

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fifth Chamber)

20 November 2007*

In Case T-458/05,

Tegometall International AG, established in Lengwil-Oberhofen (Switzerland),
represented by H. Timmann, lawyer,

applicant,

v

Office for Harmonization in the Internal Market (Trade Marks and Designs)
(OHIM), represented by J. Weberndörfer, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of OHIM, intervener
before the Court of First Instance, being

* Language of the case: German.

Wuppermann AG, established in Leverkusen (Germany), represented initially by H. Huisken, and subsequently by I. Friedhoff, lawyers,

ACTION brought against the decision of the Second Board of Appeal of OHIM of 21 October 2005 (Case R 1063/2004-2), as rectified on 16 November 2005, relating to invalidity proceedings between Wuppermann AG and Tegometall International AG,

THE COURT OF FIRST INSTANCE
OF THE EUROPEAN COMMUNITIES (Fifth Chamber),

composed of M. Vilaras, President, F. Dehousse and D. Šváby, Judges,

Registrar: K. Andová, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 30 December 2005,

having regard to the response of OHIM lodged at the Registry of the Court on 5 April 2006,

having regard to the response of the intervener lodged at the Registry of the Court on 12 April 2006,

further to the hearing on 13 February 2007,

gives the following

Judgment

Background to the dispute

- 1 On 2 July 1999 Tegometall International AG filed an application under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, for registration of a Community word mark with the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM).
- 2 The mark for which registration was sought is the word sign TEK.
- 3 The goods in respect of which registration of the mark was sought are in Classes 6 and 20 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond, for each of those classes, to the following description:
 - Class 6: ‘Shelves and parts of shelves, in particular hanging baskets for shelves, all the aforesaid goods of metal’;

— Class 20: ‘Shelves and parts of shelves, in particular hanging baskets for shelves’.

- 4 On 18 May 2001 the mark TEK was registered as a Community trade mark.

- 5 On 23 July 2003 Wuppermann AG applied for the Community trade mark TEK to be declared invalid pursuant to Article 51(1)(a) of Regulation No 40/94, on the ground that the registration was caught by the absolute grounds for refusal laid down in Article 7(1)(b), (c) and (g) of the Regulation.

- 6 On 3 February 2004 the applicant filed an application to restrict the list of goods included in Class 20, which was granted by the Cancellation Division. After restriction, the goods in Class 20 covered by the mark TEK are the following:

‘Shelves and parts of shelves, in particular hanging baskets for shelves, all the aforesaid goods not of wood.’

- 7 By decision of 20 September 2004 the Cancellation Division rejected the intervener’s application for a declaration of invalidity and ordered it to pay the costs, taking the view that the absolute grounds for refusal referred to in Article 7(1)(b), (c) and (g) of Regulation No 40/94 were not applicable in the present case.

- 8 On 16 November 2004 the intervener brought an appeal against the decision of the Cancellation Division (Case R 1063/2004-2) on the ground that each of the grounds for invalidity referred to by Article 51(1)(a) in conjunction with Article 7(1)(b), (c) and (g) of Regulation No 40/94 was applicable.
- 9 By decision of 21 October 2005, as rectified on 16 November 2005 ('the contested decision'), the Second Board of Appeal allowed the intervener's appeal, annulled the decision of the Cancellation Division and ordered the removal from the register of the mark, on the ground that the mark was descriptive for the purposes of Article 7(1)(c) of Regulation No 40/94 and devoid of any distinctive character within the meaning of Article 7(1)(b) of that regulation.
- 10 The Second Board of Appeal essentially took the view, first, that, since the word 'tek' means teakwood in Italian and French, since it is undisputed that shelves and parts of shelves are made of teakwood and since it cannot be ruled out that shelves and parts of shelves of metal and of plastic could imitate teakwood, the word 'tek', used for shelves and parts of shelves of metal and not of wood, served 'to designate the appearance, the external aspect and, as the case may be, other qualitative aspects of teakwood'. Accordingly, it concluded that the mark TEK constituted a purely descriptive indication for the purposes of Article 7(1)(c) of Regulation No 40/94, which should remain available for competitors. Second, it took the view that since the word 'tek' is not capable of distinguishing the goods designated according to their origin, it was also necessary to exclude the mark from registration because it lacks distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94. On the other hand, it took the view that it was not required to consider whether the mark at issue was such as to mislead the public for the purposes of Article 7(1)(g) of Regulation No 40/94.

11 On 29 December 2005 the applicant stated, by letter to OHIM, that it was restricting the list of goods covered by the mark TEK to the following:

- Class 6: ‘Shelves and parts of shelves, in particular hanging baskets for shelves, all the aforesaid goods of metal and not of imitation wood’;

- Class 20: ‘Shelves and parts of shelves, in particular hanging baskets for shelves, all the aforesaid goods not of wood or imitation wood’.

Forms of order sought

12 The applicant claims that the Court should:

- alter the contested decision;

- dismiss the application for the Community word mark TEK to be declared invalid;

- in the alternative, annul the contested decision and remit the case to OHIM for reassessment;

- order the intervener to pay the costs of the invalidity proceedings, the appeal before OHIM and the present action.

13 OHIM contends that the Court should:

- dismiss the action;
- order the applicant to pay the costs.

14 The intervener contends that the Court should dismiss the action.

Law

Subject-matter of the proceedings

Arguments of the parties

15 The applicant submits that the restriction of its application for registration of 29 December 2005 in respect of goods in Classes 6 and 20 which are not of imitation wood must be taken into account by the Court in so far as that restriction is a new matter for the purposes of the second subparagraph of Article 48(2) of the Rules of

Procedure of the Court of First Instance, which came to light only after the Second Board of Appeal had taken its decision. It follows, *a contrario*, from Article 74(2) of Regulation No 40/94 in conjunction with Article 48(2) of the Rules of Procedure that, generally, new facts, evidence and arguments may be introduced in the context of invalidity proceedings (Case T-222/02 *HERON Robotunits v OHIM (ROBOT-UNITS)* [2003] ECR II-4995, paragraph 50 et seq.).

- 16 At the hearing, the applicant stated that that application to restrict the list of goods had been filed when the application initiating proceedings was lodged and that it had been registered by OHIM. It also claimed that Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619 was not relevant in the present case, since negative restrictions are provided for in the classification established by the Nice Agreement.
- 17 OHIM asserts that the applicant's statement of surrender concerning goods of imitation wood may not be taken into consideration since it brings about an unlawful alteration in the subject-matter of the proceedings under Article 135(4) of the Rules of Procedure (Case T-164/03 *Ampafrance v OHIM — Johnson & Johnson (monBeBé)* [2005] ECR II-1401, paragraph 21).
- 18 OHIM also takes the view that the Cancellation Division was wrong to authorise the restriction of the list of goods of 3 February 2004, since that restriction of goods was unlawful in the light of the case-law (*Koninklijke KPN Nederland*, paragraphs 114 and 115). None the less, in OHIM's submission, even when that restriction is taken into account, the Board of Appeal correctly took the view that the relevant provisions on invalidity were applicable.

Findings of the Court

- 19 Under Article 63(2) of Regulation No 40/94, the Court may annul or alter a decision of a Board of Appeal of OHIM only ‘on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of [Regulation No 40/94] or of any rule of law relating to their application or misuse of power’. Article 74 of that regulation requires that that review of legality must be carried out in the light of the factual and legal context of the dispute as it was brought before the Board of Appeal (Case T-57/03 *SPAG v OHIM — Dann and Backer (HOOLIGAN)* [2005] ECR II-287, paragraph 17; Case T-320/03 *Citicorp v OHIM (LIVE RICHLI)* [2005] ECR II-3411, paragraph 16, and the order of 15 November 2006 in Case T-366/05 *Anheuser-Busch v OHIM — Budějovický Budvar (BUDWEISER)*, not published in the ECR, paragraph 27).
- 20 It follows that the Court may annul or alter a decision against which an action has been brought only if, at the time the decision was adopted, it was vitiated by one of those grounds for annulment or alteration. The Court may not, however, annul or alter that decision on grounds which come into existence subsequent to its adoption (Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237, paragraph 55).
- 21 Moreover, under Article 26(1)(c) of Regulation No 40/94 ‘[a]n application for a Community trade mark shall contain ... a list of the goods or services in respect of which the registration is requested’.

- 22 Article 44(1) of Regulation No 40/94 states that [t]he applicant may at any time withdraw his Community trade mark application or restrict the list of goods or services contained therein’.
- 23 In the present case, it is undisputed that the applicant restricted the goods covered by its application for registration of a Community trade mark after the adoption of the contested decision. Accordingly, however OHIM deals with that application, the application cannot affect the legality of the contested decision, which is the only decision being challenged before the Court (see, to that effect, the order in *BUDWEISER*, paragraphs 40 to 48).
- 24 Admittedly, in the case of a Community trade mark application covering a number of goods, the Court has interpreted a statement by the applicant for the trade mark made before the Court, and thus subsequent to the Board of Appeal’s decision, to the effect that the applicant was withdrawing its trade mark application only in respect of some of the goods covered by the initial application, either as a statement that the contested decision is challenged only in so far as it refers to the remainder of the goods covered (see, to that effect, Case T-289/02 *Telepharmacy Solutions v OHIM (TELEPHARMACY SOLUTIONS)* [2004] ECR II-2851, paragraphs 13 and 14), or, if such a statement was made at an advanced stage of the proceedings before the Court, as a partial withdrawal of the action (see, to that effect, Case T-194/01 *Unilever v OHIM (ovoid tablet)* [2003] ECR II-383, paragraphs 13 to 17).
- 25 However, if, by its restriction of the list of goods referred to in the Community trade mark application, the applicant for the trade mark is not seeking to withdraw from that list one or more goods, but to alter a characteristic, such as the intended purposes of all the goods on that list, it is possible that that alteration might have an effect on the examination of the Community trade mark carried out by the instances of OHIM during the administrative procedure. Accordingly, to allow that alteration

at the stage of the action before the Court would amount to changing the subject-matter of the proceedings pending, which is prohibited by Article 135(4) of the Rules of Procedure. Such a restriction cannot therefore be taken into account by the Court in its examination of the substance of the action (see, to that effect, *monBeBé*, paragraphs 20 to 22).

26 It is therefore necessary to establish whether the reference, in the application initiating proceedings, to the applicant's restriction on 29 December 2005 of the goods claimed in respect of the mark at issue may be interpreted as a statement by the applicant that it challenges the contested decision only in so far as it relates to the goods on the amended list.

27 That is not the case. By that restriction, the applicant did not withdraw certain goods from the list of goods in respect of which registration of the mark in question is sought, but altered the characteristics of all the goods on that list, specifying that those goods must not be made 'of imitation wood'. As stated at paragraphs 11 and 25 above, such a restriction cannot be taken into account by the Court, since it would change the subject-matter of the proceedings.

28 It must therefore be concluded that the goods to be taken into account in this action are those in the list of goods referred to in the applicant's initial trade mark application, as restricted on 3 February 2004 (see paragraphs 3 and 6 above).

29 As regards the argument raised by OHIM that the Cancellation Division wrongly authorised the application for a restriction of the goods which are not of wood, of 3 February 2004, it must be pointed out that, even if that argument were admissible, that restriction of goods, as OHIM observes, did not have any effect on the Board of

Appeal's analysis regarding the descriptive character and the lack of distinctiveness of the mark at issue. That argument must therefore be rejected as having no bearing at all on the outcome of these proceedings.

The substance

- 30 In support of its application, the applicant relies on four pleas in law, alleging infringement of Article 7(1)(c), (b) and (g) and the second sentence of Article 73, respectively, of Regulation No 40/94.
- 31 It is appropriate to examine, first of all, the fourth plea, alleging infringement of the second sentence of Article 73 of Regulation No 40/94.

The plea alleging infringement of the second sentence of Article 73 of Regulation No 40/94

— Arguments of the parties

- 32 The applicant submits that, throughout the administrative proceedings on invalidity, it was not able to express a view on whether the absolute ground for refusal of

registration provided for in Article 7(1)(c) of Regulation No 40/94 was made out by the fact that the meaning 'teakwood' called to mind by the mark at issue could serve to describe goods made in imitations of that wood. Since there was no oral procedure, it submits that at no point did it have an opportunity to comment on the views expressed by the Board of Appeal, which appeared only in the Board's decision.

33 In that regard, the applicant observes that the intervener pleaded before the Board of Appeal the absolute grounds for refusal based on Article 7(1)(b) and (c) of Regulation No 40/94 by submitting merely that the mark at issue could call to mind the words 'technology' or 'technical'. The applicant further states that the intervener relied exclusively on the ground for refusal based on Article 7(1)(g) of Regulation No 40/94 in submitting that the word mark TEK could mislead the relevant sections of the French- and Italian-speaking public by creating the impression that the applicant's goods could imitate teakwood.

34 The applicant recalls that the right to be heard is infringed where the proprietor of the mark has not had an opportunity to express its views on the application of the absolute grounds for refusal which the Board of Appeal applied of its own motion (*EUROCOOL*, paragraph 21).

35 It also observes that it was deprived of the possibility of expressing its views on the Board of Appeal's reasoning and in particular on the possibility of further restricting the list of goods in respect of which registration was sought.

- 36 OHIM counters that, contrary to what the applicant claims, the principle of the right to be heard was not infringed.
- 37 It observes, first, that the intervener expressly based its action on each of the grounds for invalidity referred to in Article 51(1)(a) and Article 7(1)(b), (c) and (g) of Regulation No 40/94. Second, even though the intervener referred to imitations of teakwood in its argument relating not to Article 7(1)(b) and (c) of Regulation No 40/94 but to Article 7(1)(g) thereof, it is undisputed that it is the fact that imitations of teakwood exist which has become the subject-matter of the proceedings.
- 38 Accordingly, in its submission, the applicant was informed not only of all the grounds for invalidity but also of all the facts taken into account by the Board of Appeal in its decision.
- 39 OHIM recalls that the absolute grounds for refusal are always the subject of an assessment, at least in respect of all the types of goods referred to in the list of goods which are found on the market. It submits that, by reason of that principle, the Board of Appeal was obliged to take account of the undisputed existence of imitations of wood in the discussion of all the grounds for invalidity, including those laid down in Article 7(1)(b) and (c) of Regulation No 40/94.
- 40 Lastly, it adds that the Board of Appeal is not required to submit to the parties for comment a draft decision containing all the considerations and all the legal arguments deemed relevant.

41 The intervener submits, for its part, that the applicant was able to present its comments on the ground for refusal of registration laid down in Article 7(1)(c) of Regulation No 40/94, resulting from the fact that its goods can imitate teakwood.

— Findings of the Court

42 It should be pointed out, at the outset, that, pursuant to the second sentence of Article 73 of Regulation No 40/94, decisions of OHIM are to be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.

43 In accordance with that provision, a Board of Appeal of OHIM may base its decision only on matters of fact or of law on which the parties have been able to set out their views (Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 42, and Case T-242/02 *Sunrider v OHIM* (TOP) [2005] ECR II-2793, paragraph 59).

44 The general principle of protection of the right to defend oneself is enshrined in the law of Community trade marks by that provision (*LIVE RICHLI*, paragraph 21). According to that general principle of Community law, a person whose interests are appreciably affected by a decision taken by a public authority must be given the opportunity to make his point of view known (Case 17/74 *Transocean Marine Paint v Commission* [1974] ECR 1063, paragraph 15, and *LIVE RICHLI*, paragraph 22).

- 45 Furthermore, according to the case-law, although the right to be heard, as laid down by the second sentence of Article 73 of Regulation No 40/94, covers all the factual and legal factors and the evidence which forms the basis of the decision of the Board of Appeal, it does not apply to the final position which the administration intends to adopt (Case T-303/03 *Lidl Stiftung v OHIM — REWE-Zentral (Salvita)* [2005] ECR II-1917, paragraph 62, and judgment of 5 April 2006 in Case T-388/04 *Kachakil Amar v OHIM (Longitudinal line ending with a triangle)*, not published in the ECR, paragraph 20). Accordingly, the Board of Appeal is not obliged to hear an applicant on a factual assessment which forms part of its final decision.
- 46 In this case, the applicant claims that, throughout the administrative proceedings on invalidity, it was not able to express its views on whether the absolute ground for refusal based on Article 7(1)(c) of Regulation No 40/94 arose from the fact that the meaning ‘teakwood’ was capable of applying to imitations of wood.
- 47 The Court finds, first, that, from the stage at which the mark was examined before the Cancellation Division, there was an exchange of views on whether the mark was descriptive in respect of the meaning ‘teakwood’ for the purposes of Article 7(1)(c) of Regulation No 40/94.
- 48 The intervener based its application for the Community trade mark at issue to be declared invalid on Article 51(1)(a) in conjunction with Article 7(1)(b)(c) and (g) of Regulation No 40/94, stating, in particular, that the registered word sign TEK constituted an indication serving to designate the quality of goods which contained teakwood. The application for a declaration of invalidity was notified to the applicant, which subsequently surrendered the following goods: ‘shelves and parts of shelves of wood’ included in the description of goods in Class 20 covered by the mark at issue.

49 It is in those circumstances that the Cancellation Division considered that, following the exclusion of shelves and parts of shelves of wood from the list of goods covered by the Community trade mark, the mark TEK could no longer be regarded as an indication serving to designate a quality of the goods.

50 Second, the Board of Appeal did not endorse the Cancellation Division's finding. The Board of Appeal took the view that, if it was, admittedly true that the proprietor of the Community trade mark had excluded goods of wood from the list of goods, that did not mean that shelves of metal or of plastic could not imitate teakwood furniture. It concludes that 'used in relation to shelves of metal or of plastic, the expression 'tek' serves, consequently, to designate the appearance, the outward aspect and, as the case may be, other qualitative aspects of teakwood'.

51 By taking the view that the exclusion of goods of wood was not sufficient to preclude the mark at issue from being descriptive, on account of the fact that the goods in respect of which that mark had been registered could be of imitation teakwood, the Board of Appeal relied on the same legal framework — Article 7(1)(c) of Regulation No 40/94 — and the same factual framework as the Cancellation Division.

52 Third, although the Board of Appeal reached a conclusion different from that of the Cancellation Division, it referred to the argument raised by the intervener before it, to the effect that the mark at issue created the illusion for the relevant sections of the French and Italian-speaking public that a product possesses the hardness, the weight and the imputrescibility of teakwood, since shelves and parts of shelves are frequently no longer made of teakwood but of other materials, which are oiled, dyed, lacquered or laminated in order to produce the effect of teakwood. That argument of the intervener clearly illustrated the fact that it was possible that the goods at issue might continue to call to mind the quality and the characteristics of teakwood.

- 53 It is true, as the applicant states, without being disputed by OHIM, that the fact that shelves and parts of shelves could imitate teakwood was asserted by the intervener before the Board of Appeal only in the context of the absolute ground for refusal based on Article 7(1)(g) of Regulation No 40/94, and not in relation to Article 7(1)(c) of Regulation No 40/94. The fact remains, however, that the applicant was able to express its views during the proceedings on the fact on which the Board of Appeal based its reasoning.
- 54 It is undisputed that imitation teakwood is associated with the appearance of real teakwood. Moreover, the teakwood appearance of goods such as shelves and parts of shelves should inevitably be the same irrespective of whether they are made of real teakwood or of imitation teakwood, that is to say of materials other than that wood.
- 55 It must be stated that, during the invalidity proceedings, the applicant commented or could have commented on the fact that the registered word sign was capable of calling to mind the appearance of teakwood. The applicant had the opportunity to express a view on the ground for refusal of registration laid down in Article 7(1)(c) of Regulation No 40/94, put forward by the intervener in its application for a declaration of invalidity, according to which the registered word sign TEK constituted an indication serving to describe the quality of goods which contain teakwood, and on the Cancellation Division's finding according to which it is true that, in accordance with the dictionary excerpts in Italian and French, the word 'tek' serves to designate teakwood (see paragraph 10 of the Cancellation Division's decision).
- 56 Accordingly, the Board of Appeal did not infringe the applicant's rights of defence, since the latter had been in a position to express its views on all the matters of fact and of law on which the Board of Appeal based its decision in the context of Article 7(1)(c) of Regulation No 40/94.

57 The other arguments put forward by the applicant do not invalidate that finding.

58 Contrary to what the applicant claims, the circumstances of this case differ from those which gave rise to *EUROCOOL*. In that case, the Board of Appeal had applied of its own motion a new absolute ground for refusal without according the applicant for the mark the possibility to express its views on the application of that ground. In the present case, by contrast, the Board of Appeal considered each of the absolute grounds for refusal and in particular that based on Article 7(1)(c) of Regulation No 40/94, which had been examined by the Cancellation Division. The Board of Appeal based its reasoning on all the characteristics of the goods covering their quality as imitation wood, which are the criteria of analysis coming within the scope of Article 7(1)(c) of Regulation No 40/94.

59 Furthermore, it is of little importance that that argument relating to imitations of wood was raised by the intervener in the context of an absolute ground other than that applied by the Board of Appeal. It is apparent from the case-law that assessment of the facts is a part of the decision-making act itself and the right to be heard does not extend to the final position which the administration intends to adopt. In those circumstances, the Board of Appeal was not obliged to hear the applicant in relation to the assessment of the facts on which it chose to base its decision (see, to that effect, *Salvita*, paragraph 62, and *Longitudinal line ending with a triangle*, paragraph 20).

60 It follows that, for all those reasons, the fourth plea, alleging infringement of the second sentence of Article 73 of Regulation No 40/94, must be rejected as unfounded.

The plea alleging infringement of Article 7(1)(c) of Regulation No 40/94

— Arguments of the parties

61 The applicant disputes that the mark applied for can be regarded as being descriptive of the goods at issue.

62 First, the applicant claims that the consumer who is reasonably well-informed and reasonably observant and circumspect does not understand the word 'tek' as having any descriptive value for the designated goods, since the mark was registered for goods not of wood and those goods are not of teakwood or of imitation teakwood.

63 In its submission, as regards shelves and parts of shelves made of materials other than wood, the consumer who is reasonably well-informed and reasonably observant and circumspect gives the word 'tek' a meaning other than teakwood and, in particular, it is likely that he or she understands the mark TEK as a combination of the first two letters of the name of the Tegometall company.

64 At the hearing the applicant added that, if the word 'tek' was indeed listed in dictionaries with the meaning 'teakwood', it was however used only rarely.

65 As regards the fact that the word 'tek' refers to the dark brown colour of teakwood, the applicant claims that that argument raised by the intervener is belated and that in any event, it cannot be inferred from the fact that goods are, in certain cases, the colour of teak that they are actually made of teakwood. Furthermore, the dictionary of colours uses the English word 'teak' and not 'tek', although the English-speaking public is not the relevant public in the present case.

66 The applicant adds that, in order that the relevant sections of the public understand the mark TEK as having a descriptive function in relation to goods which are not of wood, the term must be employed by the user in a context which refers unequivocally to a descriptive meaning. That is true of adhesive film which confers, on the surface of another object, the colour, structure and mottle of teakwood, with the sole purpose of giving the goods in question an appearance similar to that of teakwood. However, the goods in respect of which it sought registration are not used with the specific aim of imitating teakwood.

67 In this respect, the applicant claims that, in order to assess a trade mark's registrability, the decisive criterion is not whether, in a certain context, the mark might be perceived by the public as descriptive, but to consider whether, in itself, irrespective of the circumstances in which it might be used, the mark could assume a purely descriptive role in respect of the goods covered by the registration (Case T-356/00 *DaimlerChrysler v OHIM* [2002] ECR II-1963, paragraph 46, and Case T-360/00 *Dart Industries v OHIM (UltraPlus)* [2002] ECR II-3867, paragraph 52).

68 Second, the applicant claims that it is not possible to link the term 'tech', which is perceived by the public as an abbreviation, an acronym pronounced as such, to the word sign TEK, which is perceived as a combination of letters and, therefore, pronounced separately as the sequence of letters 't', 'e' and 'k'.

- 69 It submits that, in order to assess the registrability of a mark, it is necessary to know whether the sign which is the subject-matter of the proceedings is capable of being registered and not to examine whether similar signs are capable of being registered. Thus, even if the pronunciation is identical, differences in the way in which signs are written may lead to a different assessment in respect of their registration.
- 70 In the applicant's submission, even if one were to attribute to the word sign TEK the meaning of the abbreviation of 'technology' or of 'technique', it cannot be considered that that mark could describe the characteristics of the goods being registered. In the case of shelves and parts of shelves, the words 'technique' or 'technology' do not have a given or unequivocal descriptive meaning and do not describe the precise characteristics of those goods.
- 71 It also claims that although certain elements of shelves are capable of assuming a technical character and, on that basis, can be patented, it cannot be inferred from this that the public would regard such goods, by their very nature, as having a technical character.
- 72 OHIM observes that it is undisputed that, in French and Italian, the word 'tek' means teakwood, and that shelves and parts of shelves can be of teakwood. In its submission, it does not appear to be disputed that the public will understand 'tek' as being descriptive of teakwood, at least in cases in which the surface of an object is conferred with a dye, a structure and a texture which correspond to those of teakwood.
- 73 It submits that the Board of Appeal was right to hold that, in order to analyse the descriptiveness of the mark, only the list of goods accompanying the mark was relevant and that, if a sign is descriptive for only some of the goods in a given category, it could not be registered for that category (Case T-322/03 *Telefon & Buch v OHIM — Herold Business Data (WEISSE SEITEN)* [2006] ECR II-835, paragraph 83).

- 74 The intervener contends, like OHIM, that the mark TEK is descriptive of the goods at issue. In its submission, 'teak' is a colour which is brown in tone, or teak brown defined as such in 'A Dictionary of Color' (Maerz and Paul). Accordingly, in so far as colour is a common indication of the outward appearance of objects and in the present case of shelves, it is possible that the relevant Italian- and French-speaking public will understand the mark TEK as an indication of quality.
- 75 It contends that the mark TEK is purely descriptive of the goods being registered, irrespective of the context in which they might be used. Even if the restriction of the goods to those which are not of imitation wood is taken into consideration, it submits that any descriptive link between the sign and the goods cannot however be ruled out, since the word 'tek' describes the colour of the goods concerned which are not of wood and which are not of imitation wood.
- 76 It takes the view that the word 'tek' will also be understood by most consumers as an abbreviation of the word 'technical'. In this respect, it observes that, according to the Work Manual of the Trade Marks Registry of the United Kingdom Intellectual Property Office, 'tek' and 'tec' are considered equivalent and are not allowed for non-technical goods, and that the Board of Appeal refused registration of the word mark CYBERTEK since the average consumer will be able to link the concept 'tek' with the words 'technical' or 'technology' (see Decision R 826/2004-1 of 15 December 2004 (CYBERTEK)).

— Findings of the Court

- 77 According to settled case-law, Article 7(1)(c) of Regulation No 40/94 prevents the signs or indications to which it refers from being reserved to one undertaking alone

because they have been registered as trade marks. That provision pursues an aim that is in the public interest, which requires that such signs and indications may be freely used by all (Case T-348/02 *Quick v OHIM (Quick)* [2003] ECR II-5071, paragraph 27; see also, by analogy, Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 25).

- 78 Furthermore the signs referred to by Article 7(1)(c) of Regulation No 40/94 are signs regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services, thus enabling the consumer who acquired the product or service to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (see *Quick*, paragraph 28, and the case-law cited).
- 79 The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are those which may serve in normal usage from the point of view of the relevant public to designate, either directly or by reference to one of their essential characteristics, goods or services in respect of which registration is sought (Case C-383/99 P *Procter & Gamble v OHIM* [2001] ECR I-6251, paragraph 39, and Case T-19/04 *Metso Paper Automation v OHIM (PAPERLAB)* [2005] ECR II-2383, paragraph 24).
- 80 It follows that, for a sign to be caught by the prohibition set out in that provision, there must be a sufficiently direct and specific relationship between the sign and the goods or services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods or services in question from one of their characteristics (see, to that effect, Case T-311/02 *Lissotschenko and Hentze v OHIM (LIMO)* [2004] ECR II-2957, paragraph 30, and *PAPERLAB*, paragraph 25).

81 Therefore, the descriptiveness of a mark may only be assessed, first, in relation to the goods or services concerned and, secondly, in relation to the perception of the target public, which is composed of the consumers of those goods or services (*CARCARD*, paragraph 25, and Joined Cases T-367/02 to T-369/02 *Wieland-Werke v OHIM (SnTEM, SnPUR, SnMIX)* [2005] ECR II-47, paragraph 17).

82 In the present case, the Court notes, as a preliminary point, that this action concerns only the following goods referred to in the trade mark application: shelves and parts of shelves, in particular hanging baskets for shelves, all the aforesaid goods of metal, in Class 6, and all the aforesaid goods not of wood, in Class 20. As demonstrated at paragraphs 19 to 29, the Court may not take into consideration the restriction of the list of goods covered by the trade mark application to all the goods which do not imitate teakwood, which occurred after the contested decision.

83 The relevant public is deemed to be the average consumer who is reasonably well-informed and reasonably observant and circumspect (Case T-219/00 *Ellos v OHIM [ELLOS]* [2002] ECR II-753, paragraph 30; see also, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). Given the nature of the goods at issue (shelves, parts of shelves and hanging baskets), they are intended for general consumption. Furthermore, the perception of the word 'tek' must be assessed in relation to the French and Italian-speaking consumer, since the term at issue is a word in the French and Italian languages.

84 In those circumstances, it is appropriate to determine, in the context of the application of the absolute ground for refusal laid down in Article 7(1)(c) of Regulation No 40/94, whether, from the point of view of the relevant public, there is a sufficiently direct and specific relationship between the mark TEK and the goods referred to in the application for registration as analysed by the Board of Appeal.

- 85 As regards the meaning of the word sign TEK, it should first of all be noted that the applicant did not call into question, before the Board of Appeal, the finding of the Cancellation Division, at paragraph 10 of its decision, that it is true that, according to the dictionary excerpts submitted in Italian and French, the word 'tek' serves to designate teakwood. The applicant's arguments merely claim, in essence, that the use of a metal shelf structure with shelves of metal or of glass clearly does not create the impression that the shelf or shelf parts are of teakwood.
- 86 The applicant stated at the hearing before the Court, without disputing that the word 'tek' is indeed listed in French and Italian dictionaries, that it none the less doubted that that word is actually used in that sense.
- 87 It is therefore common ground that the word 'tek' means teakwood in French and Italian dictionaries and that it constitutes one of the ways of writing teakwood in those dictionaries. It is a brownish type of wood, hard, very dense and imputrescible and the word 'tek' thus designates a type of wood and the characteristics of that wood.
- 88 In that regard, it is irrelevant whether or not the word 'tek' is used in the sense of teakwood. For OHIM to refuse to register a trade mark on the basis of Article 7(1)(c) of Regulation No 40/94 it is not necessary that the signs and the indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes (Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 32, and *LIMO*, paragraph 32).

89 As regards the nature of the relationship between the word sign TEK and the goods concerned, the Board of Appeal took the view, at paragraphs 13 to 15 of the contested decision, that, since shelves and parts of shelves can be made of teakwood and since it is possible that those goods of metal and of plastic could imitate teakwood, the expression 'tek', used in connection with shelves of metal or of plastic, served to designate the appearance, the external aspect and, as the case may be, other qualitative aspects of teakwood.

90 The applicant does not dispute that shelves, parts of shelves and hanging baskets can be made of teakwood or that the abovementioned goods may none the less have the appearance of teakwood on account of the fact that shelves are nowadays made of materials other than teakwood which are oiled, lacquered or covered with adhesive film giving the impression of that type of wood. The applicant claims that the relevant public does not understand the word 'tek' as a characteristic of its goods since the goods in respect of which the mark was registered are of metal and are not of teakwood or of imitation teakwood.

91 The fact remains that the applicant sought the registration of its mark in respect of shelves and parts of shelves, hanging baskets, all the aforesaid goods of metal in Class 6, and for all the aforesaid goods not of wood in Class 20. The Board of Appeal was therefore right to take the view, at paragraph 17 of the contested decision, that the list of goods '[was] absolutely not restricted to shelves of glass or of metal recognisable as such'.

92 Accordingly, having regard to the list of goods in respect of which the mark TEK was registered, the applicant will in future be able to present its goods in materials such as plastic or metal which none the less give the appearance of teakwood. The goods at issue, in particular those made of plastic, will be able, by virtue of their dye, their

outward appearance and all the techniques currently on the market for imitating wood, to give the impression that they are of teakwood or that they possess at least certain characteristics of teakwood.

⁹³ Thus, the link between the meaning of the term ‘tek’, on the one hand, and shelves and parts of shelves and hanging baskets, all the aforesaid goods of metal and not of wood, on the other, is sufficiently close to fall within the scope of the prohibition laid down by Article 7(1)(c) of Regulation No 40/94 (see, to that effect, *ELLOS*, paragraph 37).

⁹⁴ In this respect, it is of little importance that the applicant does not market the goods in respect of which it sought registration with the aim of imitating teakwood. As previously stated, the descriptiveness of a mark may be assessed only in relation to each of the categories of goods and services referred to in the application for registration (see paragraph 81 above). The fact that a word sign is descriptive in relation to only some of the goods or services within a category listed as such in the application for registration does not preclude that word sign being refused registration (Case T-355/00 *DaimlerChrysler v OHIM (TELE AID)* [2002] ECR II-1939, paragraph 40).

⁹⁵ Accordingly, in the light of the specific and direct relationship between the word sign TEK and shelves, parts of shelves and hanging baskets of metal and not of wood, the Board of Appeal rightly held that, on the basis of Article 7(1)(c) of Regulation No 40/94, the word sign TEK was not capable of constituting a Community trade mark.

96 In so far as a word sign must be refused registration under Article 7(1)(c) of Regulation No 40/94 if at least one of its possible meanings designates a characteristic of the goods or services concerned (*OHIM v Wrigley*, paragraph 32), the Court finds that the Board of Appeal did not commit an error of assessment by failing to analyse whether the mark TEK was also perceived as a descriptive indication of certain technical or technological aspects of the goods in English and German-speaking areas.

97 The first plea, alleging infringement of Article 7(1)(c) of Regulation No 40/94, must therefore be rejected.

98 As regards the second and third pleas, alleging infringement of Article 7(1)(b) and (g) of Regulation No 40/94, respectively, it should be pointed out, as is evident from Article 7(1) of Regulation 40/94, that it is sufficient that one of the absolute grounds for refusal applies in order for the sign at issue not to be registrable as a Community trade mark (Case C-104/00 P *DKV v OHIM* [2002] ECR I-7561, paragraph 29).

99 Accordingly, it is not necessary to consider the applicant's arguments alleging infringement of Article 7(1)(b) and (g) of Regulation No 40/94.

100 In the light of the foregoing, the action must be dismissed in its entirety.

Costs

101 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs, if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it must be ordered to pay the costs incurred by OHIM, in accordance with the form of order sought by OHIM.

102 As the intervener has not applied for costs, it must bear its own costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Fifth Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders the applicant to pay the costs, except those incurred by the intervener;**

3. Orders the intervener to bear its own costs.

Vilaras

Dehousse

Šváby

Delivered in open court in Luxembourg on 20 November 2007.

E. Coulon

Registrar

M. Vilaras

President