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“Sophienwald” again: the General Court confirms descriptiveness of a historical geographical indication

Katharina Schmid (schmid-ip) · Monday, July 22nd, 2024

Already in 2019, the Austrian Supreme Court (“OGH”) had confirmed the lower instance decisions cancelling the Austrian figurative mark “SW Sophienwald” for being deceptive of its geographical origin for glassware and related goods in classes 14, 21 and 33 (decision of 26.11.2019, [case 4 Ob 152/19k](#), please refer to [my prior blog post here](#)).

One year later, in 2020, the same cancellation applicant successfully cancelled the EUTM registration for the same mark (in color), as depicted below. On appeal, the General Court (“GC”), in line with both lower instances, confirmed the descriptiveness of “Sophienwald” as a geographical indication (Ruling of 3 July 2024, [T-597/22 – Sophienwald v EUIPO – Zalto Glas \[Sw Sophienwald\]](#)). It made express reference to the OGH decision of 2019 and came to similar conclusions, at the same time highlighting relevant aspects of EU trademark law:



[Depiction: the meanwhile cancelled EUTM 013448981 “Sw Sophienwald”]

The GC held that the term ‘Sophienwald’ is, in particular, the historical name of a locality in Bohemia situated in the border area between Austria and the Czech Republic, which has been

known as Žofina Hut since 1945. Since the beginning of the 19th century at the latest, the area has been of particular importance for the art of glassmaking on account of the glassworks and glass factories located there. This was also mentioned on the applicant's website. The relevant public for the goods at issue ("beverage glassware; materials [cloths] for polishing; wine glasses" in class 21 and "non-monetary coins" in class 14) consists of end consumers and a specialized public, such as glassware retailers or wholesalers, who purchase the goods for commercial purposes.

Accordingly, the term "Sophienwald" and its connection with glass production is known to specialist glass dealers, who understand it as a designation of origin for the goods in question. Accordingly, even if the area is today known as Žofina Hut, 'Sophienwald' can be understood by part of the relevant Austrian (specialist) public as the geographical name of that place and associated with the Bohemian tradition of glassmaking. It is thus **descriptive** for glassware or goods closely connected with glassware (paras 55 and 56). The sequence of letters "Sw" is understood merely as an acronym of the term "Sophienwald" and does not render the mark distinctive (para 75) (nor did the graphical element around the letters "Sw", a three-leaved clover, according to the mark's description).

Further interesting takeaways from the decision are the following:

- The **relevant point in time** for the assessment of distinctiveness is the application date of the contested mark (para 14).
- The **case-law of a Member State**, while it is not binding on the EU Courts, may provide relevant indications about the relevant public's perception of the sign at issue in that state (see para 58, with reference to GC judgment T-40/03 – Julián Murúa Entrena, EU:T:2005:285, para 69).
- It is sufficient if a **ground for invalidity** exists in relation to a **not insignificant** part of the relevant public (para 62, referring to GC judgment T-878/16 – KARELIA, EU:T:2017:702, para 27).
- That a term refers to a **historical** fact does not necessarily mean that only the older generations are aware of its meaning, especially among a specialist public (para 64).
- It is not necessary that the products are in fact **produced** at the place in question, but sufficient if the relevant public makes a connection with the place or region. In the case at hand, this was so because the region, or the village of Sophienwald, is known for its centuries'-old tradition of glass production and has a positive connotation.
- **Descriptive uses** of a mark **on the trademark owner's website** can be a **disadvantage** at the time of defending the mark from invalidation!

And by way of recap:

- Article 7(1)(c) EUTMR excludes geographical names from registration, which designate certain geographical places which are already famous or well-known **or** which may be used by undertakings and must be kept free for them as indications of geographical origin for the type of goods or services concerned (para 38).
- Geographical indications are only registrable if they are (i) not known, or (ii) at least not known as the name of a geographical place, to the relevant public, or (iii) if the characteristics of the place designated makes it unlikely that the relevant public could assume that the goods could originate from or are conceived at that place (para 39).

So far, no appeal to the Court of Justice of the EU is pending, but I will watch out for it and update this post, should this become necessary.

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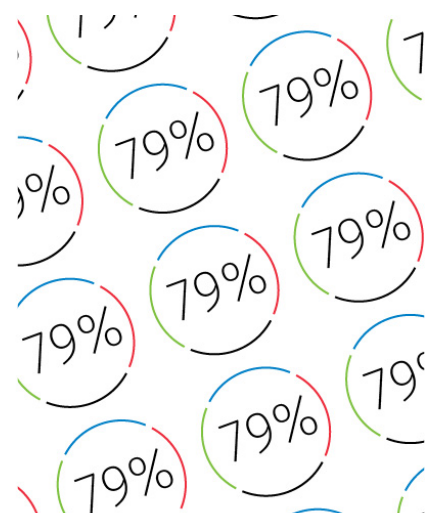
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