ORDER OF THE COURT OF FIRST INSTANCE (Second Chamber)

30 June 2009 *

In Case T-285/08,

Securvita — Gesellschaft zur Entwicklung alternativer Versicherungskonzepte mbH, established in Hamburg (Germany), represented by M. van Eendenburg, C. Uhlig and J. Nabert, lawyers,

applicant,

v

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

defendant,

* Language of the case: German.

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 26 May 2008 (Case R 525/2007-4) relating to the application for registration of the word sign Natur-Aktien-Index as a Community trade mark,

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

composed of I. Pelikánová, President, K. Jürimäe (Rapporteur) and S. Soldevila Fragoso, Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Registry of the Court of First Instance on 21 July 2008,

having regard to the response lodged at the Court Registry on 3 November 2008,

makes the following

Order

Background to the dispute

1 On 19 January 2006, the applicant, Securvita Gesellschaft zur Entwicklung alternativer Versicherungskonzepte mbH, filed an application with the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) to register the sign Natur-Aktien-Index as a Community trade mark, 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 (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1)).

2 The goods and services for which registration was sought are in Classes 16, 36 and 42 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 16: 'Printed matter';

— Class 36: 'Analysis (financial), financial consultancy, insurance consultancy, stock exchange quotations, clearing (financial), securities brokerage, factoring, sponsorship, financing services, mutual funds, investment, health insurance underwriting, credit bureaux, life insurance underwriting, hire-purchase financing, retirement payment services, savings banks, trusteeship, financial management, insurance brokerage, insurance information, Insurance consultancy, insurance underwriting, apartment house management, real estate management, real estate appraisal, leasing of real estate, real estate agencies, renting of flats, accommodation bureaux (apartments), grant of loan, financial information, services of a real estate agent, services of a finance agent, collection of rent';

— Class 42: 'Licensing of intellectual property'.

3 By decision of 14 February 2007, the examiner rejected the application for registration on the basis of Article 7(1)(b) and (c) and (2) of Regulation No 40/94 (now Article 7(1)(b) and (c) and (2) of Regulation No 207/2009), on the ground that, for the German-speaking public, the sign in question was descriptive and devoid of any distinctive character.

4 On 4 April 2007, the applicant filed an appeal with OHIM against the examiner's decision on the basis of Articles 57 to 62 of Regulation No 40/94 (now Articles 58 to 64 of Regulation No 207/2009).

5 By decision of 26 May 2008 ('the contested decision'), the Fourth Board of Appeal of OHIM dismissed that appeal. The Board of Appeal essentially found that the sign in question was devoid of any distinctive character for German-speaking areas of the European Community, within the meaning of Article 7(1)(b) of Regulation No 40/94, since, for the relevant public, it contains 'direct information' making it possible to

understand that it relates to a stock exchange index of shares in the main ecological undertakings or undertakings whose activities involve ecological durability.

Forms of order sought by the parties

6 The applicant claims that the Court should amend the contested decision in such a way that it orders registration of the trade mark applied for from OHIM as a Community trade mark.

7 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

8 Under Article 111 of its Rules of Procedure, where it is clear that the Court of First Instance has no jurisdiction to take cognisance of an action or where the action is manifestly inadmissible or manifestly lacking any foundation in law, the Court may, by reasoned order, without taking further steps in the proceedings, give a decision on the action.

9 In the present case, the Court considers that it has sufficient information, in the form of the documents in the case, and decides, pursuant to that article, to give its decision without taking further steps in the proceedings.

10 The Court finds that the single head of claim in the present action seeks to have the Court amend the contested decision so as to order registration as a Community trade mark of the trade mark applied for from OHIM.

11 As a preliminary point, it must be borne in mind that, in accordance with settled case-law, under Article 63(6) of Regulation No 40/94 (now Article 65(6) of Regulation No 207/2009), OHIM is required to take the measures necessary to comply with judgments of the Community judicature. Accordingly, it is not for the Court of First Instance to issue directions to OHIM. It is for the latter to draw the appropriate inferences from the operative part and grounds of judgments of the Court (Case T-331/99 *Mitsubishi HiTec Paper Bielefeld* v *OHIM* (*Giroform*) [2001] ECR II-433, paragraph 33; Case T-164/03 *Ampafrance* v *OHIM — Johnson & Johnson* (*monBeBé*) [2005] ECR II-1401, paragraph 24; and Case T-35/04 *Athinaiki Oikogeniaki Artopoiia* v *OHIM — Ferrero* (*FERRÓ*) [2006] ECR II-785, paragraph 15).

12 Although it is true that the single head of claim in the present action seeks an order for registration of the trade mark applied for, it must nevertheless be considered that it constitutes an application for alteration for the purposes of Article 63(3) of Regulation No 40/94 (now Article 65(3) of Regulation No 207/2009), which provides, with regard to actions brought against decisions of the Boards of Appeal, that '[t]he Court of Justice has jurisdiction to annul or to alter the contested decision'.

13 In that regard, it should be borne in mind that, in accordance with settled case-law, Article 63(3) of Regulation No 40/94 must be read in the light of Article 63(2) of that regulation (now Article 65(2) of Regulation No 207/2009), pursuant to which: '[t]he action may be brought 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', and in the context of Articles 229 EC and 230 EC (Case T-163/98 *Procter & Gamble* v *OHIM* (*BABY-DRY*) [1999] ECR II-2383, paragraphs 50 and 51, and Case T-373/03 *Solo Italia* v *OHIM — Nuova Sala* (*PARMITALIA*) [2005] ECR II-1881, paragraph 25).

14 The jurisdiction of the Court to alter decisions operates to the effect that the Court adopts the decision which the Board of Appeal ought to have taken, in accordance with the provisions of Regulation No 40/94 (see, to that effect, judgment of 4 October 2006 in Case T-190/04 *Freixenet* v *OHIM* (*Shape of a frosted white bottle*), not published in the ECR, paragraphs 16 and 17).

15 Accordingly, the admissibility of a head of claim seeking alteration by the Court of the decision of a Board of Appeal must be assessed in the light of the powers conferred on that Board by Regulation No 40/94.

16 It must be noted that, pursuant to Article 62(1) of Regulation No 40/94 (now Article 64(1) of Regulation No 207/2009), following the examination as to the allowability of an appeal brought against a decision of one of the departments listed in Article 57(1) of that regulation (now Article 58(1) of Regulation No 207/2009), the Board of Appeal 'may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution'. It follows that the Board of Appeal does not have power to issue directions to the department whose decision it examined.

17 Moreover, even if it were accepted that the single head of claim in the present action may be interpreted as an application for alteration seeking to have the Court amend the contested decision, not so as to order registration of the trade mark applied for, but so that the trade mark is registered, it must be noted that registration of a Community trade mark is a consequence of a finding that the conditions laid down in Article 45 of Regulation No 40/94 (now Article 45 of Regulation No 207/2009) have been met, although the departments of OHIM responsible for registration of Community trade marks do not, in that respect, adopt any formal decision which might be the subject of an appeal.

18 Article 45 of Regulation No 40/94 provides that, '[w]here an application meets the requirements of this Regulation and where no notice of opposition has been given within the period referred to in Article 42(1) or where opposition has been rejected by a definitive decision, the trade mark shall be registered as a Community trade mark, provided that the registration fee has been paid within the period prescribed'. The same article states that '[i]f the fee is not paid within this period the application shall be deemed to be withdrawn'.

19 Pursuant to Article 126 of Regulation No 40/94 (now Article 131 of Regulation No 207/2009), an examiner is to be responsible for taking decisions on behalf of OHIM in relation to an application for registration of a Community trade mark, including the matters referred to in Articles 36, 38 and 66 of that regulation (now Articles 36, 37 and 68 of Regulation No 207/2009), except in so far as an Opposition Division is responsible. In addition, pursuant to Article 127(1) of Regulation No 40/94 (now

Article 132(1) of Regulation No 207/2009), an Opposition Division is to be responsible for taking decisions on an opposition to an application to register a Community trade mark.

20 It is thus apparent from the provisions cited in paragraphs 18 and 19 above that the powers conferred on the examiner and the Opposition Division do not relate to finding whether all the conditions for registration of a Community trade mark, laid down in Article 45 of Regulation No 40/94, are met.

21 It follows that, in the context of appeals brought against decisions of the examiner or the Opposition Division, in accordance with Article 57(1) of Regulation No 40/94, a Board of Appeal can be called upon to rule, in the light of the powers conferred on it by Article 62(1) of that regulation, only on certain of the conditions for registration of a Community trade mark listed in paragraph 19 above, that is to say, either on the compliance of applications for registration with the provisions of that regulation, or on the outcome of any opposition to such applications.

22 Consequently, it is clear that a Board of Appeal does not have power to take cognisance of an application that it register a Community trade mark.

23 In those circumstances, nor is it for the Court, in accordance with the case-law cited in paragraph 14 above, to take cognisance of an application for alteration requesting that it amend the decision of a Board of Appeal to that effect.

24 It follows from all the foregoing considerations that the single head of claim in the present action must be rejected and, accordingly, the action as a whole must be dismissed as manifestly inadmissible.

Costs

25 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, in accordance with the form of order sought by OHIM.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby orders:

1. The action is dismissed as manifestly inadmissible.

2. Securvita Gesellschaft zur Entwicklung alternativer Versicherungskonzepte mbH shall pay the costs.

Luxembourg, 30 June 2009.

Registrar	President
E. Coulon	I. Pelikánová