JUDGMENT OF THE GENERAL COURT (Seventh Chamber)

16 July 2025 (*)

(EU trade mark – Invalidity proceedings – EU figurative mark Iceland – Absolute grounds for invalidity – Descriptive character – Article 7(1)(c) of Regulation (EC) No 207/2009 (now Article 7(1)(c) of Regulation (EU) 2017/1001))

In Case T-106/23,

Iceland Foods Ltd, established in Deeside (United Kingdom), represented by G. Vos, lawyer,

applicant,

supported by

International Trademark Association (INTA), established in New York (United States), represented by N. Parrotta, M. Perraki and A. Lubberger, lawyers,

intervener,

v

European Union Intellectual Property Office (EUIPO), represented by V. Ruzek, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO, intervener before the General Court, being

Icelandic Trademark Holding ehf, established in Reykjavik (Iceland), represented by A. von Mühlendahl and H. Hartwig, lawyers,

THE GENERAL COURT (Seventh Chamber),

composed of K. Kowalik-Bańczyk, President, E. Buttigieg and I. Dimitrakopoulos (Rapporteur), Judges,

Registrar: G. Mitrev, Administrator,

having regard to the written part of the procedure,

further to the hearing on 16 October 2024,

gives the following

Judgment

1 By its action under Article 263 TFEU, the applicant, Iceland Foods Ltd, seeks the annulment of the decision of the Grand Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 15 December 2022 (Case R 1613/2019-G) (‘the contested decision’).

Background to the dispute

2 On 23 January 2018, Icelandic Trademark Holding ehf filed with EUIPO an application for a declaration of invalidity of the EU trade mark which had been registered following an application filed by the applicant on 12 February 2013 for the figurative sign reproduced below:

3 The goods and services covered by the mark at issue in respect of which a declaration of invalidity was sought were in Classes 29, 30 and 35 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and corresponded, for each of those classes, to the following description:

– Class 29: ‘Meat, poultry and game; meat, vegetables and fruit extracts; preserved, dried and cooked fruits and vegetables; extracts of fruit and/or vegetables; meat products; sausages; jellies, jams, fruit preserves, vegetable preserves, compotes; desserts in Class 29; eggs, milk; dairy products; yoghurt; edible oils and fats; nuts and nut butters; pickles, tofu; food spreads; soups; nut paste; frozen foods included in Class 29; potato crisps and potato products (for food); prepared meals and constituents therefor; snack foods; none of the aforesaid goods consisting wholly or principally of fish’;

– Class 30: ‘Coffee, tea, cocoa, sugar, rice, tapioca, sago, couscous, coffee substitutes, coffee essences, coffee extracts, mixtures of coffee and chicory; chocolate; chocolate products; flour and preparations made from cereals and/or rice and/or flour; bread,

biscuits, cookies, cakes, pastry goods, and confectionery, edible ices; honey, treacle; syrup, molasses; yeast, baking-powder; salt, mustard; vinegar, pepper, sauces, ketchup, salad sauces; spices; chutney; refreshing ice; ice cream, water ices, frozen confections; preparations for making ice cream and/or water ices and/or frozen confections; breakfast cereals; pizza, pasta and pasta products; custard powder; mousses; puddings; meat pies; mayonnaise; meat tenderisers for household purposes; royal jelly for human consumption (other than for medicinal purposes); natural sweetener; prepared meals and constituents therefor, snack foods, all included in Class 30; frozen foods included in Class 30; herbs';

– Class 35: 'Retail services, retail stores services, mail order retail services, electronic or on-line retail services, supermarket and hypermarket services connected with meat, poultry, game, meat, vegetables and fruit extracts, preserved, dried and cooked fruits and vegetables, extracts of fruit and/or vegetables, meat products, sausages, jellies, jams, fruit preserves, vegetable preserves, compotes, desserts, eggs, milk, dairy products, yoghurt, edible protein derived from soya beans, edible oils and fats, nuts and nut butters, pickles, herbs, tofu, food spreads, soups, nut paste, frozen foods, potato crisps and potato products (for food), prepared meals and constituents therefor, snack foods, coffee, tea, cocoa, sugar, rice, tapioca, sago, couscous, coffee substitutes, coffee essences, coffee extracts, mixtures of coffee and chicory, chocolate, chocolate products, flour and preparations made from cereals and/or rice and/or flour, bread, biscuits, cookies, cakes, pastry goods, confectionery, edible ices, honey, treacle, syrup, molasses, yeast, baking-powder, salt, mustard, vinegar, pepper, sauces, ketchup, salad sauces, spices, chutney, refreshing ice, ice cream, water ices, frozen confections, preparations for making ice cream and/or water ices and/or frozen confections, breakfast cereals, pizza, pasta and pasta products, custard powder, mousses, puddings, meat pies, mayonnaise, meat tenderisers for household purposes, royal jelly for human consumption (other than for medicinal purposes), natural sweetener; advertising services; marketing and promotional services; organisation, operation and supervision of sales and promotional incentive schemes and customer loyalty schemes; information, advisory and consultancy services all relating to the aforesaid services'.

4 The grounds for invalidity relied on in support of the application for a declaration of invalidity were, in essence, those set out in Article 52(1)(a) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1), as amended, read in conjunction with Article 7(1)(b), (c) and (g) of that regulation (now, respectively, Article 59(1)(a) and Article 7(1)(b), (c) and (g) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1)).

5 On 27 May 2019, the Cancellation Division upheld the application for a declaration of invalidity in respect of all the goods and services referred to in paragraph 3 above.

6 On 24 July 2019, the applicant filed a notice of appeal with EUIPO against the Cancellation Division's decision.

7 In the proceedings before the Grand Board of Appeal, Icelandic Trademark Holding raised an additional ground for invalidity to those submitted before the Cancellation Division, based, in essence, on the application of Article 52(1)(a) in conjunction with Article 7(1)(f) of Regulation No 207/2009 (now Article 7(1)(f) of Regulation 2017/1001).

8 By the contested decision, the Grand Board of Appeal dismissed the appeal. In essence, in the first place, it found that the application for a declaration of invalidity of the mark at issue, based on Article 7(1)(f) of Regulation No 207/2009, was inadmissible on account of its late submission at the appeal stage.

9 In the second place, first, the Grand Board of Appeal found that the mark at issue was perceived by the relevant public, namely the English-speaking general public of the European Union, as an indication that the goods and services covered by it came from Iceland. It added that that perception was not altered by the figurative elements of the contested mark on account of their decorative nature. Accordingly, it took the view that that mark had been registered contrary to Article 7(1)(c) of Regulation No 207/2009.

10 Secondly, the Grand Board of Appeal recalled, in essence, that it was sufficient that one of the absolute grounds for refusal applied in order for the sign at issue not to be registrable as an EU trade mark. In any event, if that mark were to be examined in the light of Article 7(1)(b) of Regulation No 207/2009, it would have to be found to be devoid of distinctive character.

Forms of order sought

11 The applicant claims that the Court should:

– annul the contested decision;

– remit the case to the Cancellation Division for further prosecution;

– order EUIPO to pay the costs of the present action and order Icelandic Trademark Holding to pay the costs of the proceedings before the Cancellation Division and the Grand Board of Appeal.

12 EUIPO contends that the Court should:

– dismiss the action;

– order the applicant to pay the costs in the event that a hearing is convened.

13 Icelandic Trademark Holding submits that the Court should:

– dismiss the action;

– order the applicant to pay the costs.

14 The International Trademark Association (INTA) claims that the Court should:

– annul the contested decision;

– order it to pay its own costs.

Law

15 The applicant relies, in essence, on two pleas in law alleging, first, infringement of Article 7(1)(c) of Regulation No 207/2009 and, secondly, infringement of Article 7(1)(b) of that regulation.

The first plea in law, alleging infringement of Article 7(1)(c) of Regulation No 207/2009

16 The Grand Board of Appeal found, in essence, that the mark at issue was, for the relevant public, descriptive of the geographical origin of the goods and services which it covered or their characteristics given, in particular, the high level of recognition of the geographical name ‘Iceland’ and of the characteristics of that country as regards nature, ecology, renewable energy, economic prosperity, skilled workforce and in connection with its actual industry and exports. In view of those factors, it could be concluded that, in respect of the relevant public, Iceland was a country capable of producing many different types of goods and providing a wide range of services. Therefore, according to the Grand Board of Appeal, the relevant public will establish a link between the goods and services in question and the mark at issue as indicating their geographical origin or certain characteristics of theirs specifically linked to that geographical origin.

17 The applicant and INTA claim that the Grand Board of Appeal infringed Article 7(1)(c) of Regulation No 207/2009. They dispute the assessments of the Grand Board of Appeal and, consequently, the finding as to the descriptive character of the mark at issue in respect of all the goods and services in question.

18 More specifically, according to the applicant, despite there being no EU legislation which prohibits the registration of names of countries as trade marks, the Grand Board of Appeal has, nevertheless, effectively imposed such a prohibition in the contested decision. In that regard, the Grand Board of Appeal relied, in the applicant’s view, on non-decisive factors, such as the recognition of the geographical name ‘Iceland’ by the relevant public or on imprecise and unsubstantiated characteristics of that place which are, in any event, irrelevant. In addition, the Grand Board of Appeal did not take into account certain surveys submitted by the applicant. Lastly, the applicant criticises the Grand Board of Appeal for incorrectly finding that the figurative elements of the contested mark served only to highlight the word element. Even if the word mark Iceland had to be regarded as descriptive

for the purpose of Article 7(1)(c) of Regulation No 207/2009, which the applicant disputes, the figurative elements of the distinctive typography in combination with the red and yellow background of the mark at issue preclude, by contrast, regarding that mark as descriptive.

19 EUIPO and Icelandic Trademark Holding dispute the arguments of the applicant and INTA.

20 In that regard, it is apparent from the case-law that, under Article 52(1)(a) of Regulation No 207/2009, an EU trade mark is to be declared invalid on application to EUIPO or on the basis of a counterclaim in infringement proceedings where that trade mark has been registered in breach of the provisions of Article 7 of that regulation.

21 Under Article 7(1)(c) of Regulation No 207/2009, 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 are not to be registered. Under Article 7(2) of Regulation No 207/2009 (now Article 7(2) of Regulation 2017/1001), Article 7(1) of Regulation No 207/2009 is to apply notwithstanding that the grounds of non-registrability obtain in only part of the European Union.

22 Those signs and indications are deemed incapable of performing the essential function of a trade mark, namely that of identifying the commercial nature of the goods or services (judgments of 23 October 2003, *OHIM* v *Wrigley*, C-191/01 P, EU:C:2003:579, paragraph 30, and of 27 February 2002, *Eurocool Logistik* v *OHIM (EUROCOOL)*, T-34/00, EU:T:2002:41, paragraph 37).

23 For a sign to be caught by the prohibition set out in Article 7(1)(c) of Regulation No 207/2009, there must be a relationship between the sign and the goods or services in question that is sufficiently direct and specific to enable the relevant public immediately to perceive, without further thought, a description of the goods and services in question or of one of their characteristics (see judgments of 12 January 2005, *Deutsche Post EURO EXPRESS* v *OHIM (EUROPREMIUM)*, T-334/03, EU:T:2005:4, paragraph 25 and the case-law cited, and of 22 June 2005, *Metso Paper Automation* v *OHIM (PAPERLAB)*, T-19/04, EU:T:2005:247, paragraph 25 and the case-law cited).

24 Furthermore, although it is irrelevant whether such a characteristic is commercially essential or ancillary, a characteristic, within the meaning of Article 7(1)(c) of Regulation No 207/2009, must nevertheless be objective and inherent to the nature of that product or service and intrinsic and permanent with regard to that product or service (see judgment of 7 May 2019, *Fissler* v *EUIPO (vita)*, T-423/18, EU:T:2019:291, paragraph 44 and the case-law cited).

25 As regards, more particularly, signs or indications which may serve to designate the geographical origin or intended purpose of categories of goods or the place of performance

of the categories of services in respect of which an EU trade mark is applied for, especially geographical names, it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response (judgment of 6 September 2018, *Bundesverband Souvenir – Geschenke – Ehrenpreise* v *EUIPO*, C-488/16 P, EU:C:2018:673, paragraph 37; see also, by analogy, judgment of 4 May 1999, *Windsurfing Chiemsee*, C-108/97 and C-109/97, EU:C:1999:230, paragraph 26).

26 In that regard, it should be borne in mind that it is not permissible, first, to register geographical names as trade marks where they designate specific geographical locations which are already famous or known for the category of goods or services concerned and which are therefore associated with that category of goods or services by the relevant class of persons and, secondly, to register geographical names which are liable to be used by undertakings and must remain available to such undertakings as indications of geographical origin of the category of goods or services concerned (see, by analogy, judgment of 4 May 1999, *Windsurfing Chiemsee*, C-108/97 and C-109/97, EU:C:1999:230, paragraph 29, 30 and 37).

27 Accordingly, a sign may not be refused registration on the basis of Article 7(1)(c) of Regulation No 207/2009 unless the geographical name in respect of which registration as a trade mark is sought designates a place which is associated in the mind of the relevant class of persons, at the time the application for registration is made, with the category of goods and services concerned, or it is reasonable to assume that such an association may be established in the future (judgment of 6 September 2018, *Bundesverband Souvenir – Geschenke – Ehrenpreise* v *EUIPO*, C-488/16 P, EU:C:2018:673, paragraph 38; see also, by analogy, judgment of 4 May 1999, *Windsurfing Chiemsee*, C-108/97 and C-109/97, EU:C:1999:230, paragraph 31).

28 Even if the relevant public does know of a geographical location, it does not automatically follow that the sign may serve, in trade, to designate geographical origin. In order to examine whether the conditions for application of the ground for refusal to register at issue have been satisfied, account must be taken of all the relevant circumstances, such as the nature of the goods or services designated, the greater or lesser reputation, especially within the economic sector involved, of the geographical location in question and the relevant public's greater or lesser familiarity with it, the customs obtaining in the area of activity concerned and the question to what extent the geographical origin of the goods or services at issue may be relevant, in the view of the persons concerned, to the assessment of the quality or other characteristics of the goods or services concerned (see, to that effect, judgment of 25 October 2005, *Peek & Cloppenburg* v *OHIM (Cloppenburg)*, T-379/03, EU:T:2005:373, paragraph 49).

29 Furthermore, in invalidity proceedings based on an absolute ground for refusal, as the registered EU trade mark is presumed to be valid, it is for the person who has filed the

application for a declaration of invalidity to invoke before EUIPO the specific facts which call the validity of that trade mark into question (judgment of 13 September 2013, *Fürstlich Castell'sches Domänenamt* v *OHIM – Castel Frères (CASTEL)*, T-320/10, EU:T:2013:424, paragraph 28).

30 In the present case, in the first place, it should be recalled that the applicant does not dispute the definition of the relevant public, adopted by the Grand Board of Appeal in paragraphs 89 to 93 of the contested decision, according to which that public was made up of the English-speaking general public of the European Union on the date of the application for registration of the mark at issue on 12 February 2013, located in the territories of Cyprus, Finland, Ireland, Malta, the Netherlands, the Scandinavian countries, including Denmark, and the United Kingdom.

31 In the second place, in the contested decision, the Grand Board of Appeal found, in essence, that the word 'Iceland' was recognised by a significant part of the relevant public as the name of a country which is a member, inter alia, of the European Economic Area (EEA).

32 In that regard, first, it should be noted that the mark at issue refers to the name of a country which is, from a geographical perspective, located in Europe, is composed of a relatively sparsely populated territory and has a surface area larger than that of some Member States of the European Union and of the EEA.

33 Secondly, it must be found that, contrary to what the applicant claims, the Grand Board of Appeal did not treat the recognition of Iceland as a decisive factor when assessing the descriptive character of the mark at issue. It clearly stated, in paragraph 121 of the contested decision, that the assessment of the descriptive character of that mark also required taking into account other relevant factors such as the knowledge of the characteristics of the location designated by that geographical name and the link between the categories of goods and services and the mark at issue.

34 In the third place, in the contested decision, the Grand Board of Appeal noted various characteristics of Iceland on the basis of which it could be concluded, in its view, that Iceland was a country capable of producing many different types of goods and providing a wide range of services.

35 In that regard, first, it should be recalled that the applicant disputes that it is a well-known fact that Iceland is one of the most environmentally friendly countries in the world, the Grand Board of Appeal's assessment of the extensive trade relations between Iceland and the EU Member States and the description of Iceland's tourism industry as 'booming'. The Grand Board of Appeal, it argues, incorrectly found that the most common destination for goods exported from Iceland was Denmark and not the Netherlands and made an error of fact by finding that Iceland offered a reasonably wide range of goods and services.

36 However, it is clear that the applicant does not put forward any specific argument or

evidence to call into question the validity of the Grand Board of Appeal's assessments. Accordingly, it must be held that the assessment of those characteristics relating to Iceland cannot be called into question by the applicant's general and unsupported arguments. In addition, first, the analysis of the evidence on which the Grand Board of Appeal relied in the contested decision makes it possible to confirm that they establish to the requisite legal standard, first, that Iceland was an environmentally friendly country, which contributed, moreover, to making it a popular tourist destination (see paragraphs 108, 109, 125, 126 and 146 of the contested decision, concerning the supporting information from the *Collins Dictionary* and the *Encyclopedia Britannica*, and, in particular, the survey by Íslandsstofa (Promote Iceland) conducted in 2015 in Denmark, France, Germany and the United Kingdom, in relation to the perception of Iceland by tourists, and the data from the document *Tourism in Iceland in Figures, May 2016*). Secondly, it is apparent from those items of evidence that Iceland offered a wide range of goods and services, while maintaining, in respect of those goods and services, significant commercial relationships with the EEA countries (see, in particular, paragraph 127 of the contested decision, referring to the Statistical Yearbook of Iceland of 2015 and to the statement from the president of the foreign trade division of Statistics Iceland, of 27 January 2016, on exports from Iceland to the European Union during the period from 1999 to 2014). Furthermore, those items show that those commercial relationships have remained stable or have slightly intensified since the date of the application for registration of the mark at issue on 12 February 2013.

37 Secondly, as regards the contentions of the applicant and INTA as to the relevance of the characteristics of Iceland which were taken into account in the contested decision in order to assess the link between that country and the goods and services covered by the mark at issue, it is apparent from the case-law referred to in paragraphs 26 and 27 above that trade marks have a descriptive character where they designate specific geographical locations which are already famous or known for the category of goods or services concerned, but also those geographical locations in respect of which it is reasonable to assume that, in the future, they will be used by undertakings as an indication of geographical origin of the category of goods or services concerned.

38 It follows from the foregoing that the applicant is incorrect to claim that it was necessary, in the present case, to assess the 'reputation' which Iceland enjoyed among the relevant public, or which it was liable to enjoy in the future, in relation to the goods and services covered by the mark at issue. As is apparent from the case-law referred to in paragraph 28 above, it is appropriate to take into account a set of circumstances, as they existed on 12 February 2013, and to do so with a prospective outlook; those circumstances are not limited to only the question of reputation. In addition, the various characteristics of Iceland, which were taken into consideration by the Grand Board of Appeal, are significant for the purpose of ascertaining the extent to which the geographical origin of the goods or services in question is likely to be relevant, in the mind of the relevant class of persons, for the assessment of the quality or other characteristics of the goods or services concerned.

39 For those reasons, the applicant is not justified in criticising the Grand Board of Appeal for taking into account the economic prosperity, including the assessment of gross domestic product (GDP), skilled workforce or even the presence of various industries, since those factors could make it possible to ascertain whether Iceland was likely to become famous or known as a place of geographical origin in relation to the goods and services in question. It is apparent from an overall reading of the contested decision, in particular of paragraphs 146, 147 and 176 thereof, that the Grand Board of Appeal acknowledged the relevance of the Icelandic economy (both in respect of quantitative aspects, like GDP, and qualitative aspects) in order to support its finding as to the capability of that country to produce and offer a wide range of goods and services and as to the descriptive character of the mark at issue in the relevant public's perception. In that regard, it is also necessary to note that it is apparent from the case-law that GDP is relevant when ascertaining the characteristics of a geographical location referred to by the sign for which registration is sought and, consequently, when assessing the link that exists between the goods and services covered by that sign and the geographical name referred to (see, to that effect, judgment of 23 February 2022, *Govern d'Andorra* v *EUIPO (Andorra)*, T-806/19, not published, EU:T:2022:87, paragraph 65). In the present case, it is also apparent from paragraphs 118, 127 and 144 of the contested decision that the Grand Board of Appeal took into account the economic indicators as a whole, in combination with the statistical data on Iceland's exports and imports.

40 In the light of the foregoing, it is necessary to examine specifically the question whether the mark at issue designated, in the mind of the relevant class of persons, a place which was associated, at the time the application for registration was made, with the categories of goods and services concerned, or whether it was reasonable to assume that such an association might be established in the future.

The goods in Classes 29 and 30 covered by the mark at issue

41 First, the Grand Board of Appeal found that the indication of geographical origin, in essence, of foodstuffs and agricultural products was not only current practice in trade, but also obligatory in respect of certain goods for the purpose of achieving a high level of health protection for consumers and guaranteeing their right to information. Accordingly, consumers seeing the name of a country on those products would be more likely to perceive it as a place of origin and in a descriptive sense, even if the country in question does not enjoy any particular reputation or is not known for a particular product.

42 Secondly, the Grand Board of Appeal found that while Iceland may be mainly associated with fish, seafood, meat and dairy products, it produced other food products, such as fruits, vegetables and herbs. Furthermore, greenhouses, heated with geothermal energy might make it possible to expect, reasonably, a capacity for quite varied food production. Given that poultry is reared and eggs and cereals are commonly produced, packaged and marketed in Europe, consumers might think that those products are capable of originating from Iceland. This may also be the case as regards edible fats and oils and, in particular, rapeseed

oil which can be grown in colder climates.

43 Thirdly, the Grand Board of Appeal decided that, even if, as a result of their very nature, certain goods in Class 30 were not grown in Iceland, such as cocoa, coffee, tea, rice, sago and tapioca, they could nevertheless be processed there and adapted to local tastes.

44 The applicant claims, in essence, that the Grand Board of Appeal was incorrect to focus, when assessing the link between the goods in Classes 29 and 30 and the geographical name in question, on the fact that Iceland produced, to some extent, foodstuffs, even though those goods represented only a small proportion of the goods exported by that country. In addition, as regards certain 'exotic' goods, the assessments of the Grand Board of Appeal are purely theoretical and irrelevant. Moreover, the applicant submits that the legal obligation to indicate the country of origin on a product has no bearing on the use of the name of that country as a trade mark.

45 In that regard, in the first place, it should be noted that the goods in Classes 29 and 30 covered by the mark at issue include foodstuffs of plant and animal origin and liquids intended for human consumption, which all belong to the food sector.

46 According to the case-law, it is consistent with the usual practice for agricultural products and foodstuffs that they be designated by a geographical term which indicates or is capable of indicating their geographical origin (see, to that effect, judgment of 15 October 2003, *Nordmilch* v *OHIM (OLDENBURGER)*, T-295/01, EU:T:2003:267, paragraphs 42 to 45). The geographical origin of the goods in question may be regarded as capable of being particularly relevant, in the view of the relevant public, to the assessment of the quality or other characteristics of the goods concerned, in the light also of health, economic, environmental, social and ethical considerations of a general nature.

47 In the second place, it should be observed that, as is apparent from the documents in the file from the administrative proceedings before EUIPO, Iceland produces and exports various types of agricultural products and foodstuffs, in particular fish and fish-based products, various types of meat, dairy products, fruits and vegetables. In particular, it is apparent from those documents in that file that Iceland produced and exported those goods between 1999 and 2014, that is to say during a period both prior and subsequent to the date of the application for registration of the mark at issue (see, in particular, paragraph 127 of the contested decision, referring to the Statistical Yearbook of Iceland of 2015 and to the statement from the president of the foreign trade division of Statistics Iceland, of 27 January 2016, on exports from Iceland to the European Union during the period from 1999 to 2014).

48 In addition, the Grand Board of Appeal was correct to state, in paragraph 154 of the contested decision (see paragraph 42 above), as regards certain other goods in question, such as poultry and eggs, that they could be reared and produced anywhere in Europe and were therefore also capable of originating from Iceland. Similarly, edible fats and oils, in particular rapeseed oil, could be produced or grown even in colder climates, like in Iceland.

Accordingly, those goods in Classes 29 and 30 that are covered by the mark at issue may generally be produced, packaged and marketed in Iceland and exported to EEA countries.

49 It follows that Iceland produced, on the date of the application for registration of the mark at issue, a wide range of goods in Classes 29 and 30 covered by the mark at issue, that it also exported those goods and that it was capable of producing others. In the light of Iceland's present or prospective capacity to produce and export those goods, it is appropriate to find that where one of the products in Classes 29 and 30 is marketed under the mark at issue, it may be perceived as originating from that country. In that regard, contrary to what the applicant claims, the Grand Board of Appeal cannot be criticised for not taking into account the circumstance linked to an allegedly 'small' proportion of the foodstuffs exported by Iceland. Assuming that the present export of foodstuffs by Iceland is not a relatively significant part of its exports in general, such a claim does not make it possible to call into question the descriptive link between the mark and the goods in Classes 29 and 30 in so far as that claim does not take into account, from a prospective viewpoint, the link which may reasonably be established between the mark at issue and the goods concerned.

50 In addition, in so far as the applicant puts forward arguments intended to dispute the existence of a link between the mark at issue and seal meat, it is clear that the applicant does not call into question the fact that other types of meat, such as beef, mutton and pork, are produced in Iceland and, according to the evidence submitted during the administrative proceedings, exported by Iceland. Accordingly, its arguments cannot call into question the descriptive character of the mark at issue as regards the broader category of 'meat' in Class 29.

51 As regards cocoa, coffee and tea in Class 30, it is admittedly true, as the applicant claims, that those goods, as a result of their very nature, are not grown in Iceland and that it is unlikely that they will be in the future. However, the Grand Board of Appeal correctly stated, in paragraphs 152 and 155 of the contested decision, that they could be processed there and adapted to the local taste. The examples of tea selections from Ireland, England or Scotland – where that good is not grown – offered for retail in the European Union, relied on by the Grand Board of Appeal, are also relevant illustrations of that point. Those findings are applicable to other goods in the classes in question, such as sugar, chocolate and chocolate products and various fruit products which may be grown and dried, canned or otherwise processed in Iceland, in particular as regards bilberry products, wild brambleberries and redcurrants (see paragraph 152 of the contested decision).

52 If the applicant's claims are to be understood as referring to the lack of evidence substantiating the existence, in Iceland, of a practice of processing or adapting to local preferences goods like cocoa, coffee or tea and other goods referred to in paragraph 51 above, it must nevertheless be found that the possibility would remain reasonable in the view of the relevant public. That type of goods may be marketed in a particular way, by emphasising a product which has a flavour profile adapted to the local taste or other

specific qualities linked to their geographical origin.

53 It must be noted that those goods, and certain other goods in Classes 29 and 30, such as spices, sauces, ketchup and various other goods, may, as a result of adaptation, be imbued with characteristics specific to Iceland – having regard, for example, to processing methods which enable particular flavours to be emphasised – and be perceived as such by the relevant public.

54 In the light of all of the foregoing, it must be found that the Grand Board of Appeal was correct to find that the mark at issue had a descriptive character in respect of the goods in Classes 29 and 30.

The services in Class 35 covered by the mark at issue

55 The services in Class 35 that are covered by the mark at issue, first, refer, in essence, to retail services in stores and online. Secondly, they include advertising, marketing and promotional services and services of commercial organisation and operation of an undertaking.

56 The Grand Board of Appeal took the view, in essence, that the mark at issue could be used as a reference to the place from which the retail services in Class 35 were generally provided. In addition, the relevant public might perceive that mark as a reference to a specific quality of the goods marketed in connection with those services.

57 The applicant submits, in essence, that it is unlikely that the services in Class 35 originate from Iceland, given the low density of its population and the fact that its territory is in large part uninhabitable, which make it impossible to maintain a food retail chain. Furthermore, the applicant highlights the fact that Iceland does not ‘export’ any retail service.

58 As a preliminary point, although that is not disputed by the parties, it should be noted that, in paragraph 160 of the contested decision, the Grand Board of Appeal recalled that the services concerned were ‘essentially retail services’. In paragraph 161 of that decision, the Grand Board of Appeal analysed the link between those services and the geographical name in question, referring expressly to ‘retail outlets’. However, in paragraphs 162 to 164 of that decision, when analysing that link, it disregarded the services expressly referred to, by referring to ‘categories of services designated by the contested mark’ (paragraph 162), ‘the services in question’ or ‘those services’ (paragraph 163) and ‘the services covered by the contested mark’ (paragraph 164), those paragraphs of the contested decision citing, in addition, the judgment of 20 July 2016, *Internet Consulting* v *EUIPO – Provincia Autonoma di Bolzano-Alto Adige (SUEDTIROL)* (T-11/15, EU:T:2016:422), which concerned, in essence, business management and administration services.

59 Accordingly, even though, in its reasoning, the Grand Board of Appeal did not make an express reference to advertising, marketing and promotional services and services of commercial organisation and operation of an undertaking, it is clear from an overall reading

of the reasons set out in paragraphs 162 to 164 of the contested decision that they must be understood as referring to all of the services covered by the mark at issue and not only those relating to retail. The findings linked to the specific qualities of services, which may be described by the geographical name 'Iceland' in so far as they are 'for example, … tailored to the particular requirements of businesses operating in that region, characterised by a particular political, administrative and linguistic context', are applicable, in principle, only to services, in essence, of advertising, marketing and promotion and of commercial organisation and operation of an undertaking, and all the more so because that statement refers to the professional public, for which those services are intended.

60 In any event, in the absence of arguments from the applicant and INTA regarding the assessment of the future link between the services referred to in paragraphs 58 and 59 above and the geographical name designated by the mark at issue, the present analysis of the Court will focus on that assessment having regard only to, in essence, retail services and the geographical name in question.

61 It is necessary to stress that the retail services, covered by the mark at issue, concern food products, beverages and household goods, all of which are produced in Iceland. Moreover, that may include goods, such as fish, seafood or other ocean products, in respect of which the applicant does not dispute that Iceland is known as the country of origin.

62 As regards the applicant's arguments concerning the lack of exports of the services covered by the mark at issue and Iceland not having a reputation in relation to those services and the arguments alleging that the size of the Icelandic population prevents that country from being able to maintain a food retail chain, they cannot succeed, for the same reasons as set out in paragraphs 37 and 38 above, without, moreover, any distinction according to the demographic significance of the geographical location in question being relevant. It is reasonable to take the view that, where the services in question bear the mark at issue, they will be perceived as being provided in stores located in that country.

63 In the light of the foregoing, it must be found that the Grand Board of Appeal was correct to find that the mark at issue had a descriptive character in respect of the services in Class 35.

Certain transversal claims of the applicant and INTA

64 None of the other arguments of the applicant or INTA is capable of invalidating the Grand Board of Appeal's finding relating to the descriptive character of the mark at issue in respect of the goods and services it covers.

65 In the first place, the applicant and INTA submit that the Grand Board of Appeal erred in law by finding, in essence, that registering the names of countries necessarily came within the scope of the absolute ground for refusal referred to in Article 7(1)(c) and (f) of Regulation No 207/2009, irrespective of the goods or services concerned.

66 However, it is clear that such a claim stems from an incorrect reading of the contested decision. As is evident from a comprehensive reading of that decision, in particular of paragraphs 94 to 214 thereof, the Grand Board of Appeal carried out a detailed analysis of the descriptive character of the mark at issue in respect of all of the goods and services in question.

67 In the second place, it should be noted that, contrary to what the applicant claims, neither the typography nor the colour of the mark at issue give it an unusual or striking effect. The word element of that mark is represented in a font of standard white letters, without any typographical specificity. While, admittedly, it is positioned on a red, orange and yellow rectangular background, of which the yellow and orange effect gives it the impression of having a slightly faded look, the coloured background, in particular in orange and yellow colours, is, in essence, common in the advertising and on packaging, with the result that the consumer may regard it as a decorative element.

68 In those circumstances, the Grand Board of Appeal was correct to find that the figurative elements of the mark at issue served only to highlight the word element of that mark and did not alter in any way the descriptive content conveyed by the latter element.

69 In the third place, as regards the applicant's argument that Article 12(b) of Regulation No 207/2009 (now Article 14(b) of Regulation 2017/1001) guarantees that Icelandic entities may use the name 'Iceland', it should be noted that the wording of that provision, entitled 'Limitation of the effects of [an EU] trade mark', is as follows:

'[An EU] trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade:

…

(b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;

…

provided he uses them in accordance with honest practices in industrial or commercial matters.'

70 The provision referred to in paragraph 69 above is intended, inter alia, to resolve the problems posed by registration of a mark which consists wholly or partly of a geographical name and does not confer on third parties the right to use the name as a trade mark but merely guarantees their right to use it descriptively, that is to say, as an indication of geographical origin, provided that it is used in accordance with honest practices in industrial and commercial matters (see, by analogy, judgment of 4 May 1999, *Windsurfing Chiemsee*, C-108/97 and C-109/97, EU:C:1999:230, paragraphs 26 to 28).

71 Contrary to what the applicant appears to be suggesting, the fact that Article 12(b) of Regulation No 207/2009 ensures that every trader may freely use indications concerning the characteristics of goods and services does not guarantee the protection of the public interest underlying Article 7(1)(c) of that regulation. On the contrary, that fact clearly discloses the need for the ground of refusal set out in Article 7(1)(c) of Regulation No 207/2009 – which, moreover, is an absolute ground for refusal – to be actually applied to any sign which may designate a characteristic of the goods or the services in respect of which the mark is registered (see, to that effect, judgment of 10 March 2011, *Agencja Wydawnicza Technopol* v *OHIM*, C-51/10 P, EU:C:2011:139, paragraph 61 and the case-law cited). Accordingly, the applicant's argument must be rejected as unfounded.

72 In the fourth and last place, the applicant appears to criticise the Grand Board of Appeal for dismissing, as inadmissible, the survey compiled on 2 August 2019, which took account of telephone interviews conducted in June 2019.

73 However, from a combined reading of, inter alia, paragraphs 137, 138, 157 and 196 of the contested decision, it must be found that the Grand Board of Appeal did not assess whether the survey carried out on 2 August 2019 was admissible, but rather whether it had evidential value.

74 Furthermore, even assuming that the applicant intends to dispute the assessment of that survey's evidential value, it is sufficient to note that it does not infer any specific effect which that survey might have had on the assessment of the descriptive character of the mark at issue. In any event, as the Grand Board of Appeal found, correctly, in paragraph 157 of the contested decision, the mere act of asking the persons surveyed which goods come to mind on seeing the mark at issue is not an infallible or appropriate test for assessing the latter's descriptive character since that assessment must always be carried out in the light of the goods and services covered by that mark (see the case-law cited in paragraph 23 above).

75 In the light of all of the foregoing, the first plea in law must be rejected.

The second plea in law, alleging infringement of Article 7(1)(b) of Regulation No 207/2009

76 By the second plea in law, the applicant, supported by INTA, submits, in essence, that the Board of Appeal infringed Article 7(1)(b) of Regulation No 207/2009.

77 EUIPO and Icelandic Trademark Holding dispute the arguments of the applicant and INTA.

78 Since it is apparent from Article 7(1) of Regulation No 207/2009 that it is sufficient that one of the absolute grounds for refusal listed therein applies in order for the sign at issue not to be registrable as an EU trade mark, and in the light of the rejection of the applicant's first plea in law, concerning the Grand Board of Appeal finding that Article 7(1)(c) of that

regulation applied in order to declare the invalidity of the mark at issue in respect of all the goods and services it covers, it is unnecessary to examine the merits of the second plea in law relied on by the applicant, alleging infringement of Article 7(1)(b) of that regulation.

79 In the light of all of the foregoing, the second plea in law must be rejected and, accordingly, the action must be dismissed in its entirety.

Costs

80 Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

81 Since a hearing has taken place and the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the forms of order sought by EUIPO and Icelandic Trademark Holding.

82 INTA is to bear its own costs in accordance with Article 138(3) of the Rules of Procedure.

On those grounds,

THE GENERAL COURT (Seventh Chamber)

hereby:

1. **Dismisses the action;**

2. **Orders Iceland Foods Ltd to bear its own costs and to pay those incurred by the European Union Intellectual Property Office (EUIPO) and Icelandic Trademark Holding ehf;**

3. **Orders the International Trademark Association (INTA) to bear its own costs.**

Kowalik-Bańczyk Buttigieg Dimitrakopoulos

Delivered in open court in Luxembourg on 16 July 2025.

V. Di Bucci M. van der Woude

* Language of the case: English.