

ORDER OF THE COURT (Fifth Chamber)

24 September 2009 (*)

(Appeal – Community trade mark – Regulation (EC) No 40/94 – Article 7(1)(b), (c), (d) and (g) – Application for a declaration of invalidity – Community word mark I.T.@MANPOWER)

In Case C-520/08 P,

APPEAL under Article 56 of the Statute of the Court of Justice, brought on 20 November 2008,

HUP Usługi Polska sp. z o.o., formerly HP Temporärpersonalgesellschaft mbH, established in Czeladz (Poland), represented by M. Ciresa, Rechtsanwalt,

appellant,

the other parties to the proceedings being:

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by A. Folliard-Monguiral, acting as Agent,

defendant at first instance,

Manpower Inc., established in Milwaukee (United States), represented by V. Marsland, Solicitor, and A. Bryson, Barrister,

intervener at first instance,

THE COURT (Fifth Chamber),

composed of M. Ilešič (Rapporteur), President of the Chamber, A. Tizzano and A. Borg Barthet, Judges,

Advocate General: J. Mazák,

Registrar: R. Grass,

after hearing the Advocate General,

makes the following

Order

1 By its appeal, HUP Usługi Polska sp. z o.o., formerly HP Temporärpersonalgesellschaft mbH ('HUP Usługi Polska'), seeks to have set aside the judgment of the Court of First Instance of the European Communities of 24 September 2008 in Case T-248/05 HUP Usługi Polska v OHIM – Manpower (I.T.@MANPOWER) ('the judgment under appeal'), by which the Court of First Instance dismissed its action for the annulment of the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 5 April 2005 (Case R 124/2004-4) ('the contested decision'), which had confirmed the dismissal of its application for a declaration that the registration of the mark I.T.@MANPOWER was invalid.

Legal context

2 Article 7 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), which is headed 'Absolute grounds for refusal', provides in paragraph 1:

'The following shall not be registered:

...

(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;

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;

...

(g) trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service;

...'

3 Article 51 of Regulation No 40/94, which is headed 'Absolute grounds for invalidity', provides in paragraph 1:

'A Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings,

(a) where the Community trade mark has been registered in breach of the provisions of Article 5 or of Article 7;

...'

4 Regulation No 40/94 has been repealed by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codified version) (OJ 2009 L 78, p. 1), which entered into force on 13 April 2009. Nevertheless, in view of the date of the facts, the present case remains governed by Regulation No 40/94.

The facts

5 On 25 June 1998 Manpower Inc. ('Manpower') applied for, and on 16 December 1999 it obtained, registration of the Community word mark I.T.@MANPOWER for goods and services in Classes 9, 16, 35, 38, 41 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 ('the Nice Agreement'), and corresponding, for each of those classes, to the description included in paragraph 3 of the judgment under appeal.

6 On 21 June 2001, HUP Usługi Polska filed an application for a declaration of invalidity of the mark I.T.@MANPOWER on the basis of Article 51(1)(a) of Regulation No 40/94, read in conjunction with Article 7(1)(b), (c), (d) and (g) thereof.

7 On 5 December 2003, the OHIM Cancellation Division dismissed that application.

8 On 5 February 2004, HUP Usługi Polska filed an appeal against that division's decision.

9 By the contested decision, the Fourth Board of Appeal of OHIM held that the mark I.T.@MANPOWER was registered in conformity with Article 7(1)(b), (c), (d) and (g) of Regulation No 40/94 and, therefore, dismissed that appeal.

The action before the Court of First Instance and the judgment under appeal

10 By application lodged at the Registry of the Court of First Instance on 1 July 2005, HUP Usługi Polska brought an action for annulment of the contested decision, on the basis of a single plea in law alleging infringement of Article 7(1)(b), (c), (d) and (g) of Regulation No 40/94.

11 The Court of First Instance pointed out in paragraph 39 of the judgment under appeal that the relevant public in relation to whom the absolute grounds for refusal invoked in the present case must be assessed are English-speaking consumers.

12 With regard to Article 7(1)(c) of Regulation No 40/94, the Court of First Instance noted, in paragraph 36 of that judgment, that the descriptive nature of a mark which consists of a combination of elements must be found for the whole constituted by those elements.

13 In paragraph 40 of the judgment under appeal, the Court of First Instance stated that an assessment must be made, for the application of that provision, as to whether, for the relevant public, there is a sufficiently direct and specific relationship between the mark I.T.@MANPOWER and the goods and services at issue.

14 That said, the Court of First Instance found, in paragraphs 41 and 42 of the judgment under appeal, in essence, that that mark's message is not sufficiently clear so as to describe any of the characteristics of goods and services related to employment agency services with

regard to IT personnel in Class 35 of the Nice Agreement, let alone the more generally outlined goods or services in Classes 9, 16, 38, 41 and 42 of that agreement.

15 The Court of First Instance found, in paragraph 43 of the judgment under appeal, that the combination in question of an acronym, a symbol and a word cannot, viewed as a whole, be regarded as a known English expression designating the goods or services at issue or referring to one of their characteristics.

16 Therefore, the Court of First Instance held, in paragraph 45 of that judgment, that the Fourth Board of Appeal of OHIM did not in any way err in finding that the mark I.T.@MANPOWER is not descriptive of the characteristics of the goods and services at issue.

17 With regard to Article 7(1)(b) of Regulation No 40/94, the Court of First Instance stated, in essence, in paragraphs 50 to 54 of the judgment under appeal, that the Fourth Board of Appeal of OHIM was correct to hold that the mark I.T.@MANPOWER has at least some degree of distinctiveness. The Court considered that:

- viewed as a whole, that mark possesses at least some degree of distinctiveness owing to its uncommon structure characterised by the ‘@’ symbol and because the meaning of the mark is too vague and imprecise;
- the combination of the three elements in that mark cannot be regarded as complying with linguistic rules; and
- the original and uncommon character of the mark I.T.@MANPOWER is due, in particular, to the insertion of the symbol ‘@’ between the elements ‘it’ and ‘manpower’.

18 With regard to Article 7(1)(d) of Regulation No 40/94, the Court of First Instance observed, in paragraphs 58 to 60 of the judgment under appeal, that HUP Usługi Polska claimed that all the elements of the mark I.T.@MANPOWER had become customary in current language, whereas it should, under that provision, be determined whether that mark has become customary in current language as a whole and not only with regard to the individual elements constituting it. The Court consequently held, in paragraph 63 of the judgment, that the Fourth Board of Appeal of OHIM did not err in any way in finding that the mark has not become customary in current language.

19 With regard to Article 7(1)(g) of Regulation No 40/94, the Court of First Instance stated, in essence, in paragraphs 65 and 70 of the judgment under appeal, that the Fourth

Board of Appeal of OHIM was correct to hold that the mark I.T.@MANPOWER was not deceptive, because it was not clear enough to designate any clear characteristics of the goods and services at issue.

20 Having regard to all of the foregoing, the Court of First Instance dismissed the application in its entirety.

Forms of order sought

21 HUP Usługi Polska requests that the Court set aside the judgment under appeal and order OHIM to pay the costs.

22 OHIM and Manpower request that the Court dismiss the appeal and order HUP Usługi Polska to pay the costs.

The appeal

23 Under Article 119 of the Rules of Procedure, where an appeal is, in whole or in part, clearly inadmissible or clearly unfounded, the Court may at any time, acting on a report from the Judge-Rapporteur and after hearing the Advocate General, by reasoned order dismiss the appeal in whole or in part, without opening the oral procedure.

24 In support of its appeal, HUP Usługi Polska relies on a single plea in law, alleging infringement of Article 7(1)(b), (c), (d) and (g) of Regulation No 40/94. That plea consists of four parts, the second, third and fourth of which should be dealt with together.

The first part of the single plea, alleging infringement of Article 7(1)(c) of Regulation No 40/94

Arguments of the parties

25 By this part of the single plea, HUP Usługi Polska essentially submits that, according to the relevant case-law, a sign is not descriptive when there is a perceptible difference between the neologism or the word and the mere sum of its parts. That presupposes that, because of the unusual nature of the combination in relation to the goods or services that the sign designates, the neologism or word creates an impression which is sufficiently far removed from that

produced by the mere combination of meanings lent by the elements of which the sign is composed, with the result that it goes beyond those elements.

26 HUP Usługi Polska adds that, contrary to what follows essentially from paragraph 41 of the judgment under appeal, as the mark I.T.@MANPOWER is a combination of generic and comprehensive terms and a well-known symbol, it does not represent an unusual combination in the eyes of the relevant public. That mark designates, therefore, the characteristics of the goods and services at issue.

27 OHIM states principally that the Court of First Instance properly assessed the descriptiveness of the mark I.T.@MANPOWER by holding, in particular, that it contains more than the sum of its parts because of its fanciful construction. It is, therefore, an unusual combination of an acronym, a symbol and a word, so that the Court of First Instance has not infringed Article 7(1)(c) of Regulation No 40/94.

28 Manpower asserts, in essence, that the first part of the single plea is directed against the Court of First Instance's appraisal of the facts, in particular in paragraphs 41 and 42 of the judgment under appeal. As HUP Usługi Polska does not plead any distortion of the facts, that part must be rejected as inadmissible.

Findings of the Court

29 Under Article 7(1)(c) of Regulation No 40/94, 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.

30 In that regard, the Court has held that the descriptive character of a mark comprising several words, such as that at issue in the present case, may be assessed, in part, in relation to each of its terms, taken separately, but must, in any event, also be established in relation to the whole which they comprise (see Case C-273/05 P OHIM v Celltech [2007] ECR I-2883, paragraphs 76 and 79, and the order of 6 February 2009 in Case C-17/08 P MPDV Mikrolab v OHIM, paragraph 38).

31 In the present case, it is apparent from paragraph 43 of the judgment under appeal that the combination of the three elements comprising the mark I.T.@MANPOWER cannot be regarded as a usual way of designating goods and services or as a known English expression designating the goods or services at issue.

32 It follows that, in light of the unusual combination of the three elements which comprise it, that mark, viewed as a whole, is not descriptive of the goods or services at issue.

33 Therefore, HUP Usługi Polska's argument concerning the Court of First Instance's failure to take account of the relevant case-law relating to the descriptiveness of a mark must be rejected as clearly unfounded.

34 HUP Usługi Polska's argument relating to paragraph 41 of the judgment under appeal concerns the factual analysis carried out by the Court of First Instance.

35 In that regard, it should be noted that it follows from Article 225 EC and the first paragraph of Article 58 of the Statute of the Court of Justice that an appeal is limited to points of law. The Court of First Instance, therefore, has exclusive jurisdiction to find and appraise the relevant facts and to appraise the evidence. The appraisal of the facts and evidence thus does not, save where they have been distorted, constitute a point of law which is subject, as such, to review by the Court of Justice on appeal (see, in particular, Case C-104/00 P DKV v OHIM [2002] ECR I-7561, paragraph 22, and the judgment of 20 September 2007 in Case C-193/06 P Nestlé v OHIM, paragraph 53 and the case-law cited).

36 As HUP Usługi Polska has not established any distortion of the facts and evidence by the Court of First Instance so far as concerns paragraph 41 of the judgment under appeal, the arguments referred to in paragraph 26 of the present order must be rejected as clearly inadmissible.

The second, third and fourth parts of the single plea, alleging respectively infringement of Article 7(1)(b), (d) and (g) of Regulation No 40/94

Arguments of the parties

37 By the second, third and fourth parts of the single plea, HUP Usługi Polska claims essentially that:

– contrary to the reasoning in paragraphs 51 to 55 of the judgment under appeal, the mark I.T.@MANPOWER is devoid of the required minimum degree of distinctive character with regard to all the goods and services at issue;

- contrary to the Court of First Instance’s finding in paragraph 60 of the judgment under appeal, all the elements of that mark have become customary, so that it does not create an imaginative overall impression going beyond the sum of its elements; and

- contrary to the Court of First Instance’s findings in paragraphs 67 and 68 of the judgment under appeal, that mark will deceive the relevant public if the goods and services at issue have no connection with manpower in the sector of information technology.

38 OHIM contends, in essence, that HUP Usługi Polska’s abovementioned assertions constitute an appraisal of the facts and that the latter does not claim any distortion in that regard.

39 Manpower contends essentially that, since the first part of the plea must be rejected, it follows that the second part should also be rejected.

40 HUP Usługi Polska’s assertion that the elements of the mark I.T.@MANPOWER have become customary must, according to Manpower, be rejected since it does not take account of the mark viewed as a whole.

41 Manpower claims that HUP Usługi Polska’s arguments relating to paragraphs 67 and 68 of the judgment under appeal constitute an appraisal of the facts.

Findings of the Court

42 In the case of the second, third and fourth parts of the single plea, HUP Usługi Polska in reality merely challenges the appraisal of the facts carried out by the Court of First Instance.

43 Since no distortion of the facts and evidence adduced before the Court of First Instance has been invoked in the present case, the second, third and fourth parts of the single plea must be rejected as clearly inadmissible in accordance with the case-law noted in paragraph 35 of the present order.

44 Therefore, it must be found, with regard to the plea viewed as a whole, that the Court of First Instance did not misconstrue the meaning of Article 7(1)(b), (c), (d) and (g) of

Regulation No 40/94, so that the appeal must be dismissed in its entirety, in part as clearly unfounded and in part as clearly inadmissible.

Costs

45 Under Article 69(2) of the Rules of Procedure, which applies to appeal proceedings by virtue of Article 118 thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since OHIM and Manpower have applied for costs and HUP Usługi Polska has been unsuccessful, HUP Usługi Polska must be ordered to pay the costs.

On those grounds, the Court (Fifth Chamber) hereby orders:

- 1. The appeal is dismissed.**

- 2. HUP Usługi Polska sp. z o.o. shall pay the costs.**

[Signatures]

* Language of the case: English.