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## Specialised public does not place 'certain procedural obligations' on OHIM

**Examination/opposition**
**International procedures**

**European Union - MAQS Law Firm**

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In *Fuller & Thaler Asset Management Inc v Office for Harmonisation in the Internal Market* (OHIM) (Joined Cases T-310/09 and T-383/09, April 12 2011), the General Court has upheld decisions of the Grand Board of Appeal of OHIM (Case T- 310/09) and the First Board of Appeal of OHIM (Case T-383/09) in which the boards had refused to register the marks BEHAVIOURAL INDEXING and BEHAVIOURAL INDEX, respectively, for goods and services in Classes 9 and 36 of the Nice Classification.

The applicant sought to register BEHAVIOURAL INDEXING and BEHAVIOURAL INDEX as Community trademarks for goods in Class 9 (including software for financial and investment management) and services in Class 36 (including financial and investment management). The OHIM examiner refused registration for all the goods/services covered by the applications, finding that the marks were descriptive under Article 7(1)(c) of the Community Trademark Regulation (207/2009).

The Grand Board of Appeal of OHIM and the First Board of Appeal of OHIM affirmed the decisions. They held that the relevant public was a specialised, English-speaking public with a high level of attention. Thus, the marks at issue would immediately, and without second thought, be understood as a direct and obvious reference to the process of compiling an index.

On further appeal to the General Court, the applicant argued, among other things, that the specialised public imposed "certain procedural obligations" on OHIM with regard to the burden of proof placed on it. According to the applicant, OHIM should have examined, of its own motion, facts other than those which were well known in order to determine whether the marks applied for were descriptive. The court rejected such an obligation as "manifestly incorrect". The purpose of the definition of the relevant public is to determine the level of attention of that public, not to place an evidentiary burden on OHIM.

Further, the court held that the boards were correct in finding that the adjective 'behavioural', insofar as it refers to "human, social and cognitive factors", may be used in all the sectors where behavioural analysis applies and, therefore, has a meaning in the financial sector. Thus, the applicant was incorrect in arguing that the term 'behavioural' was unexpected in this context. The court pointed out that, in English, the juxtaposition of the words 'behavioural' and 'index', as well as 'behavioural' and 'indexing', is grammatically correct. Moreover, it reaffirmed OHIM's conclusion that:

> " *[both expressions] plainly inform the relevant public of the fact that the goods and services in question related to the compilation of an index that takes into account human, social and cognitive factors that affect key issues in the financial management of entities and investment decisions concerning matters such as prices, returns and allocation of resources.*"

Consequently, the applicant was wrong to argue that the juxtapositions were "novel and imaginative in the sphere of software and finance", and the appeals were dismissed.

This case shows that OHIM does not have to perform additional inquiries just because the relevant consumers are sophisticated. The Grand Board of Appeal of OHIM, which has delivered eight decisions in its eight or so years of existence, also made a rare appearance - although this is clear from the General Court's decision, it seems that the case was heard by the Grand Board of Appeal due to language in the applicant's first response to the OHIM examiner, in which the applicant appealed and requested that the official appellate fees be deducted from its representative's current account - the fact that the applicant and the OHIM examiner continued to treat the case as though it were still before OHIM did not alter the fact that it had been appealed.

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