

## General Court refuses to re-register mark based on lack of distinctiveness Examination/opposition European Union - NJORD International procedures

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In *Reed Exhibitions Ltd v Office for Harmonisation in the Internal Market* (OHIM) (Case T-633/13), the General Court has rejected the application for INFOSECURITY, even though the applicant had registered a variation as a Community trademark (CTM) in 2002 for the same goods/services.

Applicant *Reed Exhibitions Ltd* filed an application for registration of the word mark INFOSECURITY as a CTM for goods and services in Classes 16, 35 and 41 of the [Nice Classification](#). OHIM informed the applicant that the mark in question was partially ineligible for registration on the grounds for refusal set out in Articles 7(1)(b) and (c) of the [Community Trademark Regulation \(207/2009\)](#). The mark was considered both descriptive and devoid of any distinctive character for all the goods and service applied for. The applicant argued that the mark was inherently distinctive or was registrable on the basis of the acquired distinctiveness rule in Article 7(3) of the regulation. The applicant was successful as to the latter claim for a limited number in Class 35, but was unsuccessful in arguing inherent distinctiveness and acquired distinctiveness for the remaining items. Accordingly, the applicant appealed to the Boards of Appeal of OHIM, and also filed additional evidence of acquired distinctiveness.

The Fifth Board of Appeal of OHIM dismissed the appeal. In short, having found that the relevant public consisted of reasonably well informed and reasonably observant average consumers, as well as professionals, the board found that INFOSECURITY was purely descriptive of all of the goods and services. Because it was descriptive, it was also considered to be devoid of any distinctive character.

The Board of Appeal also rejected the arguments in favour of the mark in question having acquired distinctive character through use. In essence, having examined the additional evidence provided for by the applicant, the Board of Appeal found that the latter had not proved that the mark would be perceived as being a trademark capable of distinguishing the applicant's goods and services from those of other undertakings.

Reed appealed this decision to the General Court, raising three pleas in law.

Firstly, it claimed that the mark was not descriptive because INFOSECURITY is an invented word not to be found in dictionaries. However, the court, citing *COMPANYLINE* (Case T-19/99), held that the fact that the mark is an invented word did not alter the assessment that the mark is descriptive of the goods and services applied for. In this regard, the court held that the mark applied for had a clear and unambiguous meaning, namely "information security".

The second plea in law was that the Board of Appeal had considered the distinctiveness in light of Article 7(1)(b) "too briefly". The court dismissed the claim as the Board of Appeal had already refused the mark under Article 7(1)(c). Further, the applicant claimed that the board had failed to take into consideration the fact that it had already successfully registered the trademark INFOSECURITY (CTM No 1230531, a variation of the word mark at issue) for the same goods and services in 2002. Having examined the relevant case law, the court dismissed the claim, stating that registrability had to be assessed based solely on the basis of the Community Trademark Regulation, in that "no person may rely to his advantage on an unlawful act committed in another procedure" (Paragraph 65).

The third plea in law concerned Article 7(3). The Board of Appeal considered that some of the evidence of acquired distinctiveness of INFOSECURITY showed use as a component of another sign, namely the figurative sign INFOSECURITY EUROPE or as a trading name, rather than a trademark. Again the court sided with the board, holding that the latter was fully entitled to conclude that use of the mark in the figurative sign could not constitute use of that term as a trademark within the meaning of Article 7(3). As regards the trade name, the court held that the applicant could not claim that the expression 'infosecurity' was not used "more as a company name" (as claimed by the Board of Appeal) while at the same time maintaining that the mark applied for had acquired distinctiveness through use as a trade name. In any case, the court found that the claimed use did not suffice on its own to prove acquired distinctiveness through use.

The applicant also criticised the board for dismissing the evidential value of two declarations ("statements"), because these were signed after the application date, and also because the applicant had coordinated the preparation of the statements. Here the court sided with the applicant as regards the post-dated aspect and the fact that the applicant had drafted the declarations. However, the court found that the evidence only expressed an opinion as to how professionals perceived the mark applied for. The statements did not, however, prove acquired distinctive character through use for average consumers, which also formed part of

the relevant public.

The applicant also claimed that the Board of Appeal had failed to consider a substantial amount of evidence provided for in the administrative proceedings. Here the court stated (Paragraph 110):

*"... the applicant's argument that the Board of Appeal failed to consider the 'substantial amount of evidence provided' for the purposes of demonstrating that the mark applied for had acquired distinctive character would amount - at least implicitly - to requiring the court to examine all the documents produced in the course of the administrative proceedings and the arguments relating thereto, even though those documents were not identified in the application by a reference to the document produced in the administrative proceedings."*

Lastly, the applicant had relied on the ownership and management of websites ([www.infosecurity.be](http://www.infosecurity.be), <http://www.infosecurity.nl/> and [www.infosecurity.co.uk](http://www.infosecurity.co.uk)) in attempting to prove acquired distinctiveness through use. Although the court acknowledged that such use, under certain circumstances, could be an indicator of acquired distinctiveness through use, it held that in the present case this was not so as the mark "may be perceived immediately as a trade name or as the title of an exhibition" (Paragraph 117).

Accordingly, the court dismissed the appeal.

This case is interesting firstly because it shows the dangers of reapplying for a variation of a CTM that is already registered – there is no guarantee that OHIM will not raise a distinctiveness citation. Secondly, the case shows the difficulty in proving acquired distinctiveness where the applied-for mark is used as a component of other commercial signs and as a trade name. Finally, the decision hints that, while the General Court generally will not revisit evidence of acquired distinctiveness, it might re-examine the weight given to individual items.

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