

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)

26 October 2000 *

In Case T-360/99,

Community Concepts AG, formerly Touchdown Gesellschaft für erfolgsorientiertes Marketing mbH, established in Munich (Germany), represented by F. Bahr and F. Cordt-Terzi, of the Munich Bar, with an address for service in Luxembourg at the Chambers of N. Decker, 16 Avenue Marie-Thérèse,

applicant,

v

Office for Harmonisation in the Internal Market (trade marks and designs) (OHIM), represented by A. von Mühlendahl, Vice-President responsible for Legal Affairs, D. Schennen, Head of the Legal Affairs Service, and E. Joly, an administrator in that service, acting as Agents, with an address for service in Luxembourg at the office of C. Gómez de la Cruz, of the Commission's Legal Service, Wagner Centre, Kirchberg,

defendant,

* Language of the case: German.

APPLICATION for annulment of the decision of the third Board of Appeal of the Office for Harmonisation in the Internal Market (trade marks and designs) of 15 October 1999 (Case R 204/1999-3) refusing registration of the word 'Investorworld' as a Community trade mark,

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

composed of: V. Tiili, President, R.M. Moura Ramos and P. Mengozzi, Judges,

Registrar: G. Herzig, Administrator,

having regard to the application lodged at the Court on 24 December 1999,

having regard to the defence lodged at the Court on 6 April 2000,

further to the hearing on 5 July 2000,

gives the following

Judgment

Background to the dispute

1 On 8 September 1998 Direkt Anlage Bank AG filed an application for registration of a Community trade mark with the Office for Harmonisation in the Internal Market (trade marks and designs) (hereinafter ‘the Office’).

2 The word in respect of which trade mark registration was sought was ‘Investorworld’.

3 The services covered by the application for registration relevant to this action are within class 36 (‘insurance; financial affairs; monetary affairs; real estate affairs’) 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. Application for registration of ‘Investorworld’ was also made in respect of goods and services within classes 9, 16, 35, 38 and 41 of the Nice Agreement.

4 By a decision of 22 February 1999, served on 23 February 1999, the examiner before whom the application came refused it under Article 38 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11 p. 1), as amended, on the ground that the word ‘Investorworld’ is devoid of distinctive character.

- 5 On 23 April 1999 the applicant filed an appeal at the Office under Article 59 of Regulation No 40/94 against the examiner's decision. The appeal was remitted to the Boards of Appeal.
- 6 By letter of 3 September 1999 Touchdown Gesellschaft für erfolgsorientiertes Marketing mbH, the applicant's predecessor, asked the Office to register a transfer into its name of the application for the Community trade mark.
- 7 The appeal was dismissed by decision of the third Board of Appeal of 15 October 1999 (hereinafter 'the contested decision') in so far as the application for registration related to services within class 36 of the Nice Agreement. The examiner's decision of 22 February 1999 was annulled in so far as it related to goods and services within classes 9, 16, 35, 38 and 41 of the Nice Agreement.
- 8 According to the contested decision, the word 'Investorworld' is, as regards services within class 36, devoid of distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94 and exclusively descriptive within the meaning of Article 7(1)(c) of that regulation. The English word 'investor' must be understood as meaning 'a person who invests or makes an investment' and the word 'world' as meaning 'world, universe', and also figuratively as 'people, society'. The word 'world' is used in this figurative sense, for example, in the expressions 'business world', 'fashion world', 'the commercial world' and 'the scientific world'. The combination of the words 'investor' and 'world' therefore indicates clearly, unequivocally, and in a manner that is immediately comprehensible, at least in the English speaking parts of the European Community, the nature and destination of the services in class 36 stated in the application in the sense of an 'investors' world, world for investors, world of investors'. Accordingly, the word 'Investorworld' is devoid of any additional fanciful element and therefore of any distinctive character.

- 9 The contested decision was served on 25 October 1999.
- 10 The Office registered the transfer of the application for the Community trade mark in question into the name of the applicant on 4 January 2000.

Forms of order sought

- 11 The applicant claims that the Court should:
- annul the contested decision in so far as it dismissed the appeal before the Office;
 - order the defendant to pay the costs, including those incurred in the proceedings before the Board of Appeal.
- 12 The Office contends that the Court should:
- dismiss the application;
 - order the applicant to pay the costs.

The application for annulment

- 13 The applicant essentially relies on two pleas in law in support of its application; first, infringement of Article 7(1)(b) of Regulation No 40/94 and, secondly, infringement of Article 7(1)(c) of that regulation.
- 14 The Office concedes that the second plea is well founded. It none the less considers that this action should be dismissed since, under Article 7(1)(b) of Regulation No 40/94, the fact that the word 'Investorworld' lacks distinctive character precludes its registration in any event.

Infringement of Article 7(1)(b) of Regulation No 40/94

Arguments of the parties

- 15 The applicant claims that the word 'Investorworld' is ungrammatical in English and is not used in written or spoken English. Therefore, contrary to the findings in the contested decision, it is not comparable with any expressions such as 'business world', 'fashion world', or 'scientific world'. The word claimed is not 'investment world' or 'investor's world', which would be linguistically accurate, but 'Investorworld'. The word has distinctive character because it is grammatically incorrect.

- 16 The fact that the language comprising the word is incorrect furthermore reflects a desire to make a double allusion to persons. In that regard, the applicant observes that it placed exaggerated emphasis on the link with people, first, by using the word 'investor' instead of 'investment' and, secondly, by adding the word 'world'.
- 17 The applicant claims that the word 'Investorworld' has a fanciful element and is therefore distinctive. Accordingly, the absolute ground for refusal laid down in Article 7(1)(b) of Regulation No 40/94, which relates to the situation where the sign applied for is wholly devoid of distinctive character, does not apply to this application for registration.
- 18 The Office acknowledges that a minimal degree of distinctive character is sufficient for a word to be registrable as a trade mark, but contends that the word in question does not have distinctive character. The fact that there is no apostrophe 's', as there should be in the expression 'Investor's world', does not suffice to impart distinctive character to the word 'Investorworld'. According to the Office, it is an almost unnoticeable difference in spelling. The Office points out in that respect that it is its settled practice to refuse registration of a sign which merely comprises a collocation of two words, neither of which is in itself capable of protection and which should, grammatically speaking, be separated.
- 19 The Office considers that the word 'Investorworld' may be interpreted figuratively to mean 'investors' world', thus indicating that the services designated relate mainly to anything that might be of some interest to investors. Accordingly, the word is devoid of distinctive character because it does not enable the undertaking where the offer for services originates to be identified. However, a sign is distinctive precisely if it is capable of distinguishing the goods and services of one undertaking from those of others. In this context, the Office states that it is its practice to refuse any word comprising the word 'world' on the one hand, and a term describing the subject-matter to which the goods or services relate, or those at whom they are targeted, on the other, as in the expressions 'world of music' for records or 'the world of wine' for goods related to wine.

Findings of the Court

- 20 Under Article 4 of Regulation No 40/94, the decisive factor if a sign capable of being represented graphically is to be eligible for registration as a Community trade mark is its capacity to distinguish the goods of one undertaking from those of another (Case T-163/98 *Procter & Gamble v OHIM, BABY-DRY* [1999] ECR II-2383, paragraph 20, and Case T-19/99 *DKV v OHIM, COMPANY-LINE* [2000] ECR II-1, paragraph 23).
- 21 Under Article 7(1)(b) of Regulation No 40/94, ‘trade marks which are devoid of any distinctive character’ are not to be registered. Distinctive character is to be assessed in relation to the goods or services in respect of which application for registration of the sign is made (*COMPANYLINE*, paragraph 24).
- 22 In this case the sign is composed exclusively of the terms ‘investor’ and ‘world’ both of which are common in English speaking countries. ‘Investor’ implies that the services designated are aimed at investors and fall within class 36 (see paragraph 3 above). The addition to that word of ‘world’ does not add any further feature such as to render the sign capable of distinguishing the services of the applicant from those of other undertakings as a whole (*BABY-DRY*, paragraph 27, and *COMPANYLINE*, paragraph 26). Constituted as it is, the sign merely refers to the ‘world of the investor’, meaning, as the Office rightly observes, that the services in question relate to anything which might be of some interest to an investor.
- 23 The fact that the word ‘Investorworld’ is not grammatically correct and therefore does not exist in English in no way alters the above findings (*COMPANYLINE*, paragraph 26).

24 Accordingly, the sign ‘Investorworld’ is devoid of distinctive character in relation to services within class 36 of the Nice Agreement.

25 It follows that the Board of Appeal rightly decided that under Article 7(1)(b) of Regulation 40/94 the word ‘Investorworld’ is not capable of constituting a Community trade mark in respect of such services.

26 As is clear from Article 7(1) of Regulation No 40/94, for a sign to be ineligible for registration as a Community trade mark, it is sufficient that one of the absolute grounds for refusal applies (see *BABY-DRY*, paragraph 29 and *COMPANYLINE*, paragraph 30). Accordingly, the application must be dismissed.

Costs

27 Under Article 87(2) of the Rules of Procedure of the Court of First Instance, 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, as applied for by the defendant.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber),

hereby:

1. **Dismisses the application;**
2. **Orders the applicant to pay the costs.**

Tiili

Moura Ramos

Mengozzi

Delivered in open court in Luxembourg on 26 October 2000.

H. Jung

Registrar

V. Tiili

President