

OPINION OF ADVOCATE GENERAL
LÉGER
delivered on 13 November 2003¹

1. How to assess whether a trade mark has become a common name in the trade for a product or service in respect of which it has been registered, with the result that the trade mark may be revoked? Should such a finding be based only on the perceptions of persons in the trade who deal in those types of products or services commercially or should it also be based on the perceptions of the relevant consumers?

I — Legal background

A — *Community legislation*

3. The Directive represents the first steps taken to approximate the national laws relating to trade marks, and its purpose is to put an end to disparities in this field, which may impede the free movement of goods and freedom to provide services and may distort competition within the common market, and which most directly affect the functioning of that market.³

2. Those are, in substance, the questions referred by the Svea hovrätt (Svea Court of Appeal), Sweden, in a dispute between two economic operators regarding a word mark relating to a food product which is commonly consumed in Sweden. By these questions, the national court asks the Court to interpret, for the first time, the provisions of Article 12(2)(a) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks.²

4. To that end, the Directive provides that the conditions for obtaining and continuing to hold a registered trade mark should, in general, be identical in all Member States and that trade marks which have been duly registered should enjoy the same protection.⁴

1 — Original language: French.

2 — OJ 1989 L 40, p. 1 (hereinafter 'the Directive').

3 — The first and third recitals in the preamble to the Directive.

4 — Seventh and ninth recitals in the preamble to the Directive.

5. As regards the registration of trade marks, Article 2 of the Directive states that a trade mark may consist of any sign capable of being represented graphically, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.⁵

6. In keeping with that requirement, Article 3(1) of the Directive lists certain cases in which a sign may not be registered as a trade mark, or, if registered, is liable to be declared invalid.

7. This is the case *inter alia* where a trade mark is devoid of any distinctive character,⁶ as well as where trade marks are 'descriptive', that is to say when they '... consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, intended purpose, value, geographical origin or the time of production of the goods or of rendering the service, or other characteristics of the goods or service'.⁷

8. The same applies to 'trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade'.⁸

9. However, a trade mark is not to be refused registration or to be declared invalid in any of these three cases if, before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character.⁹

10. As regards the protection of trade marks, Article 5(1) of the Directive sets out the principle that a registered trade mark confers on the proprietor exclusive rights in relation to the specified goods or services, entitling him to a monopoly right in the registered sign as a trade mark, without limit of time.

11. Article 12 of the Directive lists three separate cases in which the rights of the holder of a trade mark may be revoked.

5 — This condition reflects the function of affording protection by a registered trade mark which, as indicated in the 10th recital in the preamble to the Directive, is in particular to guarantee the trade mark as an indication of origin.

6 — Article 3(1)(b) of the Directive.

7 — Article 3(1)(c) of the Directive.

8 — Article 3(1)(d) of the Directive.

9 — The first sentence of Article 3(3) of the Directive.

12. One of these is specified in Article 12 (2)(a) of the Directive. It applies where, 'after the date on which [a trade mark] was registered, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service in respect of which it is registered'. It is those provisions of the Directive whose interpretation is requested by the national court.

B — National legislation

15. Article 25 of the Swedish Trade Marks Law 1960:644 of 2 December 1960, as amended for the purposes of implementing the Directive, states that a trade mark may be revoked if it no longer has a distinctive character.

13. Following on from the Directive, Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark¹⁰ introduced the Community trade mark, which is a new type of industrial property, distinct from national trade marks and having equal effect throughout the Community.¹¹

16. According to the order for reference, the *travaux préparatoires* for that law include a statement that 'in determining whether a trade mark has lost its distinctive character, particular account must be taken of the perception of those who deal with the product commercially'.¹³

14. The provisions of the Regulation relating to the obtaining, protection and revocation of rights conferred by a trade mark are the same as, or at least substantially similar to, those of the Directive in that regard.¹²

17. That statement is echoed in the report of the varumärkes- och firmautredning (Working Group on Trade Marks and Business Names), which states that 'it is not sufficient for a considerable proportion of the relevant class of persons to perceive the trade mark as a freely available description, as long as a significant number of those who deal most closely with the product perceive the trade mark as having a distinctive character'.¹⁴ It goes on to say

10 — OJ 1994 L 11, p. 1 (hereinafter 'the Regulation').

11 — Article 1(2) of the Regulation.

12 — Thus, Article 4 of the Regulation reproduces the provisions of Article 2 of the Directive as regards the signs of which a trade mark may consist, Article 7 reproduces the provisions of Article 3 relating to the grounds for refusal or invalidity, Article 9 reproduces the provisions of Article 5 concerning the rights conferred by a trade mark, and, lastly, Article 50 reproduces Article 12 relating to the grounds for revocation of a trade mark.

13 — Bill 1960:167, cited in the order for reference (p. 6).

14 — Extracts from the 'Statens offentliga utredningar' 1958:10 (pp. 169 and 170), cited in the order for reference (p. 5).

that ‘in that regard, it is the perception within the upstream distribution stages, in the wholesale trade, in the purchasing sections of department stores and retail businesses, etc., which is conclusive, rather than that of sales staff in retail shops or of consumers’.¹⁵

was that the trade mark had lost its distinctive character since, in its submission, the word ‘Bostongurka’ is now considered to be a generic term for chopped pickled gherkins. It referred in that regard to two consumer surveys in which the majority of those questioned had considered that the term ‘Bostongurka’ could be freely used by any producer of chopped pickled gherkins.

II — Facts and procedure in the main proceedings

18. Procordia Food AB (hereinafter ‘Procordia’), a company incorporated in Sweden, is the proprietor of the registered trade mark ‘Bostongurka’, relating to a preserve consisting of chopped pickled gherkins.

19. Björnekulla Fruktindustrier AB (hereinafter ‘Björnekulla’), which is also a company incorporated in Sweden, makes pickled gherkins, pickled beetroot and other semi-pickled products.

20. Björnekulla brought proceedings against Procordia seeking revocation of the trade mark of which the latter is proprietor. The basis of Björnekulla’s claim

21. Procordia disputed this claim. It relied on a market research survey of leading operators in the grocery, mass catering and food stall sectors. According to that survey, half of those questioned had claimed to recognise the term ‘Bostongurka’ as a trade mark for chopped pickled gherkins.

22. The court before which the case had been brought, the tingsrätt (District Court), Sweden, dismissed Björnekulla’s claim for revocation on the ground that it had failed to prove that the trade mark no longer had a distinctive character. It based its conclusions in particular on the *travaux préparatoires* for the Swedish Trade Marks Law, and held that the relevant class of persons for determining whether or not the trade mark in dispute had lost its distinctive character consisted of those involved in the distribution chain for the goods in question.

¹⁵ — Ibid.

23. Björnekulla appealed against this decision to the Svea hovrätt. It argued that it was apparent from the Court's case-law that the public's perception was conclusive when establishing whether, under the Directive, a trade mark could be registered and whether there was a likelihood of confusion which might constitute an infringement of the trade mark. The same should apply to the revocation of a trade mark.

class or classes of persons for determining whether a trade mark has become the common name in the trade for a product in respect of which it is registered?'

IV — Analysis

24. Procordia submitted that the *travaux préparatoires* for the Directive and its wording, in particular when the various language versions were compared, showed that the relevant class of persons is those who deal with the product commercially.

III — The question referred for a preliminary ruling

25. In the light of the parties' submissions, the Svea hovrätt decided to stay the proceedings and to refer the following question to the Court for a preliminary ruling:

26. The main issue raised by the question referred by the national court is whether Article 12(2)(a) of the Directive should be interpreted as meaning that in order to assess whether a trade mark has become a common name in the trade for a product in respect of which the mark is registered, with the result that the trade mark may be revoked, account should be taken of the perception only of those in the trade who deal with the type of goods commercially, or whether the perception of consumers of that type of goods is also relevant.

'In cases where a product is handled at several stages before it reaches the consumer what is or are, under Article 12(2)(a) of the Trade Mark Directive, the relevant

27. This question applies particularly where the goods in question pass through several trade sectors before reaching the consumer or end users, that is to say that its commercialisation follows a route which involves several successive intermediaries, such as distributors and retailers.

28. In order to answer that question, in accordance with the methods of interpretation of the Court, the wording of the Directive, in particular in its different language versions, its general scheme and its objectives must be considered in turn.¹⁶

mark has become a common name, the first question is whether, in the light of the wording of the provisions cited above, it is possible to identify the relevant class(es) in that regard.

A — *The wording of Article 12(2)(a) of the Directive*

31. In my opinion, the *travaux préparatoires* for the Directive are not of great assistance in analysing the wording of the provisions in question.

29. Article 12(2)(a) of the Directive provides that ‘a trade mark shall ... be liable to revocation if, after the date on which it was registered, in consequence of acts or inactivity of the proprietor, it has become the common name *in the trade* for a product or service in respect of which it is registered’.¹⁷

32. There is nothing in them which gives clear guidance on the meaning of the words ‘in the trade’, added by the Commission in its amended proposal for the Directive of 17 December 1985.¹⁸

30. The question which lies at the heart of the debate in this case is that of the meaning of the expression ‘in the trade’, which is used in Article 12(2)(a). Assuming that this expression refers to the relevant class(es) of persons whose point of view is to be taken into account in assessing whether a trade

33. Furthermore, contrary to what Procordia and the Swedish Government argue, no conclusive answer lies in the fact that Article 12(2)(a) of the Directive uses the expression ‘in the trade’, rather than the words ‘on the part of the public’, which appear in Articles 4(1)(b) and 5(1)(b) of the Directive. Like the Commission, I am not convinced that these two expressions require to be contrasted. In any event, it would be wrong to think that the expression ‘on the part of the public’ refers only to consumers and excludes persons in the trade. Although, according to settled case-law, ‘the perception of marks in the mind of

16 — See, *inter alia*, Case C-372/88 *Cricket St Thomas* [1990] ECR I-1345, paragraphs 14 to 23, and Case C-6/98 *ARD* [1999] ECR I-7599, paragraphs 22 to 27. See also my Opinions in Case C-372/98 *Cooke* [2000] ECR I-8683, points 24 to 45, and Case C-63/00 *Schilling and Nehring* [2002] ECR I-4483, points 17, 26 and 27.

17 — Emphasis added.

18 — 85/C 351/05 (OJ 1985 C 351, p. 4).

the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion' within the meaning of Articles 4(1)(b) and 5(1)(b) of the Directive,¹⁹ it would be wrong to conclude from that that the role is exclusive, that is to say that the perspective of persons in the trade should be entirely excluded from consideration.

34. In those circumstances, it is appropriate to compare the different language versions of the Directive.

35. As the Court stated in *CILFIT and Others*,²⁰ 'it must be borne in mind that Community legislation is drafted in several languages and that the different language versions are all equally authentic'.²¹ It follows that 'an interpretation of a provision of Community law ... involves a comparison of the different language versions'.²² In other words, as the Court held in *Van der Vecht*,²³ 'the need for a uniform interpretation of Community regulations necessitates that this passage should not

be considered in isolation, but that, in cases of doubt, it should be interpreted and applied in the light of the versions existing in the other ... languages'.²⁴

36. I agree with Procordia that the expression 'in the trade' in the English version appears to refer to a specific class of persons, whose perception alone falls to be taken into account, namely persons in the trade who carry on business in a particular commercial or industrial activity, in a specific area or sector.²⁵ It would therefore appear not to be the case that the perception of consumers falls to be taken into account in assessing whether a trade mark has become a common name for the purposes of Article 12(2)(a) of the Directive.

37. The Finnish version of Article 12(2)(a) of the Directive appears to be to the same effect. The word 'elinkeinotoiminnassa' can be interpreted as referring only to economic operators in the context of their trading activities, to the exclusion of consumers.

19 — See Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 25. See also Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23.

20 — Case 283/81 [1982] ECR 3415

21 — Paragraph 18.

22 — *Ibid.*

23 — Case 19/67 [1967] ECR 345.

24 — Page 354.

25 — See the definition of 'the trade' in *Shorter Oxford English Dictionary*, Oxford, Clarendon Press, 1970: 'those concerned in the particular business or industry in question'. Similarly, see the definition given of the word 'trade' in *Webster's Third New International Dictionary*, Merriam-Webster, USA, 1993: 'the group of persons engaged in a particular occupation, business or industry'.

38. None the less, such an exclusion does not appear in the other language versions of the Directive.

39. The Italian expression 'la generica denominazione commerciale' and the equivalent Greek expression suggest that the assessment of the generic character of a name should be based on the perception of all persons (those in the trade and consumers) who use the term in their commercial relations, that is to say in buying and selling goods and in providing services.

40. This approach also underlies the French version of the Directive. The expression 'dans le commerce' is synonymous with 'in the marketplace'.²⁶ The word 'marketplace' implies the interface of supply and demand or an exchange, a transaction, in particular between persons in the trade and consumers. The use of the expression 'dans le commerce' tends therefore to suggest that in order to assess whether a trade mark has become a common name, the perspective of both persons in the trade who deal with the type of goods or services concerned commercially and of the consumers for whom the goods or services are intended should be taken into account.

41. What is stated above in relation to the French version of the Directive would also appear to apply to the other versions of the Directive, namely the Spanish, Danish, German, Dutch, Portuguese and Swedish versions.²⁷

42. A comparison of these language versions shows that the great majority of them support the proposition that Article 12(2) (a) of the Directive should be interpreted as meaning that in order to assess whether a trade mark has become a common name, the perspective of persons in the trade who deal with the type of goods or services concerned commercially and of the consumers of the type of goods or services in question should be taken into account.

43. Nevertheless, bearing in mind the discrepancies between the different language versions of the Directive, and the lack of clear guidance provided by the *travaux préparatoires* for it, Article 12(2)(a) of the Directive should, in accordance with settled case-law, be interpreted in the light of its general scheme and its objectives.²⁸

27 — See the terms in Spanish 'en el comercio', Danish 'inden for handelen', German 'im geschäftlichen Verkehr', Dutch 'in de handel', Portuguese 'no comércio' and Swedish 'i handeln'.

28 — This method of interpretation in cases of discrepancies between different language versions was established by the Court in Case 30/77 *Bouchereau* [1977] ECR 1999, and restated in Case 11/76 *Netherlands v Commission* [1979] ECR 245, paragraph 6. See also to that effect *ARD*, cited above, paragraph 27.

26 — See *Le Petit Robert, Dictionnaire de la langue française*, Dictionnaires Le Robert, Paris, 1999.

B — *The general scheme of the Directive*

44. According to the settled case-law of the Court, the essential function of the trade mark is to guarantee the identity of the origin of the marked goods or service to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin and to make his choice accordingly.²⁹ The trade mark should thus guarantee the identity of the origin of the marked product, that is to say it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality.³⁰

45. It is for that reason that Article 2 of the Directive lays down the principle that in order to constitute a trade mark, a sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.³¹

46. Several consequences flow from this principle.

47. First, signs or indications which are incapable of distinguishing the goods or services of one undertaking from those of other undertakings cannot be registered as a trade mark, or, if they have been registered, are liable to be declared invalid. That is the effect of Article 3(1)(b), (c) and (d) of the Directive as regards respectively trade marks which are devoid of any distinctive character, descriptive trade marks, and trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

48. Secondly, where, by the use which has been made of it, a sign has acquired a distinctive character which it did not originally have, it may be registered as a trade mark, and, if it has already been registered, is not liable to be declared invalid. That is stated in Article 3(3) of the Directive, by way of qualification to the rules laid down in Article 3(1)(b), (c) and (d), referred to above.

49. Thirdly, in the converse situation, where a sign has, through the use which has been made of it, lost the distinctive character which it originally had at the time

29 — See, to that effect, Case C-10/89 *Hag II* [1990] ECR I-3711, paragraph 14; Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28; and Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 22.

30 — See, *inter alia*, *Hag II*, cited above, paragraphs 13 and 14, and *Canon*, cited above, paragraph 28, and also Case C-143/00 *Boehringer Ingelheim and Others* [2002] ECR I-3759, paragraph 29.

31 — This principle reflects the 10th recital in the preamble to the Directive, which states that the function of the protection afforded by the registered trade mark is in particular to guarantee the trade mark as an indication of origin.

when it was registered as a trade mark, the trade mark may be revoked. That is the effect of Article 12(2)(a) of the Directive.

tor of the trade mark to control the use of it by third parties in business since, under Article 5(1) of the Directive, that exclusive right is capable of existing without limit of time, thereby allowing the proprietor in question to monopolise the sign registered as a trade mark indefinitely.³²

50. Those provisions apply where the use of a trade mark has become so widespread that the sign which constitutes the trade mark in question has come to designate the kind, the type or the nature of the goods or services covered by the registration rather than the specific goods or services originating from a particular undertaking. That is the case, for example, of the terms ‘thermos’ for an insulated flask, ‘walkman’ for a portable stereo, ‘cellophane’ for a transparent film manufactured from cellulose hydrate and used for packaging, and ‘aspirin’ for a medicine which relieves pain and reduces body temperature and which is made from acetylsalicylic acid.

53. Once it is revoked other operators are allowed freely to use the registered sign. Revocation thus pursues an aim which is in the public interest, namely that signs or indications which have become a common name for goods or services in respect of which registration of a trade mark is applied for, or a trade mark has been registered, may be available to or freely used by all.³³ Like Article 3(1)(c) and (d) of the Directive, Article 12(2)(a) reflects the legitimate objective of not allowing registration of a trade mark to be used to perpetuate exclusive rights over terms that are generic or commonly associated with goods or services covered by the registration in question. Each of these provisions prevents such signs or indications from being reserved indefinitely to one undertaking because they have been registered as trade marks.

51. In cases such as those just mentioned, the function of the trade mark as an indication of origin has been lost. There is no longer any need for protection of the sign registered as a trade mark and it is therefore liable to be revoked.

52. The effect of such a revocation is to terminate the exclusive right of the proprie-

32 — See, to that effect, Case C-104/01 *Libertel* [2003] ECR I-3793, paragraph 49.

33 — See, to that effect, Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 25; Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 73; and *Libertel*, cited above, paragraph 52.

54. It follows from the above that Articles 3(1)(c) and (d) and 12(2)(a) of the Directive seek to achieve the same result, namely the guaranteeing of the distinctive character of a trade mark as an indication of origin, and the avoidance of generic terms being reserved indefinitely for a single undertaking by reason of their having been registered as a trade mark.

55. Since these provisions pursue the same result, they must be interpreted in the same way.³⁴ This is all the more the case as they use expressions or concepts which are the same or substantially similar.

56. Article 12(2)(a) of the Directive should therefore be interpreted by reference to Article 3(1)(c) and (d) of that directive.

57. In that regard, the wording of Article 3(1)(d) of the Directive deserves particular attention. In order to assess whether a sign or an indication has become the common

name for goods and services in respect of which the registration of the mark is applied for or has been applied for, with the result that such registration would be refused or that a registered trade mark is liable to be declared invalid, it expressly states that it should be considered whether the sign or indication in question has become customary 'in the current language or in the bona fide and established practices of the trade' (as was held by the Court in *Merz & Krell*, cited above³⁵).

58. In my opinion, this expression clearly refers globally both to the perception of the average consumer of the type of goods or services in question (that is to say to the perception of the reasonably well-informed and reasonably observant and circumspect consumer)³⁶ and to that of persons in the trade who deal with those goods or services commercially.³⁷

35 — The Court held that, although it does not refer expressly to the point, Article 3(1)(d) of the Directive only precludes registration of a trade mark where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that trade mark is sought (paragraph 31). It is accordingly not sufficient that those signs or indications form part of the current language or the bona fide and established practices of the trade; they must also have become the common name for the goods or services to which they relate.

36 — As regards the definition of the average consumer, see, inter alia, *Lloyd Schuhfabrik Meyer*, cited above, paragraph 26. In his Opinion in *Merz & Krell*, cited above, Advocate General Ruiz-Jarabo Colomer emphasised the connection between the average consumer and the current language, within the meaning of Article 3(1)(d) of the Directive (points 51 and 52).

37 — It might be considered that Article 3(1)(d) of the Directive applies to persons in the trade in question in two capacities, namely both as representing the context in which the bona fide and established practices of the trade are forged and as a section of the population which uses the current language, in the manner of the average consumer.

34 — See, to that effect, with particular reference to trade marks, Joined Cases C-427/93, C-429/93 and C-436/93 *Bristol-Myers Squibb and Others* [1996] ECR I-3457, paragraph 40, and Case C-379/97 *Upjohn* [1999] ECR I-6927, paragraph 30.

59. Indeed, this is illustrated by the practice currently followed by the Office for Harmonisation in the Internal Market (trade marks and designs) (OHIM) when applying Article 7(1)(d) of the Regulation, whose wording is the same as that of Article 3(1)(d) of the Directive.

words to its meaning in the bona fide and established practices of the trade.³⁹

61. This interpretation of Article 3(1)(d) of the Directive, in parallel to that in Article 7(1)(d) of the Regulation, should be extended to the interpretation of Article 12(2)(a) of the Directive.

60. On the basis of these provisions in the Regulation, the OHIM undertakes a global assessment of the perspective of the relevant classes of persons, which varies depending on the type of goods or services in question. Thus, where a mark relates to goods whose pattern of consumption is widespread, as may be the case with a food product, particular attention is paid to the meaning of the term in question in the current language, that is to say not only from the perspective of the average consumer, but also that of persons in the trade concerned.³⁸ Where a mark relates to goods or services whose use is limited to a restricted group of persons carrying on a particular trade, regard is had instead to the perception of the term in question by the persons in the trade concerned, in other

62. Article 12(2)(a) of the Directive should thus be interpreted as meaning that it refers, implicitly but necessarily, both to the perspective of the average consumer of the type of goods or services concerned and to that of persons in the trade who deal with the type of goods or services in question commercially.

38 — See the decision of the Cancellation Division of the OHIM of 13 February 2002 (133C 000372920/1) concerning the trade mark 'Bruschetta' relating to certain food products or associated services. Based on the fact that the word 'Bruschetta' appears in dictionaries and is regularly used on the Internet, the Cancellation Division held that the word was clearly used, at least in Italy, to designate an Italian dish made of a slice of toasted bread served with garlic, oil, tomato or other sauces, with the result that it was a common term in everyday language. Accordingly, the application for cancellation of the trade mark was held to be well founded.

39 — See the decision of the first Cancellation Division of the OHIM of 15 December 1999 (C0000901341/1-BSS) concerning the trade mark 'BSS' relating to ophthalmic pharmaceutical preparations and sterile solutions for ophthalmic surgery. That Cancellation Division held that in the medical and pharmaceutical fields the term represented a generic indication for 'balanced salt solution'. See also the decision of the first Board of Appeal of the OHIM of 19 December 2000 (Case R 397/2000-1) concerning the trade mark 'Proteomics' relating to various products and services in the field of scientific and medical research. Relying in particular on articles in specialist works and periodicals, the first Board of Appeal held that the term was already in common use at the time of the registration of the contested trade mark, to designate a particular field of study, which had grown rapidly over recent years, in biotechnology. See, lastly, the decision of the first Cancellation Division of 11 December 2001 (85C 000703579/1) concerning the trade mark 'DLC' relating to razors and razor blades, utensils and various accessories for those goods. Relying on several articles appearing in various periodicals and on a scientific encyclopaedia, that division of the OHIM held that the term in question was an established generic expression in the commercial area of metallurgy and not in purely academic circles to designate an industrial product called 'diamond like carbon', which was much valued for manufacturing cutting implements, such as those covered by the registration of the trade mark concerned.

63. As regards a food product that is commonly consumed, as is the case with the chopped pickled gherkins (at least in Sweden) at issue in the main proceedings, the marketing of which involves several successive intermediaries, it is thus appropriate, in order to assess whether the term protected by the trade mark has become a common name in the trade, to take into account both the perspective of the average consumer and that of persons in the trade who deal with the type of product in question commercially.

64. In my opinion, this analysis is supported by the interpretation given by the Court to Article 3(1)(c) and (3) of the Directive.

65. It should be noted that Article 3(1)(c) of the Directive states that ‘the following shall not be registered or if registered shall be liable to be declared invalid: ... 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’.⁴⁰

66. In *Windsurfing Chiemsee*, cited above, the Court held that Article 3(1)(c) of the Directive ‘is not confined to prohibiting the registration of geographical names as trade marks solely where they designate specified geographical locations which are already famous, or are known for the category of goods concerned, and which are therefore associated with those goods in the mind of the relevant class of persons, that is to say *in the trade and amongst average consumers* of that category of goods in the territory in respect of which registration is applied for’.⁴¹ According to the Court, therefore, it follows from the wording of Article 3(1)(c) that ‘geographical names which are liable to be used by undertakings must remain available to such undertakings as indications of the geographical origin of the category of goods concerned’.⁴²

67. The Court was accordingly making it clear that the descriptive character of a trade mark (at the time of its registration) must be assessed globally, taking into account the perspective of all relevant classes of persons, that is to say both that of the average consumer of the type of goods concerned and of persons in the trade who deal with the type of goods concerned commercially.

68. This global assessment of the nature of a trade mark has also been held to apply

⁴¹ — Paragraph 29, emphasis added.

⁴² — *Ibid.*, paragraph 30.

⁴⁰ — Emphasis added.

when determining whether a sign which did not originally have a distinctive character has acquired that character following the use which has been made of it, so that it may be registered as a trade mark in terms of Article 3(3) of the Directive.

69. In *Windsurfing Chiemsee*, cited above, the Court held that ‘the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings’.⁴³

70. In that regard, the Court stated that ‘in assessing the distinctive character of a mark in respect of which registration has been applied for, the following may ... be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations’.⁴⁴

71. The Court pointed out that in order for the requirement laid down in Article 3(3) of the Directive to be satisfied, the relevant class of persons, or at least a significant proportion thereof, must identify goods as originating from a particular undertaking because of the trade mark. It added that such a conclusion could not be reached solely by reference to general, abstract, data such as predetermined percentages.⁴⁵

72. It follows from this case-law that in the context of the application of Article 3(1)(c) and (3) of the Directive, the question of whether a mark does or does not have a distinctive character, *at the date of its registration*, should be assessed globally, that is to say by considering a group of factors which relate both to the perspective of the average consumer of the type of goods or services concerned and to that of persons in the trade who deal with the goods or services in question commercially.⁴⁶

73. The same should apply for the purposes of assessing the generic character of a trade mark *once it has been registered*.

⁴³ — *Ibid.*, paragraph 52.

⁴⁶ — In his Opinion in *Windsurfing Chiemsee*, cited above, Advocate General Cosmas took care to point out that in assessing the distinctive character of a trade mark which has been acquired through use, the relevant class of persons is essentially made up of consumers within the sector concerned, but also includes, in principle, traders and undertakings selling similar products, as well as manufacturers of such products (point 72).

⁴³ — Paragraph 49.

⁴⁴ — *Ibid.*, paragraph 51.

74. The expression 'in the trade', which appears in Article 3(1)(c) of the Directive, is also found in Article 12(2)(a) of that directive. Both logically and for reasons of legal certainty, it may be assumed that the expression in question should be given the same meaning in both provisions.⁴⁷

where the revocation is based on the generic character of the mark. It may be assumed in such a case that the proprietor will have invested significant sums in order to exploit the mark and to promote it in the market, particularly through advertising, to such a point that it has become the common name for the type of products or services in question.

75. Furthermore, I am of the opinion that whatever applies to assessing the distinctive character of a trade mark at the date of its registration applies equally for the purposes of assessing whether it has retained this character subsequently. It is, in reality, a question of two sides of the same coin.

78. Nevertheless, contrary to the submissions of Procordia and the Swedish Government, the conclusion cannot be drawn that the assessment of the generic character of a trade mark should rest with the perspective only of persons in the trade who deal with the type of goods or services concerned commercially, to the exclusion of that of the average consumer of the type of goods or services in question. In my opinion, such a conclusion would run counter to the objectives of the Directive.

76. Contrary to the submissions of Procordia and the Swedish Government, it is my view that this approach is not called into question by the fact that the revocation of a trade mark is considerably more serious than a decision to refuse to register a sign as a trade mark.

C — *The objectives of the Directive*

77. I do not deny that such a revocation may have material consequences for the proprietor of the trade mark, particularly

79. It must be noted that the Directive represents the first steps taken to approximate national trade mark laws and its purpose is to remove disparities in the field which may impede the free movement of

⁴⁷ — For an illustration of this situation, see, *inter alia*, the Opinion of Advocate General Jacobs in ARD, cited above, point 43.

goods and freedom to provide services and may distort competition within the common market, and which most directly affect the functioning of that market.⁴⁸

would mean opening the door to certain practices that might distort competition within the market.

80. As the Court has held on several occasions, trade mark rights 'constitute an essential element in the system of undistorted competition which the Treaty is intended to establish [and maintain]'.⁴⁹ By guaranteeing the identity of the origin of the marked goods or services to the consumer, trade marks contribute towards the creation of a system of undistorted competition in which undertakings must be able to attract and retain customers by the quality of their products or services.⁵⁰

82. There must be a strong risk that some economic operators, who deal commercially with goods or services that are the same as or similar to those covered by a trade mark, or who wish to enter that market, might resort to bringing proceedings for revocation of the trade mark solely in order to establish themselves in that market, thereby doing serious harm to the interests of their competitor (the proprietor of the trade mark) and benefiting improperly from his efforts and investment in promoting trade in the goods or services in question. The proprietor of the trade mark would be entitled to expect that he would receive lasting benefits from his efforts and investment, since a registered trade mark confers on its proprietor an exclusive monopoly, allowing him to claim the registered sign as a trade mark without limit of time.

81. In my opinion, that objective might be undermined if it were sufficient to prove that a trade mark had become generic only amongst the persons in the trade who deal with the type of goods or services in question commercially, for the trade mark to be revoked. To adopt such an approach

83. That danger, which would inevitably arise if only the perspective of persons involved in the trade were to be taken into account, was also pointed out by Advocate General Cosmas in his Opinion in *Wind-surfing Chiemsee*, cited above, in relation to the assessment of the distinctive character of a trade mark acquired through use. Mostly for reasons of competition, some

48 — First and third recitals in the preamble.

49 — See, inter alia, *Hag II*, cited above, paragraph 13; Case C-349/95 *Loendersloot* [1997] ECR I-6227, paragraph 22; Case C-63/97 *BMW* [1999] ECR I-905, paragraph 62; *Merz & Krell*, cited above, paragraph 21; and *Libertel*, cited above, paragraph 48.

50 — See, to that effect, *Merz & Krell*, cited above, paragraph 21.

economic operators may have a particular interest in the mark being registered or refused registration, in which case the position they adopt will be based on ulterior motives.⁵¹

made of whether a trade mark has become generic, with the result that it may be revoked. As has already been stated, if the Directive provided for revocation on this ground, it was precisely because the trade mark concerned no longer fulfilled its essential function.

84. Quite apart from these considerations based on the objective of freedom of competition which the Directive seeks to achieve, it should be noted that, as the 10th recital in the preamble to the Directive states, the function of the protection afforded by the trade mark is in particular to guarantee the mark as an indication of origin.

87. In my opinion, it would be to misconstrue this essential function of a trade mark to base the assessment of its generic character on the perspective only of persons in the trade who deal with the goods or services concerned commercially, to the exclusion of that of consumers or end users of that type of goods or services.

85. As has already been mentioned, the Court has consistently held that this function consists in guaranteeing the identity of the marked goods or service to the *consumer* or *end user* by enabling him, without any possibility of confusion, to distinguish the goods or service from others which have another origin.⁵²

86. It is in the light of this essential function of a trade mark, which underlies the Directive, that an assessment should be

88. Accordingly, the answer to the question referred should be that Article 12(2)(a) of the Directive should be interpreted as meaning that in order to assess whether a trade mark has become the common name in the trade for a product for which that trade mark is registered, with the result that the trade mark may be revoked, there should be taken into account globally both the perspective of consumers or end users of the type of goods or services concerned, and that of the persons in the trade who deal with that type of goods or services commercially.

51 — See point 72 of the Opinion and the examples given.

52 — See, *inter alia*, *Merz & Krell*, cited above, paragraph 22.

V — Conclusion

89. In the light of the foregoing considerations, I propose that the Court should answer as follows the question referred for a preliminary ruling by the Svea hovrätt:

Article 12(2)(a) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks should be interpreted as meaning that in order to assess whether a trade mark has become the common name in the trade for a product for which that trade mark is registered, with the result that the trade mark may be revoked, there should be taken into account globally both the perspective of consumers or end users of the type of goods or services concerned, and that of the persons in the trade who deal with that type of goods or services commercially.