

Postkantoor in Iceland

On a margin of appreciation for European IP Offices in assessing the descriptiveness of trademarks

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Summary

This article focuses on the assessment of descriptiveness in Europe and the Benelux countries. It shows that opinions still differ on whether the precondition for descriptiveness of a sign is:

- (a) that the public concerned discerns immediately and without further reflection the description of one of the characteristics of the goods and/or services;²
- (b) or, that it is enough to conclude after a full and stringent examination of the sign in relation to the goods and services that

the sign 'may serve' to describe characteristics, both now and in the foreseeable future.

The question must therefore be posed: are these criteria compatible? Or are they inherently incompatible? The author's primary perspective is that of the ex officio trademark examination conducted by the European Union Intellectual Property Office (EUIPO) and the European national offices (NOs). It is axiomatic that the evaluation of descriptiveness in inter partes proceedings before trademark authorities or national judges should be consistent with the ex-officio examination during trademark registration applications. However, it is important to recognise that the surrounding landscape is somewhat different.

First, an update on Benelux case law will be provided to demonstrate the developments under the Benelux Convention on Intellectual Property (BCIP) with regard to the aforementioned criteria and the current situation. After some reflections by the author, in the prominent presence of 'burgers', the article will continue to explore the possibilities and necessity of using both criteria together. The essential room to manoeuvre and properly apply the criteria set out by the European Court of Justice (ECJ) in the *Chiemsee*, *Doublemint*, *Postkantoor* and *Biomild* cases is found in the case law concerning an important species of descriptive signs, namely geographical names.³ Particularly relevant is the *Iceland* case, which was decided by the Grand Board of Appeal of EUIPO on 15 December 2022.⁴

Background

In a previous (2014) article, I called into question the compatibility of the 'may serve' criterion – originating from the case law of the ECJ –

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1 Generated using <https://copilot.microsoft.com/> on 14 June 2025, using the following three prompts: make an image of a postoffice in Iceland > add the flag of Iceland > add the Chiemsee in the background.
2 The original wording in the birthplace of the litigious criterion, namely GC 31 January 2001, T-135/99, ECLI:EU:T:2001:30 (Cine Action) and T-136/99, ECLI:EU:T:2001:31 (Cine Comedy): "(...) does not enable the public concerned to discern immediately and without further reflection the description of one of their characteristics", paras. 26, resp. 27. The wording in the EUIPO Guidelines, version 2025: "(...) descriptive if it has a meaning that is immediately perceived by

the relevant public as providing information about the goods and services applied for. (...) The relationship between the term and the goods and services must be sufficiently direct and specific, as well as concrete, direct and understood without further reflection." NB: with regard to the EUIPO Guidelines text currently in force, please note the subtle, and in my opinion correct, division into two separate mental activities.

3 ECJ 4 May 1999, C-108/97, ECLI:EU:C:1999:230 (Windsurfing Chiemsee), 23 October 2003, C-191/01, ECLI:EU:C:2003:579 (Doublemint) and 12 February 2004, C-363/99, ECLI:EU:C:2004:86 (Postkantoor) and C-265/00, ECLI:EU:C:2004:87 (BIOMILD).

4 Grand Board of Appeal of EUIPO 15 December 2022, joint cases R 1238/2019-G and R 1613/2019-G (ICELAND) and (ICELAND fig.). Appeal in progress, T-105/23 and T-106/23.

with the ‘immediately and without further thought’ condition – originating from EUIPO and consistent case law before the General Court (GC) – when determining the descriptiveness of trademarks.⁵ The article’s somewhat provocative conclusion posited that the *Postkantoor* criterion, i.e. ‘may serve’ was the only correct one, and that ‘immediately and without further reflection’ – originally used only to skilfully tackle a classification list of services – had unintentionally become a hard minimum condition for determining the descriptive character of a sign.⁶

It is essential to establish a link between the sign and the goods or services it designates; failure to do so precludes the sign from serving as an indicator of characteristics. However, as was observed by the United Kingdom in the Advocate General’s opinion in *Doublemint*: “the test of whether the term enables the public concerned immediately and without further reflection to detect the description of a characteristic of the goods in question is not in the Regulation and is excessively restrictive”.⁷

A bit more than a decade later, the moment seems opportune for a re-evaluation of the issue. This is particularly important because the ECJ has not yet provided a satisfactory explanation of how the phrases ‘may serve (...), now and in the foreseeable future’ and ‘immediately and without further reflection’ can be combined into a useful formula. Furthermore, the question remains as to whether there is no problem at all, for example because both elements relate to different stages of the assessment of descriptiveness. The remainder of this article will examine the question of whether it is possible to retain both the bathwater and the child without immediate danger of drowning.

Given the significant number of results returned by a search on Darts-ip™ for ‘immediately and without further reflection (thought / thinking), as well as the Dutch and French variations, it can be concluded that this formula cannot be unobtrusively removed from the *acquis communautaire*.⁸

We will be travelling back from Alicante and Luxembourg to The Hague and Brussels, where a number of significant events took place. Firstly, we will begin by examining the Spartan case that was presented to the District Court and the Court of Appeal in The Hague.⁹

Spartan and Pet’s Budget – the road to white smoke?

The *Spartan* case concerns an infringement claim before the District Court of the Hague, where the descriptiveness argument presented in defence of the case was grounded on the [current] Articles 7(1)(b)(c) (d) EUTMR, 2.2bis(1)(b)(c)(d) BCIP and 4(1)(b)(c)(d) EUTMD as the

trademarks invoked were both EU and Benelux trademarks.¹⁰ In assessing the descriptiveness of the word *Spartan*, the preliminary relief judge ruled as follows:

“Contrary to Spartan Race’s argument, it is not only trademarks that are immediately and without further reflection understood as describing a characteristic of the goods or services offered that are considered descriptive, but also trademarks that now or in the future “may indicate” a characteristic of the goods or services in question in one of their potential meanings. Although the criterion cited by Spartan Race is reflected in a number of judgments of the General Court of the European Union and in the guidelines of the EUIPO, it was developed prior to the aforementioned case law of the Court of Justice of the European Union (see footnote 5). It is therefore incompatible with that case law, not least because it is difficult to see how ‘future reasonably foreseeable use’ (see *Postkantoor* judgment) could be recognisable ‘immediately and without reflection’. The preliminary relief judge finds support for this provisional opinion in the article by T. Westenbroek “*Cogito ergo sum*”.”¹¹

The Court of Appeal dealt with the case by assessing the alleged infringement, finding that there was no risk of confusion; thus avoiding an assessment of the validity of the invoked trademark. In doing so it found that the mark had a very limited distinctive character:

“(…) the SPARTAN RACE trademark has, at best, very limited distinctive character for obstacle races. It is not disputed that the component RACE is entirely descriptive of obstacle races. Nor is it disputed that the English word SPARTAN can refer to the characteristics “disciplined, courageous, showing great endurance” and that the word has that meaning in all Member States of the EU. The combination of SPARTAN and RACE can therefore refer to a race by or for people with discipline, courage and endurance, while it is also established between the parties that these characteristics are required for, or tested by, participation in obstacle courses. Insofar as the connection thus established between the trademark and obstacle courses is not sufficiently direct and concrete to render the trademark invalid on the basis of Article 7(1)(c) or (b) of the Trade Marks Act, it in any case means that the inherent distinctive character of the trademark is very limited”.¹²

5 T. Westenbroek, ‘Non cogito ergo sum: onmiddellijk en zonder verder nadenken onbedoeld het grootste misverstand in het Europese merkenrecht’, in: *Intellectuele Eigendom en Reclamerecht (IER)* 2014/29. The article sought to trace the origins of the phrase ‘immediately and without further thought’, and in doing so encountered variations that were frequently, but incorrectly, referred to, such as GC 27 February 2002, T-106/00, ECLI:EU:T:2002:43 (STREAMSERVE), para. 40 and GC 20 July 2004, T-311/02, ECLI:EU:T:2004:245 (LIMO) para. 30. In both cases the GC only refers to the necessity of a “sufficiently direct and specific relationship”.

6 See *Cine Action*, already mentioned, paras. 28-29.

7 See *Doublemint*, already mentioned, ECLI:EU:C:2003:225, opinion AG Jacobs of 10 April 2003, para. 35. Not surprisingly, this test has also never been mentioned in any version of the Trademark Directive (EUTMD).

8 Darts-ip™ search conducted 25 June 2025: (...) reflection: BoA 410, GC 31 and ECJ 4; (...) thought: BoA 805, GC 77 and ECJ 1* and lastly (...) thinking:

BoA 14. Although these figures are only indicative, the author believes them to be sufficiently representative for the argument. * As a fun pun this happens to be ECJ 14 March 2011, C-369/10 P, ECLI:EU:C:2011:148 (MEMORY).

9 The District Court of The Hague has exclusive jurisdiction in the Netherlands for disputes concerning EU trademarks.

10 In order to prevent semantic confusion, European trademarks will only be referred to as “EU trademarks” and not (also) as “Community trademarks”, even when strictly taken applicable.

11 District Court of The Hague 1 June 2016, C/09/507063 / KG ZA 16-313, ECLI:NL:RBDHA:2016:6665 (SPARTAN) para. 4.5. Oops, that must be “Non cogito ergo sum”.

12 Court of Appeal The Hague 30 May 2017, 200.195.059/01, ECLI:NL:GHDHA:2017:1533, (SPARTAN) paras. 4.16-4.18, thereby avoiding the matter of descriptiveness.

The appeal was dismissed. It must be noted that this event represented an ideal opportunity to submit questions to the ECJ for a preliminary ruling. Unfortunately, this opportunity was missed.

Three years later, in the midst of the COVID epidemic, the Benelux Court of Justice (BenCJ) ruled in favour of BOIP in an appeal case concerning a refusal on absolute grounds, namely *Pet's Budget* for a wide variety of pet (care) products in various classes. The BenCJ's ruling was unambiguous in its clarity:

“There is no need for a “direct and immediate link” between the sign and the goods and services in question, such that the relevant public perceives “immediately and without further reflection” a description of one of the characteristics of those goods and services, as argued by the appellant.”¹³

White smoke? Criterium habemus. Lucem habemus!

Further reflection

To summarise the subject under discussion, it would be prudent to re-examine AG Jacobs's perspective on the matter, as articulated in his opinion in *Doublemint*. It appears highly probable that the phrase “immediately and without further reflection” has been integrated into the EUIPO and GC's repertoires as a means of enhancing the comprehensibility and transparency of the requisite ‘direct and concrete link’. However, it apparently has also served to reduce clarity.

In *Spartan*, it seems that the Court of Appeal is reluctant to assess the descriptiveness, perhaps because it believes that it will not fully achieve this objective with ‘immediately and without further reflection’. This approach contrasts with the preliminary relief judge's initial inclination, which appeared to be heading in that direction. It is important to note that a small degree of interpretation remains possible between the explanation of the word ‘Spartan’ in terms of its meaning as a description of human character traits and the organisation of an ‘obstacle course’.¹⁴

It is evident that declaring a trademark invalid is a significant legal action. In instances where a new trademark application is being refused on absolute grounds due to descriptiveness, it is possible to inform the applicant that they cannot monopolise the trademark, but that they are at liberty to utilise it, just as others should be permitted to do so. However, taking away someone's already acquired, used and cherished trademark requires a solid case, and the bar may unintentionally be set slightly higher. While judges in infringement proceedings strive to apply the same criterion, it should be noted that the context in which they apply it differs considerably, as in most cases the trademark is already being used for specific goods or services. ‘Immediately and without further reflection’ comes easier to mind in

those cases than in cases of ex officio assessment on absolute grounds by a trademark authority. Furthermore, in such a case, the claimant for invalidity must demonstrate that a trademark was descriptive at the time of application (i.e. retroactively).¹⁵ In practice, this often appears to be challenging.

There is a fine line between descriptive on the one hand and merely allusive or suggestive on the other. In the words of AG Jacobs in *Doublemint*: “There is no precise point at which a term suddenly switches from one category to the other, but rather a sliding scale between two extremes and an element of subjective judgment will often be required in order to determine to which extreme a term is closer.”¹⁶ Nevertheless, the line has to be drawn in each individual case. Jacobs has tried to provide guidance on how to approach this issue and the analytical steps required. This type of analysis forms a large part of the daily work of examiners, legal officers and members of the Boards of Appeal of EUIPO and European national trademark authorities.¹⁷

Jacobs starts by unfolding the umbrella: “First, it is important not to lose sight of the question which has to be answered: in relation to the product or products for which registration is sought, is this a sign or indication which may serve in trade to designate a characteristic covered by Article 7(1)(c)?”¹⁸

Jacobs then proposes a three-step model, the first step of which concerns the “factual and objective” relationship between a term and a product or its characteristics. Conversely, if the relationship in question is deemed to be “imaginative and subjective”, this renders the term more appropriate for registration. The subsequent step pertains to the reception and interpretation of the message. The question arises as to whether the term is to be considered ‘immediate’ on account of its ‘simple, clear and straightforward’ nature, or whether ‘the skills of a cryptic crossword enthusiast’ are required to detect any connection with the designated characteristic. The third and final step pertains to the significance of the characteristic in relation to the product. According to AG Jacobs, this can vary from “essential or central” to “purely incidental or arbitrary”.¹⁹

In relation to the third step, the ECJ subsequently observed in *Postkantoor* that it is “irrelevant whether or not the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary”.²⁰ This point remains to be fully elucidated. It is a topic that falls outside the scope of this article.

We are still awaiting a suitable case in which the ECJ can elaborate on the exact use and application of the magic formula for the assessment of descriptiveness and how all the ingredients exactly interrelate. Should the exact same test apply in (abstract) cases of examination on absolute grounds as in (practical) infringement cases and cancellation actions? The objective of the use of ‘immediately and without further

13 Benelux Court of Justice 15 June 2020, C 2019/6/9 (*Pet's Budget*), para. 66.

14 It can be hypothesised that this was also the reason why the defendant invoked sub d. as a precaution.

15 ECJ 23 April 2010, C-332/09 P, ECLI:EU:C:2010:225 (*Flügborse*), para. 44; GC 26 September 2016, T-476/15, ECLI:EU:T:2016:568 (*Fitness*), para. 68; Dutch Supreme Court 8 September 2006, C05/071HR, ECLI:NL:HR:2006:AV3384 (*G-Star/Benetton*) para. 3.4. Also: EUIPO Board of Appeal 22 December R 973/2021-5 (*Nestlé/Impossible Foods*), para. 34 and Court of Appeal The Hague 12 April 2022, C/09/581242, ECLI:NL:GHDHA:2022:1997 (*Nestlé/Impossible Foods*) para. 4.3. (end).

16 ECJ 23 October 2003, C-191/01, ECLI:EU:C:2003:225 (*Doublemint*), opinion AG Jacobs of 10 April 2003, para 61.

17 BOIP consistently handles a yearly workload of 20,000–30,000 trademark examinations on absolute grounds, of which an average of 5% are definitively refused. The fact that around 95% of these refusals are based on sub (c) and/or sub (b) makes this topic all the more relevant.

18 ECJ 23 October 2003, C-191/01, ECLI:EU:C:2003:225 (*Doublemint*), opinion AG Jacobs of 10 April 2003, para 59.

19 *Id.*, paras 62–64.

20 *Postkantoor* (already mentioned), dictum under 5.

reflection' seems clear, but is it justified? In *Doublemint* it was used by the GC to conclude that Doublemint was not descriptive.²¹ In the case of *Impossible Burger* the Court of Appeal The Hague used it to conclude that IMPOSSIBLE BURGER was not descriptive.

Burgerwar in Alicante and The Hague

On 18 March 2019 a request for a declaration of invalidity was filed at EUIPO against an EU trade mark IMPOSSIBLE BURGER registered for among others foodstuffs and plant-based meat substitutes.²² The cancellation action was rejected and the Board of Appeal upheld the decision.²³ The case against Impossible Foods Inc. was initiated by Nestlé that marketed INCREDIBLE BURGER.²⁴ Both were also parties in an infringement case pending before the Court of Appeal The Hague.²⁵ Nestlé has chosen to challenge the criterion of 'without further reflection', arguing that it is not a prerequisite for determining descriptiveness and was never introduced by the ECJ as such, but rather resulted from copying and pasting. Finally, Nestlé refers to the *Pet's Budget* ruling of the BenCJ. In response to the 'copy-paste' suggestion, the cancellation division comments that this is a consistently applied principle established by EU courts.

In his insightful annotation on the case before The Court of Appeal The Hague, Schut observes "that the Board of Appeal is somewhat more cautious in stating that 'in any case, there must be a sufficiently direct and specific connection with the goods', thereby leaving open the possibility that the second component of the contested test ('immediately, without the need for further thought') may go too far."²⁶

Another remarkable aspect, strongly reminiscent of the Court of Appeal The Hague in *Spartan*, is that the BoA then dismisses the case on the basis that 'IMPOSSIBLE BURGER' has distinctive character within the meaning of sub (b), and therefore no longer qualifies for assessment under (c). Interestingly, the BoA applies the case law relating to slogans and concludes that a mental process has been initiated:

"(...) it appears that by juxtaposing the adjective 'impossible' with the noun 'BURGER' the sign created at least at the date of filing a conceptual link which was very vague, unclear and not immediately comprehensible nor did it denote any characteristic of the goods. Therefore, the sign had a fanciful and distinctive character which called for an interpretative effort on the consumers and setting off a cognitive process in their mind".²⁷

It is evident that the criterion remains unaddressed, as has been the case on previous occasions. Subsequent to this, the Court of Appeal in

The Hague, evidently influenced by the case in Alicante, concluded that IMPOSSIBLE BURGER is not descriptive.²⁸ The debate surrounding the litigious criterion is summarily dismissed with reference to an order of the ECJ dated 13 December 2018, accompanied by a concise observation 'Otherwise BenCJ 15 June 2020, second chamber, C 2019/6, *Pet's Budget*, para. 66'.²⁹ In my estimation, the pertinence of the aforementioned 'order' is rightly questioned by both Schut and Van Gaal, as the matter of the criterion's validity remains unaddressed in the document.³⁰

It is worthy of note that in the meantime, on 22 March 2021, the Court of Appeal Brussels delivered a judgement in a case concerning an ex-officio refusal of the trademark application GRATIS (fig.), thereby ruling that "the word GRATIS on goods or services for which registration is requested will be immediately and unquestioningly understood by the relevant public as meaning that the goods or services do not have to be paid for'. (...) From the perspective of the relevant public, this connection is sufficiently direct and concrete."³¹ However, this is not surprising because the Court of Appeal Brussels has a longstanding tradition of invoking the criterion in cases concerning ex officio refusals of BOIP.³²

Smoke gets in your eyes – the Benelux Court of Justice in *Goodbye Yellow* and *The Winery*

Subsequent to this, the BenCJ ruling on the GOODBYE YELLOW trademark has given rise to the re-emergence of the criterion that for a short period had been considered to have been superseded.³³ The question of causality might be rendered more complex by the presence of one of the judges in the Benelux Court of Justice in *Goodbye Yellow*, who also presided over the Court of Appeal The Hague in *Impossible Burger*, as Schut observes.³⁴ Alternatively, the litigious test may be considered to lead to the desired outcome in this instance, "despite not examining the applicability of a broader test".³⁵

In any case, it is striking, to say the least, that less than two years after the *Pet's Budget* ruling, the Benelux Court of Justice stated, without explanation or justification, that the descriptive nature of 'GOODBYE YELLOW' must be assessed on the basis of the criterion of 'a sufficiently direct and concrete link (...) so that the relevant public is able to immediately and without further thought, recognise in it a description of the goods in question or one of their characteristics'.

Schut keenly observes that the BenCJ differentiates between a catalogue of the ECJ's assessment principles and then concludes separately that the criterion is applicable.³⁶ Furthermore, he has also been unable to establish that the ECJ has either formulated or

21 A judgment that was explicitly overruled by the ECJ (see note 18.).

22 EU trademark no. 17 968 798.

23 EUIPO Cancellation Division 5 April 2021, C 33 961 and BoA 22 December 2021, R 973/2021-5.

24 In the meantime, rebranded into SENSATIONAL BURGER, while IMPOSSIBLE BURGER has not yet entered the Benelux market.

25 Court of Appeal The Hague 12 April 2022, C/09/581242, ECLI:NL:GHDHA:2022:1997 (Nestlé/Impossible Foods), *BerichtenIE* 2022/5, annotation M. Schut.

26 *Id.*, Schut, para. 19 and EUIPO BoA 22 December 2021, R 973/2021-5, para. 84.

27 EUIPO BoA 22 December 2021, R 973/2021-5, para. 77, with reference to GC 22 January 2015, T-133/13, EU:T:2015:46 (*WET DUST CANT FLY*) paras. 49-51.

28 Court of Appeal The Hague 12 April 2022, C/09/581242, ECLI:NL:GHDHA:2022:1997 (Nestlé/Impossible Foods), paras. 4.3-4.14; the distinctiveness test is dealt with in paras. 4.15-4.16.

29 *Id.*, para. 4.3. and ECJ order 13 December 2018, C-409/18 (*Senetici/EUIPO – HP*).

30 Schut (already mentioned), paras. 20, 30-32 and mr. H.C.H. van Gaal, Over ananas, tassen, de toets voor beschrijvende tekens en wat zij met elkaar te maken hebben, in: *Intellectuele Eigendom en Reclamerecht* (IER) 2022/34, para. 2.

31 Court of Appeal Brussels 22 March 2021, 2017/AR/875 (*Gratis*, fig.), para. 16.

32 See: T. Westenbroek, *Waarom is Bio-Claire beschrijvend en Aquaclean niet?* Een duik in de vijver van de rechtspraak over, en de toetsing van, beschrijvende merken in de Benelux en in Europa (DeLex, Amsterdam 2011).

33 Benelux Court of Justice 13 May 2022, C-2020/16 (*Goodbye Yellow*) para. 43, appeal case against BOIP's cancellation decision 30000166 of 25 August 2020.

34 Schut, para. 21.

35 Van Gaal, paras. 6-7.

36 Schut, para. 21.

explicitly confirmed the necessity of the aforementioned criterion.³⁷ He therefore concludes that, as did Van Gaal and the undersigned earlier, only a preliminary question can provide the desired clarity.³⁸

The BenCJ seems to be going full steam ahead on the path of ‘not thinking’. In *The Winery*, an appeal against a refusal on absolute grounds, a ‘tsunami’ of variants is presented, such as ‘le public pertinent comprendra aisément’, ‘établira immédiatement et sans difficulté’, ‘ne nécessite aucun effort d’interprétation’, ‘ne déclenche aucun processus cognitif’ and finally ‘sans qu’aucun effort mental’. Prior to this, the criterion is introduced in the assessment conditions with reference to *Goodbye Yellow*.³⁹ While it may appear that the applicant must be persuaded of the fact that the sign presented is highly descriptive, this once more establishes a perplexing model and a confusing precedent, at least until there is genuine clarity.

Ventilation – Nitro and Desktop Taxatie

In this context, the Dutch cases *Nitro* and *Desktoptaxatie* are certainly worth mentioning. The discussion regarding the assessment criteria for descriptiveness is relevant not only in ex officio assessments on absolute grounds by trademark authorities, but also in inter partes infringement cases and cancellation actions. It is also pertinent to discussions regarding descriptive use, as outlined in the limitations.

In the *Nitro* case, the question is whether Brooks uses the term ‘NITRO’ to describe a feature of its running shoes, and if so, whether this use is in accordance with honest practices according to Article 14 EUTMR. Puma, the licensee of the EU trademark ‘NITRO’, argues that the Court of Appeal failed to recognise that the standard for determining descriptive use under Art. 14(1)(b) EUTMR is strict. Puma refers to *Impossible Burger* and the footnote mentioned, as well as to *Goodbye Yellow*.⁴⁰

AG Van Peursem concludes that the complaints are unfounded “because they are based on an incorrect, overly strict criterion for the restriction of Article 14(1)(b) EUTMR. What matters is that signs or indications are used that are connected with or relate to one of the characteristics of the goods traded (in this case) (...)”. According to AG Van Peursem, it is not clear that the public should be required to make ‘prohibited’ mental leaps, at least not in this context.⁴¹

This highlights an important point. After use, it becomes easier to determine whether there is a link with the goods or services in

question. This is fully different in ex officio assessment of trademarks on absolute grounds, where there has been no use yet and the assessing authority must examine whether the sign “now or reasonably to be expected in the future” may serve to indicate any characteristic. In my opinion, this clearly supports the idea of a ‘margin of appreciation’ in the assessment, allowing the trademark authorities to carry out their duties effectively. That task risks being frustrated if ‘immediately and without further thought’ is being wrongly misinterpreted and extrapolated.⁴²

Finally, in the *Desktoptaxatie* case, the parties are arguing about whether the word ‘desktoptaxatie’ is descriptive of remote or hybrid taxation.⁴³ The preliminary relief judge rejects the claim for cessation because “it is plausible that the court of first instance will rule that ‘desktoptaxatie’ is a generic and customary term for the service offered, namely remote valuation from behind a desk”.⁴⁴ The Court of Appeal Amsterdam confirms the judgment of the preliminary relief judge and does so with great certainty.⁴⁵ It also states that it disagrees with BOIP, which previously rejected two cancellation requests, because based on the arguments and documents submitted, it could not be concluded that DESKTOP TAXATIE was understood by the relevant public as “remote valuation” at the time of the application.⁴⁶

The Court continues:

“For the question of whether (...) consists exclusively of signs that may serve to designate the goods or services (for which this trademark is registered), it is not decisive whether there are also synonyms with which those goods/services can be designated (ECJ 12 February 2004 (Postkantoor); ECLI:EU:C:2004:86. The fact that the valuation service is called a “remote valuation” or “hybrid valuation” and that these names are the usual generic names for the valuation service, as claimed by [the appellant], is therefore not decisive. Furthermore, it is also not necessary for the relevant public to be able to recognise the connection between the sign and the goods/services in question immediately and without further thought (BenCJ 15 June 2020 (Pet’s Budget); ECLI:NL:XX:2020:81). The fact that “desktop valuation” has been translated into Dutch as “taxatie op afstand” (remote valuation) and that, according to [the appellant], this name is better known in the Netherlands does not detract from the ability of “desktop” in combination with “taxatie” to serve as a description of this characteristic”.⁴⁷

³⁷ *Id.*, paras. 28-31.

³⁸ *Id.*, para. 32; Van Gaal, introduction and para. 33; Westenbroek, Non cogito ergo sum, conclusion; mr. dr. J. Krommendijk en prof. mr. M.A. Loth, ‘De civiele kamer van de Hoge Raad stelt prejudiciële vragen; analyse en suggesties’, in: *Rechtsgeleerd Magazijn THEMIS* 2019-4, p.145-146, with reference to the article of Van Gaal in note 66: “The AG also addressed the question of whether a referral was necessary, but considered the matter to be an acte éclairé due to the clear Chiemsee criterion of the ECJ. Does the ‘81 Wet RO-afdoening’ mean that the Supreme Court agrees with the AG’s conclusion that the matter is éclairé? This is by no means a foregone conclusion, partly because there is discussion about this issue in the literature”.

³⁹ Benelux Court of Justice 3 December 2024, C 2023/11 (*The Winery*) paras. 30, 43-44.

⁴⁰ Dutch Supreme Court 21 February 2025, 24/01846, ECLI:NL:PHR:2025:261 (*NITRO*), opinion AG Van Peursem, para 3.6. As the appeal has not been pursued, there will be no ruling.

⁴¹ *Id.*, para. 3.7. And thank you for introducing the notion of ‘forbidden thought processes’ and this sentence for posterity: “het in aanmerking komende publiek voor hardloopschoenen vindt schokdemping van die schoenen belangrijk en is ongetwijfeld niet bezig met brandstof voor stikstofmotoren, een oneigenlijk aspect

dat hier deze hardloopschoenenzaak wordt ingefietst”. It’s impossible to translate this sentence without losing its humorous subtlety.

⁴² How do you assess the application for NITRO if it is not yet widely used in running shoes? This technology has been used by New Balance since 2018 and by Puma since 2021. In 2016, BOIP rejected the application for “Nitrogen.com” for those goods for which, following “stringent and full examination”, a concrete and direct link could be established.

⁴³ (...) so that it may be used by the defendant under the exemption of Article 2.23 (1) (b) BCIP.

⁴⁴ District Court Amsterdam 13 September 2023, C/13/736287 / KG ZA 23-605, ECLI:NL:RBAMS:2023:5789 (*Desktop Taxatie*), para. 4.3.

⁴⁵ Court of Appeal Amsterdam 15 April 2025, 200.332.648/01, ECLI:NL:GHAMS:2025:1001 (*DESKTOP TAXATIE*), para. 5.5.: (...) “The probability of the aforementioned trademark being declared invalid in the course of the proceedings on the merits is so high that the protection sought cannot be granted in these proceedings.”

⁴⁶ *Ib.*

⁴⁷ *Id.*, paras. 5.5.1 and 5.5.2. Further information on this topic can be found in: R. (Rolph) J.L. Limpens, The use of AVMs in Dutch real estate valuation – a complex and unstable panorama, in: *European Valuer*, issue 27, September 2022, p. 12-16.

Acte éclair(é)? Nou, nee'...⁴⁸ And the need for a 'margin of appreciation'? This is perhaps best illustrated by case law on geographical names, which are, after all, a species of the genus 'descriptive' as defined under sub c.

ICELAND is descriptive for everything

The *Iceland* case marks a milestone in the assessment of the descriptiveness of geographical names in European trademark law. The case concerns a cancellation action based on descriptiveness, initiated by the Icelandic government against two EU trademarks 'ICELAND', owned by the British supermarket chain Iceland Foods Limited (IFL). The trademarks are registered mainly for foodstuffs, household and kitchen apparatus, and retail services.⁴⁹ The case is of exemplar law book material, with many interesting aspects touched upon.

Most relevant for this article, is the fact that the case almost turned into a ping pong game per subcategory of goods and services, in order to establish one by one the descriptiveness in view of their existing reputation and probability of indicating origin.⁵⁰ Fortunately, the Grand Board adopted a significant (at least 120°) change in its approach, deviating from the prerequisite of an existing reputation to conclude descriptiveness. This decision resulted in a consistent reasoning process that applied to all goods and services. The Board concluded that ICELAND is a descriptive term. Iceland is a modern Western economy from which all named goods and services now, and in the near future, can originate. The new mantra is as follows:

"In view of the above, it is reasonable to assume that '(...)' is, in the mind of the relevant class of persons, capable of designating the geographical origin of the goods. Due to the degree of familiarity amongst the relevant persons with the country of (...), and with that nation's characteristics, as well as with the goods concerned, it is reasonable to conclude that the sign is liable to be used in the future by undertakings as an indication of the geographical origin of the goods. Consequently, it is plausible, credible and reasonable to consider the contested mark descriptive of the goods at issue from the perspective of the relevant public."⁵¹

The aforementioned reasoning of the Grand Board fully incorporates the concept of 'a margin of appreciation', a pivotal aspect in the assessment of descriptiveness by trademark authorities.⁵² A requirement for the public to establish a mental association

between a geographical name and relevant goods and services is a perfect parallel to the 'immediately and without further reflection' criterion. Should this indeed be the case, it would represent an enhanced level of descriptiveness. Nevertheless, it cannot be considered a prerequisite for the attribution of descriptiveness, which is defined as 'may serve (...) now or in the foreseeable future'.⁵³

The Chiemsee Two-Step

Back to the basics in *Chiemsee*, which rules that ('sub c.') 'does not prohibit the registration of geographical names as trademarks 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'.⁵⁴

According to EUIPO, a two-step assessment is required:

- (1) Firstly, it is necessary to establish that the trademark designates a geographical location and whether it is actually known as such by the relevant public.
- (2) Secondly, it is necessary to assess whether the public makes a mental association between the geographical location designated by the mark and the relevant category of goods and services and if the public does not currently make this association, the decision-taking body has to establish whether it is reasonable to assume that the public will make this association in the future.⁵⁵

It will be immediately apparent to the attentive reader that *Chiemsee* refers to an objective criterion, namely the assessment of whether the geographical name is liable to be used ('may serve') in the future as an indication of geographical origin. It should be noted that a geographical name is inherently able to describe characteristics of goods and services. This is because they comprise origin, not only in terms of manufacture, but also in terms of conception, design and even 'favourable response' (i.e. transfer of positive associations).

However, the assessment mentioned under 2) focuses on a subjective criterion, namely if the 'public makes an association'. This does not align with the sub-c. ratio, which stipulates that objective criteria must be in place to ensure the fair and equal use of descriptive signs by all market competitors. Which market competitor wouldn't be interested in using a geographical name as an origin reference?⁵⁶

⁴⁸ Translation: "Acte éclairé? Well, no..." (unfortunately without rhyme).

⁴⁹ EUIPO Grand Board of Appeal 15 December 2022, R 1238/2019-G and R 1613/2019G (ICELAND).

⁵⁰ Note: In 2004, EUIPO partially refused the 2002 trademark application for the wordmark ICELAND ex officio, namely only for 'fish', 'fish preserves' and 'living animals', but not for goods for which Iceland had no reputation or for which it was not foreseeable that a mental association could be made in the future. The discussion in Iceland took a similar turn, considering whether or not it is possible to grow tomatoes and coffee in Iceland, and if so, when.

⁵¹ EUIPO Grand Board of Appeal 15 December 2022, R 1238/2019-G, (Iceland), paras 167, 175 and 182. Note that 'reputation' has now been replaced by 'familiarity', and that the case concerns the name of a country. This represents a 120-degree turn, rather than a full 180-degree turn. A similar line of reasoning can be expected to apply to major European cities.

⁵² Specifically: "(...) it is reasonable to conclude that the sign is liable to be used in the future by undertakings as an indication of the geographical origin of the goods."

⁵³ See also: Dutch Supreme Court 9 September 2016, 15/01397, ECLI:NL:HR:2016:2573 (L'ARGENTINA), opinion AG Van Peursem, para 11.: "To require that the geographical location is already known to the relevant public (...) would mean that the consideration of the ECJ in para.31 of the *Chiemsee* judgment that Article 3(1)(c) of the Directive also prohibits the registration of geographical names as trademarks when it can reasonably be expected in the future that the goods will be associated with the relevant area would be meaningless."

⁵⁴ ECJ 4 May 1999, C-108/97 and C-109/97, EU:C:1999:230 (*Chiemsee*), dictum, under 1.

⁵⁵ See: EUIPO Guidelines and BoA Case-Law Research Report 'Descriptiveness of marks designating geographical origin', December 2022.

⁵⁶ The 'classic' school will always point to the fact that descriptive use is always possible by invoking the limitations, but this does not comply with the tasks set out to the European trademark authorities as gatekeeper. See also: EUIPO Grand Board of Appeal 15 December 2022, R 1238/2019-G, (Iceland), para. 194-195 and ECJ 6 May 2003, C-104/01, ECLI:EU:C:2003:244 (Libertel), para. 59.

Prior to the case of *Iceland*, the EUIPO's approach to geographical name refusals was merely based on subjective criteria. This has resulted in some peculiar conclusions, such as the classification of ICELAND being descriptive for fish and live animals, but not for meat and refrigerators, due to its lack of established reputation in those sectors.⁵⁷ The 'reputation argument' obscured a number of cases, thus not fully considering the underlying ratio of sub c. in relation to geographical names. *Chiemsee* can only be fully understood when considered in the context of the opinion of AG Cosmas, who advocates a less strict approach.⁵⁸ Nevertheless, the final judgment suggests that the ECJ does not fully align with the AG's position. Adopting the Chiemsee criteria unambiguously results in enhanced freedom for all market competitors to utilise geographical names.⁵⁹

Less is more clarity

In a recent decision by the Board of Appeal concerning *TOP 40* (fig.), we see a structure that initially resembles that of the *Goodbye Yellow* judgment by the BenCJ.⁶⁰ However, upon closer inspection, this decision is entirely consistent with the approach adopted by the BoA in *Iceland* and fully reflects the concept of a 'margin of appreciation'. The disputed criterion is not included in the legal framework for determining descriptiveness in relation to phase 1.⁶¹ It only appears in the conclusion once a clear and concrete link has been established.⁶² This appears to be a wholly accurate assessment. While the conclusion of the analysis of the concrete and direct link in phase 2 may be that "the mark applied for as a whole will be perceived, without further reflection, by the relevant public as descriptive in relation to the goods and services applied for", this is not, in itself, a minimum requirement for the qualification of descriptiveness. The question arises as to whether this "new" format is inspired by shifting insights following *Iceland*, or whether it is merely a one-off occurrence.

The following consideration, as a prelude to phase 2, is noteworthy for its clarity due to its concise nature:

"The refusal of a trademark on the ground of its descriptive character is justified only if, from the point of view of the relevant public, there is a sufficiently clear and specific link between the word sign and the goods or services applied for."⁶³

Less is more. Much more.

Preventing unrestrained "ins Blaue hinein interpretieren" can also be achieved effectively with the concept of "clear and concrete connection", which implicitly excludes "allusive" and "suggestive" interpretations.⁶⁴

It is possible to retain both the bathwater and the child without immediate danger of drowning, but it cannot be emphasised enough that failing to clearly distinguish between the two stages of analysis could create the impression that 'immediately and without further reflection' governs and limits the entire assessment. This leads to the same discussions arising time and again, namely which criterion applies when determining the descriptiveness of word marks.

To conclude, I would like to share three strikingly relevant quotes from Annette Kur, in her capacity as a visionary of the post-*Baby Dry* era:

"And gradually, as more and more competitors actually do respect the generic or descriptive word as being the 'property' of one company, the originally unprotectable sign will grow into something that becomes, in the end at least, rather close to a true monopoly right."

(...)

"It is not least this risk that weighs in favour of the maintenance of wordmark examination, even if this task may sometimes appear as somewhat boring and frustrating in the eyes of the highly qualified staff carrying out the watch-dog function. Their work still does some good."

(...)

"And who knows – in their judgements to come, the ECJ might still modify the very strict approach taken in the *BABY-DRY* decision and give the offices back a little more freedom in the assessment of protectability of wordmarks."⁶⁵

⁵⁷ See also: T. Westenbroek, *Stricter interpretation of the Chiemsee judgment following shift in approach by EUIPO's Grand Board of Appeal*, on www.boip.int, Know How > Expert articles > 2023.

⁵⁸ ECJ 4 mei 1999, C-108/97, ECLI:EU:C:1998:198 (*Chiemsee*) opinion AG Cosmas, para. 49: (...) "The first was flexible, allowing registration of geographical indications in principle subject to certain conditions (...). The other was rigid and did not in principle allow registration of geographical indications for reasons broadly similar to those given by the plaintiff (...)."

⁵⁹ Post-*Iceland*, the outcome of the following cases could easily be interpreted differently: GC 25 October 2005, T-379/02, EU:T:2005:373 (*Cloppenburg*), 8 July 2009, T-225/08, EU:T:2009:257 (*Alaska*) and 2 June 2021, T-854/19, EU:T:2021:309 (*Montana*). Different: GC 15 October 2003, T-295/01, EU:T:2003:267 (*Oldenburger*). With regard to 'freedom for geographical names', one might consider introducing a future 'Article 6ter PC protection for country names', or alternatively, widening the applicability of Articles 4(1)(f) EUTMD, 7(1)(f) EUTMR and 2.2bis(1)(f) BCIP, in line with the EFTA Court's ruling on 6 April 2014 in case E-5/16 (*Vigeland*), paras. 96 and 100.

⁶⁰ See note 34.

⁶¹ EUIPO Board of Appeal 31 March 2025, R 2299/2024-4 (*TOP 40*, fig.), paras. 14-18. It should be noted that the phrase 'understood without further reflection' is still mentioned under 'The notion of descriptiveness' in the EUIPO Guidelines.

⁶² *Id.*, para. 39.

⁶³ EUIPO Board of Appeal 31 March 2025, R 2299/2024-4 (*TOP 40*, fig.), paras. 17-18. This reasoning is very similar to the frequently cited judgment in this context GC 14 June 2007, T 207/06, ECLI:EU:T:2007:179 (*EUROPIG*), paras. 33-36. Incidentally, it is also good for making hamburgers.

⁶⁴ AG Jacobs (see note 18) adds a third step to this, which is to assess how essential the characteristic in question is to the goods and services in question. A good example of this is BenCJ 15 October 2024, C 2023/18 (*The Bank*), para. 22. Are you going for the food or for the location? Or both? Postkantoor (already mentioned) states unequivocally that "it is irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary" (dictum under 5).

⁶⁵ A. Kur, *Examining Wordmarks after BABY-DRY – Still (a) Worthwhile Exercise?* in: *IPRinfo* 4/2001, p.12, at p.14.

Shoot the messenger

IMPORTANT: The following propositions and key takeaways are posited by the author for educational and entertainment purposes. They may be freely discussed at a birthday party, form the theme of a conference, or be the focus of an article, thesis, dissertation or book:

- (1) The nature of the relevant public is important, but their level of attention is not relevant for the purpose of assessing the descriptive nature of a trademark.
- (2) Geographical names are descriptive by nature, unless the origin characteristic cannot be substantiated, i.e. unknown and/or unrealistic;
- (3) Trademark authorities need a margin of appreciation in the assessment of descriptiveness in view of their public task;
- (4) A sufficiently direct link between the sign applied for and the relevant goods or services is required to reach the conclusion of descriptiveness;
- (5) Now or in the future, the relevant public must, at some point in time, be able to understand what the descriptive sign describes;
- (6) An existing reputation with regards to specific goods and services is not required in order to find a geographical name descriptive;

- (7) A sign might very well be able to serve as a description of characteristics of goods and services without the relevant public knowing it yet;
- (8) 'Immediately' in the assessment of descriptiveness means that no mental steps are needed to understand the sign as describing characteristics of the goods and services.

Therefore, it merely functions to distinguish descriptive from allusive and/or suggestive.

Note from the editor: The ICELAND judgement of the General Court of 16 July 2025, in joined cases T-105/23 and T-106/23 (ECLI:EU:T:2025:729), was issued after the deadline for this article (see footnote 4). In a subsequent commentary, the author would like to refer to paragraphs 37, 38, and 40 of the judgement in question.

The Hague/Amsterdam, September 2025