Trade Marks and Geographical Indications: examples of the case law

Virginia Melgar
Chairperson of the Fifth Board of Appeal
DEFINITIONS AND BASIC PRINCIPLES
Protected Designation of Origin - PDO

• **agricultural products and foodstuffs**
  – agricultural products and foodstuffs which are produced, processed and prepared in a given geographical area using recognised know-how.

• **wine**
  – product which must be produced within a determined geographical area using recognised and recorded know-how. All products with PDO status must be produced exclusively with grapes from the area in question
Protected Geographical Indication – PGI

- **agricultural products and foodstuffs**
  - agricultural products and foodstuffs closely linked to the geographical area. At least one of the stages of production, processing or preparation takes place in the area

- **wine**
  - product with a quality, reputation or other specific features that can be attributed to a determined geographical area
  - at least 85% of the grapes coming from the area in question

- **spirit**
  - product with a quality, reputation or other characteristic that can be attributed to a determined geographical area

- **aromatised wine**
  - product as originating in a region, a specific place, or a country, where a given quality, reputation or other characteristics of that product is essentially attributable to its geographical origin.
**TSG & TTW**

*Traditional Speciality Guaranteed – TSG*
- agricultural products and foodstuffs
  - highlights traditional character, either in the composition or means of production

*Traditional Term for wine – TTW*
- wine
  - product has a protected designation of origin or a protected geographical indication under Union or national law or the production or ageing method or the quality, colour, type of place, or a particular event linked to the history of the product with a protected designation of origin or a protected geographical indication.
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<thead>
<tr>
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<th>EU</th>
<th>MS</th>
<th>International</th>
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<tbody>
<tr>
<td></td>
<td></td>
<td></td>
<td>EU is party</td>
</tr>
<tr>
<td>GI agricultural &amp; foodstuffs</td>
<td>✓</td>
<td>×</td>
<td>✓</td>
</tr>
<tr>
<td>GI wine</td>
<td>✓</td>
<td>×</td>
<td>✓</td>
</tr>
<tr>
<td>GI spirits</td>
<td>✓</td>
<td>×</td>
<td>✓</td>
</tr>
<tr>
<td>GI aromatised wines</td>
<td>✓</td>
<td>×</td>
<td>✓</td>
</tr>
<tr>
<td></td>
<td>✓</td>
<td>×</td>
<td>✓</td>
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<tr>
<td>GI non–agricultural</td>
<td>×</td>
<td>✓</td>
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<td>(not existing)</td>
<td>(not existing)</td>
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<tr>
<td>TTW</td>
<td>✓</td>
<td>×</td>
<td>✓</td>
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<td>(excluded)</td>
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<tr>
<td>TSG</td>
<td>✓</td>
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<td>✓</td>
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Registration process of PDO/PGI

From EU Member State
• Request at the competent national authority
• National check
• Submission to Commission, if national check is positive
  – Transitional national protection possible
• EU Check
  – Opposition
• Registration

From Third State
• Request to the Commission,
  – either direct or via competent national authority
• EU Check
  – Opposition
• Registration
Individual Trade Mark

- signs capable [of being represented graphically], particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertaking
- Indications which may designate geographical origin may be registered
Collective Trade Mark

• trade mark which is capable of distinguishing the goods or services of the members of an association which is the proprietor of the trade mark from those of other undertakings

• Problem:
  • What means ‘association’?
• trade mark which is capable of distinguishing goods or services which are certified by the proprietor of the trade mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, with the exception of geographical origin, from goods and services which are not so certified
### Comparison

<table>
<thead>
<tr>
<th></th>
<th>PDO/PGI</th>
<th>Individual TM</th>
<th>Collective TM</th>
<th>Certification TM</th>
</tr>
</thead>
<tbody>
<tr>
<td>Proprietor</td>
<td>No proprietor</td>
<td>Natural or legal person</td>
<td>Association</td>
<td>Natural or legal person, not supplying these g&amp;s</td>
</tr>
<tr>
<td>Definition</td>
<td>To distinguish product of a specific area and quality from products not of this area or this quality</td>
<td>To distinguish g&amp;s from one undertaking from those of another</td>
<td>To distinguish g&amp;s from members of an association from those of other undertakings</td>
<td>To distinguish g&amp;s which are certificed from g&amp;s which are not certified</td>
</tr>
<tr>
<td>What</td>
<td>Verbal only</td>
<td>Verbal and figurative</td>
<td>Verbal and figurative</td>
<td>Verbal and figurative</td>
</tr>
<tr>
<td>Important</td>
<td>Geographic term is distinctive</td>
<td></td>
<td></td>
<td>May not certify geographic origin</td>
</tr>
</tbody>
</table>
Certification marks issues
Absolute grounds cases (7(1)(j) and 7(1)(k)
Relative Grounds
CERTIFICATION MARKS
Certification mark containing a geographical concept,
Article 83(1)EUTMR

- 16/03/2021, R 2205/2020-4,
- DAIRY FARMERS OF CANADA QUALITY MILK
  LES PRODUCTEURS LAITIERS DU CANADA LAIT DE QUALITÉ

EUTMA rejected
Contains a geographical concept
Certification mark from Colombia

07/09/2020, R 1504/2020-5,
FLORVERDE
SUSTAINABLE FLOWERS

EUTMA accepted, Regulations of use ok
Absolute grounds cases (7(1)(j) and 7(1)(k)
Absolute grounds cases (7(1)(j) and 7(1)(k))

Contains translation of equivalent adjective or noun - R 2531/2015-2, 1/6/2016

EUTMA
- Cl. 33
  - Alcoholic beverages (except beer and wine)

PDO /PGI
- Hierbas Ibicencas
  - Spirit drinks

IBIZA FLIRT

EUTMA rejected
Contains 2 not compatible PDO/PGI
Absolute grounds cases (7(1)(j) and 7(1)(k))

Evocation – by referring to PDO / PGI - R 1944/2014-2, 7/7/2015

EUTMA

➢ Cl. 33
  • wine

PDO / PGI

➢ Tierra de León
➢ Castilla y León
  • wine

FRAY LEÓN

EUTMA rejected

Refers to main element of PDO/PGI
Absolute grounds cases (7(1)(j) and 7(1)(k))


EUTMA
- Cl. 33
  - wine; sparkling wines, namely crémant

PDO / PGI
- Tierra de León
  - wine
- Castilla y León
  - wine

MICHEL LEON

EUTMA published
Refers not to main element of PDO/PGI but to a name
Absolute grounds cases (7(1)(j) and 7(1)(k))

Evocation – by referring to PDO / PGI - R 26/2018-5, 23/3/2018

EUTMA

➢ Cl. 29
  • Meat; poultry

PDO / PGI

➢ Pollo y Capón, del Prat
  • Chicken capon

EUTMA rejected
Evokes the PDO
RELATIVE GROUNDS
RELATIVE GROUNDS

R 2348/2011-4 CAVAVIN / CAVA, 25/7/2013

EUTMA

➢ Cl. 33
  • Alcoholic beverages (except beers and wines); wines with registered designation of origin CAVA

CAVAVIN

Earlier right **collective** EUTM

➢ Cl. 33
  • Sparkling wine (cava)

Ground of opposition
  – Article 8(1)(b), (5) EUTMR

OPPOSITION ALLOWED
RELATIVE GROUNDS

R 1274/2013-1 FFR/ CHIANTI continuation of T-143/11, 19/9/2013

EUTMA

➢ Cl. 33
  • Alcoholic beverages (except beers);

Earlier right EUTM

➢ Cl. 33, chianti wine

Ground of opposition
  – Article 8(1)(b), (5) EUTMR
Several trade marks against VINHO VERDE

EUTMA’s

• BODEGAS JARAVERDE
• TOMBOLINI DOROVERDE
• BOSQUE VERDE
• DOROVERDE
• bio-verde
• VALE VERDE
• VEGAVERDE
• TAVOLAVERDE

Trade mark or PDO

➢ Ordinary wines from respective demarcated region
➢ Green wine

Grounds invoked
– Articles 8(1)(b), 8(4), 8(5) EUTMR

Oppositions mostly dismissed
RELATIVE GROUNDS

T-359/14, 18/9/2015

EUTMA

➢ Cl. 30 and 43

Earlier right PGI ‘Cafe de Colombia’

➢ Cl. 30 coffee

Decision of the Board annulled

Ground of opposition
– Article 8(4) EUTMR
RELATIVE GROUNDS

T-387/13, 18/9/2015

EUTMA
➢ Cl. 43

Earlier right PGI ‘Cafe de Colombia’
➢ Cl. 30 coffee

Decision of the Board annulled

Ground of opposition
– Article 8(4) EUTMR
RELATIVE GROUNDS

R-1291/2014-4, 3/6/2015

EUTMA

➢ Cl. 33 Alcoholic beverages, brandy; with the protected geographical indication "PISCO".

Earlier right PGI ‘pisco’

➢ Cl. 33 fruit spirit

Ground of opposition
– Article 8(4) EUTMR

Opposition rejected
RELATIVE GROUNDS

R-1292/2014-4, 3/6/2015

EUTMA

➢ Cl. 33 Alcoholic beverages, brandy; with the protected geographical indication "PISCO".

Earlier right PGI ‘pisco’

➢ Cl. 33 fruit spirit

Ground of opposition
– Article 8(4) EUTMR

Opposition rejected
RELATIVE GROUNDS

R-1320/2017-2, 14/12/2017

EUTMA

BLANC DE BLANCS

CENTINELA CONO SUR

➢ Cl. 33 wines and sparkling wines.

Earlier right PGI ‘sur’

➢ Cl. 33 wines

Ground of opposition
– Article 8(4) EUTMR

Opposition rejected
C-673/15 P to 676/15 P, 20/9/2017: The Tea Board v EUIPO-Delta Lingerie: Darjeeling

Opposition - EU collective marks consisting of the geographical indication - distinctive character or the repute of the earlier trade mark

<table>
<thead>
<tr>
<th>Delta Lingerie</th>
<th>The Tea Board</th>
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<tbody>
<tr>
<td><img src="Darjeeling.png" alt="" /></td>
<td><img src="Darjeeling.png" alt="" /></td>
</tr>
<tr>
<td><strong>Figurative signs</strong></td>
<td><strong>EU Collective word &amp; figurative sign</strong></td>
</tr>
<tr>
<td>Class: 25 (lingerie); 35 (sales promotion, ads,...); 38 (telecom, computer,...)</td>
<td>Class: 30</td>
</tr>
</tbody>
</table>
Earlier DO ‘Porto’ & ‘Port’ protected under EU & National law - Exhaustive nature of the protection - ‘Use’ and ‘Evocation

<table>
<thead>
<tr>
<th>Bruichladdich Distillery Co.Ltd</th>
<th>Instituto dos Vinhos do Douro e do Porto IP</th>
</tr>
</thead>
<tbody>
<tr>
<td>PORT CHARLOTTE Verbal sign</td>
<td>DO: “Porto” &amp; “Port”</td>
</tr>
<tr>
<td>Class 33: Alcoholic drinks: Whisky</td>
<td>Wines</td>
</tr>
</tbody>
</table>
T-828/16: 14/12/2017, CRDO “Torta del Casar” v EUIPO/CRDO “Queso de La Serena”
queso y torta de la Serena vs Torta del Casar

<table>
<thead>
<tr>
<th>Consejo Regulador de la Denominación de Origen Protegida «Queso de La Serena»</th>
<th>Consejo Regulador de la Denominación de Origen «Torta del Casar»</th>
</tr>
</thead>
<tbody>
<tr>
<td><img src="image1.png" alt="Queso y Torta de La Serena" /></td>
<td><img src="image2.png" alt="Torta del Casar" /></td>
</tr>
<tr>
<td>Classes 29 (Cheese from La serena), 35 (Export-Import services of cheese of La Serena) y 39 (Transport &amp; distribution of La Serena Cheese)</td>
<td>ProtectedDO(Regl 510/06) “Torta del Casar” Cheese (from El Casar)</td>
</tr>
</tbody>
</table>
The concept of evocation

The “Queso Manchego” case: How far can GI protection go? C-614/17
Infringement case before Spanish court

Challenged activity

For sheep cheese produced in La Mancha which does not comply with the specifications of the PDO

Spanish trade name nº 235378 “ROCINANTE” (word), trademark nº 2045182 and nº 2635904 (device), for cheese and cheese-related services.
Questions referred to by the Supreme Court:

(1) Must the evocation necessarily be brought about by the use of a name visually, phonetically or conceptually similar to the [PDO] or may it be brought about by the use of figurative signs evoking the [PDO]?

A registered name may be evoked through the use of figurative signs

(2) Can the use of signs evoking the region with which a [PDO] is associated constitute evocation of the [PDO] itself, even when the user of those signs is a producer established in the region associated with the [PDO], but whose products are not protected by that PDO because they do not meet the requirements set out in the product specification, apart from the geographical provenance?

Including where such figurative signs are used by a producer established in that region, but whose products, similar or comparable to those protected by the designation of origin, are not covered by it.

(3) Must the concept of the average consumer in order to assess whether there is “evocation”, be understood to cover European consumers or can it cover only consumers of the Member State in which the challenged product is produced or with which the PDO is geographically associated and in which the product is mainly consumed?

All European consumers, including consumers of that Member State.

Effective and uniform protection throughout the territory of the European Union must be guaranteed.

Evocation assessed by reference to the consumers of a single Member State may be sufficient.
Judgement nº 451 of the Spanish Supreme Court of July 18, 2019:

- Labelling infringes the PDO

- Annuls the registered trademarks and trade name “ROCINANTE”