JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)
27 February 2002 *

In Case T-106/00,

Streamserve Inc., established in Raleigh, North Carolina (United States of America), represented by M. Nedstrand, lawyer,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by A. di Carlo and G. Humphreys, acting as Agents,

defendant,

* Language of the case: English.

ACTION brought against the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 28 February 2000 (Case R 423/1999-2) concerning registration of the term STREAMSERVE as a Community trade mark,

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

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

Registrar: D. Christensen, Administrator,

having regard to the application lodged at the Registry of the Court on 27 April 2000,

having regard to the response lodged at the Registry of the Court on 8 August 2000,

having regard to the reply lodged at the Registry of the Court on 27 October 2000,

having regard to the rejoinder lodged at the Registry of the Court on 9 January 2001,

further to the hearing on 20 June 2001

gives the following

Judgment

1 On 22 August 1997, Intelligent Document Systems Scandinavia AB filed an application for a Community word mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (the Office) under 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 of which registration is sought is the term STREAMSERVE.

3 The goods in respect of which registration of the mark is sought fall within Classes 9 and 16 under the Nice Agreement concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, as revised and amended, and are described as follows:

'Class 9: Apparatus for recording, transmitting and reproducing of sounds and images; data processing equipment including computers, computer memories, viewing screens, keyboards, processors, printers and scanners; computer programs stored on tapes, disks, diskettes and other machine-readable media';

'Class 16: Listed computer programs; manuals; newspapers and publications; education and teaching material'.

4 On 18 February 1999 the transfer of the Community trade mark application to the applicant was entered in the case-file pursuant to Articles 17 and 24 of Regulation No 40/94 and Rule 31(8) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1).

5 By decision of 21 May 1999, the examiner refused the application under Article 38 of Regulation No 40/94 on the ground that the term STREAMSERVE was descriptive of the goods concerned and was devoid of any distinctive character.

6 On 20 July 1999 the applicant filed a notice of appeal at the Office under Article 59 of Regulation No 40/94 contesting the decision of the examiner to the extent to which the latter had refused the application for registration in respect of goods other than newspapers and education and teaching material.

7 On 1 October 1999 the appeal was remitted to the examiner for interlocutory revision pursuant to Article 60 of Regulation No 40/94.

8 Subsequently the appeal was remitted to the Second Board of Appeal.

9 By decision of 28 February 2000 ('the contested decision'), the Board of Appeal dismissed the appeal.

10 The Board of Appeal held, essentially, that the way in which the examiner had applied Article 7(1)(b) and (c) of Regulation No 40/94 was well founded as regards the goods to which the appeal related.

Forms of order sought

11 At the hearing, which the applicant did not attend, the Office stated that the term STREAMSERVE is actually used as such.

12 The applicant claims that the Court should:

— annul the contested decision;

— remit the case to the examiner;

— order the Office to pay the costs.

13 In its reply, the applicant claims, in the alternative, that the Court should annul the contested decision in so far as the contested decision upholds the refusal to register any goods other than 'apparatus for recording, transmitting and reproducing of sounds and images' and remit the case to the examiner.

14 The Office contends that the Court should:

— dismiss the application;

— order the applicant to pay the costs.

Admissibility of the claim that the case be remitted to the examiner

Arguments of the parties

15 The Office submits that this claim is inadmissible on the ground that, under Article 63(3) of Regulation No 40/94, the Court of First Instance has jurisdiction only to annul or to alter decisions of the Board of Appeal, whilst it is for the Office, under Article 63(6) of Regulation No 40/94, to take the necessary measures to comply with the judgment of the Court of First Instance. Since the contested decision was given by a Board of Appeal, the latter is competent, within

the Office, to comply with the judgment of the Court of First Instance. Consequently, the Court of First Instance would be encroaching on the prerogatives of the Office if it ordered the case to be remitted to the examiner.

16 The applicant has not expressed any specific views on this point.

Findings of the Court

17 It must be borne in mind, first of all, that under Article 63(3) of Regulation No 40/94 the Court has jurisdiction both to annul and to alter the contested decision and that, under Article 63(6) of that regulation, the Office is required to take the measures necessary to comply with the judgment of the Court of First Instance.

18 As is clear from the case-law of the Court of First Instance, under Article 63(6) of Regulation No 40/94 the Court of First Instance is not entitled to issue directions to the Office (Case T-331/99 *Mitsubishi HiTec Paper Bielefeld* v *OHIM* (Giroform) [2001] ECR II-433, paragraph 33). However, by remitting the case to the examiner, the Court would not be imposing on the Office any obligation to take action or refrain from doing so and would not therefore be issuing directions to the Office. It follows that the claim that the case be remitted to the examiner is not inadmissible under Article 63(6) of Regulation No 40/94.

19 Moreover, remission of the case to the examiner may be ordered by the Board of Appeal under Article 62(1) of Regulation No 40/94 and therefore falls within the measures which may be taken by the Court of First Instance in the exercise of its power to amend decisions, as provided for in Article 63(3) of Regulation No 40/94.

20 It follows that the claim that the case be remitted to the examiner is admissible.

Substance

21 The applicant raises three pleas in law, alleging infringement of Article 7(1)(c) of Regulation No 40/94, infringement of Article 7(1)(b) thereof and breach of the principle of non-discrimination.

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

Arguments of the parties

22 The applicant claims that refusal, on the basis of Article 7(1)(c) of Regulation No 40/94, to register a Community mark is justified only where its descriptive content is immediately, clearly and unmistakably obvious in relation to the goods or services specified in the application. In fact, experience shows that consumers do not perceive descriptive meanings in marks. Therefore, word signs whose descriptive meanings are apparent only after a process of intellectual reasoning should not be refused registration.

23 According to the applicant, it is unlikely that the two words 'stream' and 'serve' immediately and directly convey the type of abstract meaning within the field of information technology suggested by the Board of Appeal.

24 The applicant submits in particular that the Board of Appeal has not established that the word 'serve' is an abbreviation of the technical term server. Recalling the decision of the Third Board of Appeal in Case R 26/1998-3, NETMEETING, the applicant claims that account must be taken to a certain degree of the more general meanings of the word serve, such as be a 'servant to somebody', 'work for somebody', 'supply with goods and services' or 'be satisfactory for a need or purpose'. If that approach is taken, it is apparent that the word 'serve' does not have either a single unambiguous meaning or a meaning which relates specifically to the goods concerned and, therefore, the sign STREAMSERVE does not suggest an immediate link to those goods.

25 The applicant considers that, in any event, the sign STREAMSERVE taken as a whole has a different meaning from that of the individual words which make it up.

26 At the very most, according to the applicant, the sign STREAMSERVE could be regarded as suggestive but not as descriptive.

27 The applicant submits that registration of the sign STREAMSERVE would not result in the creation of obstacles for the applicant's competitors since the latter

are able to use, as trade marks, a large number of other combined terms including either the word 'stream' or the word 'serve'.

28 Furthermore, in doubtful cases, registration of the same sign in other Member States has a presumptive effect for the purposes of the Office's registration procedures.

29 In the present case, it maintains that the term STREAMSERVE was, prior to the contested decision, registered in Sweden and Norway, trade mark law in those countries having been harmonised by First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 p. 1). The Swedish registration covers the same goods as those at issue in the present case. Furthermore, the Swedish Patent and Trade Mark Office assesses English word signs in the same way as Swedish ones.

30 The applicant also states that on 28 March 2000 it filed an application at the United Kingdom Patent Office Trade Marks Registry for registration of the sign STREAMSERVE for goods falling within Class 9, encompassing goods designated as 'data processing equipment including computers, computer memories, viewing screens, keyboards, processors, printers and scanners; computer programs stored on tapes, disks, diskettes and other machine-readable media', as well as certain computer services falling within Class 21. That application was published to allow oppositions to be entered without the Patent Office having raised any objections based on absolute grounds for refusal.

31 The applicant observes that, for the purposes of registering trade marks, the Swedish Patent Office and the UK Patent Office apply more stringent criteria than the Office inasmuch as they carry out an *ex officio* examination of the grounds of refusal.

32 Furthermore, on 30 March 2000, the applicant filed an application at the Deutsches Patent- und Markenamt (German Patent and Trade Mark Office) for registration of the sign STREAMSERVE for the same goods and services as those specified in the registration procedure initiated in the United Kingdom. That application was published on 31 August 2000 to enable oppositions to be entered, without the Deutsches Patent- und Markenamt raising any objections founded on absolute grounds for refusal. For the purposes of trade mark registration, the Deutsches Patent- und Markenamt applies identical or analogous criteria to those applied by the Office. In addition, English word signs are assessed in the same way as German ones.

33 Finally, the applicant states that the sign STREAMSERVE was registered in the Benelux countries on 29 March 2000 and in France on 20 April 2000 in respect of the same goods and services as those specified in the application filed in the United Kingdom. Furthermore, applications for registration were published for opposition (in Spain on 2 July 2000 and in the United States of America on 31 October 2000) and applications for registration were filed (in Denmark on 28 March 2000 and in Italy on 4 April 2000).

34 For its part, the Office rejects the applicant's arguments and submits that the contested decision is not vitiated by any error in law. That appraisal applies to all the goods covered by the application. As regards more specifically the categories of goods described as 'manuals' and 'publications', the Office contends that the sign STREAMSERVE is also descriptive of those goods since stream-serving technology can be used for the transmission of texts.

Findings of the Court

35 Under Article 7(1)(c) of Regulation No 40/94, registration is to be refused for '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'. Moreover, Article 7(2) of Regulation No 40/94 states that '[p]aragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community'.

36 Article 7(1)(c) of Regulation No 40/94 prevents the signs or indications referred to in that provision from being reserved to one undertaking alone because they have been registered as a mark. That provision thus pursues an aim which is in the public interest, namely that such signs or indications may be freely used by all (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 25).

37 As regards the descriptive character of a sign, it must be pointed out, first of all, that it must be appraised in relation to the way it is perceived by the public to whom it is specifically addressed.

38 At the hearing the Office stated correctly that the relevant public to whom it is addressed comprises average English-speaking consumers who use the Internet and are interested in its audiovisual aspects. Moreover, that public is deemed to be reasonably well informed and reasonably observant and circumspect (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26, and, to the same effect, Case T-359/99 *DKV* v *OHIM* (EuroHealth) [2001] ECR II-1645, paragraph 27).

39 As regards the applicant's argument that third parties, and more particularly its competitors, do not need to use the sign at issue to designate the goods to which the application relates, it must be observed that, in paragraph 35 of *Windsurfing Chiemsee*, the Court of Justice held that the application of Article 3(1)(c) of Directive 89/104, which corresponds to Article 7(1)(c) of Regulation No 40/94, does not depend on there being a real, current or serious need to leave a sign or indication free.

40 Accordingly, as the Office has rightly pointed out, for the purpose of applying Article 7(1)(c) of Regulation No 40/94, it is necessary only to consider, on the basis of the relevant meaning of the word sign at issue, whether, from the viewpoint of the public addressed, there is a sufficiently direct and specific relationship between the sign and the goods for which registration is sought.

41 In that connection, it must be observed, as a preliminary point, that the term STREAMSERVE is a word made up of a basic verb (serve) and a noun (stream). For the consumers concerned, the term thus composed does not appear unusual.

42 As regards the meaning of the term STREAMSERVE, it is clear from paragraphs 12 and 13 of the contested decision and from the explanations given by the Office at the hearing that that term refers to a technique for transferring digital data from a server, enabling them to be processed as a steady and continuous stream. In that connection, the applicant's arguments concerning the various possible meanings of the element 'serve' are irrelevant. In view of the goods for which registration is sought, the meaning of the terms 'stream' and 'serve' adopted by the Office is correct. However, it must be borne in mind that, to be caught by Article 7(1)(c) of Regulation No 40/94, it is sufficient if at least one of the potential meanings of a word sign designates a characteristic of the goods or services concerned.

43 As regards the nature of the relationship between the term STREAMSERVE and the goods concerned, the Board of Appeal found, in paragraph 12 of the contested decision, that that term is directly descriptive of the intended purpose of the goods.

44 As regards goods falling within the categories 'apparatus for recording, transmitting and reproducing of sounds and images', 'data processing equipment including computers, computer memories, viewing screens, keyboards, processors, printers and scanners', 'computer programs stored on tapes, disks, diskettes and other machine-readable media' and 'listed computer programs', the Office observed pertinently, in its response and rejoinder and at the hearing, that the technique of transferring digital data from a server so as to enable them to be processed as a steady and continuous stream involves, or indeed requires, the use of those goods. The abovementioned technique does not merely constitute a field in which those goods are applied but rather is one of their specific functions. Accordingly, for the public addressed, there is a sufficiently direct and specific relationship between the term STREAMSERVE and those goods.

45 As regards, more particularly, screens, keyboards, processors, printers and scanners, it must be observed that those goods do not appear as such in the application for registration but are mentioned only as examples of goods falling within the category 'data processing equipment'. Accordingly, the abovementioned goods must not be taken into account in the appraisal of the descriptive character of the term at issue. Therefore, even if it were assumed that a sufficiently direct and specific link between the term STREAMSERVE and those goods were lacking, the appraisal set out above would not thereby be undermined.

46 Moreover, even if the term STREAMSERVE were assumed not to be descriptive of all the goods included in the category 'data processing equipment', it must be observed that the applicant has applied for registration of the sign at issue for all

goods in that category without drawing any distinction between them. Accordingly, the Board of Appeal's assessment that it relates to all those goods must be confirmed (see, to that effect, *DKV* v *OHIM*, cited above, paragraph 33).

47 As regards the national decisions referred to by the applicant, it must be borne in mind that, as is clear from the case-law, the Community trade mark regime is an autonomous system with its own set of objectives and rules peculiar to it; it is self-sufficient and applies independently of any national system (Case T-32/00 *Messe München* v *OHIM* (electronica) [2000] ECR II-3289, paragraph 47). Consequently, the registrability of a sign as a Community mark must be assessed by reference only to the relevant Community rules. Accordingly, the Office and, if appropriate, the Community judicature are not bound by a decision given in a Member State, or indeed a third country, that the sign in question is registrable as a national mark. That is so even if such a decision was adopted under national legislation harmonised with Directive 89/104 or in a country belonging to the linguistic area in which the word sign in question originated.

48 It follows that the applicant's argument based only on the existence of national decisions to the effect that the term STREAMSERVE is registrable as a national mark, and in particular the decision given in the United Kingdom, is irrelevant. Moreover, the applicant has put forward no argument of substance that could be inferred from those decisions.

49 It is clear from all the foregoing that the term STREAMSERVE may serve, within the meaning of Article 7(1)(c) of Regulation No 40/94, to designate a characteristic of the goods mentioned in paragraph 44.

50 As regards goods in the categories 'manuals' and 'publications', the Office has not proved to a sufficient legal standard that the term STREAMSERVE designates the purpose or any other characteristic thereof. The technique of transferring digital data from a server, enabling them to be processed in a steady and continuous stream, does not require or even involve the use of those goods. Nor can it be alleged, as the Office does in its rejoinder, that the term in question is descriptive of those goods because the technique to which that term refers can also be used for the transfer of texts by electronic means. The transfer of texts by electronic means is, at most, a field of application of that technique but not a technical function of the goods in question. Moreover, the term STREAMSERVE likewise does not appear to designate another characteristic of the abovementioned goods. Accordingly, for the public addressed, there is not a sufficiently direct and specific relationship between the term STREAMSERVE and those goods.

51 It follows that the plea alleging infringement of Article 7(1)(c) of Regulation No 40/94 must be upheld with respect to the goods in the categories 'manuals' and 'publications' and must be dismissed as regards all the other goods.

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

Arguments of the parties

52 The applicant argues that the mark is sufficiently inventive to possess the minimum distinctive character required for registration.

53 The Office contends that signs which are descriptive of the kind, quality, quantity or other characteristics of the goods or services in respect of which registration is sought frequently fall within the scope of both Article 7(1)(c) of Regulation No 40/94 and Article 7(1)(b) thereof. The Office contends, therefore, that the arguments developed by it concerning the descriptive character of the mark applied for are also relevant as regards the absence of distinctive character.

54 As regards the applicant's argument that the sign STREAMSERVE is inventive, the Office considers that the use, for the goods in respect of which registration is sought, of the combination of the two words stream and serve is neither unusual nor inventive. According to the office, the term STREAMSERVE does not convey any additional message beyond the meaning of those two words put together. Consequently, the term STREAMSERVE is devoid of the minimum distinctive character required.

Findings of the Court

55 Under Article 7(1)(b) of Regulation No 40/94, registration is to be refused for 'trade marks which are devoid of any distinctive character'. Moreover, Article 7(2) of Regulation No 40/94 states: '[p]aragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community'.

56 Furthermore, the distinctive character of a sign can be appraised only by reference to the goods or services for which registration is sought.

57 In this case, since the contested decision concerns goods of which it has been held above that the term STREAMSERVE is descriptive, it must be borne in mind that, according to consistent case-law, it is sufficient for one of the absolute grounds of refusal listed to apply for the sign not to be registrable as a Community trade mark (Case T-345/99 *Harbinger* v *OHIM* (TRUSTEDLINK) [2000] ECR II-3525, paragraph 31, Case T-360/99 *Community Concepts* v *OHIM* (Investorworld) [2000] ECR II-3545, paragraph 26, and Case T-24/00 *Sunrider* v *OHIM* (VITALITE) [2001] ECR II-449, paragraph 28). To that extent, this plea must therefore fail.

58 It is appropriate, on the other hand, to consider the substance of the plea in so far as the contested decision concerns goods falling within the categories 'manuals' and 'publications'.

59 According to paragraph 15 of the contested Decision, the Board of Appeal considered that the term at issue is 'directly descriptive of the goods covered by the application' and, therefore, that it is not distinctive. The Board of Appeal therefore inferred, in substance, that the term at issue was not distinctive because of its descriptive character. However, it has been held above that, as far as the abovementioned goods are concerned, registration of the term STREAMSERVE could not be refused on the basis of Article 7(1)(c) of Regulation No 40/94. Consequently, the reasoning of the Board of Appeal in relation to Article 7(1)(b) of Regulation No 40/94 must be rejected, since it is based on the error established above.

60 Furthermore, it must be pointed out that neither the contested Decision, nor the records of the Office nor the explanations given by the Office at the hearing contain anything to demonstrate that the term STREAMSERVE is not distinctive for goods in the categories 'manuals' and 'publications'.

61 It follows that the plea alleging infringement of Article 7(1)(b) of Regulation No 40/94 must also be upheld in so far as it relates to goods in the categories 'manuals' and 'publications', and must be rejected as regards all other goods.

The plea alleging breach of the principle of non-discrimination

Arguments of the parties

62 The applicant maintains that the Board of Appeal infringed the principle of non-discrimination by rejecting its appeal, whereas in case R 55/1999-1, the First Board of Appeal allowed registration of the sign IMAGESTREAM for the same goods, with the exception of 'apparatus for recording, transmitting and reproducing of sounds and images'. According to the applicant the two cases are sufficiently comparable to merit identical treatment. In that connection, the applicant observes, in particular, that the list of products in respect of which the claim is made is identical in both cases, regard being had to the exclusion formulated in the ancillary request made in the reply of 'apparatus for recording, transmitting and reproducing sounds and images'. However, according to the applicant, in case R 55/1999-1 the First Board of Appeal considered that the sign IMAGESTREAM was merely suggestive. However, the word 'serve' is at the very least no more descriptive of the goods concerned than the word 'image'.

63 The Office, although approving the principle that it must avoid treating identical or comparable cases in a discriminatory manner, replies that the registrability, as a Community mark, of each sign must be examined in detail by reference to the inherent characteristics of that sign.

64 The Office submits that the signs IMAGESTREAM and STREAMSERVE are different and that no evidence has been adduced as to the daily use of the words 'image' and 'stream' to describe the goods referred to or concerning the applicant's contention that the word 'image' is no less descriptive than the word 'serve'.

65 Furthermore, according to the Office, no change to the list of goods covered by the application would have any effect on the legality of the contested decision.

Findings of the Court

66 It must be observed, in the first place, that decisions concerning registration of a sign as a Community mark which the Boards of Appeal are called on to take under Regulation No 40/94 are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the legality of the decisions of Boards of Appeal must be assessed solely on the basis of that regulation, as interpreted by the Community judicature, and not on the basis of a previous decision-making practice of those boards.

67 Two hypotheses therefore exist. If, by accepting, in a previous case, the registrability of a sign as a Community mark, the Board of Appeal correctly applied the relevant provisions of Regulation No 40/94 and, in a later case comparable to the previous one, the Board of Appeal adopted a contrary decision, the Community judicature will be required to annul the latter decision because of infringement of the relevant provisions of Regulation No 40/94. In this first hypothesis, the plea alleging breach of the principle of non-discrimination must therefore fail. On the other hand, if, by accepting in an earlier case the registrability of a sign as a Community mark, the Board of Appeal erred in law and, in a later case, comparable to the previous one, the Board of Appeal adopted

a contrary decision, the first decision cannot be successfully relied on to support an application for the annulment of the latter decision. It is clear from the case-law of the Court of Justice that observance of the principle of equal treatment must be reconciled with observance of the principle of legality according to which no person may rely, in support of his claim, on unlawful acts committed in favour of another (see, to that effect, Case 134/84 *Williams* v *Court of Auditors* [1985] ECR 2225, paragraph 14, and Case 188/83 *Witte* v *Parliament* [1984] ECR 3465, paragraph 15). On the basis of this second hypothesis, the plea alleging breach of the principle of non-discrimination must therefore also fail.

68 It follows that the plea alleging breach of the principle of non-discrimination must fail.

69 For the sake of completeness, it must be observed that, whilst it may be accepted that factual or legal grounds contained in an earlier decision might constitute arguments to support a plea alleging infringement of a provision of Regulation No 40/94, it must be pointed out that, in this case, the applicant has not claimed that the decision concerning the mark IMAGESTREAM contains grounds such as to call in question the assessment made above in relation to the pleas alleging infringement of Article 7(1)(c) and (b) of Regulation No 40/94. It must also be observed that, in its application, the applicant itself indicated, in regard to the semantic analysis of the word 'stream', which is an element common to the signs at issue, that the Boards of Appeal upheld the same meaning in both cases.

70 It follows from all the foregoing that the application must be upheld as regards goods falling within the categories 'manuals' and 'publications' and must for the rest be dismissed.

The applicant's claim in the alternative and the claim that the case should be remitted to the examiner

71 As regards the applicant's claim in the alternative that the contested decision should be annulled and remitted to the examiner in respect of goods other than 'apparatus for recording, transmitting and reproducing of sounds and images', it must be pointed out that this claim in the alternative is subsumed under the main claim and must therefore be rejected to the same extent as the main claim.

72 Pursuant to Article 63(3) of Regulation No 40/94, the Court of First Instance, as stated in paragraph 17 above, has jurisdiction both to annul and to alter the contested decision. However, to the extent to which it is appropriate to uphold the present application, it must be concluded that the applicant's interests are sufficiently safeguarded by annulment of the contested decision without there being any need for the case to be remitted to the examiner.

Costs

73 Under Article 87(3) of the Rules of Procedure, the Court may order that the costs be shared where each party succeeds on some and fails on other heads. In the present case, since the applicant's application has been granted only in respect of a limited number of goods, the applicant must be ordered to bear its own costs and to pay two thirds of the defendant's costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber),

hereby:

1. Annuls the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 28 February 2000 (Case R 423/1999-2) as regards goods in the categories 'manuals' and 'publications';

2. For the rest, dismisses the application;

3. Orders the applicant to bear it own costs and to pay two thirds of the defendant's costs and orders the defendant to bear one third of its own costs.

Mengozzi Tiili Moura Ramos

Delivered in open court in Luxembourg on 27 February 2002.

H. Jung
Registrar

P. Mengozzi
President