

**Appeal brought on 17 February 2010 by Media-Saturn-Holding GmbH against the judgment of the General Court (Fourth Chamber) delivered on 15 December 2009 in Case T-476/08 Media-Saturn-Holding GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)**

(Case C-92/10 P)

(2010/C 113/42)

*Language of the case: German*

**Parties**

*Appellant:* Media-Saturn-Holding GmbH (represented by C.-R. Haarmann and E. Warnke, lawyers)

*Other party to the proceedings:* Office for Harmonisation in the Internal Market (Trade Marks and Designs)

**Form of order sought**

The appellant claims that the Court of Justice should:

- set aside the judgment of the General Court of the European Union of 15 December 2009 in Case T-476/08;
- annul the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 28 August 2008 in Case R 591/2008-4;
- order the appellant to pay the costs of the proceedings before the Board of Appeal, the General Court of the European Union and the Court of Justice.

**Pleas in law and main arguments**

The present appeal is brought against the judgment of the General Court which dismissed the action brought by the appellant for annulment of the Decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market of 28 August 2008 rejecting its application for registration of the figurative mark 'BEST BUY'. The appellant claims that the General Court erred in law and was incorrect in its interpretation of the absolute ground for refusal of registration

in respect of trade marks which are devoid of any distinctive character laid down in Article 7(1)(b) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark. The appeal consists of three parts.

First, the appellant claims that the General Court unlawfully inferred absence of distinctiveness from the assessment of a mark other than the one actually applied for. Its assessment of distinctiveness was carried out in relation to a sign which contains the correctly written word element 'BEST BUY' and which was the subject of another set of proceedings before that court. In contrast to that other sign, in the mark applied for by the appellant the arrangement of the prominent letter 'B', which forms the first letter of both the words 'BEST' and 'BUY', means that an alleged word element 'BEST BUY' is formed only after a pause for thought. Since the additional distinctiveness of that mark stemming from the unusual and incorrect manner in which it is written has a sufficient minimum of distinctiveness, the General Court ought not to have relied on an earlier decision relating to a sign in which that specific feature was lacking.

Second, the General Court failed to have regard to the principle that the question whether or not a complex mark has distinctive character must depend on an assessment of the mark as a whole. No such overall assessment was carried out in the judgment under appeal. The General Court assessed whether each individual element was capable on its own of conferring distinctiveness on that sign, a question which was then automatically answered in the negative if in that court's view the element was not distinctive in itself. An overall assessment of the mark, from which it could not be excluded that the sum of elements ineligible on their own for protection would result in a mark eligible for protection when viewed as a whole, was not carried out.

Third, the Court used an excessively strict criterion in its assessment of distinctiveness. It held that it was sufficient that the mark be perceived 'principally' as an advertising slogan in order for the refusal of registration laid down in Article 7(1)(b) of Regulation No 40/94 to apply. However, that approach constitutes a failure to have regard to the legal principles of Article 7(1)(b) of Regulation No 40/94, as applied in concrete terms by the Court of Justice. The laudatory connotation of a word mark does not mean that it cannot be appropriate for the purposes of guaranteeing to consumers the origin of the goods or services which it covers. It is entirely possible that such a mark can be perceived by the relevant public both as an advertising slogan and as an indication of commercial origin. In that regard, the General Court ought at least to have provided reasons why this was not however the case in respect of the mark applied for.