

# World Trademark Report

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## **ROCKBASS descriptive, says advocate general**

Advocate General Sharpston has issued an opinion (Case C-301/05 P), advising the European Court of Justice to dismiss an appeal from a decision of the European Court of First Instance (CFI) in relation to an application to register the word mark ROCKBASS.

The CFI had upheld an Office for Harmonization in the Internal Market decision to reject an application to register ROCKBASS as a Community trademark for "technical sound equipment, mixing desks, sound effect equipment, amplifiers, loudspeaker boxes, active loudspeaker boxes (combos); containers, cases and bags for the aforesaid goods"; "musical instruments, in particular guitars, electric guitars, bass guitars, acoustic guitars, guitar accessories, namely strings, frets, truss rods and straps; containers, cases and bags for the aforesaid goods"; "containers, cases and bags". The rejection was based on the claimed descriptive character of the word ROCKBASS, which, in the view of the Board of Appeal, made reference to a bass guitar, an instrument which lends itself in particular to playing rock music, and also designated a bass guitar technique - "rock bass". The applicant, an individual named Hans-Peter Wilfer, appealed on seven grounds.

The first ground of appeal in relation to Article 19 of the Statute of the Court of Justice was not considered by Sharpston as Wilfer withdrew his request under that article.

In his second ground Wilfer alleged an infringement of Article 74(1) of the Community Trademark Regulation, which provides as follows: "In proceedings before it the Office shall examine the facts of its own motion". Wilfer claimed that the CFI should have taken into account a statement later lodged by Wilfer noting that parallel registrations had succeeded in other jurisdictions (eg, the United States). However, Sharpston stated that this information was not of any relevance to the question of descriptive character and concluded that the ground of appeal was unfounded.

The third ground of appeal also related to the aforementioned statement. Wilfer alleged an infringement of Article 74(2) of the Community Trademark Regulation, which provides that "the Office *may* disregard facts or evidence which are not submitted in due time by the parties concerned". Although the statement was not submitted in due time, Wilfer claimed that the Board of Appeal had discretion to take into account the additional evidence. Thus, the board should have examined it in order to ensure, at the very least, that it did not contain any new relevant facts or evidence, and the CFI should have annulled the earlier decision on this basis. Sharpston disagreed. She opined that procedural irregularity entails the annulment of a decision only if it is shown that the decision without this procedural irregularity might have been substantively different. This was not the case here, as the aforementioned statement did not contain any new facts or arguments.

The fourth, fifth and seventh ground of appeal related to Article 7(1)(c) of the regulation. Wilfer argued that the CFI neither took into account other possible meanings of the word 'ROCKBASS' nor did it consider whether that term had other possible grammatical permutations, (eg, among others things, noun/noun and verb/adjective). Sharpston, however, agreed with the CFI in that a word mark must be refused registration if at least one of its possible meanings designates a characteristic of the goods or services concerned. By analogy, this meant that all the grounds raised under Article 7(1)(c) were unfounded. In particular, Sharpston noted that the CFI ruled correctly in finding that the sign ROCKBASS did not diverge from English word composition rules and therefore did not create an impression sufficiently far removed from that produced by the mere combination

of the two words 'ROCK' and 'BASS'.

In his sixth ground of appeal, Wilfer alleged that the CFI incorrectly disregarded the fact that containers, cases and bags intended to transport musical instruments and their accessories fall within Class 15. In addition, he pointed out that the CFI neglected the fact that the goods in Class 9 are not used autonomously in relation to the handling of electric instruments. However, Sharpston opined that the first part of this ground of appeal required a reassessment of the facts found by the CFI and the Board of Appeal and was therefore inadmissible. Moreover, the second point was unfounded since the fact that the equipment may also be used in another way did not mean that the sign was not descriptive.

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