

Review

Intellectual Property

BioMonitor receives harsh treatment at CFI

In case T-257/08 Biotronik GmbH & Co. v OHIM (9 July 2009) Biotronik applied for registration of BioMonitor as a CTM for goods and services in classes 9, 10 and 38. OHIM refused the application on the grounds that it was purely descriptive, in particular for consumers in German or English-speaking countries of the EU. Biotronik appealed to OHIM's 4th Board of Appeal which upheld the refusal.

Biotronik appealed further to the CFI, raising two grounds in support of its application:

- i) that the mark was not descriptive; and
- ii) that the mark had distinctive character.

The CFI noted that the mark would be descriptive if there was a link which, for the relevant public, immediately brought to mind the goods and services in question and/or their characteristics. The goods listed in the application were specialist medical apparatus which analysed vital body functions and were aimed at professional use. As a result, the CFI felt that the relevant public was medical professionals, and more specifically doctors, private clinics and hospitals. The CFI also felt that, since the grounds for refusal were only raised in respect of two languages, namely, English and German, the relevant public would be limited to German or English speakers.

Having isolated the relevant public, the CFI considered the mark itself, which consisted of two words in juxtaposition with each other, i.e. bio and monitor. First, it noted that 'bio' was a prefix of Greek origin, meaning 'biology', 'biological' or 'to do with living organisms'. Second, the word 'monitor' meant 'to observe, supervise, measure or test at regular intervals' in English whilst in German, it meant a technical device, relating to control or supervision. The juxtaposition of the two words to create the word "biomonitor" would therefore indicate some kind of medical apparatus which dealt with biological data.

The CFI admitted that although a juxtaposition of two descriptive words was, in principle descriptive, if it formed a coined term due to the unusual combination, the mark could be registered. In the present case, the word 'biomonitor' was not considered to be of unusual character; the capital 'M' in the middle of the word was

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negligible, did not have any particular creativity and the juxtaposition of the words conformed to the grammatical rules in English and German.

As a result, the CFI held that the relevant section of the public would consider the word 'biomonitor' descriptive of a medical device able to control or supervise body functions. It was noted that the goods in question often required technical devices, such as monitors, and the mark was therefore clearly descriptive.

Further, Biotronik's argument that the word 'biomonitor' would be registrable in the UK and had already been registered in Switzerland was considered immaterial. The CFI highlighted, yet again, that the EU regime was autonomous in its application and independent of any national system.

On the basis that the applicant's mark was descriptive of the goods and services listed in class 10, the CFI rejected Biotronik's appeal and the registration of 'BioMonitor' was refused. The Court held that there was no need to consider the second limb of Biotronik's argument, since Article 7 prohibited registration if any one of the grounds was fulfilled.

This decision reflects the CFI's willingness to uphold the public interest element of Article 7 which seeks to enable free use of marks which describe or characterise goods or services. Applicants would do well to ensure that any mark which might be viewed as descriptive or non-distinctive incorporates a different spelling, unusual grammar or a logo element to make it more distinctive and override the descriptiveness.

FURTHER INFORMATION

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