

European Union Intellectual Property Office

Grand Board of Appeal

Alicante, Spain

RE: Cases R 1613/2019 *Iceland Foods Limited v. Icelandic Trademark Holding ehf* and R 1238/2019-1 *Iceland Foods Limited v. Islandsstofa (Promote Iceland), The Icelandic Ministry for Foreign Affairs and SA - Business Iceland*

Amicus Brief (Third Party Observations) – International Trademark Association

The International Trademark Association (“**INTA**”) has prepared this brief in relation to cases R 1613/2019 *Iceland Foods Limited v. Icelandic Trademark Holding ehf* and R 1238/2019-1 *Iceland Foods Limited v. Islandsstofa (Promote Iceland), The Icelandic Ministry for Foreign Affairs and SA - Business Iceland* pending before the Grand Board of Appeal of the European Union Intellectual Property Office (the “**Grand Board**”).

Article 37(6) of Commission Delegated Regulation (EU) 2018/625 of 5 March 2018 supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union Trade Mark, and repealing Delegated Regulation (EU) 2017/1430 (“**EUTMDR**”) allows for intervention of interested groups or bodies in appeal proceedings before the European Union Intellectual Property Office (EUIPO) referred to the Grand Board.

About INTA

INTA is a global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property (IP) to foster consumer trust, economic growth, and innovation. Members include nearly 6,500 organizations, representing more than 34,350 individuals (trademark owners, professionals, and academics) from 185 countries, who benefit from the Association’s global trademark resources, policy development, education and training, and international network. Founded in 1878, INTA is headquartered in New York City, with offices in Beijing, Brussels, Santiago, Singapore, and Washington, D.C., and a representative in New Delhi. For more information, visit www.inta.org.

An important objective of INTA is to protect the interests of the public by the proper use of trademarks. In this regard, INTA strives to advance the development of trademark and related IP and unfair competition laws and treaties throughout the world, based on the global public interest in avoiding deception and confusion. INTA has been an official non-governmental observer to the World Intellectual Property Organization (“WIPO”) since 1979 and actively participates in all trademark related WIPO proposals. INTA has influenced WIPO trademark initiatives such as the Trademark Law Treaty, and also is active in other international arenas, including the Asia Pacific Economic Cooperation Forum (“APEC”), the Association of Southeast Asia Nations (“ASEAN”), the European Union (EU), and the World Trade

Organization (“WTO”).

The present brief was drafted by INTA independently of the parties in the case at issue.

INTA’s interest in the case

INTA is not a party in the case but believes that the case is significant to the development of trademark law and presents itself as an *amicus curiae* (“friend of the court”) in the matters raised therein, as it has done in the past (see **Annex A** listing previous amicus interventions by INTA before European courts and the Grand Board).

Through its International Amicus Committee, INTA provides expertise concerning trademark and other IP-related laws to courts and trademark offices around the world through the submission of *amicus curiae* briefs or similar filings. Through these kinds of filings, INTA takes advantage of procedures that allow an independent third party to a proceeding to voluntarily offer an opinion on a legal matter, such as the proper interpretation or application of the law, or an explanation for why certain policies are superior.


The purpose of INTA’s intervention in such cases is to ensure that the court or tribunal is fully informed about the relevant issues that may impact the law in a given jurisdiction. Unlike the parties in litigations, who typically focus on the specific facts of a case and argue for a particular outcome, INTA plays a neutral role, addressing only the legal issues. INTA hereby acts in the interest of the represented manufacturers, producers, suppliers of services, traders or consumers, who are affected by the various issues of concern in this case regarding the analysis of the **distinctiveness/descriptiveness of state names** in the context of their ability to serve as a source indicator and thus as a trademark. Accordingly, INTA is acting in the interest of parties that will be affected by the result of this case as required by Art 37 (6) EUTMDR.

INTA hopes that this submission may be of assistance to the Grand Board.

Background and procedural overview

1. The matter concerns the cancellation proceedings against two EU trademarks (**EUTM**) registered in the name of Iceland Foods Limited for a variety of goods and services. Iceland Foods Limited was founded in 1970 and is a major British food retailer. It has over 900 stores throughout the UK, with further stores owned or franchised stores across Europe, particularly in Ireland, with a turnover of billions of euros.
2. The first contested trademark is the EUTM no 2673374 **ICELAND** (*word*). It was filed by Iceland Foods Limited before the EUIPO on April 19, 2002 and was registered on December 9, 2014 for goods and services in classes 7, 11, 16, 29, 30, 31, 32 and 35. A cancellation (invalidity) action was filed by Islandsstofa (Promote Iceland), The Icelandic Ministry for Foreign Affairs and SA - Business Iceland under no. 14 030 C on November 14, 2016. The grounds invoked were Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b), (c) and (g) EUTMR. The cancellation action was upheld by the EUIPO Cancellation Division by decision of April 5, 2019 on the basis of Article 7(1)(c) EUTMR only.
3. The Cancellation Division held that the mark was descriptive of the geographic origin of the goods and services. Acquired distinctiveness was raised but considered not to have been proved. Such decision was appealed before the EUIPO Board of Appeals (BoA) on

June 5, 2019 and observations were filed. The BoA (First Board) considered that the case is important because, *inter alia*, it highlights the issue of using the names of nations as trademarks (par. 14) and the scope of objection that arises under Article 7(1)(c) EUTMR when a sign is a geographical name (par. 23). It issued an Interim Decision on January 11, 2021 (**First Interim Decision**) referring the case to the Grand Board. Under the First Interim Decision, the Grand Board is called upon to decide on the scope of the objection (against registration as a trademark) that can be raised under Article 7(1)(c) EUTMR when a sign is a geographical name. The BoA listed a number of matters on which it requested clarification from the Grand Board.

4. The second contested trademark is the (*figurative*) EUTM no. 011565736 . It was filed by Iceland Foods Limited before the EUIPO on February 12, 2013 and was registered on September 13, 2014 for goods and services in classes 29, 30, 35. A cancellation (invalidity) action was filed by Icelandic Trademark Holding eh on January 23, 2018. The grounds invoked were Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b), (c) and (g) EUTMR.
5. The cancellation action was upheld by the EUIPO Cancellation Division by decision of May 27, 2019 on the basis of Article 7(1)(c) EUTMR only, namely that the mark was descriptive of the geographic origin of the goods and services. Acquired distinctiveness was raised but considered not to have been proved. Such decision was appealed before the EUIPO BoA on July 24, 2019 and observations were filed. The BoA (First Board) considered that the case is important because, *inter alia*, it highlights the issue of using the names of nations as trademarks (par. 13) and the scope of objection against registration of a trademark that arises under Article 7(1)(c) EUTMR when a sign is a geographical name (par. 22). It issued an Interim Decision on January 11, 2021 (**Second Interim Decision**) referring the case to the Grand Board. It again remarked that the Grand Board is called upon to decide on the scope of objection against registration of a trademark that arises under Article 7(1)(c) EUTMR when a sign is a geographical name.

Issues Addressed by INTA

6. In both the First Interim Decision and the Second Interim Decision, the BoA raised a substantial list of questions that, in the BoA's view, required clarification by the Grand Board. In this submission INTA addresses the two questions below:
 - a) "When a trade mark is identical to the name of a whole country, does less emphasis need to be placed on the exact goods for which the geographical location is known, in the assessment of distinctiveness of the mark?" (par. 24 of the First Interim Decision and par. 23 of the Second Interim Decision) and
 - b) "Generally, are these issues applicable not only to Article 7(1)(c) EUTMR, but also for Article 7(1)(b) EUTMR – which relates to objections that might arise where a sign is not patently descriptive, but more generally non-distinctive?" (par. 24 of the First Interim Decision and par. 23 of the Second Interim Decision);
7. The underlying issue in both cases is the registrability of state names and, in general, geographical terms as trademarks. The questions posed to the Grand Board might lead to

the conclusion that names of states or other geographical terms are inherently descriptive/non-distinctive in connection with all categories of goods/services. Therefore, the outcome of the cases might have a disruptive effect on any possible sector/industry. Many registered trademarks consisting of or including state names, or adjectives thereof, exist in various registries, including that of the EUIPO. The validity of all those marks and their enforcement *vis-à-vis* third parties but also of all marks consisting of or containing other geographical terms might therefore be adversely affected, as well as that of future applications.

8. This submission serves to support the right to register a state name and any geographical term, as a trademark, if the relevant requirements are respected.

Legal Framework

9. Article 7 EUTMR¹:

Absolute grounds for refusal

1. *The following shall not be registered:*

[...]

(b) trade marks which are devoid of any distinctive character;

(c) 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; [...]

(g) trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service; [...]

2. *Paragraph 1(b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested as a consequence of the use which has been made of it.*

Reasons why INTA is submitting this brief

10. INTA believes that the fundamental principles of public international law do not recognize an exclusive right of states to geographic terms, including country names. In particular, it is INTA's position that country names are registrable under the Paris Convention for the Protection of Industrial Property (Paris Convention) and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) inasmuch as they constitute signs "capable of distinguishing the goods or services of one undertaking from those of other undertakings" (Article 15(1) TRIPS).

11. Moreover, under Article 6*ter* of the Paris Convention countries do not benefit from special protection for their geographic names and only their official emblems and symbols do. In

¹ Similar provisions were included in the previous EU trademark regulations and the current Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the EU Member States relating to trade marks (EUTMD) and previous EU directives on (national) trademarks. Therefore, the EU case law mentioned in this brief, issued on any of these legal texts, concerns the issues of the case at hand.

fact, comparing the wording of subparagraphs (a) and (b) of Article 6^{ter}(1), it is clear that a distinction was meant between names of international intergovernmental organizations, protected under subparagraph (b)), and names of countries which are not within the exhaustive list of signs covered by subparagraph (a).

12. It is INTA's position that the rights of trademark owners as established under the international legal framework – including the above binding international treaties – should be recognized and protected. No interpretation of the public interest provides justification for disregarding such international legal framework as it applies to trademarks. Such an approach would be inconsistent with the legal obligations of the 177 contracting parties of the Paris Convention under Article 6 and, therefore, should not be upheld.
13. In this respect, WIPO's Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) has been addressing the different practices and approaches, and existing areas of convergence across various countries and territories of the Paris Convention regarding the protection of country names as trademarks. No definitive conclusions have been reached yet but it should be noted that already "*several SCT members indicated that in the context of their normative systems, country names do not constitute a separate or specific category of sign. Such names are included in the broader category of geographical terms, which may either be considered distinctive and therefore registrable as a mark or non-distinctive and refused registration*"². The same approach, namely that state names do not constitute a separate category of marks, is accepted by the CJEU case law. The Interim Decisions refer to a non-uniformity of states' positions vis-à-vis protection of state names³. As an example it is stated that in Greek trademark law there was from 2012 until March 2020 a ban included in the law for the registration of trademarks consisting of or containing state names. However, even during the time when this provision was valid, courts applied it in a very strict manner, namely limited only to official state names (e.g. in the case at issue "Republic of Iceland"), per an official document of the Greek Trademark Office to WIPO in which it was stated that this provision is to be interpreted in the above manner. This provision was eliminated from the law by virtue of the recent amendment of the trademark law in March 2020, as it ran counter to Article 6^{ter} of the Paris Convention.
14. Lastly, it is mentioned in the Interim Decisions⁴ that "*the EUTM proprietor only acquired their EUTM for 'Iceland' in 2005 while the nation (referred to as the 'Icelandic nation') was established in 874*". INTA notes on that point that temporal priority is irrelevant in the absolute grounds' examination, while in any case no prior right of a nation to its name exists as such. It is, furthermore, noted that the General Court in the MONACO case⁵ specifically denied trademark protection for the word MONACO to the Principality of MONACO for a number of goods and services.

² See WIPO document SCT/38/2, available at http://www.wipo.int/edocs/mdocs/sct/en/sct_38/sct_38_www_380656.pdf para. 8.

³ Par. 19 and 20 of the First and Second Interim Decisions respectively, "*The approach taken by the Office is not universal outside the EU. There are examples of nation states that provide for a greater level of protection specifically for country names. For example, in Serbia the 'name or abbreviation of the name of a country' is excluded from registration (Article 5(13) of the Law on Trademarks of Serbia, dated December 11, 2009). The Trademark Law of Albania provides that 'a sign is not registered as a trademark if it consists of the name of a State' (Article 142(1)(g) of the Law N° 9947 on Industrial Property of Albania, dated July 7, 2008)*".

⁴ Pars. 13 and 14 respectively in the First and Second Interim Decision.

⁵ Judgement of 15 January 2015, MONACO, T-197/13.

15. INTA submits that names of states and all other geographical terms are not *per se* unregistrable under the EUTMR and should not be subject to special treatment which is more severe than that applied to other signs which a trademark can consist of. Accordingly, the name of a state and all other geographical terms may serve as an indicator of the origin of the relevant goods/services and be consequently registered as a trademark. It is therefore for the court or tribunal to assess, on a case-by-case basis and not *in abstracto*, whether a specific state name or other geographical term would be perceived as a distinctive and non-descriptive sign in connection with the specific goods/services for which registration is sought. In this regard, INTA recommends that the Grand Board further clarifies that state names are not among those signs for which, according to the established case-law, it is more difficult to establish distinctive character, such as slogans, shape of goods and colors. This is important in order to avoid state names being subject to a higher threshold to establish distinctive character.

A. Descriptiveness - Article 7(1)(c) EUTMR

16. The sole ground found applicable by the BoA to the cases at issue was descriptiveness, under Article 7(1)(c) EUTMR. According to settled case law, descriptiveness of a trademark can be assessed only by reference, first, to the goods or services in respect of which the registration is sought and, second, to the relevant public's perception of that sign (see judgement of 29/04/2004, joined cases C-468/01 P and C-472/01 P, '*Procter & Gamble*', paragraph 33; judgment of 08/05/2008, C-304/06 P, '*Eurohypo*', paragraph 67; and judgment of 21/01/2010, C-398/08 P, '*Audi*', paragraph 34). Accordingly, Article 7(1)(c) EUTMR sets as a requirement that a sign may be deemed descriptive only if it consists "exclusively" of a descriptive element.

17. As stated by the CJEU in Joined Cases C-108/97 and C-109/97, *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v. Boots- und Segelzubehör Walter Huber and Franz Attenberger (Windsurfing Chiemsee)* in order to assess descriptiveness of a geographical term, it shall be examined whether such term designates **a place which is currently associated** in the mind of the relevant class of persons **with the category of goods** concerned, or whether it is *reasonable to assume* that such an association may be established in the future (par. 31). According to the same decision, a geographical term would be descriptive if the geographical area was already famous or known **for the category of goods concerned** (par. 29), or if it is "reasonable to assume" it would become so in the future. This is the so-called "*Freihaltebedürfnis*". The relevant consumers for that assessment are consumers in the territory in respect of which the registration is applied for (par. 29).

18. The issue therefore is whether the area is known (or reasonably assumed to be known in the future) for the specific goods or services. The reason being that, in that case, the term would be associated with those goods in the mind of the consumers of that category of goods. The competent authority must assess under the *Windsurfing Chiemsee* criteria whether a geographical name in respect of which application for registration as a trademark is made designates a place which is currently associated, in the mind of the relevant class of persons, with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future (par. 31).

19. It is clear from the above, that the connection of the geographical term must be with the goods/services for which protection is sought and stems from the fact that these are goods/services for which the geographical area is known or reasonably assumed to be known in the future.
20. The European case-law does not entail that if a geographical area is famous or known to exist in the world, its name shall be automatically and for this reason excluded from registration as trademark. In effect, even if that area or country was evoked in the minds of consumers when seeing the mark, it would not directly describe any of the characteristics of the goods/services. In this respect INTA refers to the fact that the Advocate-General has indicated in its Opinion⁶ to *Windsurfing Chiemsee* that Article 3(1)(c) does not exclude all geographical terms without exception, for example, if:
- a) the geographical name is not known to trade and consumers, at least not as an indication of a geographical place. Geographical terms which are completely unknown cannot fall within the provision, that is, terms referring to places unknown to the general public whether within or outside the Member State in which the question of protection of the trademark arises, because the public is in any event not in a position to connect the goods in question with the places designated by the geographical indications concerned (this situation has also been recognized, for example, by the UK Intellectual Property Enterprise Court in the so-called SIVEC-case in 2017⁷);
 - b) there is the so-called "Mont Blanc" exception: given the characteristics of the place (in the case of Mont Blanc: the highest mountain in Europe), it is unlikely that traders and consumers think that the goods come from that place (in case of the MONT BLANC trademark: writing instruments and stationery, because nobody could logically suppose a pen to originate from the mountain in question).
21. For this reason, the finding, for example, of the General Court in the MONACO decision, mentioned also in the First Interim Decision and the Second Interim Decision, that the word MONACO is descriptive of "*magnetic data carriers, paper and cardboard goods not included in other classes, printed matter, photographs, transport, travel arrangement, entertainment, temporary accommodation*", would raise concerns in view of the *Windsurfing Chiemsee* criteria that the area must be known for such goods/services. On the contrary, given that the Principality of Monaco is known internationally for Formula 1, a generous interpretation of the *Windsurfing Chiemsee* decision might justify a refusal for "sporting activities".
22. INTA notes that the reasoning summarized in para. 20 of the MONACO decision⁸, namely that because a country is known in general as a country, a trademark consisting of the

⁶ Opinion of Mr Advocate General Cosmas delivered on 5 May 1998. - *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger*. - References for a preliminary ruling: Landgericht München I - Germany. - Directive 89/104/EEC - Trade marks - Geographical indications of origin. - Joined cases C-108/97 and C-109/97.- see par. 35. <https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:61997CC0108&from=HR>

⁷ Intellectual Property Enterprise Court (IPEC) 14 June 2017; *Mermeren Kombinat AD v Fox Marble Holdings plc*; [2017] EWHC 1408 (IPEC): "if the average consumer had never heard of a place, the name of that place cannot inherently designate a geographical origin in the mind of the average consumer. Consequently, the trade mark was inherently distinctive".

⁸ In par. 20, the Court explains the rationale of the BoA decision the appeal against which it was considering and in par. 58 it agrees with it: "*the link between each of the products and services concerned and the territory of Monaco, indicating, in respect of 'magnetic data carriers' in Class 9, and 'goods made from these materials [paper and cardboard], not included in other classes; printed matter; photographs' in Class 16, that the contested mark could 'correspond to an indication of the subject matter of those*

name of such country would be descriptive for any goods and services as the consumer when seeing it would think that the goods/services originate from that country, appears to misconstrue the principles of *Windsurfing Chiemsee*.

23. If that were the case, no rights could be acquired on any geographical term or derivatives thereof. Similarly, if all names of known countries, cities, lakes, rivers, areas, were deemed to denote the geographic origin of the goods and services of a trademark, which would thus be descriptive *per se*, the CJEU would not have subjected the descriptiveness of such names to the above mentioned *Windsurfing Chiemsee* criteria.
24. Factors such as the following should be considered irrelevant in the assessment of descriptiveness of a geographical term: whether in the country at issue there is production/provision of the goods/services denoted by the mark, whether consumers are aware of the existence of the said country, whether the country has a strong economy, whether it is an exporting country, whether the goods denoted are needed and used by industries in the said country, whether the goods bear any features that lead consumers not to associate the goods with the said country, that a printed matter or periodical could have as subject matter the country at issue⁹.
25. The CJEU confirmed on the contrary, that these terms are *a priori* registrable and, for this reason, Article 3(1)(c) EUTMR serves to filter those applications that are indeed descriptive in the sense explained by the CJEU¹⁰.

Distinctiveness - Article 7(1)(b) EUTMR

26. On the basis of the settled case-law and EUIPO practice, all descriptive marks are necessarily non-distinctive (CJEU Case C-363/99 *Postkantoor*, par. 86, CJEU Case C-265/00 *BIOMILD* paras. 18, 19 and case law cited therein). As mentioned above, however, in INTA's view, not all trademarks corresponding to geographical terms are descriptive by their nature. It shall therefore also be examined whether a mark consisting of or containing a geographical term meets the *minimum distinctive* character threshold set forth in Article 7(1)(b) EUTMR.
27. INTA considers the criteria for assessing the distinctive character of signs consisting of or containing geographical terms, such as the one at issue, to be no different from those applied to other categories of trademarks (by analogy CJEU Case C-299/99, *Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd*, par. 48).
28. The distinctive character of a mark must be assessed in relation to the goods or services in respect of which registration is applied for and in relation to the perception of the relevant

products, such as books, tourist guides, photographs, etc., all of which relate to the Principality of Monaco' (paragraph 26 of the contested decision)"

⁹ To that effect see also the INTA submissions concerning the George Orwell cases mentioned above. For all the factors see paras. 5 and 6 of the first and second Interim Decisions respectively.

¹⁰ Par. 33. See also par. 25 "Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. These provisions therefore prevent such signs and indications from being reserved to one undertaking alone because they have been registered as trade mark".

consumers (see also Case C-299/99 *Philips*, paras 59 and 63 and Case C-218/01 *Henkel*, par. 50).

29. Furthermore, it shall be assessed only by reference to the relevant public's perception of that sign (see CJEU judgment of 29/04/2004, joined cases C-468/01 P and C-472/01 P, '*Procter & Gamble*', paragraph 33; CJEU judgment of 08/05/2008, C-304/06 P, '*Eurohypo*', paragraph 67; and CJEU judgment of 21/01/2010, C-398/08 P, '*Audi*', paragraph 34).
30. Any greater difficulty as might be encountered in the specific assessment of the distinctive character of certain trademarks cannot justify the assumption that such marks are *a priori* devoid of distinctive character or can acquire such character only through use (CJEU judgement C-404/02 *Nichols*, 16/09/2004, par. 29).
31. Finally, reference is made to the CJEU judgement in *#Darferdas?*¹¹, where, with respect to the analysis of the distinctiveness of a potential trademark, the Court ruled that the facts and circumstances to be taken into account *include all the likely types of use of the mark applied for, which (in the absence of other indications)* in light of the customs in the economic sector concerned, can be practically significant, in the sense that if the sign may serve as trademark in any one of those types of use, this is sufficient to proceed to registration.

Misleading Character - Public Order – Symbols - Bad Faith

32. It is a different question to determine whether a mark consisting of or containing a geographical term would be misleading if it gave the impression that the goods or services are produced in a specific area or bear certain characteristics connected to a specific geographic area. In INTA's opinion, the mere fact that a geographic term appears in a trademark does not automatically and without any other conditions lead consumers to believe that goods/service originate from this area, not only because consumers are used to seeing geographical terms as denoting commercial and not geographic origin. In the case at issue the marks were not found to be misleading.
33. Furthermore, INTA stresses that in any case where misleading character, public order, Article 6ter of the Paris Convention or bad faith concerns are raised, these shall be examined separately. When the mark has passed the absolute grounds test of the above mentioned Article 7(1)(b)-(c) EUTMR it may still be refused registration if it is misleading under Article 7(1)(g) EUTMR or against public order, if it consists of a symbol which is prohibited from registration under Article 6ter of the Paris Convention or if there is bad faith. None of these grounds was found to apply in the present cases. As for the possible misleading or deceptive character of the mark, this would result from its use and therefore would be an issue to be assessed *in concreto* rather than *in abstracto* and in cancellation rather than application proceedings.

Overall Evaluation

34. It follows from all the above that state names are not excluded from registration *a priori*.

¹¹ CJEU Case C-541/18, dated 12 September 2019, *AS v. Deutsches Patent- und Markenamt (#darferdas?)*.

From the First Interim Decision and the Second Interim Decision, it appears that there is a concern about granting an exclusive right to a state name and barring possible descriptive uses of the same by third parties.

35. In this regard, INTA stresses, on the one hand, that possible descriptive uses of the state names at issue made in accordance with Article 14 EUTMR would not amount to trademark infringement and therefore cannot be legitimately barred by the owner of the relevant mark; and on the other hand, that a mere descriptive use of said mark by the owner would expose it to a revocation action for non-use.
36. In other words, barring the registration as a trademark of state names is not the correct tool to preserve possible descriptive uses of such names or other geographical terms, also because the EU trademark system already provides for specific rules to this end. The registrability of a state name (or other geographical name) as a trademark will require a case-by-case fact based analysis.
37. Consequently, it should be taken into consideration that granting trademark protection to the ICELAND signs at issue shall not bar possible descriptive uses of the word ICELAND, which are meant to remain in the public domain.

Conclusion

INTA's views on the cases referred to the Grand Board are, therefore, as follows:

There is no category of indications, including state names, that is *per se* excluded from trademark registration;

The same rules apply for geographical indications as for any other indication;

The same rules apply for state names as for any other geographical indication;

State names or other geographical terms may very well serve as an indicator of the origin of goods/services and be consequently registered as a trademark. It is for the relevant court/tribunal to assess, on a case-by-case basis, whether a specific name of a state or other geographical term would be perceived as non-distinctive in relation to the specific goods/services, by applying the standard threshold which is applicable to all the other signs.

State names or other geographical terms are not *per se* descriptive of the geographic origin, quality or other characteristics of the goods/services. They are *a priori* registrable. The only exception is if the area or country is famous or known for the specific goods/ services or if there are clear indications that such relation between the goods/services involved and the geographical name for which trademark protection is sought, would arise in the future. This must be verified based on a "reality-check"¹². In the German legal literature, for example, it is noted that this should not be a "theoretical-speculative" estimate, but a "*realitätsbezogene Prognose*"¹³ as it is also reflected in CJEU judgement *#Darferdas?*. It is fame or association in relation to the specific goods/services that could render a mark descriptive and preclude

¹² Opinion of Advocate General van Peursum to Dutch Supreme court case *Quilate vs Foralways (L'ARGENTINA)* dated 9 September 2016, par. 3.4 ECLI:NL:PHR:2016:920.

¹³ Ströbele et al, *Markengesetz*, 11th ed. 2015, §8 II no. 2, Rn. 416, p. 491.

registration. A general knowledge among consumers that a geographical area exists would not be sufficient.

On this basis, INTA believes that the Grand Board should make a detailed "reality-based" assessment of each type of goods and services covered by the EU marks of Iceland Foods Limited and of these trademarks' ability to serve as a trademark for such goods and services. Such ability should not be ruled out simply on the basis of general and theoretical criteria such as, per the Cancellation Division's and BoA's decisions, that *'it is reasonable to assume that Iceland might be associated with those goods in the future'* and that the goods *'do not bear any particular features which would lead the relevant consumers not to associate the indication 'Iceland' with the origin of the goods'*.

ANNEX A

INTA has filed the following *amicus* submissions in cases before European courts:

- Third Party Observations on April 1, 2021 in [Case R 964/2020-4, EUROMADI IBERICA, S.A./Zorka Gerdzhikova](#)
- Third Party Observations on 3 March 2021 in [Cases R 1719/2019-5 and R 1922/2019-5, The Estate of the Late Sonia Brownell Orwell ./. EUIPO](#).
- Third Party Observations on 24 February 2021 in [Case R 2248/2019-5, The Estate of the Late Sonia Brownell Orwell ./. EUIPO](#).
- Letter of submission on December 23, 2020 in [Case C-421/20 ACACIA S.R.L v. Bayerische Motoren Werke Aktiengesellschaft](#)
- Third Party Observations on December 1, 2020 to EUIPO Grand Board in [Case R 1304/2020-G, Der Grüne Punkt Duales System Deutschland GmbH ./. Halston Properties, s.r.o. GmbH](#)
- Letter of submission to Novartis AG on September 28, 2020, in Joint Cases *Novartis AG v. Impexco NV* and *C-254/20 Novartis AG v. PI Pharma NV* ([C-253/20 and C-254/20](#))
- Letter of submission to Novartis AG on August 27, 2020, in Joint cases *C-147/20, Novartis Pharma GmbH v. Abacus Medicine A/S* and *C-224/20, Merck Sharp & Dohme B.V. et al. v. Abacus Medicine A/S et al.* ([C-147/20 and C-224/20](#))
- Statement of Intervention on January 6, 2016, in the case *DHL Express (France) v EUIPO* ([T-142/15](#)).
- Statement of Intervention on April 25, 2014 in the case *Voss of Norway v OHIM* ([C-445/13 P](#)).
- Written Observations on March 16, 2010 in the case *Nokia Corporation v. Her Majesty's Commissioners of Revenue and Customs* (HMRC) ([C-495/09](#)).
- Letter of submission to Specsavers International Healthcare Limited on August 23, 2012 in the trademark case *Specsavers International Healthcare Limited & others vs Asda Stores Limited* ([C-252/12](#)).
- Letter of submission to Intel Corporation on September 5, 2007, in the trademark case *Intel Corporation v. CPM United Kingdom Ltd.* ([C -252/07](#)).
- Letter of submission to Adidas and adidas Benelux on June 12, 2007 in the trademark case *Adidas and adidas Benelux* ([C-102/07](#)).
- Letter of submission to SARL Céline on April 25, 2006 in the trademark case *SARL Céline v. SA Céline* ([C-17/06](#)).
- Submission as intervener to the English Court of Appeals on October 16, 2006 in the case *Special Effects v L'Oréal SA* (HC 05C012224, Court of Appeal 2006 0744).
- Letter of submission to Bovemij Verzekeringen N.V. on June 17, 2005 in the case *Bovemij Verzekeringen N. V. v. Benelux Merkenbureau* (ECJ - C-108/05).
- Letter of submission to Schering-Plough Ltd. on December 5, 2003 in the trademark case *Schering-Plough Ltd v. European Commission and EMEA* (CFI T-133/03).

- Letter of submission to Merck Inc. on April 4, 2003 in the trademark case *Paranova A/S v. Merck & Co., Inc, Merck, Sharp & Dohme B. V. and MSD (Norge) A/S* (EFTA Court E-3/02).
- Letter of submission to Praktiker Bau - und Heimwerkermarkte AG on March 20, 2003 in the trademark case *Praktiker Bau - und Heimwerkermarkte AG* (ECJ C- 418/02).
- Letter of submission to Shield Mark on November 1, 2001 in the trademark case *Shield Mark v. J. Kist* (ECJ C-283/01).
- Letter of submission to Libertel Groep B.V. on July 6, 2001 in the trademark case *Libertel Groep B.V. v. Benelux Merkenbureau* (ECJ - C- 104/01)
- Letter of submission to Glaxo Wellcome Limited on October 10, 2000 in the trademark case *Glaxo Wellcome Limited v. Dowelhurst Limited and Swingward Limited* (ECJ - C-143/00)