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JUDGMENT OF THE COURT

23 October 2003 [\(1\)](#)

(Appeal - Community trade mark - Regulation (EC) No 40/94 - Absolute ground for refusal to register - Distinctive character - Marks consisting exclusively of descriptive signs or indications - DOUBLEMINT)

In Case C-191/01 P,

Office for Harmonisation in the Internal Market (Trade Marks and Designs), represented by V. Melgar and S. Laitinen, acting as Agents, with an address for service in Luxembourg,

appellant,

supported by

Federal Republic of Germany, represented by A. Dittrich and B. Muttelsee-Schön, acting as Agents, with an address for service in Luxembourg,

and by

United Kingdom of Great Britain and Northern Ireland, represented by J.E. Collins, acting as Agent, assisted by D. Alexander, Barrister, with an address for service in Luxembourg,

interveners in the appeal,

APPEAL against the judgment of the Court of First Instance of the European Communities (Second Chamber) of 31 January 2001 in Case T-193/99 *Wrigleyv OHIM(DOUBLEMINT)* [2001] ECR II-417, seeking to have that judgment set aside, in which the Court of First Instance annulled the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 16 June 1999 (Case R 216/1998-1) dismissing the appeal brought by Wm. Wrigley Jr. Company against the refusal to register the word DOUBLEMINT as a Community trade mark,

the other party to the proceedings being:

Wm. Wrigley Jr. Company, established in Chicago, Illinois (United States of America), represented by M. Kinkeldey, Rechtsanwalt, with an address for service in Luxembourg,

applicant at first instance,

THE COURT,

composed of: V. Skouris, President, P. Jann, C.W.A. Timmermans, C. Gulmann, J.N. Cunha Rodrigues and A. Rosas (Presidents of Chambers), D.A.O. Edward, A. La Pergola, J.-P. Puissochet (Rapporteur), R. Schintgen, F. Macken, N. Colneric and S. von Bahr, Judges,

Advocate General: F.G. Jacobs,

Registrar: H. von Holstein, Deputy Registrar,

having regard to the Report for the Hearing,

after hearing oral argument from the parties at the hearing on 21 January 2003, at which the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) was represented by A. von Mühlendahl, acting as Agent, and V. Melgar, and Wm. Wrigley Jr. Company by M. Kinkeldey,

after hearing the Opinion of the Advocate General at the sitting on 10 April 2003,

gives the following

Judgment

1.

By an application lodged at the Registry of the Court on 17 April 2001, the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (hereinafter OHIM) brought an appeal under Article 49 of the EC Statute of the Court of Justice against the judgment of the Court of First Instance of 31 January 2001 in Case T-193/99 *Wrigley v OHIM (DOUBLEMINT)* [2001] ECR II-417 (hereinafter the contested judgment), in which the Court of First Instance annulled the decision of the First Board of Appeal of OHIM of 16 June 1999 (Case R 216/1998-1) (hereinafter the contested decision) dismissing the appeal lodged by Wm. Wrigley Jr. Company (hereinafter Wrigley) against the refusal to register the word DOUBLEMINT as a Community trade mark for various classes of goods including in particular chewing gum.

Regulation (EC) No 40/94

2.

Article 4 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) provides as follows:

A Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

3.

Article 7 of that Regulation provides as follows:

1. The following shall not be registered:

(a) signs which do not conform to the requirements of Article 4;

(b) trade marks which are devoid of any distinctive character;

(c) 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;

...

2. Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community.

3. Paragraph 1(b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it.

4.

Article 12 of Regulation No 40/94 provides:

A Community trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade:

...

(b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;

...

provided he uses them in accordance with honest practices in industrial or commercial matters.

Facts of the case

5.

On 29 March 1996 Wrigley applied to OHIM for registration as a Community trade mark of the word DOUBLEMINT for goods within, inter alia, Classes 3, 5 and 30 of the Nice Agreement concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 17 June 1957, as revised and amended, in particular chewing gum.

6.

The examiner at OHIM rejected that application by decision of 13 October 1998, following which Wrigley brought an appeal before OHIM.

7.

By the contested decision, the First Board of Appeal of OHIM dismissed the appeal on the ground that the word DOUBLEMINT, a combination of two English words with no additional fanciful or imaginative element, was descriptive of certain characteristics of the goods in question, namely their mint-based composition and their mint flavour, and that it could therefore not be registered as a Community trade mark by virtue of Article 7(1)(c) of Regulation No 40/94.

Procedure before the Court of First Instance and the contested judgment

8.

By an application lodged at the Registry of the Court of First Instance on 1 September 1999, Wrigley brought an action for annulment of the contested decision. The Court of First Instance upheld that action.

9.

After citing, at paragraph 19 of the contested judgment, Article 7(1)(c) of Regulation No

40/94, the Court of First Instance found, at paragraph 20 of the judgment, that by that provision the Community legislature intended to prevent the registration of signs which, owing to their purely descriptive nature, are incapable of distinguishing the goods of one undertaking from those of another but that signs or indications whose meaning goes beyond the exclusively descriptive are, by contrast, registrable as Community trade marks.

10.

Secondly, the Court of First Instance held, at paragraphs 23 to 28 of the contested judgment, that the word DOUBLEMINT was not exclusively descriptive in this case. It found that the adjective double was unusual when compared with other English words such as much, strong, extra, best or finest and that, when combined with the word mint, it had two distinct meanings for the potential consumer: twice the usual amount of mint or flavoured with two varieties of mint. Furthermore, it found that mint is a generic term which includes spearmint, peppermint and other culinary herbs, and that there are several possible ways of combining two sorts of mint and, in addition, various strengths of flavour are possible in the case of each combination.

11.

Thirdly, the Court of First Instance found, at paragraph 29 of the contested decision, that the numerous meanings of DOUBLEMINT are immediately apparent, at least by association or by allusion, to an average English-speaking consumer and thus deprive that sign of any descriptive function, for the purposes of Article 7(1)(c) of Regulation No 40/94, whereas for a consumer who does not have a sufficient mastery of the English language, the word will, by its very nature, have a vague and fanciful meaning.

12.

The Court of First Instance therefore concluded, at paragraph 30 of the contested judgment, that the word DOUBLEMINT, when applied to the goods referred to in the application for registration, had an ambiguous and suggestive meaning which was open to various interpretations and did not enable the public concerned immediately and without further reflection to detect the description of a characteristic of the goods in question. Since it was not exclusively descriptive, the term could not, according to the Court of First Instance, be refused registration. The Court of First Instance accordingly annulled the contested decision.

The appeal

13.

OHIM claims that the Court should set aside the contested judgment and order Wrigley to pay the costs.

14.

Wrigley contends that the Court should dismiss the appeal and order OHIM to pay the costs.

15.

By order of the President of the Court of 17 October 2001, the Federal Republic of Germany and the United Kingdom of Great Britain and Northern Ireland were granted leave to intervene in support of OHIM.

Arguments of the parties

16.

OHIM contends that the Court of First Instance erred in law in finding that a word such as DOUBLEMINT had to be exclusively descriptive to be excluded from registration as a

Community trade mark under Article 7(1)(c) of Regulation No 40/94.

17.

OHIM observes at the outset that a less rigorous approach to interpreting the absolute grounds for refusal in Article 7 of Regulation No 40/94 would have the effect of considerably increasing the number of applications for signs which have more than one meaning and which, by reason of their descriptiveness, should never be endowed with the protection conferred by registration as a trade mark.

18.

Next, OHIM points out that an interpretation of the absolute ground for refusal to register based on a sign's descriptiveness must take account of the other two absolute grounds for refusal in Article 7(1)(b) and (d) of Regulation No 40/94 relating to a sign's lack of distinctive character and to its customary usage.

19.

In particular, the general exclusion from registration as Community trade marks of signs which are devoid of distinctive character, as set out in Article 7(1)(b) of Regulation No 40/94, is separate from the grounds for refusal in Article 7(1)(a) and 7(1)(c). Wholly descriptive signs are, by their very nature, deemed incapable of distinguishing the goods of one undertaking from those of another. There can be no legal monopoly for words which are incapable of fulfilling the function of a trade mark, unless they have acquired distinctiveness in consequence of the use made of them, pursuant to Article 7(3) of Regulation No 40/94.

20.

Finally, OHIM contends, contrary to the finding of the Court of First Instance in the contested judgment, that a word such as DOUBLEMINT does not cease to be descriptive simply because it can have several meanings and is therefore ambiguous. In the mind of the average consumer, DOUBLEMINT is spontaneously associated with certain potential characteristics of the goods in question, namely their mint-based composition and their mint flavour, so that the word is necessarily descriptive and cannot therefore be registered as a Community trade mark.

21.

Wrigley, on the other hand, takes the view that Article 7(1)(c) of Regulation No 40/94 does not preclude registration of a word such as DOUBLEMINT, consisting of elements each of which by itself is descriptive, where that word, taken as a whole, is an unusual combination of those elements and is not, in ordinary language and in the mind of the average consumer, as such clearly and unambiguously purely descriptive of certain characteristics of the goods concerned.

22.

According to Wrigley, the grammatical structure of the word DOUBLEMINT is unusual and elliptical and nobody would describe the characteristics of chewing gum by saying that it has a doublemint flavour. In addition, the word DOUBLEMINT has many possible meanings, which precludes consumers from remembering one of them in particular, and this gives the sign an ambiguous and suggestive meaning.

23.

Wrigley adds that OHIM's objective of ensuring that terms which are wholly descriptive remain freely available for use by competitors can apply only to signs in respect of which there is a reasonably clear and foreseeable need for competitors to use a particular term to describe certain characteristics of their goods. That is not the case in relation to the word

DOUBLEMINT, which, since its registration almost a century ago with the United States Patent and Trademark Office, that is to say in an English-speaking country, has not been used by the public or by competitors in a descriptive way. Wrigley also points out that OHIM's Boards of Appeal have already accepted composite words for registration such as, for example, Alltravel and Megatours for travel services, Transeuropea for transport services and Oilgear for hydraulic machinery.

24.

In its observations, Wrigley claims that the word DOUBLEMINT wholly satisfies the conditions laid down by the Court of Justice in Case C-383/99 P *Procter & Gamble v OHIM* [2001] ECR I-6251 relating to the BABY-DRY trade mark for a word to be accepted as having distinctive character.

25.

The United Kingdom Government, intervening in support of OHIM, argues that the purpose of Article 7(1)(c) of Regulation No 40/94 is to prevent signs or indications, like the word DOUBLEMINT, which are descriptive of the characteristics of the goods or services, or which are simply suitable for describing them in normal use by an average consumer, from being used as trade marks by one undertaking alone. As the Court held in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, the registration of such signs or indications as trade marks would run counter to the public interest, which dictates that they should be freely available for use.

26.

The Court ought therefore to make it clear in this case, in so far as it is not evident from the judgment in *BABY-DRY*, firstly that a term does not have to be in current descriptive use to be precluded from registration, but that a reasonable apprehension that it may be so used in the future suffices, and, second, that the fact that more than one term can be used to describe the characteristics of particular goods does not mean that those terms cease to be descriptive.

27.

The German Government, also intervening in support of OHIM, submits that the word DOUBLEMINT is a purely descriptive indication that anybody must be able to use freely. The possible multiplicity of meanings inherent in the components of the description does not contradict that view. Those other meanings are all of a descriptive nature, including in German-speaking countries, as indeed the Bundespatentgericht and the Bundesgerichtshof have held in relation to the words Marktfrisch, Doppel Caramel, Double Color and Double Action.

Findings of the Court

28.

Under Article 4 of Regulation No 40/94, a Community trade mark may consist of any signs capable of being represented graphically, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

29.

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, 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.

30.

Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under Article 7(3) of Regulation No 40/94.

31.

By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-0000, paragraph 73).

32.

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 provisions itself indicates, that such signs and indications could be used for such purposes. A 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.

33.

In the present case, the reason given by the Court of First Instance, at paragraph 20 of the contested judgment, for holding that the word at issue could not be refused registration under Article 7(1)(c) was that signs or indications whose meaning goes beyond the merely descriptive are capable of being registered as Community trade marks and, at paragraph 31 of the contested judgment, that that term cannot be characterised as exclusively descriptive. It thus took the view that Article 7(1)(c) of Regulation No 40/94 had to be interpreted as precluding the registration of trade marks which are exclusively descriptive of the goods or services in respect of which registration is sought, or of their characteristics.

34.

In so doing, the Court of First Instance applied a test based on whether the mark is exclusively descriptive, which is not the test laid down by Article 7(1)(c) of Regulation No 40/94.

35.

It thereby failed to ascertain whether the word at issue was capable of being used by other economic operators to designate a characteristic of their goods and services.

36.

It follows that it erred as to the scope of Article 7(1)(c) of Regulation No 40/94.

37.

In those circumstances, OHIM's submission that the contested judgment is vitiated by an error of law is well founded.

38.

It follows from the foregoing that the contested judgment must be set aside.

39.

Under the second sentence of the first paragraph of Article 61 of the Statute of the Court of Justice, the Court may, if it annuls the decision of the Court of First Instance, refer the case back to the Court of First Instance for judgment.

40.

In the present proceedings, the case must be referred back to the Court of First Instance and costs must be reserved.

On those grounds,

THE COURT,

hereby:

1. Sets aside the judgment of the Court of First Instance of the European Communities of 31 January 2001 in Case T-193/99 *Wrigley v OHIM (DOUBLEMINT)*;

2. Refers the case back to the Court of First Instance;

3. Reserves the costs.

Skouris

Jann

Timmermans
Gulmann

Cunha Rodrigues

Rosas
Edward

La Pergola

Puissochet
Schintgen

Macken

Colneric
von Bahr

Delivered in open court in Luxembourg on 23 October 2003.

R. Grass

V. Skouris

Registrar

President

1: Language of the case: English.