



Reports of Cases

Case T-11/15

Internet Consulting GmbH
v
European Union Intellectual Property Office

(EU trade mark — Proceedings for a declaration of invalidity — EU word mark SUEDTIROL — Article 7(1)(c) and Article 52(1)(a) of Regulation (EC) No 207/2009 — Absolute ground for refusal — Geographical indication of origin — Descriptive character)

Summary — Judgment of the General Court (Fourth Chamber), 20 July 2016

1. *EU trade mark — Surrender, revocation and invalidity — Invalidity proceedings — Admissibility — Conditions — Interest in bringing proceedings*

(Council Regulation No 207/2009, Arts 5, 52 and 56(1)(a), (b) and (c))

2. *EU trade mark — Definition and acquisition of the EU trade mark — Absolute grounds for refusal — Marks composed exclusively of signs or indications capable of designating the characteristics of a product or service — Assessment of the descriptive nature of a sign — Geographical names*

(Council Regulation No 207/2009, Arts 7(1)(c), and 66(2); Council Regulation No 2081/92)

3. *EU trade mark — Definition and acquisition of the EU trade mark — Absolute grounds for refusal — Marks composed exclusively of signs or indications capable of designating the characteristics of a product or service — Word mark SUEDTIROL*

(Council Regulation No 207/2009, Art. 7(1)(c))

4. *EU trade mark — Definition and acquisition of the EU trade mark — Absolute grounds for refusal — Marks composed exclusively of signs or indications capable of designating the characteristics of a product or service — Aim — Need to preserve availability — Link between the geographical indication of origin and the goods or services — Scope of the examination by EUIPO*

(Council Regulation No 207/2009, Art. 7(1)(c))

5. *EU trade mark — Effects of the EU trade mark — Limitations — Article 12(b) of Regulation No 207/2009 — Purpose — Relationship with Article 7(1)(c) of Regulation No 207/2009*

(Council Regulation No 207/2009, Arts 7(1)(c), and 12(b))

1. Article 5 of Regulation No 207/2009 on the EU trade mark contains a general definition of persons who can be proprietors of EU trade marks. It states that ‘any natural or legal person, including authorities established under public law, may be the proprietor of a [European Union] trade mark’.

It follows that the reference to authorities established under public law is by way of an example of the legal persons who can be proprietors of such a trade mark and that those persons are entitled to exercise their rights pursuant to Article 56(1)(b) and (c) of Regulation No 207/2009. However, there is no indication that Article 56(1)(a) of the regulation which, unlike Article 5, refers only to ‘any natural or legal person’, should be interpreted as excluding authorities established under public law. The grounds for revocation and invalidity, in particular the absolute grounds for invalidity within the meaning of Article 52 of Regulation No 207/2009, may be invoked by any person, regardless of private or public capacity, which is why the only requirement at the end of Article 56(1)(a) is that the person ‘has the capacity in its own name to sue and be sued’. Therefore, the lack of explicit reference in Article 56(1)(a) of Regulation No 207/2009 to authorities established under public law cannot be taken to mean that those authorities are excluded from the scope of that provision.

(see paras 18, 19)

2. According to the case-law, Article 7(1)(c) of Regulation No 207/2009 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

As regards, more particularly, signs or indications which may serve to designate the geographical origin of the categories of goods in relation to which registration of the mark is applied for, especially geographical names, it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response. That case-law is equally applicable to services.

Furthermore, it may be observed, first, that the registration of geographical names as trade marks where they designate specified geographical locations which are already famous, or are known for the category of goods or services concerned, and which are therefore associated with that category in the mind of the relevant class of persons, is excluded as, secondly, is the registration of geographical names which are liable to be used by undertakings and must remain available to such undertakings as indications of the geographical origin of the category of goods or services concerned.

In that connection, it must be observed that the EU legislature, in derogation from Article 7(1)(c) of Regulation 2007/2009, has preserved the possibility of registering signs which may serve to designate geographical origin as collective marks pursuant to Article 66(2) of that regulation and, for certain goods, where they meet the necessary conditions, as geographical indications or designations of origin which are protected under the provisions of Regulation No 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs.

However, it must be noted that, in principle, Article 7(1)(c) of Regulation No 207/2009 does not preclude the registration of geographical names which are unknown to the relevant class of persons — or at least unknown as the designation of a geographical location — or of names in respect of which, because of the type of place they designate, such persons are unlikely to believe that the category of goods or services concerned originates there.

(see paras 29-34)

3. From the point of view of the relevant public, made up of a highly attentive German-speaking population in Italy and the European Union and the Italian-speaking population in Italy, the word mark SUEDTIROL, registered in respect of ‘Business management; business administration; office functions’, ‘Packaging and storage of goods’, and ‘Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of

computer hardware and software; legal services', falling respectively within Classes 35, 39 and 42 of the Nice Arrangement, is descriptive of the services concerned within the meaning of Article 7(1)(c) of Regulation No 207/2009.

The word mark SUEDTIROL will be understood by the relevant public not only as a reference to a geographical region, which gives rise to a favourable response, but also, in view of the prosperity and dynamic economic development of the region, as an indication that the services designated by the mark originate from that region. Moreover, various undertakings established in that region actually offer services of the same type as the services designated by the mark SUEDTIROL, so that when those services are marketed under the said mark, the relevant public will perceive the mark to be an indication of their origin.

In addition, the services covered by the contested mark do not possess any particular quality that could lead the relevant public to disassociate the geographical indication from the geographical origin of those services. Therefore, it must be held that Article 7(1)(c) of Regulation No 207/2009 does not allow registration of the geographical indication in question, which is known to those concerned as the designation of a geographical region to the extent that it is likely that those concerned may imagine that the services in question originate from that region.

(see paras 38, 43, 48)

4. The purpose of Article 7(1)(c) of Regulation No 207/2009 is to prevent an economic player from monopolising a geographical indication of origin to the detriment of its competitors. Even though, in principle, the Board of Appeal cannot refuse registration under Article 7(1)(c) of Regulation No 207/2009 until it has examined the relevance of the geographical indication of origin for such competitive relationships, by considering the association between that origin and the goods and services for which the mark is sought, the depth of that examination may nevertheless vary according to several factors, such as the extent, the reputation or the nature of the geographical indication of origin in question. The likelihood of a geographical indication of origin influencing competitive relationships is strong in the case of a large region with a reputation for the quality of a wide range of goods or services, and is weak in the case of a well-defined place the reputation of which is limited to a restricted number of goods or services.

In circumstances where the geographical indication of origin is already known or reputed, EUIPO may merely confirm the existence of such an association, rather than carrying out an actual examination of the existence of the association.

(see paras 44-46)

5. The purpose of Article 12(b) of Regulation No 207/2009, concerning limitations on the trade mark's effects, in the context of its relationship with Article 7(1)(c) of Regulation No 207/2009, in particular for trade marks which do not fall within the scope of that provision because they are not exclusively descriptive, is to ensure, inter alia, that use of an indication relating to geographical origin, which also forms part of a complex trade mark, does not fall within a prohibition that the proprietor of such a mark is entitled to enforce under Article 9 of the regulation, where that indication is used in accordance with honest practices in industrial and commercial matters.

However, the legal principle concerning the public interest underlying Article 7(1)(c) of Regulation No 207/2009, which is also evident in the possibility, under Article 66(2) of that regulation, for signs or indications which may serve to designate the geographical origin of the goods may, by way of derogation from Article 7(1)(c), to constitute collective marks, does not run counter to Article 12(b) of the regulation, which does not have a decisive bearing on the interpretation of the first provision. Indeed, Article 12(b) of Regulation No 207/2009, which aims, inter alia, to resolve the problems posed by registration of a mark consisting wholly or partly of a geographical name, does not confer on third

parties the right to use the name as a trade mark but merely guarantees their right to use it descriptively, that is to say, as an indication of geographical origin, provided that it is used in accordance with honest practices in industrial and commercial matters.

Therefore, the interest in retaining the availability of indications of geographical origin is not sufficiently protected by the content of Article 12(b) of Regulation No 207/2009.

(see paras 53-56)