting a breed in its own right, the Board of Appeal did not err in finding that the word ‘continental’ was descriptive for the products and for the services at issue.

- 58 Thirdly, in relation to the applicant’s assertion, according to which its breeding kennel remains a ‘closed’ breeding kennel, which has as a consequence that only dogs with a pedigree proving that they come from that breeding kennel have the right to be designated by the Community trade mark once registered, it should be noted that it cannot outweigh the Board of Appeal’s finding that the breed of dogs at issue was recognised by the SKG, and that various internet websites referred to the dogs known as ‘continental bulldogs’ as dogs belonging to a new breed. Those elements make it possible, to the requisite legal standard, to conclude that at least part of the relevant public perceived a direct link between the above term and the breed of dog at issue, independently of the potentially ‘closed’ character of the applicant’s breeding kennel.
- 59 In addition, in so far as the decision to keep a breeding kennel ‘closed’ or to open it remains a decision for the breeders themselves, that situation is akin to that relating to particular marketing circumstances which, according to settled case-law, are not relevant in trade mark law, given that they may vary with time and in accordance with the will of the holders of those trade marks (see, by analogy, judgment of 23 September 2009 in Case T-99/06 *Phildar v OHIM – Commercial Jacinto Parera (FILDOR)*, not published in the ECR, paragraph 68 and the case-law cited).
- 60 Though that case-law was established in the context of proceedings relating to relative grounds for refusal, it is applicable, by analogy, in the context of absolute grounds for refusal. In that regard, it should be noted that the above case-law was established on the basis that the examination of the likelihood of confusion which the OHIM authorities are called on to carry out in the context of Article 8(1)(b) of Regulation No 207/2009 is ‘prospective’ and pursues an aim in the general interest, which is that the relevant public is not exposed to the risk of being misled as to the commercial origin of the goods in question. That examination cannot be dependent on the commercial intentions, whether carried out or not, and naturally subjective, of the trade mark proprietors (see, to that effect, Case T-147/03 *Devinlec v OHIM - T.I.M.E. ART (QUANTUM)* [2006] ECR II-11, paragraph 104).
- 61 The public interest pursued by Article 7(1)(c) of Regulation No 207/2009, requiring that indications or signs which are descriptive of the characteristics of the goods or services for which registration is sought may be used freely by all (see paragraph 13 above), also give rise to a prospective examination, relating to the descriptiveness of the indications or of the signs for which registration as a trade mark has been sought, as emerges from *OHIM v Wrigley*, paragraph 33 above. It must be noted that that examination likewise cannot depend on commercial intentions, by their nature subjective, of the trade mark applicants, such as the applicant’s intention to keep its breeding kennel ‘closed’.
- 62 In that same context, the applicant’s assertion according to which, even if there is a requirement that the term ‘continental’ be available, all are free to use the term in order to designate a dog as a ‘continental bulldog’, provided that the dog actually belongs to that breed, that is, provided that it is a dog with a pedigree proving that it comes from the ‘closed’ breeding kennel at issue, must be dismissed as unfounded. The fact remains that registration of the trade mark applied for would allow the applicant, even though the breed of dog in question is recognised by one or more competent organisations, to enjoy the exclusive rights conferred by Regulation No 207/2009 and inter alia its Article 9 et seq., which may be relied on against third parties who are contemplating using, in the absence of the applicant’s consent, that Community trade mark in business.

- 63 Secondly, the applicant's argument that any use before registration of a sign for which registration as a Community trade mark is sought cannot be used to refuse that registration, nor support a finding, inter alia having regard to the future, that that sign is descriptive, must also be dismissed. The assessment of the effect that certain elements prior to the application for registration as a trade mark can have, whether prior national registrations or other elements, on the assessment of the registrable character of the trade mark applied for in relation to the grounds of Article 7 of Regulation No 207/2009 depends on the actual circumstances of the case (see, by analogy, judgment of 23 October 2008 in Case T-158/06 *Adobe v OHIM (FLEX)*, not published in the ECR, paragraph 52 and the case-law cited). In the present case, contrary to the applicant's assertion, the Board of Appeal has not applied a new absolute ground for refusal of registration, not provided for by Community trade mark law, but has merely taken into consideration all relevant items in order to evaluate what the perception of the sign at issue was by the relevant public at the date of the application for registration.
- 64 Thirdly, in relation to the applicant's assertion, according to which it was not trying to register a trade mark for the protection of an existing breed, it is sufficient to refer to paragraphs 40 and 41 above, where it has already been noted that, as early as the date of the application for registration, some of the relevant consumers perceived the term 'continental bulldog' and, accordingly, the term 'continental' used in the context of the goods and services at issue, as a reference to the new breed of dogs.
- 65 Finally, fourthly, in relation to the applicant's assertion according to which OHIM had followed, in the past, a different registration practice and, inter alia, already registered a Community trade mark in relation to the breed of dog 'Elo', it must be observed that, admittedly, OHIM is under a duty to exercise its powers in accordance with the general principles of EU law, such as the principle of equal treatment and the principle of sound administration. In the light of those two principles, OHIM must, when examining an application for registration of a Community trade mark, take into account the decisions already taken in respect of similar applications and consider with especial care whether it should decide in the same way or not (Case C-51/10 P *Agencja Wydawnicza Technopol v OHIM* [2011] ECR I-1541, paragraphs 73 and 74).
- 66 That said, the way in which the principles of equal treatment and sound administration are applied must be consistent with respect for legality. Therefore, for reasons of legal certainty and of sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. That examination must be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the present case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (see *Agencja Wydawnicza Technopol v OHIM*, paragraph 65 above, paragraphs 75 and 77 and the case-law cited).
- 67 Contrary to what has occurred in the present case, it has not been proved that in the case cited by the applicant, the 'Elo' breed was recognised by the SKG or by a comparable cynological association, nor that relevant consumers were made aware of it as a new breed of dog in its own right. In the circumstances, the applicant cannot rely on the above prior decision of OHIM, relating, indeed, to an application for a different trade mark, in order to show the illegality of the contested decision.
- 68 The Court must also dismiss as irrelevant the references made by the applicant to other trade marks containing the word 'continental' or constituted of that single word, extracts of which were presented in the annex to the application, especially in so far as they concern other goods and services than those at issue in the present case, or, in some cases, are figurative and thus not comparable to the present case.

69 Having regard to all of the above, the conclusion must be that the Board of Appeal did not err in finding that the word ‘continental’ was descriptive of the goods and services at issue, within the meaning of Article 7(1)(c) of Regulation No 207/2009.

70 The first plea must therefore be dismissed as unfounded.

The second plea

71 Since Article 7(1) of Regulation No 207/2009 makes it clear 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 as a Community trade mark (see judgment of 28 June 2011 in Case T-487/09 *ReValue Immobilienberatung v OHIM (ReValue)*, not published in the ECR, paragraph 80 and the case-law cited), it is no longer necessary to consider, in the present case, the second plea raised by the applicant alleging breach of Article 7(1)(b) of that regulation.

72 Moreover, according to settled case-law, a trade mark which is descriptive of the characteristics of goods or services for the purposes of Article 7(1)(c) of Regulation No 207/2009 is, on that account, necessarily devoid of any distinctive character in relation to those goods or services within the meaning of Article 7(1)(b) of that regulation (see *ReValue*, paragraph 71 above, paragraph 81 and the case-law cited).

73 In the circumstances, the second plea in law, alleging violation of Article 7(1)(b) of Regulation No 207/2009, must in any event be dismissed.

74 The action must therefore be dismissed in its entirety.

Costs

75 Under Article 87(2) of the Rules of Procedure of the General Court, 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 applicant has been unsuccessful, it must be ordered to pay the costs of these proceedings, in accordance with the form of order sought by OHIM.

On those grounds,

THE GENERAL COURT (Second Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Continental Bulldog Club Deutschland eV to pay the costs.**

Forwood

Dehousse

Szwarcz

Delivered in open court in Luxembourg on 17 April 2013.

[Signatures]