

GEOGRAPHICAL INDICATIONS, DESIGNATION OF ORIGIN VERSUS EUROPEAN UNION TRADEMARK – CONFLICT OR CO-EXISTENCE?

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Abstract

The study aims to highlight the situations that may arise in the context of the registration of a European Union trademark that refers to the same type of product for which a system of protection by geographical indication or designation of origin is established.

After brief introductory considerations, there will be approached the definitions given to geographical indications, designations of origin and trademarks in the European Union legislation, highlighting the similarities and differences between them, an approach that the study proposes in order to precisely delimit the boundaries between the three notions.

Being thus clarified these aspects, there will be identified in the European legislation the conflict situations that may arise between the geographical indications and designations of origin on the one hand and the European Union trademark on the other hand, as well as the modalities in which they may coexist, being finally analysed the relevant aspects in this matter in the jurisprudence of the Court of Justice of the European Union.

Keywords: *geographical indication, designation of origin, European Union trademark, generic mentions, use in trade, evocation, imitation, usurpation.*

1. Introduction

In a society where symbols predominate and where the development of trade offers many alternatives on the existing consumer market, there is a tendency for consumers around the world to appreciate products whose origin is determined, due to the fact that they bear an obvious imprint of the area and the conditions from which they come or of their characteristics and qualities.

More and more consumers give more importance to the quality of products they consume than to the quantity, which generates a demand for products whose geographical origin is specified.

However, it is possible that neither the origin nor the basic characteristics of a product are the only elements on which consumers base their decisions but also its authenticity, a context in which it is necessary to properly differentiate the label of the product which benefits from "added value".

If in the past the production and consumption of foodstuffs and not only took place locally, in recent years it has been found that they have exceeded the boundaries of a given territory, so that now the two processes take place in different territories (production in one territory and consumption in one or more territories other than the place of production).

That is why it was necessary to establish a protection system in order to give efficiency to the

connection between the products and the quality given by the reputation of a country, region and territory.

Products identified by a geographical indication or designation of origin are certainly the result of traditional processes and knowledge passed down from generation to generation by a community from a given region.

The issue of protection of designations of origin of foodstuffs arose for the first time when signing the 1958 Lisbon Agreement on the international protection and registration of designations of origin¹, the contracting parties being obliged to protect on their territories the designations of origin of the products of other contracting parties recognized and protected as such in the country of origin and registered with the International Bureau of WIPO, unless they declare within one year from the application for registration that they cannot provide protection.

The Geneva Act of the Lisbon Agreement on designations of origin concluded in 2015 extends the Lisbon system also for the geographical indications (until then it referred only to designations of origin) and makes, in Article 6, the mention that the (Member) States undertake to "*protect the designations of origin and the geographical indications*" in accordance with their own legal system and practice and that "*the contracting parties which do not distinguish, in their national or regional laws, between the designations of origin and the geographical indications are not*

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¹ The Lisbon Agreement (Arrangement) on the protection of designations of origin and their international registration was signed in Lisbon on October 31, 1958; it was revised in Stockholm on June 14, 1967.

required to make such a distinction in their national or regional legislation."

According to the Agreement, the geographical indications are defined as indications that identify a good as originating in the territory of a Member State, or a region or locality in that territory, where a certain quality, reputation or other characteristic of it can be attributed to its geographical origin and provides additional protection of geographical indications for wines and spirits.

Evidence that particular importance has been given to the specification of origin and of commercial origin of products and that the Member States undertake to protect in their territories the designations of origin of products from other countries is represented by the fact that the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) of April 15, 1994², a separate chapter has been allocated to them, and by Article 22 paragraph 1 there was provided a definition of the geographical indication as being any indication identifying a product as originating in the territory of a third Member State, or from a region or locality in that territory, in case a quality, reputation or other characteristic of that product can be attributed, in essence, to that geographical region.

Following the adoption of TRIPS in 1994, the right on geographical indications has been of interest to a large number of political class officials, traders and producers, so it can rightly be said that this Agreement has been the source of the success for the geographical indications in a considerable number of countries.

The protection of the designations of origin and the geographical indications is essentially intended to guarantee to the consumers that the agricultural products bearing a registered geographical indication have certain specific characteristics due to their origin in a given geographical area and therefore offer a quality assurance due to their geographical origin, in order to allow operators who have agreed to make real qualitative efforts to obtain higher revenues in return and to prevent third parties from abusively taking advantage of the reputation arising from the quality of these products.

The trademarks are signs used to distinguish products or services on the market; inform the consumers about the origin of a product or service and allow the association of a product or service with a specific undertaking, due to the precise quality or

reputation provided by the available information of the manufacturer who manufactures or proposes it.

Therefore, the sign symbolizing the geographical origin or commercial origin of the product has a considerable impact on the purchase of that product.

As such, given the diversity of products placed on the market and the abundance of information about them, the consumer must, in order to make a better choice, have clear and concise information on the origin of the product.

In other words, when faced with a variety of foodstuffs, the consumer must know in particular and distinguish the products which have a particular origin or which belong to a particular trader, in order to finally choose the product which possesses certain characteristics and whose place of origin is clearly known to him and to avoid the risk of misleading regarding the characteristics or geographical or commercial origins of the products purchased.

2. Geographical indication, designation of origin and European Union trademark

Without going into detail about the registration procedures, the acquisition of protection and the modalities in which the protection of the rights to these signs is lost, which are not the subject of this study, there will be identified the definitions given to the geographical indications, the designations of origin and the European Union trademark by different normative acts, following to highlight the similarities and differences between them as well as the specific functions of each, in order to more easily understand situations of conflict or coexistence between designations of origin and geographical indications on the one hand and the European Union trademark on the other.

The EU Regulation no. 1151/2012 on systems in the field of quality for agricultural products and foodstuffs³, defines the designation of origin as a designation identifying a product originating in a particular place, region or, in exceptional cases, country whose characteristics are mainly or exclusively due to a certain geographical environment with its own natural and human factors and whose production stages all take place in a delimited geographical area (Article 5 paragraph 1).

The same Regulation defines in Article 5 paragraph 2 the geographical indications as a name that

² The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) of 15 April, 15, 1994 constitutes Annex 1C to the Agreement establishing the World Trade Organization (WTO), signed in Marrakech and approved by the Decision 94/800/ EC of the Council of December 22, 1994 concerning the conclusion, on behalf of the European Community, in the fields of its competence, of the agreements reached during the multilateral trade negotiations in Uruguay Round (1986-1994), published in OJ L 336, p. 1, Special Edition, 11/vol. 10, p. 3.

³ Regulation (EU) No 1151/2012 of the European Parliament and of the Council of November 21, 2012 on quality systems for agricultural products and foodstuffs, published in OJ L 343, 14.12.2012, p.1-23.

identifies a product originating from a certain place, region or country, in which case a certain quality, reputation or other characteristic can be attributed mainly to the geographical origin of the product and when at least one of the production stages takes place in the defined geographical area.

In the wine sector there are relatively similar definitions of the geographical indications and the designations of origin that describe products that must meet the requirements of Article 93 paragraph 1 letters a and b of the EU Regulation No. 1308/2013⁴, namely to hold a quality which is mainly or exclusively due to a certain geographical environment with its own natural and human factors or which can be attributed to a certain geographical area.

In other words, in the case of the designation of origin there must be elements to establish the link between the quality or characteristics of the product and the geographical environment as described in Article 5 paragraph 1, and in the case of the geographical indication elements to establish the link between a certain quality, reputation or other characteristic of the product and the geographical origin mentioned in Article 5 paragraph 2 of the Regulation.

Trademarks of products or services registered under the conditions and according to the norms provided by the EU Regulation no. 2017/1001⁵ are called “European Union trademarks”.

According to Article 4 of the EU Regulation no. 2017/1001 may constitute an EU trademark any sign, especially words, including names of persons, or drawings, letters, numbers, colours, the shape of the product or its packaging or sounds provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings and are represented in the Register of the European Union Trade Marks, in such a way as to enable the competent authorities and the public to determine clearly and precisely the object of the protection conferred to the holder of that trademark.

An EU certification trademark is according to the definition given by the provisions of Article 83 of Regulation 2017/1001, an EU trademark designated as such on the date of submitting the trademark application and which is able to distinguish, on the one hand, the products or services for which the material, the manner of manufacture of the goods or the

provision of services, the quality, accuracy or other characteristics, except geographical origin, are certified by the trademark holder and, on the other hand, the goods and services which do not benefit from a such certification.

In this context, it has been appreciated in the doctrine that only the collective trademark can be geographically descriptive, it can be confused in some cases with the individual trademark that involves a geographical name used in an arbitrary manner⁶.

However, the European legislature has expressly recognized by Directive (EU) 2015/2436⁷ that the Member States may register collective trademarks or descriptive geographical certification trademarks, stipulating that by way of derogation from Article 4 paragraph (1) letter (c), the Member States may provide that signs or indications which may be used to designate, in trade, the geographical origin of products or services may constitute guarantee/certification trademarks (Article 29 paragraph 3 of the Directive) or collective trademarks (Article 30 paragraph 2 of the Directive).

Protected designations of origin and geographical indications may be used by any operator trading a product in accordance with the specifications, and in the case of products originating in the Union and traded under a protected designation of origin or a protected geographical indication, the Union symbols associated with them appear on the labels; representations of the geographical area of origin may also appear on them, as well as representations in the form of text, graphic representations or symbols relating to the Member State and/or region in which the geographical area of origin is located.

In other words, the rights on geographical indications and designations of origin are always collective rights, which are exercised by an association or a group of producers located in a certain area and cannot be transferred to other persons.

Unlike geographical indications and designations of origin, trademarks may pass freely into the patrimony of another manufacturer, and it is not mandatory that for the use the trademark the

⁴ Regulation (EU) No 1308/2013 of the European Parliament and of the Council of December 17, 2013 establishing a common organization of the markets in agricultural products and repealing Regulations (EEC) No 922/72, (EEC) No 234/79, (EC) No. 1037/2001 and (EC) No. 1234/2007 of the Council, published in OJ L 347, 20.12.2013, p. 671-854.

⁵ Regulation (EC) No. 2017/1001 of the European Parliament and of the Council of June 14, 2017 on the European Union trade mark, published in OJ L 154, 16.06.2017, p.1-88, repealed Regulation (EC) No. 207/2009 of the Council of February 26, 2009 on the European Union trade mark.

⁶ Le Goffic, Caroline, La marque de nature collective fait-elle bon ménage avec l'indication géographique? in Th.Georgopoulos, Marques vitivinicoles et appellations d'origine. Conflits, mimétismes et nouveaux paradigmes, Ed. Mare&Martin vol. 6, p.234.

⁷ Directive (EU) 2015/2436 of the European Parliament and of the Council of December 16, 2015 on the approximation of the laws of the Member States relating to trade marks, published in OJ L 336, 23.12.2015, p. 1-26.

manufacturer prove the connection with a particular region and traditional manufacturing methods⁸.

It should be mentioned that since the early 1970s, the Court of Justice of the European Union (CJEU) has specified the function of the protected designation of origin, that of informing and ensuring that the designated product has qualities and characteristics due to its geographical location; the existence of a spatial and qualitative connection was required⁹.

The geographical function has as essential function that of guaranteeing the identification by the public of the geographical origin and/or of certain characteristics specific to the product.

The rights conferred to the holder of a registered trademark are intended to enable it to exercise its essential function of indicating the origin and to play an essential role of the competition system, those rights may be maintained only if the function for which they were assigned is actually exercised on the market¹⁰.

3. Conflict or co-existence between geographical indications, designations of origin and the European Union trademark. Evocation, imitation, usurpation, commercial use

So, we have seen what a geographical indication, a designation of origin as well as a trademark mean and how they are regulated in the European Union legislation, obviously the natural question is whether a product can be covered simultaneously by various legally protected distinctive signs, such as trademark, designation of origin and geographical indication and whether a sign can simultaneously protect several titles such as trademark, designation of origin and geographical indication?

In order to provide an answer to both questions and to determine the conditions under which a product may be covered simultaneously by various legally protected distinctive signs and whether a sign may simultaneously protect several titles as those covered by this title and to determine whether this is appropriate, we consider relevant the provisions of Article 7 paragraph 1 letter j of the EU Regulation no. 2017/1001 which establishes an absolute reason for

refusal to register the trademarks that conflict with trademarks that are excluded from registration under the Union legislation, of national law or of international agreements to which the Union or the Member State concerned is a party, which provide the protection of the designations of origin and of the geographical indications.

These provisions should be linked to the provisions of other regulations applicable to geographical indications and designations of origin in order to establish the manner of interference and possible situations which might arise in case of conflict between the signs which are the subject of this study.

Thus, in the case of a conflict between the geographical indications and the designations of origin on the one hand and trademarks on the other hand, their regime is governed by the provisions of Article 13 paragraph 1 letters a-d of the EU Regulation no. 1151/2012.

Similar regulations can be found in Article 103 paragraph 2 of the EU Regulation no. 1308/2013 regarding wines, Article 20 paragraph 2 of the EU Regulation no. 251/2014¹¹ regarding the aromatized wine products, as well as in Article 16 of the EC Regulation no. 110/2008¹² regarding spirits.

The protection conferred by the stated texts must be interpreted in relation to the objective pursued by the registration of the latter, namely to enable the products to be identified as having their origin in a given territory, where a certain quality, reputation or other characteristic of those products may be essentially attributed to their geographical origin.

The first situation described provides direct or indirect use modalities and the comparable different products in respect of which the protection afforded by the Protected Designation of Origin (PDO) and the Protected Geographical Indication (PGI) must be opposed, while the other situations refer to certain abusive behaviours from which the PDO and PGI holders may defend themselves, in the case of such uses the intention to exploit that reputation shall be presumed.

First, the registered names shall be protected against any direct or indirect commercial use of a registered name for products which are not covered by the registration, if those products are comparable to

⁸ M.Blakeney, Proposal for the International Regulation of Geographical Indications, in *The Journal of World Intellectual Property*, Vol. 4, Issue 5, 2001, p. 632.

⁹ Judgment of 20 February 1975, *Commission v Germany*, C-12/74, EU: C: 1975: 23.

¹⁰ Opinion of Advocate General Giovanni Pitruzzella delivered on 18 September 2019 case C-622/18 AR v. *Cooper International Spirits LLC, St Dalfour SAS, Etablissements Gabriel Boudier SA*, point 71.

¹¹ Regulation (EU) No 251/2014 of the European Parliament and of the Council of 26 February 2014 on the definition, description, presentation, labeling and protection of geographical indications of aromatised wine products and repealing Council Regulation (EEC) No 1601/91, published in OJ L 84, 20.03.2014, p. 14-34.

¹² Regulation (EC) No 110/2008 of the European Parliament and of the Council of 15 January 2008 on the definition, designation, presentation, labeling and protection of geographical indications of spirit products and repealing Council Regulation (EEC) No 1576/89, published OJ L 39, 13.2.2008, p. 16-54.

those registered under that name or if by a such use is exploited the reputation of the protected name, including where those products are used as ingredients.

The direct and indirect use of a designation of origin or of a geographical indication did not pose particular problems. The trademark which is disputed that it flagrantly reproduces a protected name: „Ibiza Flirt”(Spanish protected designation of origin „Ibiza”)¹³, „Tres toros” (Spanish protected designation of origin „Toro”)¹⁴, „Tempos Vega Sicilia”(Italian protected designation of origin „Sicilia”)¹⁵, „Domaine de l’île Margaux” (French protected designation of origin „Margaux”)¹⁶, „Carlos Serres” (Greek protected designation of origin „Serres”)¹⁷, „Manzanilla Gonzales Pallacios” (Spanish protected designation of origin „Manzanilla”)¹⁸, „Duque de Villena”(Spanish protected designation of origin „Villena”)¹⁹ were all censored without much difficulty in the European jurisprudence.

In case of comparable products, PDOs and PGIs must be opposed when they do not comply with the specifications, while in the case of non-comparable products it must be proved that they exploit the reputation of the PDO or PGI²⁰.

The use of the expression "direct or indirect commercial use of a registered geographical indication" implies the use of the indication in question in the form in which it was registered or, at least, in a form which has such close links with it, that the term „use” requires, by definition, the very use of the protected geographical indication, which must be present identically or at least similarly, phonetically and/or visually, in the sign in dispute²¹.

Unlike "direct" use, which requires that the protected geographical indication be applied directly to the product concerned or its packaging, an "indirect" use means that this indication is included in the additional vectors of marketing or of information, such as an advertising for the product concerned or documents relating to it²².

The Court has already established defining elements regarding the notion of "direct" use, acknowledging that it may be the use of a mark containing a geographical indication or a term corresponding to that indication and its translation for products which do not meet the appropriate specifications, as it was the case of figurative marks which were the subject of the main proceedings.

Thus, the situation referred to in letter a expressly prohibits other operators from using for commercial purposes a registered geographical indication for products which do not meet all the required specifications, in particular in order to take undue advantage of the reputation of that geographical indication.

Second, the registered names are protected against any misuse, imitation or evocation, even if the true origin of the products or services is indicated or if the protected name is translated or accompanied by words such as "gender", "type", "method", "as prepared in", "imitation" or other similar words, including when those products are used as ingredients.

It is noted that three distinct notions are used, namely: evocation, imitation and usurpation which are not defined by any of the Regulations relating to geographical indications and designations of origin²³.

As such, the doctrine has suggested that the three notions should be distinguished according to the intentional element of reproduction; evocation refers to a simple connection of image or perception in the mind of the consumer that is really much less powerful than the usurpation or imitation²⁴.

The wording of the letter b in question does not contain any element which would enable the precise definition of the meaning of the concept of evoking a protected geographical indication. At most, an analysis in the context in comparison with the other two hypotheses mentioned earlier in that provision, namely "usurpation" and "imitation", allows to consider that the concept of "evocation" is somewhat similar to the geographical indication in question, even if it seems to

¹³ EUIPO, R 2531/2015-2, Ibiza Flirt.

¹⁴ TUE, 28 September 2017, T-206/16, Tres Toros 3, EU:T:2017:673.

¹⁵ TUE, 9 February 2017, T 695/15, Tempos Vega Sicilia, EU:T:2017:69.

¹⁶ OHMI, 21 January 2015, R 248/2014-4, Domaine de l’Île Margaux.

¹⁷ OHMI, 14 March 2008, R 984/2007-1, Carlos Serres.

¹⁸ OHMI, 11 June 2004, R 946/2002-1, Manzanilla Gonzalez Palacios.

¹⁹ OHMI, 11 December 2002, R 1220/2000-2, Duque de Villena.

²⁰ Le Goffic, Caroline, La protection des indications géographiques, Editura Litec, Paris, 2010, p.137.

²¹ Opinion of the Advocate General Henrik Saugmandsgaard ØE delivered on 22 February 2018 in Case C - 44/17 The Scotch Whiskey Association, The Registered Office v. Michael Klotz, point 28.

²² Judgement Scotch Whisky Association v. Michael Klotz, C-44/17, EU:C:2018/415, point 32.

²³ Leonie Bourdeau, Stefan Martin, *Le conflit entre marques et indications géographiques: la notion d’évocation et sa mise en oeuvre par les instances européennes*, in Th.Georgopoulos, Marques vitivinicoles et appellations d’origine. Conflits, mimétismes et nouveaux paradigmes, Ed. Mare&Martin vol. 6, p. 120.

²⁴ Theodore Georgopoulos, Les marques commerciales nationales a l’épreuve des indications géographiques européennes-A propos de l’affaire Cognac, RD.Rur., no.401, mars 2012.

assume the lowest degree of similarity of the three notions²⁵.

The notion of "evocation" is an objective notion which does not require the proof of the intention of the trademark holder to evoke a PDO or PGI²⁶.

The cases of evoking a protected name are complex, its disguise being very subtly made, aspects that are to be highlighted in the light of the jurisprudence of the Court of Justice of the European Union (CJEU).

The concept of "evocation" covers the case where the term used to designate a product incorporates part of a protected name, so that the consumer, in the presence of the product name, is induced, as a reference image, the goods benefiting from that name²⁷.

By the decision pronounced in Case C-614/17²⁸, the Court of Justice of the European Union examined the protection of designations of origin in relation to the graphic representations which might suggest a link between a product and the protected geographical origin by a designation of origin and established that the use of figurative signs evoking the geographical area with which a designation of origin is associated may constitute an evocation of the latter and may therefore be prohibited even if those figurative signs are used by a manufacturer established in that region, but whose products, similar or comparable to those protected by that designation of origin, are not covered by it.

The Court also ruled that in order to determine the existence of an "evocation", the national court must take into account the presumed expectation of an average consumer, normally informed, sufficiently attentive and informed, including the consumer in the Member State where the product is manufactured, which gives rise to the evocation of the protected name and in which it is consumed mainly in order to determine whether the figurative signs are capable of inducing them directly, as a reference image, the authenticity of the products benefiting from that name²⁹.

In the context in which, according to the relevant regulations, a protected designation of origin can only be represented by words and not by images, what brings new in the jurisprudence of the Court the Queso Manchego decision is the fact that the legal protection of the designation of origin involves the prohibition of some graphical representations that could suggest to the consumer a link between the product and the protected designation of origin.

In its jurisprudence, the Court has also examined the situation of phonetic or visually similar product names with a PDO or PGI for similar products, ruling that in order to assess whether this constitutes an "evocation", the referring court must take into account the phonetic and a visual similarity of these names, as well as any elements which may indicate that such a resemblance is not accidental, so as to verify whether, in the presence of a product name, the average European consumer, normally informed and sufficiently attentive and knowledgeable, is induced, as a reference image, the product benefiting from the protected geographical indication³⁰.

There is also an "evocation" of a protected designation of origin when, in the case of products with visual analogies, the sales names bear a phonetic and visual³¹ similarity, such a resemblance is obvious if the term used to designate the product in that case it ends in the same two syllables as the protected name and comprises the same number of syllables as it; in the analysis of the existence of an evocation, account must be taken of any elements which may indicate that the phonetic and visual similarity between the two names is not accidental.

There may also be an "evocation" even in the absence of any risk of confusion between the products in question³², being especially important not to create in the public perception an association of ideas about the origin of the product, nor to allow an operator to obtain undue benefits from the reputation of a protected geographical indication.

In the consumer's perception, the link between the manufacturer's reputation and the quality of the

²⁵ Opinion of Advocate General Henrik Saugmandsgaard ØE delivered on 22 February 2018 in Case C - 44/17 The Scotch Whiskey Association, The Registered Office v Michael Klotz, point 53.

²⁶ Opinion of Advocate General Jacobs delivered on 17 December 1998 in Case C-87/97, point 33.

²⁷ Judgement of Bureau national interprofessionnel du Cognac, C-4/10 and C 27-10, EU:C:2011:484, pct.56, Judgement Consorzio per la tutela del formaggio Gorgonzola, C87/97, EU:C:1999:115, pct.25 and Judgement Commission/Germany, C-132/05, EU:C:2008:117, pct.44.

²⁸ CJUE, 2 May 2019, Fundación Consejo Regulador de la Denominación de Origen Protegida Queso Manchego Ímpotriva Industrial Quesera Cuquerella SL, Juan Ramón Cuquerella Montagud, C-614/17, ECLI:EU:C:2019:344.

²⁹ Judgement Mars, C-470/93, EU:C:1995:224, point 24, Judgement Gut Springenheide and Tusky, C-210/96, EU:C:1998:369, punctul 31, Judgement Estée Lauder, C-220/98, EU:C:2000:8, point 30, Judgement Lidl Belgium, C-356/04, EU:C:2006:585, point 78, Judgement Severi, C-446/07, EU:C:2009:530, point 61, Judgement Lidl, C-159/09, EU:C:2010:696, point 47, as well as Judgement Teekanne, C-195/14, EU:C:2015:361, point 36).

³⁰ Judgement Viiniverla Oy, C-75/15, EU:C:2016:35, point 48.

³¹ Judgement Bureau national interprofessionnel du Cognac, C-4/10 and C 27-10, point 57, Judgement Consorzio per la tutela del formaggio Gorgonzola, C-87/97, point 27 and Judgement Commission/Germany, C-132/05, point 46.

³² Judgement Consorzio per la tutela del formaggio Gorgonzola, C-87/97, point 26 and Judgement Commission/Germany, C-132/05, point 45.

products depends on the belief that the products sold under the designation of origin are authentic³³.

The jurisprudence of the Court has also ruled that the notion of "evocation" covers the case where the term used to designate a product incorporates part of a protected name, so that the consumer, in the presence of the product name, is induced as a reference image the product benefiting from that name³⁴.

It should be noted that the ban on evocation is not necessarily linked to the existence of real public confusion; it is not necessary for a consumer to consider that the evocative mark covers what the PDO protects.

Thirdly, the registered names are protected against any false or misleading indication as to the provenience, origin, nature or essential qualities of the product, which appears on the inside or outside of the packaging, in the advertising material or documents relating to the product concerned, and against packaging the product in a packaging likely to create an erroneous impression as to its origin.

Thus, in order to establish the existence of a "false or misleading indication" prohibited by that provision, no additional information must be taken into account with the sign in question in the designation, presentation or labelling of the product concerned, in particular as regards the real origin of the latter.

It is sufficient for a false or misleading indication to be present on one of the three supports referred to in that provision, namely "in the designation, presentation or labelling" of the product in question, to be considered "likely to give a false impression regarding its origin", within the meaning of that provision³⁵.

Finally, the registered names are protected against any other practice which could mislead the consumer as to the true origin of the product.

In addition to the three cases presented above, the fourth situation evokes other practices which are not considered by the three and which could mislead the consumer as to the true origin of the product.

In the context of the interference of a trademark containing geographical connotations and indications that take into account the same region, country, place, the situation that may arise is governed by the provisions of Article 14 of EU Regulation No. 1151/2012, according to which, if a designation of origin or geographical indication is registered under the Regulation, the registration of a trademark the use of which would be contrary to Article 13 paragraph 1 and relating to the same type of product must be refused if the trademark application is submitted after the date of submission with the Commission of the application for

registration in respect of the designation of origin or the geographical indication.

According to Article 6 paragraph 4 of the Regulation, a name proposed for registration as a designation of origin or geographical indication is not registered if, given the reputation and name of a trademark, as well as its duration, the registration of the proposed name as a designation of origin or geographical indication is likely to mislead the consumer as to the true identity of the product.

Also relevant are the provisions of Article 7 paragraph 1 letter g of Regulation no. 2017 / 1001, according to which the registration of trademarks that are likely to deceive the consumer public is rejected, for example on the nature, quality or geographical origin of the product or service.

A trademark may be registered only if it is established that, by its use, it acquired a distinctive character in that part of the Community in which it had a distinctive character *ab initio*.

As such, it is sufficient for a trademark to be devoid of any distinctive character in a single Member State in order to block registration at Community level; on the contrary, once the trademark whose Community registration is sought acquires that distinctive character in the territory in which it was devoid of any distinctive character, the ground for refusal is no longer applicable.

The use of a trademark must take place exclusively in the context of a commercial activity aimed at an economic advantage and not in the private sector.

In order to establish the existence of a commercial use, the territory in which the protection of the sign is invoked must be taken into account; aspect that derives especially from the principle of territoriality.

An application of registration for a Community trademark may be refused only if it is put to serious use in the territory of the Member State in which it is protected.

The relevant territory for examining the scope of these exclusive rights is the one on which is applicable each of these legal rules in which those rights originate³⁶.

The trademark must be used as a distinctive element in the sense that it must enable the identification of an economic activity carried on by its holder.

A distinction must be made between the scope of the sign and the extent of its use; a sign whose geographical extent of protection is only local has a local scope only.

³³ Judgement Budejovicky Budvar, C-478/07, EU:C:2009:521, point 110.

³⁴ Judgement Bureau national interprofessionnel du Cognac, C-4/10 and C 27-10, point 56, Judgement Consorzio per la tutela del formaggio Gorgonzola, C-87/97, point 25 and Judgement Commission/Germany, C-132/05, point 44, Judgement Viiniverla Oy, C-75/15, point 21.

³⁵ Judgement Scotch Whisky Association v. Michael Klotz, C-44/17, EU:C:2018/415, point 67.

³⁶ Judgement TUE 24.03.2009 Moreira da Fonseca General Optica T-318/06, T-321/06, Rep. P.II-649, point 40.

The scope of a sign cannot depend solely on the geographical extent of its protection.

In order to be able to prevent the registration of a sign, the one invoked in support of the opposition must be effectively used in a sufficiently significant way in trade and have a geographical extent that goes beyond the local domain; in other words, the use should take place on an important part of the respective territory.

In order to establish this aspect, account must be taken of the duration and intensity of the use of that sign as a distinctive element for its recipients, who are buyers and consumers, as well as suppliers and traders.

The use of the sign made exclusively or for the most part between the date of submitting the Community trademark application and the publication of this application will not be sufficient to establish that this sign has been used commercially in order to demonstrate that it has not a sufficient scope (see the device Judgement CJUE 29.03.2011, C-96/09-Budvar).

There is the possibility of invocation within an opposition to the registration of a Community trademark of other signs which are not registered trademarks or well-known trademarks and which have been the subject of prior registration, such as geographical indications, but there have to be excluded the geographical indications which have been registered at community level; only those that benefit from protection at national level are targeted.

Finally, it should be mentioned that the geographical indications may coexist with the trademarks, Article 13 of the Geneva Act of the Lisbon Agreement explicitly recognizing the coexistence of the designations of origin or the geographical indications with earlier rights conferred by the trademark. Thus, the text allows the contracting parties to grant limited exceptions to the rights conferred by a trademark in the sense that such an earlier trademark may not, in certain circumstances, entitle its holder to prevent the granting of protection or the use in the contracting party of a designation of origin or registered geographical indications.

Moreover, the provisions of Article 14 paragraph 2 of EU Regulation no. 1151/2012 stipulate that a trademark whose use is contrary to Article 13 paragraph 1 of the Regulation and which has been requested, registered or established by its use in good faith in the territory of the Union, if this possibility is provided for by the legislation in question, before the date on which the application for protection of the designation of origin or geographical indication is sent to the Commission, may continue to be used or renewed for that product, despite the registration of a designation of origin or geographical indication, if the trademark does not fall within the grounds for cancellation or

revocation provided for in the Community Trademark Regulation; in such cases, the use of the protected designation of origin, the protected geographical indication and the relevant marks is permitted.

These issues were also noted by the CJEU in *Bavaria I*³⁷, namely that the acquisition of the status of protected geographical indication does not have the effect of restricting the rights to similar trademarks, previously registered in good faith, unless there are good grounds for cancellation or revocation of the trademark, in the present case not being identified an impediment to the coexistence of the trademark with the protected name, the trademark "Bavaria" being prior to the protected name, the Court establishing that the relative presumption of good faith has not been overturned.

This decision is relevant in the light of the analysis of the coexistence of geographical names and similar trademarks, which appear on the same market and in respect of the product from the same range.

Thus, the continued use of a trademark in conflict with a PGI or a PDO is possible only if, in the first place, the trademark was registered in good faith before the date of submitting the application for registration of the designation of origin or geographical indication and, secondly, that the mark is not affected by the grounds for invalidity or forfeiture provided for.

If the earlier trademark was not registered in good faith or, even if it was registered in good faith, even if that mark may be affected by grounds for invalidity or revocation, protection of the registered designation of origin or geographical indication shall prevail on the earlier mark.

In the context of the above regarding the conflict between trademarks, the question arises as to the legal regime of generic names, in this sense taking into account the provisions of Articles 6 and 7 of paragraph 1 of the Lisbon Agreement on the protection and designation of their origin and international registration provide that the designation of origin registered under the Arrangement cannot be considered generic as long as it is protected as a designation of origin in the country of origin.

It is considered that the generic names cannot be registered, just as the protected names cannot become generic, and the generic elements of a registered name cannot be protected.

It is common ground that a geographical name could, in so far as it is used, become a generic name, in the sense that it could be regarded by the consumers as an indication of a particular type of product rather than as an indication of the geographical origin of the product, an example in this sense being the names "Camembert" and "Brie".

³⁷ Judgement *Bavaria NV, Bavaria Italia Srl v. Bayerischer Brauerbund eV*, C-343/07, ECLI:EU:C:2009:415, point 119.

Thus, in assessing the generic nature of a name, account must be taken of the places where that product was produced both inside and outside the Member State which obtained the registration of that name, the consumption of that product and how this name is perceived by consumers inside and outside the Member State concerned, the existence of special national legislation on the product in question and how that name has been used in accordance with Community law³⁸.

The Court was called upon to rule on this issue in *Bavaria I*³⁹, ruling that a name becomes generic only if it disappears the direct link between, on the one hand, the geographical area of the product and, on the other hand, a specific quality of this product, its notoriety or any other characteristic of it which may be attributed to that origin, and the name merely describes a genus or a type of products.

4. Conclusions

It is common ground that the association of a trademark with a geographical indication or designation of origin confers economic advantages to its holder and offers a high degree of legal protection.

Trademark recognition is an essential element of trade and the geographical indications and designations of origin play a key role in highlighting brands for products whose quality is given by the place of origin, in other words, the geographical indications can add value to a region, they can help to create a "regional brand".

I have seen that the protection afforded by the Union regulations does not apply to all designations of origin or geographical indications, but only to those defined in those regulations.

The system of protection of registered names in the European Union is based on the principle that the registration of a name containing more than one term confers protection on both the constituent elements of

the compound name and its composition as a whole, unless that element is the name of an agricultural product or foodstuff considered a generic name.

It is necessary to differentiate between value-added products due to the characteristics of the product related to its geographical origin and products bearing the mark of a particular producer, in order to prevent malicious practices, to achieve market transparency and fair competition, all with the common denominator of consumer protection against misleading practices.

The provisions governing situations of conflict between trademarks and registered names, as analysed in the light of the jurisprudence of the CJEU, indicate that the first situation is limited to acts of use of a protected geographical indication / designations of origin, the second situation is limited to acts of usurpation, imitation or evocation, so that the third situation extends the scope by including the "indications" (for instance information provided to consumers) that appear in the designation, presentation or labelling of the product in which, although they do not really evoke the protected geographical indication, are classified as 'false or misleading' as to the links which the product has with the latter, the latter referring to any other practice which might mislead the consumer regarding the true origin of the product.

The purpose of these regulations is to protect the geographical indications and designations of origin, both in the interests of the consumers, who must not be misled by misleading indications, and in the interests of the economic operators who incur higher costs to guarantee the quality of products and who must protect against acts of unfair competition.

Although more difficult to accept, I have noticed that protected names may coexist with trademarks, the provisions of Article 13 of the Geneva Act of the Lisbon Agreement and Article 14 paragraph 2 of EU Regulation no. 1151/2012 recognizing explicitly the coexistence of designations of origin or geographical indications with the earlier rights conferred by trademarks.

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³⁸ Judgement din 25 octombrie 2005, Germany, Denmark/Commission, C-465/02 și C-466/02, ECLI:EU:C:2005:636, points 76-99, Judgement din 26 februarie 2008, Commission/Germania, C-132/05, ECLI:EU:C:2008:117, point 53.

³⁹ Judgement *Bavaria NV, Bavaria Italia Srl / Bayerischer Brauerbund eV*, C-343/07, point 107.

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