

# Trade Marks and Geographical Indications: examples of the case law

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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 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.

## Regime – EU vs Member State

	EU	MS	International	
			EU is party	MS is party
<b>GI agricultural &amp; foodstuffs</b>	✓	✗	✓	✗
<b>GI wine</b>	✓	✗	✓	✗
<b>GI spirits</b>	✓	✗	✓	✗
<b>GI aromatised wines</b>	✓	✗ (since 28/03/2017)	✓	✗ (since 28/03/2017)
<b>GI non-agricultural</b>	✗ (not existing)	✓	✗ (not existing)	✓
<b>TTW</b>	✓	✗ (excluded)	✓	✗ (excluded)
<b>TSG</b>	✓	✗ (excluded)	✓	✗ (excluded)

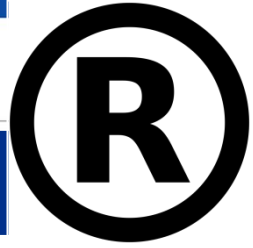
## Registration process of PDO/PGI

### 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

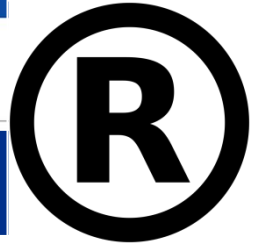
- Request to the Commission,
  - either direct or via competent national authority
- EU Check
  - Opposition
- Registration



## *Individual Trade Mark*

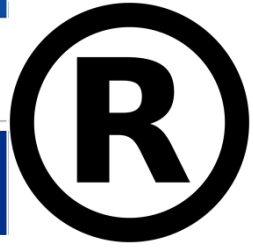
- signs capable [of being represented graphically], particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are **capable of distinguishing the goods or services of one undertaking from those of other undertaking**
- 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'?



## *Certification Trade Mark*

- 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

	<b>PDO/PGI</b>	<b>Individual TM</b>	<b>Collective TM</b>	<b>Certification TM</b>
Proprietor	No proprietor	Natural or legal person	Association	Natural or legal person, not supplying these g&s
Definition	To distinguish product of a specific area and quality from products not of this area or this quality	To distinguish g&s from one undertaking from those of another	To distinguish g&s from members of an association from those of other undertakings	To distinguish g&s which are certified from g&s which are not certified
What	Verbal only	Verbal and figurative	Verbal and figurative	Verbal and figurative
Important			Geographic term is distinctive	May not certify geographic origin

**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

FLORVERDE



SUSTAINABLE  
FLOWERS

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))**



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

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

Evocation – by referring to PDO / PGI - R 2274/2011-4, 25/4/2012

## EUTMA

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

MICHEL LEON

## PDO /PGI

- Tierra de León
  - wine
- Castilla y León
  - wine

**EUTMA published**  
Refers not to main element of  
PDO/PGI but to a name

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

## 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**

## 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



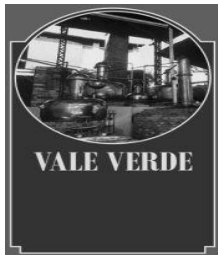
**OPPOSITION ALLOWED**

Ground of opposition

- Article 8(1)(b), (5) EUTMR

## EUTMA's

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



## Trade mark or PDO

**VINHO VERDE**  
PORTUGAL

- Ordinary wines from respective demarcated region
- Green wine

Grounds invoked

- Articles 8(1)(b), 8(4), 8(5) EUTMR

Oppositions mostly dismissed



## 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

**T-387/13, 18/9/2015**

**EUTMA**

➤ Cl. 43

**COLOMBIANO**  
  
**HOUSE**

Earlier right PGI ‘Cafe de  
Colombia’

➤ Cl. 30 coffee

*Decision of the Board  
annulled*

Ground of opposition

– Article 8(4) EUTMR

## 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

*Opposition rejected*

- Ground of opposition
- Article 8(4) EUTMR

## 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



*Opposition rejected*

- Ground of opposition
- Article 8(4) EUTMR

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

**EUTMA**

Earlier right PGI ‘sur’

**BLANC DE BLANCS**

➤ Cl. 33 wines

**CENTINELA CONO SUR**

➤ Cl. 33 wines and sparkling wines.



*Opposition rejected*

Ground of opposition

– Article 8(4) EUTMR

## 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

Delta Lingerie	The Tea Board
 <p data-bbox="175 834 421 860">Figurative signs</p>	 <p data-bbox="1045 867 1619 893">EU Collective word &amp; figurative sign</p>
<p data-bbox="175 943 962 1002">Class: 25 (lingerie); 35 (sales promotion, ads,...); 38 (telecom, computer,...)</p>	<p data-bbox="1045 943 1261 969">Class: 30 (tea)</p>

## C-56/16 P, 14/9/2017: Instituto dos Vinhos do Douro e do Porto IP & República Portuguesa (Porto) V EUIPO/COM/Bruichladdich Distillery Co.Ltd (Port Charlotte)

Earlier DO ‘Porto’ & ‘Port’ protected under EU & National law - Exhaustive nature of the protection - ‘Use’ and ‘Evocation

<b>Bruichladdich Distillery Co.Ltd</b>	<b>Instituto dos Vinhos do Douro e do Porto IP</b>
PORT CHARLOTTE Verbal sign	DO: “Porto” & “Port”
Class 33: Alcoholic drinks: Whisky	Wines

## 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

Consejo Regulador de la Denominación de Origen  
Protegida «Queso de La Serena»



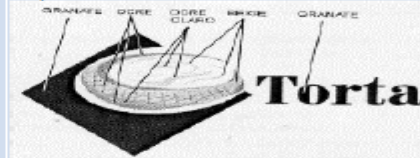
Classes 29 (Cheese from La Serena), 35 (Export-Import services of cheese of La Serena) y 39 (Transport & distribution of La Serena Cheese)

Consejo Regulador de la Denominación de Origen  
«Torta del Casar»

EU figurative Mark



Spanish mark



Protected DO (Regl 510/06) “Torta del Casar”

Cheese (from El Casar)



# 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 n° 235378 “ROCINANTE” (word),  
trademark n° 2045182 and n° 2635904 (device),  
for cheese and cheese-related services.



# Preliminary ruling

## 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.*

# Final word

## Judgement nº 451 of the Spanish Supreme Court of July 18, 2019:

- Labelling infringes the PDO
- Annuls the registered trademarks and trade name “ROCINANTE”



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Thank you