

# Review

## Intellectual Property

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## CFI does not buy BEST BUY

Case T-476/08 Media-Saturn-Holding GmbH v OHIM (15 December 2009). On upholding an OHIM Board of Appeal decision refusing the registration of trade mark application BEST BUY and device for goods and services in 25 classes for being non-distinctive under Article 7(1)(b), the CFI has confirmed that BEST BUY and device is a common expression understood by the relevant public to indicate the advantageous price of products or services when compared to their market value.

### BACKGROUND

Media-Saturn-Holding GmbH (“Saturn”) filed a CTM for BEST BUY and device for various goods and services. The OHIM examiner refused the application on the basis of Article 7(1)(b) stating that the expression consisted of common English terms which referred solely to a bargain in relation to the designated goods and services. Confirming the examiner’s decision on appeal, the Board of Appeal held that BEST BUY and device was devoid of distinctive character. Saturn appealed to the CFI.

### SATURN’S ARGUMENTS

In its appeal, Saturn claimed that the mark applied for had the minimum degree of distinctive character, that its graphical presentation was not common in advertising, particularly in view of the original presentation of the letter B at the beginning of both words Best and Buy and therefore that the public would perceive the commercial origin of the goods and services. Saturn also claimed that the examiner did not submit evidence showing that the expression was commonly used in advertising and devoid of distinctive character.

### CFI JUDGMENT

Rejecting Saturn’s appeal, the CFI referred to decision T-122/01 Best Buy Concepts/OHIM (BEST BUY), where the CFI stated that the mark BEST BUY and device consisted of two common English words referring to an advantageous relation between the price of the designated services and their market value, that the relevant public would perceive immediately the expression as a promotional formula or a slogan indicating that the services were offered as the best purchase or the best bargain and that the fact that the two elements were juxtaposed did not mean that the

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**BEST BUY** was commonly understood by the public to indicate advantageously priced products

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omission of an article was sufficient to make it an inventive expression which would be liable to give it a distinctive character.

In the present case, the CFI stated that the public would exclusively consider the expression as an indication of the advantageous relation between the quality and the price and not as the indication of the commercial origin of the goods and services. The fact that the application was filed for a broad range of goods and services emphasized the lack of distinctive character of the expression.

The CFI also stated that the rectangle was a simple geometric shape which only highlighted the commercial nature of the message and did not give additional distinctive character insofar as the presentation of a slogan was made to attract visually the attention of the public.

Regarding the prominence of the letter B, the CFI stated that, despite the fairly unusual presentation of BEST BUY, promotional slogans in supermarkets usually appeared with a device. The fact that the letter B was placed at the beginning of both words in the mark was not sufficient to give distinctive character and the public would understand that the letter B would be common to both words. The use of an ordinary font did not add any distinctive character either.

Regarding the applicant's argument in respect of the absence of evidence of the alleged ordinary character of the mark applied for in the advertising sector and the subsequent lack of distinctive character of the mark, the CFI held that the Board of Appeal had demonstrated to the requisite legal standard that there was a lack of distinctive character in relation to the designated goods and services.

The CFI stated that since Saturn claimed that the mark applied for was distinctive, despite the analysis of the Board of Appeal based on clear and convincing reasoning, it was for Saturn to provide specific and substantiated information, showing that the trade mark applied for had a distinctive character per se, given that Saturn had a better knowledge of the market.

## COMMENT

This decision is not surprising and follows the reasoning of decision T 122-01, confirming that a promotional message framed in a rectangle does not have sufficient distinctive character to be a badge of origin. The CFI has put into a commercial context the use of the mark applied for by highlighting the fact that promotional slogans used in supermarkets are usually combined with a device.

This decision also raises the issue of applications by retailers which attempt to protect a mark in relation to numerous goods and services. The CFI considers that filing for a broad range of goods and services emphasized the lack of distinctive character of the mark applied for. It would be interesting to know why the variety of designated goods and services was said to have an influence on the degree of distinctiveness of a mark at the time of the filing.

## FURTHER INFORMATION

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