

EUIPO Board of Appeal confirms refusal of mark consisting of sequence of numbers

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Legal updates: case law analysis and intelligence

- The sequence of numbers from 0 to 23 on three lines, when applied to the goods/services at issue, would not easily and instantly be recalled as a distinctive sign
- The examination of absolute grounds for refusal may not consist solely of the repetition of allegedly comparable decisions
- A trademark applicant may not rely, for their own benefit and in order to secure the same decision, on a possible mistake

In a decision of 2 May 2023 in [MARGIELA](#) (Case R 1967/2022-1), the First Board of Appeal of the European Union Intellectual Property Office (EUIPO) has upheld the refusal to register a figurative mark consisting of the numbers 0 to 23 on three lines for lack of distinctiveness in relation to goods and services in Classes 4, 11, 21 and 35.

Background

The case started when MARGIELA filed an application for an EU trademark (EUTM) for the following figurative mark, covering a broad list of goods in Classes 4, 11 and 21, primarily related to candles and lighting, and for retail services of such goods (and other goods) in Class 35:

0 1 2 3 4 5 6 7 8 9
10 11 12 13 14 15 16
17 18 19 20 21 22 23

This application was refused on absolute grounds, namely that the mark was devoid of distinctiveness pursuant to Article 7(1) (b) of [Regulation 2017/1001](#). The examiner's reasoning was as follows:

- The applicant could not rely on certain prior case law (CJEU's decision in [Case C-51/10 P](#)), since the trademark application at issue was refused on the basis of Article 7(1)(b), and not on the basis of Article 7(1)(c) of the regulation.
- The relevant consumers would perceive the sign applied for as a listing of the product/article number sold by the applicant or, for example, as a barcode on a product.
- The applicant's attempt to refer to earlier EUTM registrations did not amount to a violation of the principle of non-discrimination, or a reason for invalidating a decision which *per se* appeared to be reasonable and conformed to the regulation as interpreted by the EU judicature

MARGIELA appealed, presenting, among others, the following arguments:

- The CJEU's judgment in C-51/10 P held that signs composed exclusively of numerals with no graphic modifications may be registered as trademarks. Therefore, a numeral may be registered as a trademark provided that it is not descriptive or non-distinctive for the goods and services concerned.
- The sign applied for presented no connection with the goods and services, since it was composed by all the numbers from 0 to 23 - including 0 that could not be connected to quantities of products or services.
- The sign applied for would be perceived as a figurative trademark composed of numbers positioned on three separate lines, one above the other, and not as a mere enumeration of numbers.
- The applicant's series of numbers was the subject of at least eight EU registrations (such as the one below) that differed from the sign applied for only by the presence of a circle on a number, which is different in each registration.

0 1 2 3 4 5 6 7 8 9
10 11 12 13 14 15 16
17 18 19 20 21 22 23

- In the light of the principles of equal treatment and sound administration, the EUIPO must take into account the decisions already taken in respect of similar applications and must carefully consider whether or not it should decide in the same way.

Decision

The First Board of Appeal of the EUIPO did not buy these arguments, holding as follows:

- The sign at issue would likely be perceived by the relevant public as a pre-printed tag/label to be affixed.
- There must be certain aspects of the signs at issue which may be easily and instantly memorised by the relevant public and which would make it possible for those signs to be perceived immediately as indications of the commercial origin. However, the sequence of numbers from 0 to 23 on three lines, when applied to the goods and services for which protection was sought, would not easily and instantly be recalled by the relevant public as a distinctive sign.
- The goods at issue are sold in physical stores, but the mark applied for cannot be verbally communicated in such stores.
- The examples of use related to goods in Classes 14, 18 and 25, which are different business sectors.
- As regards the examples of earlier trademark registrations relied on by the applicant, including the one above and the identical mark registered in Classes 3, 8, 9, 11, 14, 16, 18, 24, 25 and 27, each case must be decided on the basis of its own facts. The examination of absolute grounds for refusal must be complete and rigorous and may not consist solely of the repetition of allegedly comparable decisions or cases. The principle of equal treatment must be reconciled with respect for legality. Each case is thus assessed on the basis of its individual factual circumstances, which does not make it mandatory to require the conditions of another case to be applied. A person filing an application for a trademark may not rely, for their own benefit and in order to secure the same decision, on a possible mistake.

Comment

This decision is in line with current EUIPO policy concerning the non-binding nature of prior decisions, which can be considered as "mistakes". But where is the legal certainty, for all involved? When the same proprietor has previously registered eight very comparable EUTMs, one wonders where the "mistake" was made in this case. It is hoped that this decision will be appealed further, in that it is a very clear example of when a trademark applicant ought to be able to rely on the principles of legal certainty and non-discrimination.

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