

The General Court (GC) has confirmed a decision of OHIM's Second Board of Appeal (BoA), concerning the CTM designation of a WIPO International Registration of the following mark:

**PERLE'**

covering wines and sparkling wines, amongst other goods, in Class 33. The GC confirmed that the mark did not satisfy the absolute grounds for registration under Article 7(1)(b) and (c) CTMR as it was descriptive and therefore not distinctive in respect of wines and sparkling wines.

The evidence that had been submitted by the applicant in an attempt to overcome the objection by demonstrating that the mark had acquired distinctive character in the relevant member states was not sufficient, as it did not cover all of the territories in which the mark was deemed descriptive in relation to the designated goods.

#### 1. Application of Article 7(1)(b) and (c) CTMR

On the basis that the term "perlé" is used to describe lightly sparkling wines, the GC confirmed the BoA's decision that PERLE' would be perceived by the general public as denoting a characteristic of wines and sparkling wines, and therefore was not distinctive, as consumers would not be able to identify the origin of the product on the basis of the mark.

The GC confirmed that, by directly designating, or referring to a characteristic of the goods and/or services covered, a mark is incapable of identifying the origin of these goods and/or services to the relevant public, and must be refused registration under Article 7(1)(c).

The GC found that the mark PERLE' was substantially identical to the term "perlé", for the general public to directly perceive, without further reflection, the mark as indicating a characteristic of the wines and sparkling wines covered by the application. The GC found that the word "perlé" was used to describe a lightly sparkling wine. The use of an apostrophe instead of an acute accent on the final "e" of the mark did not make it distinctive. The GC confirmed the view of the BoA that the addition of an apostrophe was highly reminiscent of the acute accent on the final "e" of "perlé", and that the relevant public would still perceive the mark as designating a characteristic of the wines and sparkling wines covered by the mark applied for.

In this case, the "relevant public" was defined as consumers of wines and sparkling wines. This included wine professionals and the general public who speak English and French, as the term "perlé" appears in English and French vocabulary. The GC indicated that there was an English and French cultural aspect to wine, a great proportion of the public were average wine consumers with a knowledge of wine, and they would understand the meaning of the term "perlé".

Even where the average consumer did not understand the meaning of the term, it would often purchase wine with the assistance of a wine professional, who would understand the meaning of the term and provide necessary guidance. In addition, the term "perlé" is defined in dictionaries and on the internet, so the average consumer would readily have access to the meaning of the mark. Therefore, the GC deemed that it would be reasonable to acknowledge public awareness of the meaning of "perlé", in relation to wines.

The GC stressed that a descriptive mark does not, at the time of registration, have to be effectively used to designate the goods and/or service covered by an application, it is enough that it could be used to do so. Equally, even where there are terms other than the mark to describe the designated goods and/or services, or where a mark has meanings other than the descriptive one, it will still be considered descriptive.

The GC dismissed the appeal under Article 7(1)(b) and (c), on the grounds that the mark applied for, which was substantially identical to the term "perlé", was descriptive of sparkling wines, could not indicate the origin of the designated goods to the relevant consumer, and therefore should be refused.

#### 2. Acquired Distinctiveness under Art 7(3) CTMR

The GC dismissed the applicant's arguments that the BoA had not properly considered the evidence of acquired distinctiveness that it had submitted.

The GC stated that to show that a mark has acquired distinctive character, the evidence must demonstrate this in relation to a significant proportion of the relevant public, in all territories where the mark is deemed to lack distinctive character. In this case, the mark was found to be descriptive in respect of French and English speaking consumers, and therefore in the UK, France, Belgium, Luxembourg, Malta and Ireland. As the applicant had only submitted evidence relating to the UK and France, this was deemed insufficient to demonstrate that the mark had acquired the necessary distinctive character to overcome this objection.

Therefore, the GC dismissed the appeal under Art 7(3)CTMR, and the application was refused in respect of *wines and sparkling wines*.

#### Comment

This judgment is not particularly surprising in view of the similarity between the mark applied for and a clearly descriptive term. However, it does provide a useful reminder that evidence of acquired distinctiveness must address the entire geographical area to which it is deemed applicable.

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