

Case T-379/03

Peek & Cloppenburg KG

v

**Office for Harmonisation in the Internal Market
(Trade Marks and Designs) (OHIM)**

(Community trade mark — Word mark Cloppenburg — Absolute grounds for refusal to register — Descriptive character — Geographical origin — Article 7(1)(c) of Regulation (EC) No 40/94)

Judgment of the Court of First Instance (Second Chamber, Extended Composition), 25 October 2005 II - 4636

Summary of the Judgment

- 1. Community trade mark — Appeals procedure — Appeals before the Community judicature — Procedural role of the Office — Right of the Office, although designated as the defendant, to support the applicant's claims — Application not devoid of purpose (Rules of Procedure of the Court of First Instance, Art. 133(2))*

2. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Marks composed exclusively of signs or indications which may serve to designate the characteristics of goods — Retail trade services mark — Word mark Cloppenburg*

(Council Regulation No 40/94, Art. 7(1)(c))

1. In appeal proceedings in the field of Community trade marks, whether those are proceedings involving, before a Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('the Office'), parties other than the applicant before the Court of First Instance or are proceedings involving only the applicant and the Office, while the Office does not have the requisite capacity to bring an action against a decision of a Board of Appeal, conversely it cannot be required to defend systematically every contested decision of a Board of Appeal or automatically to claim that every action challenging such a decision should be dismissed. Nothing prevents the Office from endorsing a head of claim of the applicant's or from simply leaving the decision to the discretion of the Court, while putting forward all the arguments that it considers appropriate for giving guidance to the Court. On the other hand, it may not seek an order annulling or altering the decision of the Board of Appeal on a point not raised in the application or put forward pleas in law not raised in the application. In addition, while the Office is admittedly designated in Article 133(2) of the Rules of Procedure as the defendant before the Court of First Instance, that designation cannot alter the consequences flowing from the broad logic of Regulation No 40/94 on the Community trade mark as regards Boards of Appeal. At the very most it enables the matter of costs to be settled,

should the contested decision be annulled or altered, irrespective of the position adopted by the Office before the Court.

When the Office endorses the applicant's heads of claim, the correspondence of the parties' claims and arguments does not relieve the Court of the need to examine the lawfulness of the contested decision in the light of the pleas in law put forward in the application initiating the proceedings.

The contested decision having been neither amended nor withdrawn and the Office not possessing the power to do so or to give instructions to that effect to the Boards of Appeal, the applicant still has an interest in obtaining annulment of that decision and the

action has not become devoid of purpose.

(see paras 22-24, 27-29)

2. The word sign Cloppenburg for which registration is sought in respect of 'retail trade services' falling within Class 35 of the Nice Agreement may not serve to designate, for the purposes of Article 7 (1)(c) of Regulation No 40/94 on the Community trade mark, from the point of view of an average German consumer, the geographical origin of the services covered by the application for registration of a mark.

In order to examine whether the conditions for application of the ground for refusal to register at issue have been satisfied, account must be taken of all the relevant circumstances, such as the

nature of the goods or services designated, the greater or lesser reputation, especially within the economic sector involved, of the geographical location in question and the relevant public's greater or lesser familiarity with it, the customs obtaining in the area of activity concerned and the question to what extent the geographical origin of the goods or services at issue may be relevant, in the view of the persons concerned, to the assessment of the quality or other characteristics of the goods or services concerned.

The German town of Cloppenburg, numbering about 30 000 inhabitants, is one with which the relevant public, if the latter knows the town at all, is only slightly, or at the very most, moderately, familiar and it presents no link with the category of services concerned.

(see paras 39-40, 46, 49-51)