



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

The Boards of Appeal

**DECISION
of the Second Board of Appeal
of 19 July 2006**

In Case R 450/2006-2

Hormel Foods Corporation

1 Hormel Place

Austin,

Minnesota 55912-3680

United States of America

Applicant / Appellant

represented by Lorenz Seidler Gossel, Widenmayerstr. 23, D-80538 München,
Germany

APPEAL relating to Community trade mark application No 4 202 255

THE SECOND BOARD OF APPEAL

composed of T. de las Heras (Chairman), M. Bra (Rapporteur) and D.T. Keeling
(Member)

Registrar: E. Gastinel

gives the following

Decision

Summary of the facts

- 1 By an application filed on 17 December 2004, Hormel Foods Corporation (hereinafter ‘the applicant’) sought to register the word mark

SPAM

as a Community trade mark (‘CTM’) for the following list of services, as amended in the course of the proceedings:

Class 36 - Economic consultancy, particularly in combination with network services; providing of expertise, engineering services and computer programming; economic consulting services.

Class 38 - Services to avoid or suppress unsolicited e-mails.

Class 42 - Creation and maintenance of computer software; technical consultancy, particularly in combination with network services; providing of expertise, engineering services and technical consulting services.

- 2 By letter dated 14 July 2005, the examiner informed the applicant that the trade mark did not appear to be eligible for registration for the services applied for under Article 7(1)(b) and (c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (hereinafter ‘CTMR’) (OJ EC 1994 No L 11, p. 1; OJ OHIM 1/95, p. 52). The examiner stated that the mark consists exclusively of a descriptive term used in trade, which refers directly and unequivocally to characteristics of the services applied for. The term SPAM means amongst others ‘irrelevant or inappropriate messages sent on the Internet to a large number of users’ (*Compact Oxford English Dictionary*); or ‘unsolicited usually commercial e-mail sent to a large number of addressees’ (*Merriam Webster Online Dictionary*). When applied to the services applied for, the mark will be immediately perceived as a descriptive indication of their object or their intended purpose. In addition, being primarily descriptive, the mark is devoid of any distinctive character.
- 3 On 14 September 2005, the applicant filed observations in which it disputed the examiner’s view that the mark was not eligible for registration. Its arguments may be summarised as follows:
 - The sign SPAM is neither incapable of performing the essential function of a trade mark nor does it lack a minimum degree of distinctiveness.
 - The services at issue are not exclusively directed at a specialised public but in fact, at the public at large. The relevant public is the average English-speaking customer normally well-informed and reasonably attentive.
 - It is doubtful that the average consumer is aware that the term SPAM might be used in the sense which has been quoted by the Office. Such customers would define unwanted emails as ‘junk’ or ‘trash’ messages.
 - Moreover, SPAM has other meanings (it may also refer to a kind of canned spicy ham or to a movie) which would be more evident to the average consumer. The term does not enable the targeted public to detect immediately

and without further reflection, the description of a characteristic of the service in question.

- Even if SPAM were recognised as a term for ‘unsolicited commercial e-mails’, it would not be recognised as a description for exactly the services that are claimed.
- 4 By letter of 2 February 2006, the examiner informed the applicant of his decision (hereinafter ‘the contested decision’) that the application was not eligible for registration on the grounds stated in his previous letter. In reply to the applicant’s submissions, the examiner further added:
- In this case the relevant consumers cannot be simply defined as the public at large. On the one hand, the applicant has claimed protection in respect of services for which the relevant public is composed at least of consumers with a certain degree of specialisation or interest, such as the services applied for in Class 38, which address only professionals or, at least, persons familiar with the way of managing messages through the Internet. As far as the services in Class 42 are concerned, it is noted that in accordance with its general heading, this class includes mainly services in relation to complex fields of activities, provided by engineers, physicists, etc. The relevant consumer of such services is not the average consumer, given that there is no objective need for an average individual to make use of these professional’s services, unless under certain and specific circumstances. The relevant public, for the services at issue is composed of professionals or, at least, consumers with a certain degree of specialisation or interest.
 - A search in the Internet through Google for the term SPAM revealed 214.000.000 hits. The same search gives 199.000.000 hits excluding the name ‘Hormel’. Thus it appears that the term SPAM is widely known in relation with the meaning given in the previous communication. It is also true that the word SPAM has other meanings. However, this does not exclude the possibility that one meaning may result more evident in some contexts. The most evident meaning of the term SPAM for the consumers of the services at issue will certainly be ‘unsolicited usually commercial e-mail sent to a large number of addressees’ rather than a designation for canned spicy ham or a reference to a television movie. It is reminded that a word must be refused registration under Article 7(1)(c) CTMR if at least one of its possible meanings designates a characteristic of the goods or services concerned.
 - The abuse of the electronic communications medium to send unsolicited messages in bulk has become a growing concern for public authorities and for private companies. Therefore, it is not possible to understand the applicant’s contention that the services like ‘economic consulting’ or ‘providing of expertise, engineering services and technical consulting services’ simply have nothing at all to do with SPAM. The massive reception of unsolicited messages is certainly not a domestic problem but has specific consequences for both private and public economies. The term SPAM in relation to the services applied for in Classes 36 and 42, will be understood as an obvious direct reference that the ‘economic consulting services’ deal,

for instance, with the impact of unsolicited messages on the productivity of a company, or that ‘technical consulting services’ are simply focused on that problem, for instance, seeking to install barriers to prevent the reception of such e-mails.

- It is true that the term SPAM as such designates ‘electronic messages’ and not a service to suppress them. However, when confronted with the word in relation to the services applied for in Class 38, the relevant consumer will immediately understand that what is sought is precisely to avoid or suppress unsolicited emails. Thus the mark is descriptive.
- 5 On 31 March 2006, the applicant filed a notice of appeal against the contested decision. The statement of grounds was filed on 2 June 2006.
 - 6 The appeal was submitted to the examiner for revision pursuant to Article 60 CTMR and was remitted to the Boards of Appeal on 29 June 2006.

Grounds of appeal

- 7 The applicant requests that the contested decision be set aside and that the application be allowed to proceed to registration. Its arguments may be summarised as follows:
 - The services at issue are not exclusively directed at ‘professionals’ or ‘consumers with a certain degree of specialization or interest’. As acknowledged in the contested decision, the services in Class 42 are also directed to general consumers, at least under certain circumstances. It is illegitimate to narrow the circle of relevant consumers to ‘professionals’ familiar with computers or ‘electronic messaging’. Economic consulting services, engineering services and technical consulting services may be provided without being directly related to computers and to customers without any expertise in this area.
 - It cannot be assumed that the average English-speaking customer (or even someone with a certain degree of interest) would be familiar with computers and electronic messaging in such a way that he would be aware that SPAM designates ‘irrelevant or inappropriate messages sent on the internet to a large number of users’ or ‘unsolicited usually commercial email sent to a large number of addresses’. Although computers are well established today, computer users are not necessarily familiar with technical aspects and phenomena such as ‘trash messages’. The relevant consumer does not understand SPAM as being purely a descriptive term for unsolicited commercial e-mails.
 - Even if the word SPAM was recognised as a term for ‘unsolicited commercial emails’, it would not be recognised as a description for the services applied for in Classes 36 and 42. Services like ‘economic consulting’, may be unrelated to computers (and unsolicited commercial e-mail). Thus SPAM cannot be considered as being descriptive for such services. It is also not descriptive for services such as ‘creation and maintenance of computer software’ because the designation describes, in the Office’s opinion,

messages and not software programmes or even the creation and maintenance of such programmes. A software developer's services are totally different from unsolicited emails (which are not even services). Most of the services applied for are neither directly, nor specifically related to spam e-mail, as defined by the Office.

- In any case, the Office concedes that the terms, as such, SPAM is seen as 'electronic messages' and is not a service to suppress them. Therefore, it must be acknowledged that such a term cannot be exclusively descriptive for the services in question.

Reasons

- 9 The appeal complies with Articles 57, 58 and 59 CTMR and Rule 48(1) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark ('CTMIR') (OJ EC 1995, No L 303, p.1; OJ OHIM 2-3/95, p. 258). It is therefore admissible.
- 10 Pursuant to Article 7(1)(c) CTMR, trade marks which consist exclusively of signs or indications which may serve in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services, should not be registered.
- 11 By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) CTMR pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved for one undertaking alone because they have been registered as trade marks (see, *inter alia*, judgment of the Court of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger* ('Chiemsee') [1999] ECR I-2779, at paragraph 25).
- 12 The signs and indications referred to in Article 7(1)(c) CTMR are those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned (see judgment of the Court of 23 October 2003 in Case C-191/01 P *OHIM v Wm. Wrigley Jr. Company* ('Doublemint') [2003] ECR I-12447, at paragraph 32).
- 13 Moreover, a word mark which is descriptive of the characteristics of the goods or services for the purposes of Article 7(1)(c) of CTMR is, on that account, necessarily devoid of distinctive character with regard to the same goods or services for the purposes of Article 7(1)(b) CTMR (see, by analogy judgment of the Court of 12 February 2004 in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* ('Postkantoor') [2004] ECR I-1619, at paragraph 86).

- 14 The distinctiveness or descriptiveness of a trade mark must be assessed, firstly, in relation to the goods or services in respect of which registration of the sign is applied for and, secondly, in relation to the perception of the section of the public which consists of average consumers of the products or services in question, who are reasonably well informed and reasonably observant and circumspect (see judgments of the Court of First Instance of 27 February 2002 in Case T-219/00 *Ellos AB v OHIM* ('Ellos') [2002] ECR II-753, paragraph 29, and of 27 November 2003 in Case T-348/02 *Quick restaurants SA v OHIM* ('Quick') [2003] ECR II-5071, at paragraph 29).
- 15 In this case, the services at issue are directed either at a specialised public essentially made up of professionals (e.g. 'economic consultancy, particularly in combination with networking services'; 'economic consulting services'), or at the very least, a public consisting of individuals who are familiar with the use of computers ('providing of expertise, engineering services and computer programming', in Class 36; 'creation and maintenance of computer software', in class 42;) and interest in networking and electronic communications ('services to avoid or suppress unsolicited e-mails', in Class 38; 'technical consultancy, particularly in combination with network services; providing of expertise, engineering services and technical consulting services', in Class 42). Although it cannot be excluded that a general consumer without having any particular expertise might also on some occasions, make use of services such as those applied for in Class 42, this seems quite exceptional, be it only for the cost of such services which aim to solve complex problems by highly qualified professionals, such as engineers or specialised technicians. Thus it cannot be assumed that a significant part of the end-users of the services applied for are average general consumers, without expertise nor particular interest in these areas.
- 16 Moreover, since the mark applied for is an English word, the relevant public is the English-speaking public.
- 17 The applicant does not dispute that the word SPAM means, *inter alia*, 'unsolicited commercial e-mail sent to a large number of users' or 'irrelevant or inappropriate messages sent on the Internet to a large number of users', as stated by the examiner. However he contends that the word SPAM also has other meanings (e.g. 'sort of canned spicy ham' or a 'movie character') which would be more evident to the relevant consumer who according to the applicant, is the average general consumer.
- 18 The applicant's contention that the word SPAM would not be understood by a large part of the average English speaking public in the sense given by the examiner, cannot be sustained. Indeed, the Board notes that the term SPAM is not only listed in technical dictionaries as a technical term for 'unsolicited commercial e-mail' (see *McGraw-Hill Dictionary of Scientific and Technical Terms* <http://www.xreferplus.com/entry.jsp?volid=369>) but is also cited in general dictionaries, quoted by the examiner in his letter of 14 July 2005 (see above, paragraph 2). Moreover, it appears from the Internet search carried out by the examiner that the term SPAM is widely used on the internet and is widely known in the sense given by the examiner.

- 19 Therefore, to the average individual familiar with the use of computers, *inter alia* for communication purposes -and *a fortiori* to professionals in field of activities which make extensive use of communication tools and networking- the expression SPAM unambiguously indicates that the goods or services are intended to guarantee SPAM-free communication. Thus the word SPAM seems particularly suitable to describe a characteristic of the services applied for, which is essential to the user, contrary to the applicant's contention.
- 20 The mere fact that the word SPAM may have various meanings in common parlance and could be understood in a different sense in other contexts, is not sufficient to overcome the objection based on Article 7(1)(c) CTMR, when this term is used with regard to the services at issue.
- 21 To the relevant public, the sign would immediately and without any particular effort of analysis, be understood as referring to the intended purpose of the services, *i.e.* to guarantee SPAM free communications and not as an indication of commercial origin. In the Board's view, the message expressed by the sign applied for is clear, direct and immediate to the relevant consumer.
- 22 The applicant argues that many of the services applied for are not related to SPAM free communications or with services that could be described by the word SPAM and that in any case, the word SPAM describes a thing (*i.e.* an 'e-mail') and not a service.
- 23 The Board notes, however, that the sign SPAM is directly descriptive of the purpose of the services applied for in Class 38 which aim 'to avoid or suppress unsolicited e-mails'.
- 24 As regards the services applied for in Classes 36 ('economic consultancy, particularly in combination with network services; providing of expertise, engineering services and computer programming; economic consulting services') and Class 42 ('creation and maintenance of computer software; technical consultancy, particularly in combination with network services; providing of expertise, engineering services and technical consulting services'), it is true that the broad headings employed by the applicant could include services which do not have the purpose of guaranteeing SPAM-free communications. However, since the applicant has sought registration for all sorts of services which can be specifically provided within the scope of providing SPAM free communications or to evaluate and reduce the economic impact of SPAM on the working environment, without specifying any particular goods falling outside this band, the Board has no option but to refuse its registration in full (see judgment of the Court of First Instance of 20 March 2002 in Case T-355/00 *DaimlerChrysler AG v OHIM* ('Tele Aid') [2002] ECR II-1939, at paragraph 34).
- 25 The relevant consumer is likely to be familiar with basic vocabulary used in relation to communications through the Internet. They will therefore immediately perceive SPAM as an indication of the object or purpose of the services concerned.
- 26 In the absence of any additional element, the sign applied for lacks any fanciful element and is thus devoid of the minimum degree of distinctive character required, given that it will be understood by the relevant public merely as an

indication of the object or purpose of the services applied for, and not as a mark fulfilling the function of indicating the commercial origin.

- 27 In light of the foregoing, the Board considers that the examiner rightly held that the word SPAM was descriptive and non distinctive for the services at issue and that it could not for this reason, be registered under Article 7(1)(b) and (c) CTMR.
- 28 The appeal is dismissed.

Order

On those grounds,

THE BOARD

hereby:

Dismisses the appeal.

T. de las Heras

M. Bra

D.T. Keeling

Registrar:

E. Gastinel