

JUDGMENT OF THE GENERAL COURT (Seventh Chamber)

15 February 2023 (*)

(EU trade mark – International registration designating the European Union – Word mark OTHER COMPANIES DO SOFTWARE WE DO SUPPORT – Absolute ground for refusal – No distinctive character – Article 7(1)(b) of Regulation (EU) 2017/1001)

In Case T- 204/22,

Rimini Street, Inc., established in Las Vegas, Nevada (United States), represented by E. Ratjen, lawyer,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by E. Śliwińska and T. Frydendahl, acting as Agents,

defendant,

THE GENERAL COURT (Seventh Chamber),

composed of K. Kowalik-Bańczyk, President, I. Dimitrakopoulos (Rapporteur) and B. Ricziová, Judges,

Registrar: E. Coulon,

having regard to the written part of the procedure,

having regard to the fact that no request for a hearing was submitted by the parties within three weeks after service of notification of the close of the written part of the procedure, and having decided to rule on the action without an oral part of the procedure, pursuant to Article 106(3) of the Rules of Procedure of the General Court,

gives the following

Judgment

1 By its action under Article 263 TFEU, the applicant, Rimini Street, Inc., seeks the annulment of the decision of the Fourth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 14 February 2022 (Case R 1389/2021-4) (‘the contested decision’).

Background to the dispute

2 On 30 September 2020, the applicant obtained international registration No 1 559 651 designating the European Union from the International Bureau of the World Intellectual Property Organisation (WIPO). That international registration (‘the contested international registration’) was

notified to EUIPO on 12 November 2020. It concerns the word sign OTHER COMPANIES DO SOFTWARE WE DO SUPPORT.

3 The contested international registration was made in respect of services in Class 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, corresponding to the following description: ‘Computer software consulting services; technical support services, namely, providing maintenance services for enterprise and database software; technical support services, namely, providing troubleshooting of enterprise and database software problems; maintenance of computer software; technical support services, namely, troubleshooting computer software problems’.

4 By decision of 18 June 2021, the examiner refused the contested international registration protection in the European Union in respect of all the services referred to in paragraph 3 above, on the basis of Article 7(1)(b) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1), read in conjunction with Article 7(2) of that regulation.

5 On 10 August 2021, the applicant filed a notice of appeal with EUIPO against the examiner’s decision.

6 By the contested decision, the Board of Appeal dismissed the appeal on the ground that the contested international registration was devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation 2017/1001, read in conjunction with Article 7(2) of that regulation. It found that the word sign at issue was merely a promotional formula within which there was nothing that might, beyond its obvious promotional meaning, enable the relevant public to memorise the word sequence easily and immediately as a distinctive trade mark for the services in question.

Forms of order sought

7 The applicant claims that the Court should:

- annul the contested decision;
- order EUIPO to pay the costs.

8 EUIPO contends that the Court should:

- dismiss the action;
- order the applicant to pay the costs.

The determination of the regulation which is applicable *ratione temporis*

9 Given the date on which the application for protection at issue was filed, which is decisive for the purposes of identifying the applicable substantive law, the facts of the case are governed by the substantive provisions of Regulation 2017/1001 (see, to that effect, order of 5 October 2004, *Alcon v OHIM*, C- 192/03 P, EU:C:2004:587, paragraphs 39 and 40, and judgment of 23 April 2020, *Gugler France v Gugler and EUIPO*, C- 736/18 P, not published, EU:C:2020:308, paragraph 3 and the case-law cited).

10 Consequently, in the present case, so far as concerns the substantive rules, any reference to Article 7(1)(b) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1) made by the applicant in its written pleadings must be understood as referring to Article 7(1)(b) of Regulation 2017/1001, the wording of which is identical.

Law

11 The applicant relies on a single plea in law, alleging infringement of Article 7(1)(b) of Regulation 2017/1001, read in conjunction with Article 7(2) of that regulation. It submits, in essence, that the contested international registration has distinctive character in relation to the services in question, thus making it possible for it to be registered.

12 EUIPO disputes the applicant's arguments.

13 Article 7(1)(b) of Regulation 2017/1001 provides that trade marks which are devoid of any distinctive character must not be registered. Under Article 7(2) of that regulation, Article 7(1) is to apply notwithstanding that the grounds of non-registrability obtain in only part of the European Union.

14 For a trade mark to possess distinctive character within the meaning of Article 7(1)(b) of Regulation 2017/1001, it must serve to identify the goods in respect of which registration is sought as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings (see judgment of 21 January 2010, *Audi v OHIM*, C- 398/08 P, EU:C:2010:29, paragraph 33 and the case-law cited). A minimum degree of distinctive character is sufficient for a sign to be capable of being registered as a trade mark (see, to that effect, judgments of 27 February 2002, *Eurocool Logistik v OHIM (EUROCOOL)*, T- 34/00, EU:T:2002:41, paragraph 39, and of 30 April 2015, *Steinbeck v OHIM – Alfred Sternjakob (BE HAPPY)*, T- 707/13 and T- 709/13, not published, EU:T:2015:252, paragraph 21).

15 The distinctive character of a mark, for the purposes of Article 7(1)(b) of Regulation 2017/1001, must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, secondly, by reference to the relevant public's perception of the mark (see judgment of 29 April 2004, *Henkel v OHIM*, C- 456/01 P and C- 457/01 P, EU:C:2004:258, paragraph 35 and the case-law cited).

16 The registration of marks made up of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by those marks is not excluded by virtue of such use (judgments of 21 January 2010, *Audi v OHIM*, C- 398/08 P, EU:C:2010:29, paragraph 35, and of 22 March 2017, *Hoffman v EUIPO (Genius)*, T- 425/16, not published, EU:T:2017:199, paragraph 66).

17 As regards the assessment of the distinctive character of such marks, the Court of Justice has already held that it is inappropriate to apply to those marks criteria which are stricter than those applicable to other types of sign (judgments of 21 October 2004, *OHIM v Erpo Möbelwerk*, C- 64/02 P, EU:C:2004:645, paragraph 32; of 21 January 2010, *Audi v OHIM*, C- 398/08 P, EU:C:2010:29, paragraph 36; and of 22 March 2017, *Genius*, T- 425/16, not published, EU:T:2017:199, paragraph 27).

18 It is also apparent from the case-law that, although all marks made up of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by those marks convey by definition, to a greater or lesser extent, an objective message, even a simple one, they can still be capable of indicating to the consumer the commercial origin of the goods or services in question. That can be the position, in particular, where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring at least some interpretation by the relevant public, or setting off a cognitive process in the minds of that public (judgments of 21 January 2010, *Audi v OHIM*, C- 398/08 P, EU:C:2010:29, paragraphs 56 and 57, and of 22 March 2017, *Genius*, T- 425/16, not published, EU:T:2017:199, paragraph 28).

19 It follows that a trade mark consisting of an advertising slogan must be regarded as being devoid of any distinctive character if it is liable to be perceived by the relevant public only as a mere promotional formula. By contrast, such a mark must be recognised as having distinctive character if, apart from its promotional function, it may be perceived immediately by the relevant public as an indication of the commercial origin of the goods and services concerned (see judgments of 11 December 2012, *Fomanu v OHIM (Qualität hat Zukunft)*, T- 22/12, not published, EU:T:2012:663, paragraph 22, and of 6 June 2013, *Interroll v OHIM (Inspired by efficiency)*, T- 126/12, not published, EU:T:2013:303, paragraph 24).

20 In that context, it is also necessary to take account of the fact that average consumers are not in the habit of making assumptions about the origin of goods on the basis of slogans and of the fact that the level of attention of the professional public may be relatively low when it comes to promotional indications which a well-informed public does not see as decisive (judgment of 13 July 2022, *Rimini Street v EUIPO (WE DO SUPPORT)*, T- 634/21, not published, EU:T:2022:459, paragraph 24).

21 It is in the light of those considerations that it must be examined whether, as the applicant claims, the Board of Appeal infringed Article 7(1)(b) of Regulation 2017/1001, read in conjunction with Article 7(2) of that regulation, in concluding that the contested international registration was devoid of any distinctive character.

22 In that regard, in the first place, it must be stated that the applicant does not dispute the Board of Appeal's assessments regarding the relevant public and its level of attention which are set out in paragraphs 15 and 16 of the contested decision. The Board of Appeal found that the public concerned by the perception of the distinctive character of the contested international registration consisted of the English-speaking general public and of English-speaking professionals in the European Union, the level of attention of which public was above average.

23 In the second place, as regards the relevant public's perception of the meaning of the contested international registration, the Board of Appeal found that the phrase 'other companies do software we do support', which was made up in accordance with the rules of English grammar and lacked any original combination of words or structure, had a clear meaning (see paragraph 18 of the contested decision). It thus deduced that the relevant English-speaking public, when faced with the services in question, would understand the international registration as meaning that its holder provided advice and support with regard to software which was created by other companies and that therefore the phrase 'other companies do software we do support' was perceived as a laudatory promotional

slogan which was intended for software users and did not contain any elements which made the sign distinctive (see paragraph 19 of the contested decision).

24 The applicant disputes the Board of Appeal's finding in that regard, submitting that the Board of Appeal did not sufficiently take into account the degree of interpretation which is necessary in order to arrive at a clear message with regard to the slogan which is the subject of the contested international registration. First, the applicant contends that, in order to arrive at the meaning which was relied on in the contested decision, the Board of Appeal, in essence, had to add several other words to the contested international registration, such as 'but the Applicant's services advise', 'the users of this' or even 'although developed by other companies', which are not part of that registration and that that entails further mental steps and thoughts. Secondly, it submits that the word sign can have several meanings, as was, it claims, acknowledged by the Board of Appeal, and that all of those meanings also require the addition of words. Thirdly, the applicant claims, in essence, that the meaning of the contested international registration is even less evident because, in the present case, protection has been sought for a sign which is not written on a single line, but on two lines. Fourthly, it submits that the contested international registration leaves a number of questions open, inter alia the way in which the support is provided and the undertakings referred to by the expression 'other companies', and that it thus conveys a vague meaning and therefore a message that is capable of setting off a cognitive process in the minds of the relevant public, making the contested international registration easy to remember and, consequently, distinctive. Fifthly, the applicant contends that the grammatical structure of that slogan and the repetition of the verb 'do' contribute towards conferring distinctive character on the contested international registration.

25 EUIPO disputes the applicant's arguments.

26 In order to assess whether or not a trade mark has any distinctive character, the overall impression given by it must be considered. That does not mean, however, that one may not first examine each of the various features of the get-up of that mark in turn. It may be useful, in the course of the overall assessment, to examine each of the components of which the trade mark concerned is composed (see judgment of 25 October 2007, *Develey v OHIM*, C- 238/06 P, EU:C:2007:635, paragraph 82 and the case-law cited).

27 In the present case, first, as regards the meaning of the various components of the sign at issue, it must be pointed out that the Board of Appeal did not err in finding, in essence, in paragraphs 18 and 20 of the contested decision, that the term 'we' referred to the service provider, namely the holder of the international registration, that the term 'do' meant 'to do something', which was inherent in the provision of a service, that the term 'support' referred to the very nature of the services in question, namely software support in respect of software created by other companies, that the term 'software' referred to software and that the expression 'other companies' referred to the companies which were the proprietors of the software which was the subject of the support services in question.

28 In so far as the applicant claims that the term 'we' is vague, results in a personalisation which gives the impression that it is the services which support and contribute towards the originality of the sign at issue and the distinctiveness of the international registration, it is sufficient to point out that, according to the case-law, the word 'we', when it is used in slogans, generally refers to the service provider (see, to that effect, judgments of 24 April 2018, *VSM v EUIPO (WE KNOW ABRASIVES)*, T- 297/17, not published, EU:T:2018:217, paragraphs 39 to 41, and of 13 May 2020, *Koenig &*

Bauer v EUIPO (we're on it), T- 156/19, not published, EU:T:2020:200, paragraph 38). Consequently, the term 'we' has a clear meaning and does not, moreover, confer any originality on the contested international registration.

29 Secondly, as regards the meaning of the sign at issue as a whole, the Board of Appeal also did not err in finding in paragraphs 17 to 19 of the contested decision that the contested international registration would be understood by the relevant public, in context and in relation to the words of which it consists, in particular the words 'other companies do software', as meaning that the holder of the international registration provides advice and support with regard to software which is created by other companies, and that that meaning was nothing more than the sum of each of the terms of which that international registration consists.

30 The applicant's line of argument that the expression 'we do support' leaves open the question of the manner in which the support is provided and that the phrase 'other companies do software' is vague, in that it does not make it possible either to understand what 'other companies' refers to or the difference between the terms 'software' and 'support', does not call that analysis into question.

31 First, it must be pointed out that, since the relevant public is not very attentive to a sign the semantic content of which is merely promotional information of a rather general nature, it will not take the time either to enquire into the various possible functions of the group of words or to commit it to memory as a trade mark (see, to that effect, judgment of 5 December 2002, *Sykes Enterprises v OHIM (REAL PEOPLE, REAL SOLUTIONS)*, T- 130/01, EU:T:2002:301, paragraph 29).

32 Secondly, it must be stated that the relevant public will perceive the contested international registration as a whole and will not examine its various details. Consequently, those terms will not be perceived in isolation, but as part of that international registration. Furthermore, it must be stated that, contrary to what the applicant submits, where it precedes the term 'support', the term 'do', which means to do something, necessarily refers to the services provided by the applicant. It therefore follows that, contrary to what the applicant claims, the term 'do' has a specific meaning which is connected with the term 'support' at the end of the sign at issue and that that latter term gives an unambiguous indication of the services which the applicant provides, namely those of support and assistance with regard to software created by other companies. Furthermore, in the light of the analysis in paragraph 29 above, it must be held that the expression 'other companies' necessarily refers to companies, other than the applicant, which produce software (do software). It therefore follows that, in that context, the term 'software' is completely unambiguous and, contrary to what the applicant claims, that term is clearly distinct from the term 'support'.

33 Consequently, the meaning on which the Board of Appeal relied is based on the ordinary meaning of the word elements of which the contested international registration consists, which constitute common English words, and on the basic rules of English grammar and syntax. The combination of common English words in a single sign, which complies with the rules of English grammar, conveys a clear and unequivocal message, which is immediately perceptible and which, contrary to the applicant's arguments, does not require any interpretative effort on the part of the average English-speaking consumer (see, by analogy, judgment of 13 July 2022, *WE DO SUPPORT*, T- 634/21, not published, EU:T:2022:459, paragraph 35 and the case-law cited).

34 Consequently, the relevant English-speaking public will break down the expression 'other companies do software we do support' into two sentences between which there is a logical

connection, namely ‘other companies do software’ and ‘we do support’, which have a clear meaning for that public and which are grammatically correct, in accordance with what was stated in paragraphs 18 and 19 of the contested decision. The applicant’s argument that, in essence, the grammatical structure of the contested international registration and the repetition of the verb ‘do’ contribute towards conferring distinctive character on it must therefore also be rejected.

35 In view of the foregoing, it must be held that the Board of Appeal did not err in finding that the message conveyed by the contested international registration was clear and that understanding it did not require any cognitive effort on the part of the relevant public.

36 The other arguments on which the applicant relies in order to demonstrate the lack of clarity of the message conveyed by the sign cannot cast doubt on the foregoing finding.

37 First, as regards the applicant’s argument that the Board of Appeal acknowledged, in essence, that the contested international registration could have several meanings, but did not take account of the fact that those meanings are not obvious without the addition of other words, it must be pointed out that, contrary to what the applicant claims, the Board of Appeal did not agree with that argument. In paragraph 22 of the contested decision, the Board of Appeal confined itself to stating, correctly, that each of the interpretations suggested by the applicant would be perceived as a laudatory slogan which was devoid of any distinctive character. Furthermore, it must be pointed out that, as is apparent from paragraph 29 above, the contested international registration will be perceived by the relevant public as meaning that the holder of the international registration provides advice and support with regard to software which is created by other companies. It must therefore be held that the meanings suggested by the applicant, which diverge from that perception, are not immediately plausible or immediately perceptible to the average consumer.

38 Secondly, as regards the applicant’s argument that the contested international registration is set out on two lines, it must be borne in mind that that international registration concerns a word sign (see paragraph 27 above) and that the applicant cannot therefore claim any particular configuration or arrangement of the elements which comprise it. The protection offered by the registration of a word mark applies to the words stated in the application for registration and not to the particular graphic or stylistic aspects which that mark might have (see, by analogy, judgment of 31 January 2013, *Present-Service Ullrich v OHIM – Punt Nou (babilu)*, T- 66/11, not published, EU:T:2013:48, paragraph 57 and the case-law cited). Moreover, the applicant has not explained the extent to which the setting out of the contested international registration on two lines confers distinctive character on it.

39 In view of the foregoing, it must be held that the Board of Appeal’s assessment regarding the perception of the contested international registration is not vitiated by any error.

40 In the third place, as regards the distinctive character of the contested international registration as regards the services in question, the Board of Appeal found in paragraph 25 of the contested decision that there was nothing in that international registration that, beyond its obvious promotional meaning, the sole function of which was to highlight the positive aspects of the services in question and to attract customers, enabled the relevant public to memorise the word sequence easily and immediately as a distinctive trade mark for the contested services.

41 The applicant submits that the contested international registration has sufficient distinctive character as regards the services in question. Relying on the case-law, it argues that the mere fact that a mark may serve as a laudatory slogan does not per se exclude it from also being capable of serving as a distinctive indication of commercial origin and that therefore it would be incorrect to impose higher requirements in relation to the distinctiveness of such a slogan than in relation to any other kind of mark.

42 EUIPO disputes the applicant's arguments.

43 In that regard, it must be stated that it is apparent from the foregoing that the contested international registration conveys a clear message to the relevant public with regard to the services in question. As regards computer software consulting services and technical support services relating to computer software, the contested international registration will be perceived by the relevant public as indicating that the holder of that sign provides advice and support with regard to software which is created by other companies. That international registration expresses the idea that its holder will deal with computer software support by providing, for example, advice and technical support, such as the maintenance of computer software or the troubleshooting of computer software problems, if the customer needs it, and that the services in question will be perceived as reliable and trustworthy since the provider will assist the customer.

44 The relevant public will therefore naturally perceive the expression 'other companies do software we do support' as a mere promotional formula or a slogan which is intended to highlight the positive qualities of the services which it is used to present and, therefore, of the provider of those services. In so doing, contrary to the applicant's arguments, the sign at issue does not display any originality or resonance, requiring at least some interpretation by the relevant public, or setting off a cognitive process in the minds of that public, within the meaning of the case-law which has been referred to in paragraph 18 above, and is not capable of indicating to the consumer the commercial origin of the services in question.

45 Consequently, the contested international registration is devoid of any distinctive character with regard to the services in question and the Board of Appeal was right in finding that it was devoid of any distinctive character pursuant to Article 7(1)(b) of Regulation 2017/1001, read in conjunction with Article 7(2) of that regulation, and in rejecting the application for protection in the European Union on the basis of Article 7(1)(b) of Regulation 2017/1001.

46 It follows that the single plea in law must be rejected and the action must therefore be dismissed in its entirety.

Costs

47 Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

48 Since the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by EUIPO.

On those grounds,

THE GENERAL COURT (Seventh Chamber)

hereby:

1. **Dismisses the action;**
2. **Orders Rimini Street, Inc., to pay the costs.**

Kowalik-Bańczyk

Dimitrakopoulos

Ricziová

Delivered in open court in Luxembourg on 15 February 2023.

E. Coulon

M. van der Woude

Registrar

President

* [Language of the case: English.](#)