

JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber,
Extended Composition)

20 March 2002 *

In Case T-355/00,

DaimlerChrysler AG, established in Stuttgart (Germany), represented by
S. Völker, lawyer,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs)
(OHIM), represented by A. von Mühlendahl and D. Schennen, acting as Agents,

defendant,

ACTION brought against the decision of the Third Board of Appeal of the Office
for Harmonisation in the Internal Market (Trade Marks and Designs) of
12 September 2000 (Case R 142/2000-3) relating to registration of 'TELE AID'
as a Community trade mark,

* Language of the case: German.

THE COURT OF FIRST INSTANCE
OF THE EUROPEAN COMMUNITIES (Second Chamber, Extended Com-
position),

composed of: R.M. Moura Ramos, President, V. Tiili, J. Pirrung, P. Mengozzi
and A.W.H. Meij, Judges,
Registrar: H. Jung,

having regard to the application lodged at the Registry of the Court of First
Instance on 24 November 2000,

having regard to the response lodged at the Registry of the Court of First Instance
on 23 February 2001,

further to the hearing on 21 November 2001,

gives the following

Judgment

Background to the dispute

- 1 On 18 February 1997 Mercedes-Benz AG filed an application for a Community word mark at the Office for Harmonisation in the Internal Market (Trade Marks

and Designs) (hereinafter 'the Office') 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 was the term 'TELE AID'.

- 3 The goods and services in respect of which registration of the trade mark was sought were in Classes 9, 12, 37, 38, 39 and 42 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 in each case to the following descriptions:

Class 9: 'Electrical and electronic devices for transferring speech and data; stationary and mobile transmission, relay and audio receivers and devices; data processing equipment and parts therefor; navigation devices; car emergency telephone systems.'

Class 12: 'Automobiles and parts therefor.'

Class 37: 'Repair services for automobiles; vehicle repair.'

Class 38: 'Operation of a communications network; mobilising and coordination of accident and rescue services.'

Class 39: ‘Towing and rescue services.’

Class 42: ‘Computing services for determining vehicle location; collection, storage, processing and output of information.’

- 4 In January 1999, the transfer of the application to the applicant was recorded in the application file pursuant to Articles 17 and 24 of Regulation No 40/94 and Rule 31(8) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1).

- 5 By decision of 9 December 1999 the examiner refused the application under Article 38 of Regulation No 40/94 on the ground that the word ‘TELE AID’ was devoid of any distinctive character and descriptive of the goods and services in question within the meaning of Article 7(1)(b) and (c) of Regulation No 40/94.

- 6 On 2 February 2000 the applicant filed an appeal against the examiner’s decision at the Office under Article 59 of Regulation No 40/94.

- 7 By decision of 12 September 2000 (hereinafter ‘the contested decision’), the Third Board of Appeal annulled the examiner’s decision in so far as it refused the application in respect of the goods in Class 12 and dismissed the appeal in respect of the other classes mentioned in the application on the ground that the term in question fell within Article 7(1)(b) and (c) of Regulation No 40/94.

Forms of order sought

8 The applicant claims that the Court should:

— annul the contested decision;

— order the Office to pay the costs.

9 The Office contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

10 The applicant relies on two pleas in law, alleging infringement of Article 7(1)(c) and of Article 7(1)(b) of Regulation No 40/94.

Infringement of Article 7(1)(c) of Regulation No 40/94

Arguments of the parties

- 11 The applicant argues that, for the purposes of the absolute grounds for refusal, a mark must be assessed as a whole and in the form applied for. In this case, however, even broken down into its two constituent parts, the term 'TELE AID' does not, in the applicant's view, constitute a descriptive indication of the goods and services concerned.

- 12 As regards the component 'tele', the applicant argues that it is neither a word on its own nor an abbreviation but two syllables used in common parlance as part of many different words. 'Tele' does not, in the applicant's submission, have the same meaning in all the combinations in which it is used, or even approximately the same meaning. In that connection the applicant cites words where 'tele' is used to denote the concept of distance, as in 'telephone' or 'telescope', those where it denotes purpose or goal ('telos' in Greek), such as 'teleology', and those where it denotes neither, such as the name of a composer (Telemann) or an area of Norway (Telemark).

- 13 Furthermore, the applicant claims, 'tele' is frequently used in the most diverse combinations as part of a trade mark, and the public is therefore accustomed to trade marks containing it. In that connection the applicant cites, *inter alia*, the trade marks TELE-ATLAS, TELE-PAGE and TELE-CARD. It therefore claims that 'tele' is not directly descriptive of the goods or services concerned.

- 14 As regards the component 'aid', the applicant states that this is frequently used in the most diverse combinations as part of a trade mark, and that the public is therefore accustomed to trade marks containing this word. In that regard the applicant refers to the German trade marks AID and BIKEAID and the Community trade marks MICROAID and FIRST AID.

- 15 Similarly, it argues that the word 'aid' is not specifically and immediately descriptive of the goods or services concerned in that it at most suggests merely the vague, uncertain and ambiguous notion of something or someone helping, assisting or supporting, or being helped or assisted.

- 16 As regards the term 'TELE AID' taken as a whole, the applicant claims that it is a neologism not found in current dictionaries of any Community language, including English, nor is it used as such in either common or technical parlance.

- 17 Furthermore, the applicant claims that 'TELE AID' does not have a clear, specific meaning but simply suggests vague, abstract notions of aid, assistance, an assistant or means of help operating or working 'remotely' or at a distance or aid provided in a way that enables distance to be surmounted.

- 18 As regards the relationship between 'TELE AID' taken as a whole and the goods and services concerned, the applicant submits that, contrary to what is stated at paragraph 20 et seq. of the contested decision, the term does not constitute a sufficiently specific descriptive indication of the intended use or quality of such goods or services.

- 19 The applicant argues that the need to maintain a sign's availability is an inherent limitation on the absolute grounds for refusal. Accordingly, in the applicant's view, even descriptive signs are non-registrable only in so far as their monopolisation stands in the way of the legitimate need of third parties, especially competitors, to be able to use them freely. There is no necessity for the term in question to remain available because it does not describe the goods or services concerned, nor is it required, or indispensable, in order to describe them. It cannot be regarded as necessary for a sign to remain available merely on the basis that the sign evokes vague associations.
- 20 Finally, the applicant submits that it would accord with the practice followed by the Boards of Appeal in their decisions for the sign to be registered. In that connection it relies on decisions of the Boards of Appeal accepting the following word marks for registration: NETMEETING, CareService, Schülerhilfe, GLOBAL CARE, MEGATOURS, SAFETYTECH, STEAM TERMINAL, ProBank, FIXIT, TOP-LOK, helpLine, HYPERLITE, Tensiontech, SAFEJAW, SURESEAL, FOILGUARD, OMNICARE, ZONEMESSAGE, BIDWATCH, Oilgear and TELESCAN.
- 21 The Office disputes the applicant's arguments and claims that 'TELE AID' is descriptive of the goods and services in question as a whole.
- 22 More particularly, the Office stated at the hearing that the descriptiveness of 'TELE AID' must be assessed, in regard to the categories of goods and services listed in the application for registration, by reference to the marketing concept which the applicant is contemplating or has used.

Findings of the Court

- 23 Article 7(1)(c) of Regulation No 40/94 provides that ‘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’ are not to be registered. Furthermore, Article 7(2) of Regulation No 40/94 provides that ‘paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community’.
- 24 Article 7(1)(c) of Regulation No 40/94 prohibits the signs and indications therein referred to from being reserved to one undertaking alone because they have been registered as trade marks. That provision therefore pursues an aim which is in the public interest, namely that descriptive signs or indications may be freely used by all (see, by analogy, Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 25).
- 25 In that context, 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 intended public to designate, either directly or by reference to one of their essential characteristics, the goods or services in respect of which registration is sought (Case C-383/99 P *Procter and Gamble v OHIM* [2001] ECR I-6251, paragraph 39). Accordingly, a sign’s descriptiveness can only be assessed by reference to the goods or services concerned and to the way in which it is understood by a specific intended public.
- 26 In this case the Board of Appeal found at paragraph 23 of the contested decision that the goods and services concerned are aimed at the average consumer in general, which the applicant did not deny. Average consumers must be deemed to

be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26, and Case T- 359/99 *DKV v OHIM (EuroHealth)* [2001] ECR II-1645, paragraph 27). Moreover, since the sign is composed of English words, the relevant public is English-speaking.

- 27 As regards the applicant's argument that third parties, and more particularly its competitors, do not need to use the sign at issue to designate the goods and services listed in the application, it must be observed that the Court found at paragraph 35 of the judgment in *Windsurfing Chiemsee* (cited above) that Article 3(1)(c) of Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), the wording of which is essentially the same as that of Article 7(1)(c) of Regulation No 40/94, does not depend on there being a real, current or serious need to leave a sign free.
- 28 Accordingly, as the Office has rightly pointed out, for the purposes of Article 7(1)(c) of Regulation No 40/94 it is necessary only to consider, on the basis of a given meaning of the sign in question, whether, from the point of view of the intended public, there is a sufficiently direct and specific association between the sign and the categories of goods and services in respect of which registration is sought.
- 29 A preliminary observation is that 'TELE AID' is composed of a substantive noun (aid) and a prefix (tele). There is therefore nothing unusual about the structure of the term. It does not diverge from English word composition rules but rather complies with them.
- 30 As regards the meaning of 'TELE AID', it is clear from paragraph 19 of the contested decision and from the explanations given by the Office in its reply and

at the hearing that the Office considers it to mean 'remote assistance'. In that connection the applicant's allegation that it does not have a clear and specific meaning is irrelevant. Taking account of the goods and services in respect of which registration is sought, the meaning adopted by the Board of Appeal is the right one. It must be observed that, in order to come within Article 7(1)(c) of Regulation No 40/94, it is sufficient that at least one of the possible meanings of a word sign identifies a feature of the goods or services concerned.

31 As to how the term 'TELE AID' and the goods and services are connected, the Board of Appeal found at paragraph 21 of the contested decision that the term designates the quality and intended use of those goods and services.

32 First of all the question arises whether the term 'TELE AID' is descriptive in relation to the categories of service listed as 'Repair services for automobiles; vehicle repair' within Class 37, 'Mobilising and coordination of accident and rescue services' within Class 38, 'Towing and rescue services' within Class 39 and 'Computing services for determining vehicle location' within Class 42.

33 As regards the services in the categories listed at paragraph 32 above, the term 'TELE AID', taken as a whole, must be deemed to be capable of designating both the kind and the quality of those services. They represent specific forms of aid. Furthermore, the fact that the aid is provided at a distance must be considered to be a quality of the services that the class of persons targeted is liable to take into account when making a choice and accordingly constitutes an essential characteristic thereof. Therefore there is a sufficiently direct and concrete association between the term 'TELE AID' and those services, from the point of view of the class of persons targeted.

- 34 Furthermore, the categories of service listed at paragraph 32 could undoubtedly also include services provided in situations not involving any distance, so that the term ‘TELE AID’ is not descriptive of all the services falling within those categories. In that regard it must be observed that the applicant has requested registration of the term ‘TELE AID’ for all those services together without distinction. Accordingly, the finding of the Board of Appeal to the effect that the application for registration relates to all those categories of service taken together must be upheld (see, to that effect, *EuroHealth*, cited above, paragraph 33).
- 35 Secondly, as to the category of goods described as ‘Car emergency telephone systems’ within Class 9, the intended use of those goods must be considered to coincide partially with the description of that category in that it expressly refers to emergency call systems. Goods that enable emergency calls to be made may serve to enable the services that provide assistance to be summoned from a distance. To that extent the intended use of those goods is for remote assistance. Accordingly, from the point of view of the relevant class of persons, there is a sufficiently direct and concrete association between the term ‘TELE AID’ and goods within the category mentioned above.
- 36 As regards the applicant’s argument relating to findings of registrability in regard to other trade marks by the Boards of Appeal, it is correct that the factual or legal grounds of earlier decisions of the Boards of Appeal may be used as arguments in support of a plea of infringement of a provision of Regulation No 40/94. None the less the Court finds that in this case the applicant has not advanced any grounds from decisions in other trade mark cases capable of calling into question the findings made above. Furthermore, the Office correctly points out that the trade mark ‘TELESCAN’, as the only mark with any aspect in common with the term ‘TELE AID’, was registered for services completely different from those at issue here, namely investments and financial services.
- 37 It follows that the term ‘TELE AID’ may, from the point of view of the intended public, serve to designate the essential characteristics of the goods and services in

the categories listed at paragraphs 32 and 35 above, within the meaning of Article 7(1)(c) of Regulation No 40/94.

- 38 Thirdly, it is necessary to consider whether 'TELE AID' is descriptive in relation to the categories of goods listed as: 'Electrical and electronic devices for transferring speech and data; stationary and mobile transmission, relay and audio receivers and devices; data processing equipment and parts therefor; navigation devices' within Class 9, and the categories of service listed as: 'Operation of a communications network' within Class 38 and 'Collection, storage, processing and output of information' in Class 42.
- 39 As regards more particularly the goods and services in the categories listed at paragraph 38 above, the Office has not adequately shown that the term 'TELE AID' may serve to indicate their intended purpose. Remote assistance, even if it requires or involves the use of those goods and services, represents at most one of many possible areas of use thereof, not a technical function. That does not suffice to conclude that there is a sufficiently direct and concrete association between the term 'TELE AID' and those goods and services from the point of view of the relevant class of persons.
- 40 It is true that the Court of First Instance held at paragraph 33 of its judgment in *EuroHealth* that the fact that a word is descriptive in relation to part only of the goods or services within a category listed as such in the application for registration does not preclude that word being refused registration where the applicant does not confine his application to the goods and services in respect of which the mark is not descriptive. But the position in this case differs from that in *EuroHealth*. 'TELE AID' is not descriptive in relation to any part of the category of goods or services mentioned at paragraph 38 above.

- 41 In addition, the Office argued at the hearing that it is apparent from the applicant's statements that it markets or intends to market the goods and services listed at paragraph 38 above as part of a system for organising remote assistance for purchasers of vehicles manufactured by it, including, as well as those goods and services, the goods and services listed at paragraphs 32 and 35 hereof. The Office concludes that the descriptiveness of the term 'TELE AID' must be assessed, in respect of all the categories of goods and services listed in the application for registration, by reference to the way in which the applicant intends to market or is marketing them.
- 42 However, contrary to what the Office argues, the Court finds that the descriptiveness of a word sign must be assessed individually by reference to each of the categories of goods and/or services listed in the application for registration. For the purposes of assessing the descriptiveness of a word sign in respect of a particular category of goods and/or services, whether the applicant for the trade mark in question is contemplating using or is actually using a particular marketing concept involving goods and/or services in other categories in addition to the goods and/or services within that category is immaterial. Whether or not there is a marketing concept is of no consequence to the right conferred by the Community trade mark. Furthermore, since a marketing concept is purely a matter of choice for the undertaking concerned, it may change after a sign has been registered as a Community trade mark and it cannot therefore have any bearing on the assessment of the sign's registrability.
- 43 In addition it does not appear that the term 'TELE AID' may serve to designate either the quality or any other essential characteristic of the goods and services within the categories listed at paragraph 38 above.
- 44 It follows that the term 'TELE AID' cannot serve, for the purposes of Article 7(1)(c) of Regulation No 40/94, to designate one of the essential characteristics of the goods and services falling within the categories listed in paragraph 38 above from the point of view of the intended public.

- 45 It follows from all of the foregoing that the allegation of infringement of Article 7(1)(c) of Regulation No 40/94 must be upheld as regards the categories of goods and services listed in paragraph 38 above and dismissed as regards the other categories of goods and services listed in paragraphs 32 and 35 above.

Infringement of Article 7(1)(b) of Regulation No 40/94

Arguments of the parties

- 46 The applicant claims that the words ‘devoid of any distinctive character’ in Article 7(1)(b) of Regulation No 40/94 imply that any degree of distinctiveness, however slight, suffices to justify registration of a sign as a trade mark and that one must not take too strict an approach when assessing distinctiveness.
- 47 The applicant claims that, as a neologism without any clear meaning, the term ‘TELE AID’ has a creative aspect to it as well as a minimum degree of fantasy, giving it the minimum level of distinctiveness required.
- 48 In addition, the applicant relies on findings of registrability made by the Boards of Appeal in relation to other trade marks (see paragraph 21, above).

- 49 The Office contends that since ‘TELE AID’ is composed only of descriptive indications of the goods and services concerned, to the exclusion of any other ingredient liable to render the term as a whole capable of distinguishing the applicant’s goods from those of other undertakings, it is devoid of any distinctive character. In that regard the Office argues that the intended consumers understand the term not as a reference to a particular undertaking but simply as a general reference to the fact that they may obtain remote assistance.

Findings of the Court

- 50 Article 7(1)(b) of Regulation No 40/94 provides that ‘trade marks which are devoid of any distinctive character’ are not to be registered. In addition Article 7(2) of Regulation No 40/94 provides that ‘paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community’.
- 51 Furthermore, a sign’s distinctiveness can be assessed only by reference first to the goods and services in respect of which registration is sought and secondly to the understanding which the relevant public has of that sign.
- 52 In this case, in so far as the contested decision relates to the goods and services in regard to which ‘TELE AID’ has been held to be descriptive in paragraph 37 of this judgment, it must be recalled that it is settled case-law that for a sign to be ineligible for registration as a Community trade mark, it is sufficient that one of the absolute grounds of refusal applies (Case T-345/99 *Harbinger v OHIM (TRUSTEDLINK)* [2000] ECR II-3525, paragraph 31, Case T-360/99 *Community Concepts v OHIM (Investorworld)* [2000] ECR II-3545, paragraph 26, and Case T-24/00 *Sunrider v OHIM (VITALITE)* [2001] ECR II-449, paragraph 28). To that extent this plea is therefore invalid.

- 53 The plea must none the less be considered in so far as the contested decision relates to the categories of goods and services listed in paragraph 38 above.
- 54 According to paragraph 25 of the contested decision, the Board of Appeal considered that the word mark in question was 'devoid of the minimum level of distinctiveness required since the intended public will understand it purely as an indication of the subject-matter of the services or intended purpose of the goods'. The Board of Appeal therefore inferred, in substance, that 'TELE AID' was not distinctive because of its descriptive character. However, the Court has held in paragraph 44, above, that as regards the categories of goods and services listed in paragraph 38 above registration of the sign 'TELE AID' cannot be refused on the basis of Article 7(1)(c) of Regulation No 40/94. Consequently, the reasoning of the Board of Appeal in relation to Article 7(1)(b) of Regulation No 40/94 must be rejected, since it is based on that error.
- 55 In addition it must be observed that there is nothing in the contested decision or the Office's response or the explanations it provided at the hearing to demonstrate that 'TELE AID' is not distinctive for the goods and services in the categories listed in paragraph 38 above.
- 56 The plea of infringement of Article 7(1)(b) of Regulation No 40/94 must accordingly be upheld as regards the categories of goods and services listed in paragraph 38 above and dismissed as regards the other categories of goods and services listed in paragraphs 32 and 35 above.
- 57 It follows from all of the foregoing that the action must be upheld as regards the categories of goods and services referred to in paragraph 38 above and dismissed as regards the rest.

Costs

- 58 Under Article 87(3) of the Rules of Procedure, the Court of First Instance may order that the costs be shared if each party succeeds on some and fails on other heads. In the present case, since the application has been granted only in respect of a limited number of goods and services, the applicant must be ordered to bear its own costs and to pay one half of the Office's costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber, Extended Composition)

hereby:

1. Annuls the decision of the Third Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 12 September 2000 (Case R 142/2000-3) as regards the following categories of goods and services:

— 'electrical and electronic devices for transferring speech and data; stationary and mobile transmission, relay and audio receivers and devices;

data processing equipment and parts therefor; navigation devices' within Class 9;

— 'operation of a communications network' within Class 38;

— 'collection, storage, processing and output of information' within Class 42;

2. As to the remainder, dismisses the action;
3. Orders the applicant to pay its own costs and one half of the defendant's costs; the defendant is to pay the other half of its own costs.

Moura Ramos

Tiili

Pirrung

Mengozzi

Meij

Delivered in open court in Luxembourg on 20 March 2002.

H. Jung

R.M. Moura Ramos

Registrar

President