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The" allure" of a famous place as a potential absolute ground of refusal? (http://trademarkblog.kluweriplaw.com/2021/04/26/the-allure-of-a-famous-place-as-a-potential-absolute-ground-of-refusal/)

Sara Parrello (http://trademarkblog.kluweriplaw.com/author/sara-parrello/), Fabio Angelini (http://trademarkblog.kluweriplaw.com/author/fangelini1/) (Bugnion S.p.A (https://www.bugnion.eu/en/professionisti/fabio-angelini-2/)) / April 26, 2021 (http://trademarkblog.kluweriplaw.com/2021/04/26/the-allure-of-a-famous-place-as-a-potential-absolute-ground-of-refusal/) / Leave a comment (http://trademarkblog.kluweriplaw.com/2021/04/26/the-allure-of-a-famous-place-as-a-potential-absolute-ground-of-refusal/#respond)

Can the name of a historical, well known place be registered as a trademark? If we think about the NEUSCHWANSTEIN case (C-488/16), the answer is: yes, it can be registered, provided there is no connection between the designated goods/services and the famous place.

But what about the "allure" associated with a well-known site? Should anyone be allowed to exclusively enjoy the mental transfer "of quality" and/or the widespread recognition among consumers? The General Court (GC) in case T-93/20 decided on March 24, 2021 might have given us an answer, but it did not, although the last word has not yet been said.

The EUIPO and the BOA partly refused an EUTM application consisting of the word mark WINDSOR-CASTLE applied for goods in classes 16 and 30 filed by Albert Darboven Holding GmbH & Co KG, a producer of, among other things, coffee and tea, for being non distinctive on the ground the mark would be perceived as a mere advertisement or promotional message for goods sold as souvenirs in Windsor Castle.

Albert Darboven appealed arguing there was no connection between the goods and the famous castle and that the goods were everyday products sold in several contexts (not only in tourism context).

The GC reversed the BOA decision. It observed that as per any other trademarks, the distinctive character of a sign must be evaluated in concrete, first, in relation to the goods or services for which registration is sought and, second, in relation to the perception of the relevant public. The GC therefore held that the expression "windsor castle" does not convey any concrete information referring to the goods in question or their characteristics, since the castle concerned is neither specifically known for the manufacture or design of such goods, nor conveys a laudatory message. The fact that consumer may perceive the mark as an indication that the goods concerned are souvenir sold in the context of tourism related to Windsor Castel was also held irrelevant.

While in the abstract the GC' decision is in line with earlier case law, it is noticeable that EUIPO also argued that, having regard to the usual touristic practice of combining a tour in the castle with the offering of traditional British afternoon tea, the relevant public would perceive the mark applied for as a laudatory indication of a certain "art of living" and not as an indication of the commercial origin of the goods at issue. However, the GC did not consider the argument as it was raised for the first time before the GC.

Now, it does not seem unreasonable to assert that the names of "royal" sites (or of most of any other famous places) may influence consumer's choices either because they are so well known or because they convey "positive" feelings being suggestive and laudatory of certain qualities related to art of living or philosophy of life (or both). After all, the same CJEU recognized in its decision C-143/19 P in the Der Grüne Punkt case (see it here at **http://trademarkblog.kluweriplaw.com/2020/01/28/der-grune-punkt-cjeu-says-yes-to-genuine-use-of-the-collective-recycling-packaging-trademark/ (https://eur04.safelinks.protection.outlook.com/?url=http%3A%2F%2Ftrademarkblog.kluweriplaw.com%2F2020%2F01%2F28%2Fder-grune-punkt-cjeu-says-yes-to-genuine-use-of-the-collective-recycling-packaging-trademark%2F&data=04%7C01%7Csara.parrello%40bugnion.eu%7C4926c44fa45948a3c2bf08d903216fc7%7C6bbd7ce966024e5a**) that a trademark function is not limited to identifying the origin of a certain product but there are other factors to be considered, among

which, also those intangible values which, depending of the nature of the goods covered and the characteristic of their perspective markets, may have a role in creating or preserving an outlet for the goods in question. Thus, by allowing registration of these names, it is also arguable that the registrant would (perhaps unfairly) benefit of a competitive advantage which it is not really entitled to.

However, since the BOA limited its examination to the sole absolute ground provided for in art. 7(1)(b) of Regulation 2017/1001 and did not examine art. 7(1)(c) of that regulation, the annulment of the contested decision is without prejudice to the possible assessment, by the EUIPO of other potentially relevant absolute grounds for refusal. So stay tuned for the second chapter of this saga…

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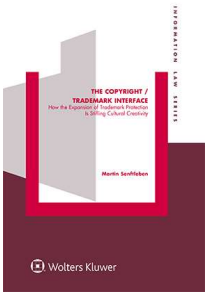

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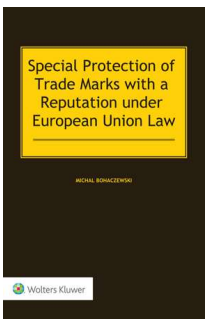

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