

Case T-458/05

Tegometall International AG

v

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

(Community trade mark — Invalidity proceedings — Application for the Community word mark TEK — Subject-matter of the proceedings — Observance of the rights of the defence — Absolute grounds for refusal — Descriptive character — Article 7(1)(b), (c) and (g) and Article 51(1)(a) of Regulation (EC) No 40/94)

Judgment of the Court of First Instance (Fifth Chamber), 20 November 2007 II - 4724

Summary of the Judgment

- 1. Community trade mark — Appeals procedure — Appeals before the Community judicature — Limitation of the list of products and services after the decision of the Board of Appeal
(Council Regulation No 40/94, Arts 63(2) and 135(4))*

2. *Community trade mark — Surrender, revocation and invalidity — Absolute grounds of invalidity — Registration contrary to Article 7(1)(c) of Regulation No 40/94 (Council Regulation No 40/94, Arts 7(1)(c) and 51(1)(a))*

1. In an action against a decision of a Board of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), the Court of First Instance may annul or alter the contested decision only if, at the time it was taken, it was vitiated by one of the grounds for annulment or alteration laid down by Article 63(2) of Regulation No 40/94 on the Community trade mark, namely 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. 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.

only decision being challenged before the Court.

It is true that, in certain circumstances, a statement by the trade mark applicant before the Court, to the effect that he withdraws his application in respect of only some of the goods covered by the initial application, may be interpreted either as a statement that the contested decision is challenged only in so far as it refers to the remainder of the goods covered, or, if such a statement was made at an advanced stage of the proceedings before the Court, as a partial withdrawal of the action.

In that regard, although 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', a limitation of that list subsequent to the contested decision of the Board of Appeal cannot affect the legality of that decision, which is the

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 paras 19, 20, 22-25)

2. The term TEK should not have been registered as a Community trade mark in respect of '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 of the Nice Agreement, by reason of the existence of the absolute ground for refusal referred to in Article 7(1)(c) of Regulation No 40/94 on the Community trade mark concerning the descriptive nature of the mark from the point of view of the average French and Italian-speaking consumer.

In Italian and French, the word 'tek' means teakwood, and thus designates a type of wood and its characteristics.

Having regard to the list of goods in respect of which the mark TEK has been registered, the proprietor is able in the future 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. 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 paras 83, 85, 87, 92, 93)