

Trademarks for numerals remain unsuccessful before the OHIM

Summary: On November 19, 2009, the European Court of First Instance issued several decisions denying registration to Community trademarks covering products of class 16 and consisting of numerals – some for numerals only and some bearing additional elements -. The reasoning of the Court show the level of distinctiveness to consider when it comes to applying to register this kind of trademarks on the Community level and the difficulties relating thereto.

On November 19, 2009, the European Court of First Instance denied registration to several Community trademark applications filed by Agencja Wydawnicza Technopol sp. z o.o. for the numerals 150, 250, 350, 222, 333 and 555 (for “*periodicals, books, games brochures*” in class 16), the numeral 1000 (for “*brochures, periodicals containing crossword puzzles and rebus puzzles, newspapers*” in class 16) as well as the word and device trademarks containing the digits 100 and 300 (covering “*posters, albums, booklets, magazines, forms, printed matter, newspapers, calendars, crosswords puzzles, rebuses*” in class 16 and products and services of classes 28 and 41).

The Board found that the word signs 150, 250, 350, 222, 333, 555 and 1000 were descriptive of the amount of information contained into the products specified in class 16. The Court confirmed by upholding that there was a direct and specific link between the marks 150, 250, 350, 222, 333, 555 and 1000 and characteristics of the goods claimed in class 16 such as their number of pages and works, amount of data, number of puzzles in the collection or ranking of items referred to in them. For the sign 1000, the Court more specially pointed out that brochures, periodicals and magazines preferred round numbers for indicating the content and this strengthened the descriptive relationship between the goods at hands and this figure for the average consumer.

With regards to the word and device trademarks composed of the digits 100 and 300, the Court confirmed the findings of the Board as to the designs involved which reached a low level of development. The overall impression emerging from these signs could have been given that the exclusive rights extended to the elements 100 and 300 prevented other undertaking from using them. The figures 100 and 300 actually similarly referred to quantities and likely to describe without further thoughts the number of pages in the publications or the number of pieces in the puzzles and riddles which determined their degree of difficulty. These were considered as essential characteristics in deciding whether to make a purchase of the goods in concerns.

These decisions are in line with the Community approach. Numerals are supposed to be eligible to trademark registration. Article 4 of Council Regulation No 207/2009 of February 26, 2009, entitled ‘*Signs of which a Community trade mark may consist*’ indeed provides that “*a Community trade mark may consist of any signs capable of being represented graphically, particularly* words, *including*

[...] letters, numerals [...] provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings”. In practice the OHIM however refuses to register as Community word trademark single letters or numerals under provisions of Article 7 of Council Regulation No. 207/2009 which sets out absolute grounds of refusal against signs being devoid of distinctive character.

Actually decision of the Third Board of Appeal for the plain numeral “7” started years ago this whole approach of the Community case and remains an unchanged position in today’s Community practice. Plain numerals *per se*, without any unusual or fanciful feature, are regarded as deprived of any distinctive character since they belong to the public domain and form part of the store of signs available to all traders. The limited number of numerals makes such signs inherently unavailable to any undertakings for the OHIM. Word trademarks composed of single

numeral lacks distinctiveness as they do not enable *prima facie* the relevant public to identify the goods or services covered as originating from a specific undertaking. The Examiners also often point out that such trademarks prevent consumers from renewing a purchasing experience if it was initially positive or from avoiding such purchase in case their first experience with the products or services was negative.

Decisions above show that the level to reach to give rise to a sufficient distinctiveness allowing registration requires the designs or other fanciful features added to the digit to be of sufficient consistence and/or visual impact to properly counterbalance and hide the sole presence of a numeral. A case by case analysis is required to determine whether the signs at hands has a sufficient distinctiveness given all the elements composing it out of the numeral itself. But one thing is sure: nude numerals have no chance to mature into registration on the Community level (unless there enjoy very particular circumstances!).

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