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In two judgements of 28 February 2024 in related cases T-746/22 and T-747/22, the General Court of the EU (GCEU) upheld the validity of two EU trademark registrations containing the geographical name 'Compton', which it considers distinctive and not descriptive for fashion items like clothing and bags. These judgments provide a good opportunity to refresh the rules on the registration and protection of geographical names as trademarks in relation to fashion items.

## THE COMPTON CASES

In the COMPTON cases, the GCEU had to examine the validity of two EU trademark registrations held by BIW INVEST AG: one word mark composed of the name 'COMPTON' registered for clothing, headgear and footwear in class 25 (case T-746/22), and one figurative mark composed of the name 'COMPTON' in a stylised font registered for trunks and bags in class 18 and for clothing, headgear and footwear in class 25 (case T-747/22).

German fashion and lifestyle company NEW YORKER filed an application for declaration of invalidity on the grounds that these trademarks are descriptive and lack distinctive character because they may serve to designate the geographical origin of the goods in question.

## GENERAL RULES

Article 7, paragraph 1 of EU Regulation 2017/1001 on the European Union trade mark (EUTMR) excludes the registration of trademarks which are devoid of any distinctive character (under b), or which consist exclusively of signs or indications which may serve, in trade, to designate certain characteristics of the goods or services, such as their geographical origin (under c). This provision pursues an aim of public interest to ensure that signs or indications capable of describing certain characteristics of goods or services may be freely used by all. For a sign to be considered descriptive, it must suggest a sufficiently direct and concrete link to the goods or services in question to enable the public concerned immediately, and without further thought, to perceive a description of the category of goods and services in question or of one of their characteristics.

As regards geographical names, it is in the public interest that they remain available because they may, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response.

# COMPTON CASES

## GEOGRAPHICAL NAMES AS FASHION TRADEMARKS



Compton



A trademark registration composed of a geographical name may be refused or invalidated when it designates a place which is currently associated in the mind of the relevant public with the category of goods concerned, or when it is reasonable to assume that such an association may be established in the future. However, the mere fact that the relevant public knows a geographical location does not automatically mean that the sign may serve, in trade, to designate their geographical origin. Equally, the mere fact that the relevant goods may be produced or designed in the geographical place in question is not per se sufficient to reasonably assume an association.

Regard must be had to the degree of familiarity amongst the relevant public with that geographical name, with the characteristics of the place designated by the name, and with the category of goods concerned. Geographical names that designate specified geographical locations that are already famous or are known for the category of goods or services concerned, and that are therefore associated with that category in the mind of the relevant class of persons, may not be registered as trademarks. The EUIPO Trade Mark Guidelines explain that ‘Milano’ should be refused for clothing, ‘Frankfurt’ for financial services, ‘Islas Canarias’ for sightseeing, tour guide and excursion services and ‘Switzerland’ for banking services, cosmetic products, chocolate and watches.

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## NO LINK BETWEEN THE GEOGRAPHICAL NAME ‘COMPTON’ & FASHION ITEMS LIKE BAGS OR CLOTHING

In the COMPTON cases, the GCEU first considered that, even though the relevant public as a whole is the general public, it is in principle justifiable to take particular account of the perception of that part of the public (in this case the German public since most evidence concerned publications in Germany) that is interested in street fashion and influenced by hip-hop culture and rap music.

While acknowledging that the city of Compton is closely associated with the birth of gangsta rap (as the birthplace of rappers Dr. Dre, Kendrick Lamar, NWA and The Game), the GCEU considered that the city of Compton does not, by definition, play such a central role in hip-hop culture and rap music as a whole. The importance of the city of Compton in the history of gangsta rap is not sufficient, on its own, to establish that all of the German public interested in street fashion and influenced by hip-hop culture and rap music, or at least a large part of that public, is familiar with the city of Compton. Moreover, it was not proven that consumers familiar with the city of Compton represent a significant portion of the general public in Germany. The GCEU concluded that the relevant public will not make a link between the geographical name ‘Compton’ and the products in question (clothing and bags) and on that basis upheld the validity of the two EU trademarks.

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## ESTABLISHED CASE LAW

This decision follows established case law of the EU Court of justice (CJEU), the GCEU and the European Union Intellectual Property Office (EUIPO), which generally accepts the registration as trademarks of geographical names that have no direct link with the clothing/fashion industry.



Compton



For instance, in the NEUSCHWANSTEIN case (C-488/16), the CJEU held that ‘Neuschwanstein’ (which is the name of a famous castle in Germany) is not descriptive for various goods including bags and clothing.

In the GIORGIO BEVERLY HILLS cases (T-162/01 and T-228/06), the GCEU held that the words ‘Beverly Hills’ are not descriptive for clothing, footwear and headgear.

In the MIAMI case (No R 2528/2017-4), the EUIPO held that the city of Miami will not be associated by the public with tracksuits, or clothing in general. The EUIPO held that: *“no reasons are apparent as to why consumers in the EU would associate the city of Miami, of all places, with tracksuits. There is no particular relationship between the geographical or climatic characteristics of the city of Miami or of the US State of Florida (including its beaches) and the nature of tracksuits.”* The EUIPO explains that, unlike indications of a country of production, it is unusual to refer to a city as a place of production for clothing. The consumer knows that clothing can be produced in any number of places, including under the same mark, and indeed not necessarily at the place where the trademark proprietor is based, but mostly in low-wage countries. Where production takes place within the EU, it is the country concerned that is normally indicated and not a particular city. This would only be different in the case of cities that the consumer currently associates with fashion, or at least as locations for fashion design, such as Paris. This too would have to be proven, because fashion design is also generally possible anywhere in the world.

In the ALEXANDRAE BARCELONA case (No B 2 186 636), the EUIPO held that ‘Barcelona’ is not descriptive for bags or clothing.

However, ‘AUSTRALIA’ was considered descriptive for a number of goods including clothing, as it indicates that the use or take-up of the goods and services in question contributes to creating a particular attitude to life linked to Australia (EUIPO Board of Appeal 06/04/2018, R 2207/2017-2, AUSTRALIA). In another decision, the EUIPO refused the registration of ‘PARIS’, holding that ‘PARIS’ is likely to be associated with a certain idea of quality, design, stylishness and even of being avant-garde. This results in a positive feeling, an expectation with regard to the quality of the goods sold and the services provided, when ‘PARIS’ is put forward as an indication of geographical origin or destination (EUIPO Board of Appeal 26/10/2015, R 3265/2014-4, Paris).

## CONCLUSION

The COMPTON cases confirm the possibility to register geographical names as fashion trademarks, if they are unknown to the relevant public or the relevant public will not currently or reasonably associate them with clothing or fashion in the future. Conversely, where a geographical name is either already famous, or is known for clothing or fashion in general, the trademark registration is likely to be refused or invalidated.

**For any questions or assistance, please reach out to our**

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