

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**

(Reference for a preliminary ruling
from the Landgericht München I)

(Directive 89/104/EEC — Trade marks — Geographical indications of origin)

Opinion of Advocate General Cosmas delivered on 5 May 1998	I - 2782
Judgment of the Court, 4 May 1999	I - 2810

Summary of the Judgment

1. *Approximation of laws — Trade marks — Directive 89/104 — Where registration of a trade mark may be refused or the trade mark declared invalid — Trade mark consisting exclusively of an indication of geographical origin — Meaning*
(Council Directive 89/104, Art. 3(1)(c))

2. *Approximation of laws — Trade marks — Directive 89/104 — Where registration of a trade mark may be refused or the trade mark declared invalid — Trade mark devoid of distinctive character — Exception — Distinctive character acquired by use — Meaning — Interpretation — Criteria*

(Council Directive 89/104, Art. 3(3))

1. Article 3(1)(c) of First Directive 89/104 on trade marks is to be interpreted as meaning that:

— it does not prohibit the registration of geographical names as trade marks solely where the names designate places which are, in the mind of the relevant class of persons, currently associated with the category of goods in question; it also applies to geographical names which are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods;

— where there is currently no association in the mind of the relevant class of persons between the geographical name and the category of goods in question, the competent authority must assess whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods;

— in making that assessment, particular consideration should be given to the

degree of familiarity amongst the relevant class of persons with the geographical name in question, with the characteristics of the place designated by that name, and with the category of goods concerned;

— it is not necessary for the goods to be manufactured in the geographical location in order for them to be associated with it.

2. The first sentence of Article 3(3) of the First Directive 89/104 on trade marks is to be interpreted as meaning that:

— a trade mark acquires distinctive character following the use which has been made of it where the mark has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;

- in the case of a trade mark embodying an indication of geographical origin, it precludes differentiation as regards distinctiveness by reference to the perceived importance of keeping the geographical name available for use by other undertakings;
- if the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied;
- in determining whether a trade mark has acquired distinctive character following the use which has been made of it, 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; in that connection, in the case of a trade mark embodying an indication of geographical origin, regard must be had in particular to the specific nature of the geographical name in question;
- where the competent authority has particular difficulty in assessing the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude it from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment.