

**European Union** - Dr Helen Papaconstantinou John Filias & Associates

In *Maharishi Foundation Ltd v Office for Harmonisation in the Internal Market* (OHIM) (Cases T-412/11 and T-426/11, February 6 2013), the General Court has held that the marks TRANSCENDENTAL MEDITATION and MÉDITATION TRANSCENDENTALE were descriptive of the goods and services for which registration was sought.

On June 4 2009 Maharishi Foundation Ltd filed two Community trademark applications for TRANSCENDENTAL MEDITATION and its French version, MÉDITATION TRANSCENDENTALE, for "instructional and teaching material (except apparatus)" in Class 16, "education, providing of training, entertainment" in Class 41, "medical services, hygienic and beauty care for human beings" in Class 44 and "personal and social services rendered by others to meet the needs of individuals" in Class 45 of the Nice Classification.

In May 20 and 25 2010, respectively, both applications were rejected by the examiner on the grounds that:

- the marks were descriptive; and
- the applicant had not submitted proof that the marks had acquired distinctiveness through use in the relevant territories, namely Ireland, Malta and the United Kingdom for TRANSCENDENTAL MEDITATION, and Belgium and France for MÉDITATION TRANSCENDENTALE.

Maharishi Foundation appealed the decisions. The Board of Appeal found that:

- "instructional and teaching material" was directed only at professionals in the educational sector, whilst the rest of the services were directed at the general public;
- the relevant territories were not limited to the English or French-speaking countries, but to the majority of the EU members, where, due to the Latin origin of the two words making up the marks, consumers were likely to immediately understand the meaning of the words 'transcendental meditation' (in English and French) as "the action of meditating on issues

relating to a spiritual realm", and thus associate them directly with the goods and services at issue; and

- the two marks were devoid of distinctive character not only because a descriptive mark necessarily lacks distinctiveness, but also because it is not capable of performing the essential function of a trademark (ie, identifying the origin of the goods or services).

The Board of Appeal also stressed that, although 'transcendental meditation' refers to a specific technique invented by Maharishi Mahesh Yogi, the fact that it is the only way to refer to a particular meditation technique makes it a generic name which informs directly the public of the content of the goods and services applied for. The board thus held that the registration of the marks would result in conferring a monopoly on the technique itself. Finally, the board found that the examiner had erroneously restricted the relevant territory to the English and French-speaking countries and decided to remit the case to the Examination Division so that the applicant could submit additional evidence of acquired distinctiveness through use in other EU member states where English and French are understood.

Maharishi Foundation filed an action for annulment of the decisions before the General Court. OHIM raised a plea of inadmissibility of the action, claiming that it was not yet final, since the case had been remanded to the examiner, but left it to the court to decide whether an action could be brought against decisions disposing of the substantive issues only in part.

The court held that a party is not entitled to bring an action before the court if the Board of Appeal upholds its claims in their entirety. However, it rejected OHIM's plea, finding that, in the present case, the contested decision had not fully upheld the applicant's claims and had legal effects for it since:

- the Board of Appeal had confirmed the examiner's findings that the mark applied for lacked distinctive character; and
- the board's decision had significantly enlarged the relevant territory to all EU member states, except Bulgaria and Greece, thus making it necessary for the applicant to provide a larger amount of evidence to prove distinctiveness acquired through use.

The court then examined the applicant's claim that the Board of Appeal had erred in concluding that the marks applied for were generic. The court held that the Board of Appeal was correct since its decision was not based on Article 7(1)(a) of the Community Trademark Regulation (207/2009), but referred to 'transcendental meditation' as generic in order to show that it was descriptive and lacked distinctiveness.

Turning to the applicant's claim that the marks at issue were not descriptive, the court stressed that, for a mark to be considered as descriptive, there should be a sufficiently direct and specific relationship with the goods and services at issue to enable the public to perceive immediately a description of the category of goods and services or one of their characteristics. The court added that it is sufficient that at least one of the possible meanings of a word mark designates a characteristic of the goods or services.

The court then considered the enlargement by the board of the concept of 'relevant consumer'. After a thorough analysis of the perception of the words 'transcendental meditation', the court concluded that, because these words had a Latin origin, they would be understood in all the romance language countries of the European Union, with the only exception of Bulgaria and Greece, despite the inversion of the words in some of these languages and some differences both visually and with regard to pronunciation. Therefore, it confirmed OHIM's conclusion that even a consumer who does not speak English or French would be able to understand the meaning of the marks.

Upon examining the descriptiveness of the mark, the court questioned the applicant's claim that the word 'transcendental' does not belong to the everyday vocabulary of the average consumer and has a very particular meaning used in philosophy and mathematics. The court took the position that the board was correct in finding that 'transcendental meditation' would be understood by the average consumer as the action of meditating on issues relating to a spiritual realm. Although the court confirmed that 'transcendental meditation' does not describe the exact meditation technique at issue, it came to the conclusion that consumers would immediately understand the expression.

Based on the aforementioned conclusions, the court ruled that there was a sufficiently direct and specific relationship between the marks applied for and the goods and services for which registration was sought, as they could serve, in

trade, to indicate the subject-matter of the goods and services. The court also pointed out that, even if the public does not know exactly how meditation is practiced or what this particular method consists of, the marks would directly inform consumers about the content of the goods and services applied for.

Consequently, the court rejected the action in its entirety.

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