

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fifth Chamber)

7 June 2005*

In Case T-316/03,

Münchener Rückversicherungs-Gesellschaft AG, established in Munich (Germany), represented by G. Würtenberger and R. Kunze, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by D. Schennen and G. Schneider, acting as Agents,

defendant,

* Language of the case: German.

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 26 June 2003 (Case R 337/2002-4), regarding an application for registration of the Community word mark MunichFinancialServices,

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

composed of M. Vilaras, President, M. E. Martins Ribeiro and K. Jürimäe, Judges,

Registrar: C. Kristensen, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 12 September 2003,

having regard to the response lodged at the Court Registry on 19 January 2004,

further to the hearing on 13 January 2005,

gives the following

Judgment

Background to the dispute

- 1 On 15 June 2000 the applicant filed an application for registration of a Community trade mark with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.
- 2 The mark for which registration was sought is the word mark MunichFinancial-Services.
- 3 The services in respect of which the registration was sought fall within Class 36 of the Nice Agreement of 15 June 1957 concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as revised and amended. The services in question correspond to the following description: 'financial services'.
- 4 By decision of 18 February 2002 the examiner dismissed the application on the ground that the mark applied for was descriptive of the services concerned and devoid of any distinctive character within the meaning of Article 7(1)(b) and (c) of Regulation No 40/94.

- 5 On 18 April 2002 the applicant brought an appeal before OHIM, on the basis of Article 59 of Regulation No 40/94, against the examiner's decision.
- 6 By decision of 26 June 2003 ('the contested decision'), notified to the applicant on 14 July 2003, the Fourth Board of Appeal dismissed the appeal on the ground that the mark applied for was descriptive, within the meaning of Article 7(1)(c) of Regulation No 40/94.

Forms of order sought

- 7 The applicant submits that the Court of First Instance should:

- annul the contested decision;

- order OHIM to pay the costs.

- 8 OHIM contends that the Court should:

- dismiss the application;

- order the applicant to pay the costs.

Law

- 9 The applicant raises, in substance, a single plea, alleging infringement of Article 7(1)(c) of Regulation No 40/94.

Arguments of the parties

- 10 The applicant submits, first of all, that an average consumer who is reasonably well informed and reasonably observant and circumspect could not, without further reflection, understand the semantic content of the word mark making up the trade mark applied for, so that there are no grounds on which to conclude that the mark cannot be protected.
- 11 In that regard, the applicant submits that the word mark MunichFinancialServices is not descriptive of the services covered by the trade mark application, because the combination of the various words of which it is composed is distinctively original, and unusual. The unusual character derives from the fact that the contested word mark is not constructed according to the rules of English grammar. The contested word mark leaves the consumer wholly uncertain as to the nature of the relationship between the place name 'Munich' and the expression 'FinancialServices'.
- 12 In order to show that the contested word mark does not fall within the scope of Article 7(1)(c) of Regulation No 40/94, the applicant also refers to the scheme of analysis suggested by Advocate General Jacobs in paragraphs 61 to 64 of his Opinion in Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, I-12449).

- 13 Advocate General Jacobs suggests that, in order to determine whether a mark has a descriptive character there must be an assessment, first, of the way in which a term relates to a product or service, or to one of its characteristics, second, the way in which a term is perceived and, third, the significance of the characteristic designated by the mark in relation to the product or service, in particular in the consumer's mind.
- 14 First of all, as regards the manner in which the term relates to the product or service, or to one of its characteristics, the applicant submits that the combination of words which make up the word mark MunichFinancialServices does not enable an unequivocal link to be established with the services concerned on account of its unusual grammatical construction, being linguistically flawed, and on account of the ambiguity which results from that. Thus the relevant public cannot without further interpretation, on account of the multiplicity of meanings of its content, perceive the supposedly descriptive character, upheld by the Board of Appeal, of the mark applied for.
- 15 Next, as regards the way in which the word is perceived, the applicant takes the view that, on account of the unusual grammatical configuration of the term, the supposedly descriptive character of the mark applied for is not clear *ipso facto* and *de plano*.
- 16 Finally, as regards the importance of the characteristic designated by the mark in relation to the goods or service, particularly in the mind of the consumer, the applicant takes the view that the relevant potential clients do not attach a great deal of importance to whether the financial services offered come specifically from a supplier of services established in Munich, since for financial services the supplier's principal place of business is completely irrelevant.

- 17 Referring to paragraph 30 of the Opinion of Advocate General Jacobs in *Wrigley*, the applicant observes, thirdly, that the need to keep descriptive words freely available, in accordance with Article 7(1)(c) of Regulation No 40/94, exists only where competitors have a reasonably clear and foreseeable need to use that specific word in order to describe certain characteristics of their goods or services. The applicant argues that such a need does not exist in this case, because competitors have grammatically correct expressions at their disposal (such as, for example, the expression 'financial services coming from Munich' or 'financial services being offered from Munich') and, therefore, conceptual combinations which really have a clearly descriptive character. For the remainder, the applicant refers generally to its arguments set out before OHIM.
- 18 OHIM contests all of the arguments put forward by the applicant. It argues that the Board of Appeal rightly refused the mark applied for by the applicant because it has a purely descriptive character.
- 19 More specifically, OHIM argues that the consumer will not perceive the word mark *MunichFinancialServices* as a reference to a specific undertaking, but rather as a purely descriptive indication within the meaning of Article 7(1)(c) of Regulation No 40/94.
- 20 First, the element 'financialservices' directly represents the services in respect of which registration has been applied for.
- 21 Second, as regards the element 'Munich', OHIM maintains that, in relation to financial services in general, but also in the context of banks and insurance in particular, the place name is normally used and understood as the reference to the principal place of business of the undertaking which supplies the services in question.

22 OHIM also highlights the fact that Munich is widely known as a financial centre.

Findings of the Court

23 As a preliminary point, it must be observed that, in so far as it contains a general reference to the arguments set out in the written pleadings submitted during the administrative procedure before OHIM, the application does not satisfy the requirements of Article 44(1)(c) of the Rules of Procedure and, therefore, the reference cannot be taken into account (see, to that effect, Case T-84/96 *Cipeke v Commission* [1997] ECR II-2081, paragraph 33, and Case T-20/02 *Interquellv OHIM — SCA Nutrition (HAPPY DOG)* [2004] ECR II-1001, paragraph 20).

24 Under Article 7(1)(c) of Regulation No 40/94 ‘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 service’, are not to be registered. Furthermore, Article 7(2) states that ‘paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community.’

25 According to case-law, Article 7(1)(c) of Regulation No 40/94 prevents the signs or indications referred to therein from being reserved to one undertaking alone because they have been registered as trade marks. That provision thus pursues an aim in the public interest, which requires that such signs or indications may be freely used by all (see Case T-219/00 *Ellos v OHIM (ELLOS)* [2002] ECR II-753, paragraph 27 and the case-law cited, and Case T-348/02 *Quick v OHIM* [2003] ECR II-5071, paragraph 27).

- 26 Furthermore, the signs or indications referred to in Article 7(1)(c) of Regulation No 40/94 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 (Case C-383/99 P *Procter & Gamble v OHIM* [2001] ECR I-6251, paragraph 39). Therefore, the distinctiveness of a mark may only be assessed, first, in relation to the understanding of the mark by the relevant public and, second, in relation to the goods or services concerned (Case T-34/00 *Eurocool Logistik v OHIM (EUROCOOL)* [2002] ECR II-683, paragraph 38).
- 27 In this case, the services referred to in the trade mark application are financial services, without any other specification. Next, although the mark applied for is composed of English words, the name of the town (Munich), at the beginning of the mark, designates a German city. In addition, the other words which make up that mark, 'financial' and 'services', are very typical English words and are found with a similar spelling in several other Community languages. In those circumstances, it must be held that the relevant public is composed of an average English-speaking consumer in the Community, together with average consumers in other linguistic regions of the Community — in particular German consumers — who have at least a basic knowledge of English.
- 28 In those circumstances it must be determined, in the context of the application of the absolute ground for refusal laid down by Article 7(1)(c) of Regulation No 40/94, whether there exists for the relevant public a direct and specific link between the word mark MunichFinancialServices and the services for which the application for registration was refused, namely the financial services falling within Class 36 within the meaning of the Nice Agreement.
- 29 In that regard, it must be observed that the relevant public will have no difficulty in perceiving the element 'FinancialServices' in the mark applied for as a perfect description in English of the financial services referred to in the trade mark application.

30 The question arises, however, as to whether, in the context of an overall assessment of the mark applied for, the purely descriptive character of the element 'FinancialServices' is counteracted, first, by the addition of the word 'Munich', second, by the supposedly incorrect grammatical structure, and third, by the unusual form of writing.

31 First, as regards the use in the sign of the English name for the city of Munich, the Court takes the view that it does not prevent the relevant public from immediately perceiving, without further reflection, that it refers to a city in Germany.

32 Furthermore, according to the case-law, as regards signs or indications which may serve to designate the geographical origin of the categories of goods in relation to which registration of the mark is applied for, especially geographical names, it is in the public interest that they remain available (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 26, and Case T-295/01 *Nordmilch v OHIM (OLDENBURGER)* [2003] ECR II-4365, paragraph 30). That case-law is also applicable to services.

33 That is all the more so in the field of financial services, in which the place name is normally used and understood as a reference to the principal place of business of the undertaking supplying the services in question and, therefore, to the place from which they are generally supplied. Other possible meanings for that geographical indication are without relevance since, according to the case-law, it is sufficient if at least one of its possible meanings designates a characteristic of the goods or services concerned (see *OHIM v Wrigley*, paragraph 32).

34 In this case, the city of Munich is widely known as an important financial centre and is regarded as such by the relevant public. That was concluded both by the OHIM

examiner in his decision of 18 February 2002 and by OHIM in its response. Moreover, when the applicant was invited to express its view on that point at the hearing it did not deny the city of Munich's role in the field of financial services.

35 It follows that the Board of Appeal rightly held that the name of the city of Munich, followed by the expression 'FinancialServices', will be perceived essentially by the relevant public as the geographical indication of the place of origin of the services or the place from which they are offered. Therefore, the addition of the word 'Munich' to the expression 'FinancialServices' does not diminish the descriptive character attached to that expression. On the contrary, it reinforces it on account of the decisive role that that city plays in the field of financial services.

36 Second, as far as concerns the supposedly grammatically incorrect structure of the sign at issue, it must be observed that such a fact, even if established, does not affect the assessment of the contested sign set out above (see, to that effect, Case T-19/99 *DKV v OHIM (COMPANYLINE)* [2000] ECR II-1, paragraph 26, and Case T-360/99 *Community Concepts v OHIM (Investorworld)* [2000] ECR II-3545, paragraph 23).

37 Third, as regards the unusual way of writing of the contested sign, resulting from the fact that the three words of which it is composed are juxtaposed without spaces and the fact that each of those three juxtaposed words begins with a capital letter, it is clear that that does not amount to evidence of any creative aspect capable of distinguishing the applicant's products from those of other undertakings (see, to that effect, Case T-331/99 *Mitsubishi HiTec Paper Bielefeld v OHIM (Giroform)* [2001] ECR II-433, paragraph 25). Furthermore, the effect of a juxtaposition without spaces is completely offset by the fact that the three words constituting the contested word mark begin with a capital letter. The Board of Appeal therefore rightly held that the

word mark MunichFinancialServices will be read, heard and understood by the relevant public as ‘Munich Financial Services’ (paragraph 9 of the contested decision).

38 Lastly, there is nothing to suggest that the addition of the word ‘Munich’ to the expression ‘FinancialServices’ confers on the word mark MunichFinancialServices an additional element as a result of which it no longer has a purely descriptive character of the financial services offered from Munich (see, to that effect, Case T-359/99 *DKV v OHIM (EuroHealth)* [2001] ECR II-1645, paragraph 26).

39 It is clear from the foregoing considerations that the contested word mark enables the relevant public to discern immediately, and without any further reflection, a specific and direct connection with the financial services offered from Munich, which are included in the category ‘financial services’ covered by the mark applied for.

40 That assessment cannot be called into question by the applicant’s argument that the need to keep descriptive terms freely available in accordance with Article 7(1)(c) of Regulation No 40/94 exists only where the competitors have a reasonably obvious and foreseeable need to use that precise word in order to describe certain characteristics of their goods or services.

41 The Court points out, in that regard, that, in order for OHIM to refuse registration of a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and 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. A word 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 (*OHIM v Wrigley*, paragraph 32).

- 42 In this case, the contested word mark is without any doubt likely to be used by other economic operators in the financial sector wishing to indicate that their services are provided from Munich, which is, as stated above, one of the most important financial centres in Germany. It should be noted, in that regard, that the geographical origin of the supplier of the service is one of the characteristics expressly listed in Article 7(1)(c) of Regulation No 40/94. Consequently, the applicant's argument must be dismissed.
- 43 The Board of Appeal rightly held that the word mark MunichFinancialServices is descriptive of the financial services in question.
- 44 Accordingly, the applicant's single plea and the action as a whole must be dismissed as unfounded.

Costs

- 45 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been asked for in the successful party's pleadings. Since the applicant has been unsuccessful, it must, having regard to the form of order sought by the defendant, be ordered to pay the latter's costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Fifth Chamber)

hereby:

- 1. Dismisses the application;**

- 2. Orders the applicant to pay the costs.**

Vilaras

Martins Ribeiro

Jürimäe

Delivered in open court in Luxembourg on 7 June 2005.

H. Jung

Registrar

M. Vilaras

President