

oriGIn paper on the protection of PDO, PGI and GIs against “evocation”

Introduction

The protection against products’ labelling that may constitute an “evocation” of a PDO, PGI and GIs, as provided in Article 13(1)(b) of Regulation (EU) No 1151/2012, Article 103(2)(b) of Regulation (EU) No 1308/2013 and Article 21(2)(b) of Regulation (EU) No 2019/787, is a powerful tool for their meaningful protection in the EU, especially against “subtle” attempts to mislead consumers.

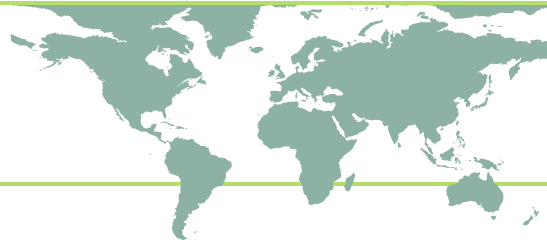
Following the Court of Justice of the European Union (CJEU) rulings (then reflected in the judgments of the national courts’ that had referred the cases at issue to the Court), the depth/meaning/notion/concept of “evocation” has been clarified over the years.

oriGIn EU and its members believe there is a need to promote a wider knowledge of evocation (and its depth) across the EU, including among IP/trademark offices, to ensure a uniform implementation of the relevant EU rules.

Crucial elements of evocation according to the EU Regulations and case-law

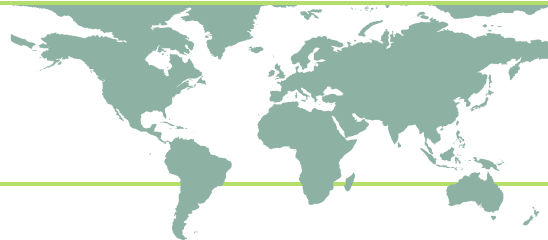
The relevant EU Regulations and case law clarify the following issues concerning the evocation of protected names:

- a. Evocation is not restricted to the use of word signs;
 - b. Evocation might be established even where there is no likelihood of confusion from consumers;
 - c. Evocation might be produced by the use of graphical elements;
 - d. Evocation might be established through explicit or implicit references;
 - e. Not only consumers in the Member State in which the product at issue is manufactured are relevant when ruling on evocation;
 - f. Evocation might be established through “conceptual” proximity;
 - g. Evocation might be established through the use of figurative elements;
 - h. The reproduction of the external appearance of products which names are protected can result in an evocation.
- a. Regulation 1151/2012 does not restrict the concept of evocation to the use of word signs. Article 13(1)(b) refers to “...any evocation...” (the same formulation is found in Article 103(2)(b) of Regulation 1308/2013 and in Article 16(b) of Regulation 110/2008).
 - b. The CJEU has expressed itself on “evocation” in several instances, including the cases “Cambozola”, “Parmesan”, “Cognac”, “Verlados”, “Glen Buchenbach” and “Manchego/Don Quixote de La Mancha”). The case law has clarified that “(...) there may be an evocation of a protected name even where there is no likelihood of confusion between the products



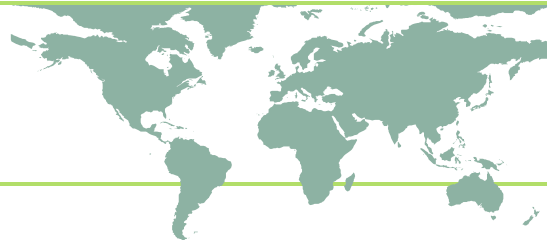
concerned and even where no Community protection extends to the parts of that designation which are echoed in the term or terms at issue”.

- c. Paragraph 55 of the “Parmesan case” (C-132/05) ruling concerns the use of graphical elements: “According to the documents in the case, in Germany, certain producers of cheese called ‘Parmesan’ market that product with labels referring to Italian cultural traditions and landscapes. It is legitimate to infer from this that consumers in that Member State perceive ‘Parmesan’ cheese as a cheese associated with Italy, even if in reality it was produced in another Member State” (see *Germany and Denmark v Commission*, paragraph 87).
- d. In the “Cognac” case (judgment of 14/07/2011, in joined cases C-4/10 and C-27/10, paragraph 46), the Court states: “Points (a) to (d) of Article 16 of Regulation No 110/2008 refer to various situations in which the marketing of a product is accompanied by an explicit or implicit reference to a geographic indication in circumstances liable to mislead the public as to the origin of the product or, at the very least, to set in train in the mind of the public an association of ideas regarding that origin, or to enable the trader to take unfair advantage of the reputation of the geographical indication concerned”. As a result, there can be an evocation of PDO, PGI and GI if explicit or implicit references are used in the labelling of the products at issue.
- e. With specific reference to consumers, the ruling of January 21, 2016 (case C-75/15, “Verlados” case), establishes that: “Article 16(b) of Regulation (EC) No 110/2008 of the European Parliament and of the Council of 15 January 2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks and repealing Council Regulation (EEC) No 1576/89 must be interpreted as meaning that, in order to assess whether there is an ‘evocation’ within the meaning of that provision, the national court is required to refer to the perception of the average consumer who is reasonably well informed and reasonably observant and circumspect, that concept being understood as covering European consumers and not only consumers of the Member State in which the product giving rise to the evocation of the protected geographical indication is manufactured”.
- f. In case C-44/17 (“Glen Buchenbach”), the Court clarifies that he “conceptual” proximity between a GI and the contested name can result in an evocation. This has to be evaluated by national courts, taking into account the fact that an average European consumer, who is reasonably well informed and observant and circumspect, when confronted with the name at issue, the image triggered in his mind is that of the product whose indication is protected. This is the first case which puts it beyond doubt that evocation can exist even where the name at issue is not similar phonetically or visually to the GIs (the contested name was “Glen Buchenbach” with respect to the GI “Scotch Whisky” – “Glen” in fact is widely used in Scotland to refer to “valley” and is an element of the trade mark of Scotch Whisky producers). Moreover, according to the Court, the indication of the true origin of the good at issue does not exclude automatically the evocation of a GI. Following the CJEU Judgment, in February 2019, the German court which had referred the case to the CJEU found that “Glen” is strongly associated with Scotland and Scotch Whisky, and the only reason to use “Glen” for a German whisky is because of its undoubted association with Scotch Whisky. As



a result, the court's decision confirmed that the use of “Glen” on a German whisky is misleading.

- g. In Case C-614/17 (“Fundación Consejo Regulador de la Denominación de Origen Protegida Queso Manchego” v. “Industrial Quesera Cuquerella SL and Juan Ramón Cuquerella Montagud”, a company which commercializes some of its cheese products, through labels with figurative elements - a knight similar to the usual depictions of “Don Quixote de La Mancha” and a bony horse and landscapes with windmills and sheep - as well as the words “Quesos Rocinante”), the CJEU confirms that an evocation of a PDO (or PGI and GI) can be produced even by the use of figurative elements. This also in the absence of visual, phonetical and conceptual similarities between the protected name and the product’s labelling. Moreover, the Court found that the use of figurative signs evoking the geographical area with which a designation of origin is associated may constitute evocation of that designation, 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 the PDO; and that an average consumer can be understood as including consumers of the Member State where the product is produced and mainly consumed. Following the CJEU Judgment, in July 2019 the Supreme Court of Spain ruled that figurative elements (“Don Quixote de La Mancha” as well as a bony horse and landscapes with windmills and sheep) have sufficient conceptual proximity to “La Mancha” region to lead consumers to associate them with the PDO “Queso Manchego”. As a result, the use of the above-mentioned figurative elements on cheese products made in “La Mancha” – without following the “Queso Manchego” product’s specification though - were considered a violation of the relevant EU law (an evocation of the PDO, according to art. 13.1.b of Regulation (EU) No 1151/2012). Likewise, the Supreme Court invalidated the registered trademark “Rocinante” (art. 14.1 of the same Regulation).
- h. Even if it did not reach the CJEU, another interesting ruling concerning evocation (in particular the reproduction of the external appearance of PDO/PGI products) was held by the Commercial Court of appeal of Alicante in October 2013, following an action brought by the Consejo Regulador of the PDO “Queso Tetilla”. “Queso Tetilla” is a Spanish PDO identifying a cheese produced in the region of Galicia, whose most recognizable feature is its singular conical shape which resembles a female breast, from which the expression “Tetilla” originates. In its Judgement n° 419/13, the Spanish Court held that “the PDO Queso Tetilla protects a traditional name which the consumers inexorably associate with a conical shape, given that the name of the PDO does not correspond with a region or a specific place, but with a cheese having a special and well-known format”. Consequently, the unauthorized commercialization of cheese with an identical shape (the package of the product at issued reproduced the typical “Tetilla” shape and was commercialized under the trademark “Mamiella Tres Oscos”) is deemed to be an infringement of this PDO according to article 13(1)(b) of Regulation (EU) n° 1151/2012 on quality schemes for agricultural products and foodstuffs, which protects PDO and PGI, among others, against evocation. The Court concludes that the “evocation may not only arise from the use of a word, but also from other practices so that when the consumer is confronted with the shape of the product the image triggered in his mind is that of the product whose designation is protected”. Previously, the Commercial Court of first instance, in its Judgement n° 58/13 of 20 March 2013, had already found that the use of the term “Mamiella” with regard to cheese constitutes an



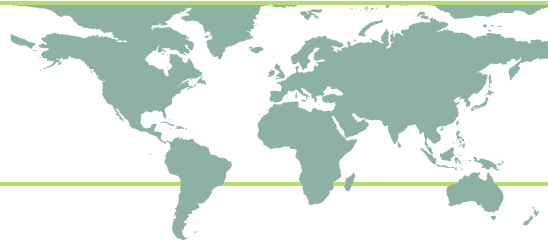
infringement of the PDO “Queso Tetilla”. Although not being similar to each other, the Court of first instance concluded that the term “Mamiella”, which comes from the Latin word “mama” (breast), evokes the PDO “Queso Tetilla”. In this regard, the Court furthermore invalidated the registration of the trademark “Mamiella Tres Oscos”. This case is relevant with respect to ruling 17 - 25822 (17 June 2019), by which the French “Cour de cassation” referred another case to the CJEU. It concerns the interpretation of article 13.1 of Regulation 1151/2012 and its depth with respect to the reproduction by third parties of shapes and physical appearances of products bearing protected names. The “Syndicat interprofessionnel de défense du fromage Morbier” had seized the “Cour de cassation” contesting the use and commercialization by the French company “Fromagère du Livradois” of a cheese product reproducing the visual appearance of the PDO “Morbier”.

- i. Since 2014, the European Union Intellectual Property Office (EUIPO), in its “Guidelines for examining European Union trade marks (<https://euipo01app.sdlproducts.com/1004922/903850/trade-mark-guidelines/introduction>), established clear principles to evaluate whether a trademark application represents an evocation of a PDO/PGI/GI. On this, see Section 4, Absolute grounds for refusal, Chapter 10, Geographical Indications, 4.3.1 Evocation/imitation, of the guidelines, available at <https://euipo01app.sdlproducts.com/1004922/906757/trade-mark-guidelines/4-3-1-evocation-imitation>:

Importantly, evocation is **not assessed in the same way as likelihood of confusion**. Therefore, it is irrelevant whether a likelihood of confusion can be established or not in order to find that there is evocation of the PDO/PGI. As the Court has held, there can be ‘evocation’ even in the absence of any likelihood of confusion. What matters is, in particular, that an association of ideas regarding the origin of the products is not created in the mind of the public, and that a trader does not take undue advantage of the reputation of the protected geographical indication (21/01/2016, C-75/15, Viiniverla, EU:C:2016:35, § 45). For evocation, **a link must be made with the product whose designation is protected**. Therefore, whether or not there is evocation will not be analysed according to the principles laid down by the Court in its judgment of 11/11/1997, C-251/95, Sabèl, EU:C:1997:528.

In assessing whether such a link is established, the Court has considered:

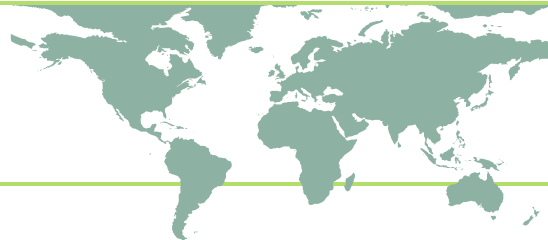
- whether there is a visual, phonetic or conceptual relationship between the terms:
 - e.g. if the terms share a characteristic beginning, such as Parmesan/Parmigiano Reggiano (26/02/2008, C-132/05, Commission v Germany, EU:C:2008:117);
 - e.g. if the terms share characteristic roots or endings that have no particular meaning, such as in Gorgonzola/Cambozola (04/03/1999, C-87/97, Cambozola, EU:C:1999:115) and Verlados/Calvados (21/01/2016, C-75/15, Viiniverla, EU:C:2016:35);
 - e.g. if the terms share the same number of letters or syllables, such as Gorgonzola/Cambozola (04/03/1999, C-87/97, Cambozola, EU:C:1999:115);





- e.g. where there is conceptual proximity, such as between Parmesan and Parmigiano Reggiano (26/02/2008, C-132/05, Commission v Germany, EU:C:2008:117, § 47).
- the degree of proximity of the goods concerned, including the actual physical appearance or the ingredients and taste of the products covered by the EUTM and the PDO/PGI (04/03/1999, C-87/97, Cambozola, EU:C:1999:115, § 27). The fact that the goods are comparable does not, as such, lead automatically to the evocation of the PDO/PGI. However, if the goods concerned are identical, this is an element in support of evocation (see paragraph 4.2 below).
- whether the part of the PDO/PGI that is included in the trade mark forms a logical and conceptual unit within the mark or not. If so, evocation is dismissed (e.g. IMPORT is not an evocation of the PDO 'Port', EXCAVADORA is not an evocation of the PDO 'Cava' and TORONTO is not an evocation of the PDO 'Toro').

Examples of where evocation was found

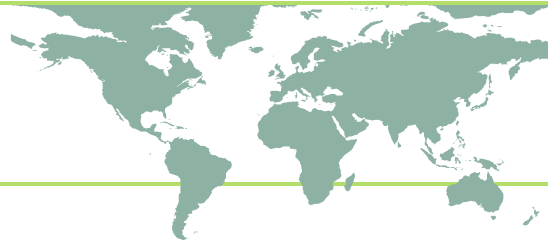
PDO/PGI	Trade Mark	Explanation
<p style="text-align: center;">CHIANTI CLASSICO</p> <p style="text-align: center;">(IT/PDO/0005/0108)</p>	 <p style="text-align: center;">(EUTM No 9 567 851)</p>	<p>The term 'chianti' evokes the PDO 'Chianti Classico' protected for oils and fats.</p> <p>(16/01/2012, R 1474/2011-2, AZIENDA OLEARIA CHIANTI, paras 14-15)</p>
<p style="text-align: center;">NÜRNBERGER BRATWÜRSTE/NÜRNBERGER ROSTBRATWÜRSTE</p> <p style="text-align: center;">(DE/PGI/0005/0184)</p>	<p style="text-align: center;">NUERNBERGA</p> <p style="text-align: center;">(EUTM No 9 691 577)</p>	<p>'because of its aural equivalence, NUERNBERGA will be understood in the sense of the geographical indication "Nürnberg".'</p> <p>(01/02/2012, R 1331/2011-4, NUERNBERGA, para. 12)</p>




<p>SCOTCH WHISKY</p>	 <p>(EUTM No 15 420 607)</p>	<p>The country name Scotland is a noun that evokes the adjective 'Scotch', which forms part of the PGI 'Scotch Whisky'.</p>
<p>LYGOURIO ASKLIPIOU (EL/PDO/0017/0050)</p>	 <p>ASKLEPIOS (EUTM No 15 510 721)</p>	<p>The term 'ASKLIPIOU', which forms part of the PDO 'Lygourgio Asklipiou', is the genitive case of the noun 'ASKLEPIOS' (or 'ASKLIPIOS'), which appears in the nominative case in the contested EUTM. The genitive case denotes, inter alia, origin and possession and in this case evokes the PDO. The figurative element is a visual repetition of the term as it consists of a typical representation of the ancient Greek god Asclepios.</p>

Examples of where evocation was not found

PDO/PGI	Trade Mark	Explanation
<p>VINHO VERDE (PDO PDO-PT-A1545)</p>	<p><u>VERDI</u> EUTM No 15 080 278</p>	<p>Due to the clear conceptual meaning of the designation 'VERDI', the relevant public will not be led to believe that the aforementioned designation depicts the PDO in question.</p> <p>The presence of a partial correlation in the present case between the terms 'VERDI' on the one hand, and 'VERDE' on the other, is not sufficient to offset the fact that the consumer of the goods in question will perceive the sign 'VERDI' as a clear reference to the Italian opera composer.</p> <p>(06/04/2017, R 1972/2016-5, VERDI, paras 12 and 14)</p>

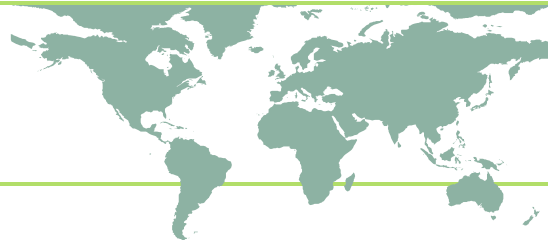


<p>Cape Girardeau County</p> <p>(Non-EU-country PGI (United States of America))</p>	 <p>EUTM No 16 081 614</p>	<p>The mark contains the term ‘craft beer’. Therefore, it is unlikely that it will be perceived as evoking a PGI relating to wine.</p> <p>Moreover, ‘Cape’ by itself is not, on its own, the significant part of the PGI. Therefore, in order to evoke the PGI, reference to the other geographically significant part of the PGI (e.g. ‘Girardeau’) is necessary.</p>
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Equivalent adjectives/nouns

The use of an equivalent adjective/noun to indicate the same origin constitutes an evocation of a PDO/PGI.

PDO/PGI	European Union trade mark (invented examples)	Explanation
<p>IBIZA (PGI-ES-A0110)</p>	<p>IBICENCO</p>	<p>Noun in the PGI → Adjective in the EUTM</p>
<p>AÇORES (PGI-PT-A1447)</p>	<p>AÇORIANO</p>	<p>Noun in the PGI → Adjective in the EUTM</p>
<p>BORDEAUX (PDO-FR-A0821)</p>	<p>BORDELAIS</p>	<p>Noun in the PDO → Adjective in the EUTM</p>
<p>JAGNIĘCINA PODHALAŃSKA (PL/PGI/0005/00837)</p>	<p>JAGNIĘCINA Z PODHALA</p>	<p>Adjective in the PGI → Noun in the EUTM</p>

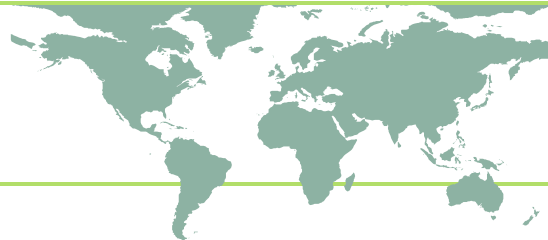



<p>MEL DO ALENTEJO (PT/PDO/0017/0252)</p>	<p>MEL ALENTEJANA</p>	<p>Noun in the PDO → Adjective in the EUTM</p>
<p>SCOTTISH WILD SALMON (GB/PGI/0005/00863)</p>	<p>WILD SALMON FROM SCOTLAND</p>	<p>Adjective in the PGI → Noun in the EUTM</p>
<p>EMILIA (PGI-IT-A0509)</p>	<p>NATURA EMILIANA EUTM No 13 018 619</p>	<p>When the public sees that a trade mark contains nouns or their corresponding adjectives relating to a given territory, it will believe that these are providing information on the geographical location where the goods are produced or processed.</p> <p>The inclusion of the term ‘NATURA’ in the sign applied for does not prevent the existence of an ‘inclusion’ and ‘evocation’ of the geographical indication ‘EMILIA’. On the contrary, this element, interpreted to mean ‘essence’ or ‘nature’, reinforces the concept conveyed by the adjective ‘EMILIANA’, which is the most distinctive element of the sign applied for.</p> <p>(28/07/2015, R 2718/2014-4, NATURA EMILIANA)</p>

Translated PDOs/PGIs

Likewise, there is evocation or imitation of the PDO/PGI when the EUTM contains or consists of a translation of the whole or part of a PDO/PGI in any of the EU languages.

PDO/PGI	European Union trade mark	Explanation
<p>COGNAC</p>	<p>KONJAKKI (invented example)</p>	<p>An EUTM that contains the term ‘Konjakki’ will be considered to evoke ‘Cognac’ in Finnish.</p>



<p>BOURGOGNE</p>	 <p>EUTM No 2417269</p>	<p>'Borgoña' is the Spanish translation of the French PDO 'Bourgogne'.</p>
<p>PÂTES D'ALSACE (FR/PGI/0005/0324)</p>	<p>ALSATIAN PASTA (invented example)</p>	<p>An EUTM that contains the expression 'Alsatian Pasta' will be considered to evoke the PGI 'Pâtes d'Alsace'.</p>

Trade marks consisting of these terms must be refused under both Article 7(1)(c) and (j) EUTMR rather than solely under Article 7(1)(c) EUTMR.

However, the Office will object to translations of PDO/PGIs only to the extent that the translation triggers a link with a product whose designation is protected.

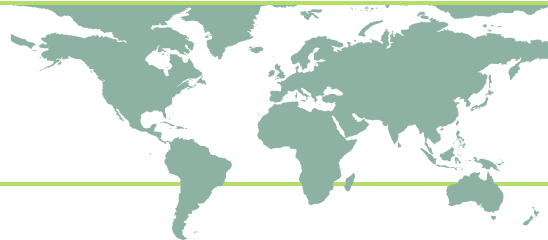
For instance, the Office will not object under Article 7(1)(j) EUTMR to the term 'BULL' just because it is, strictly speaking, the English equivalent to the Spanish word 'TORO' —'TORO' is a Spanish PDO for wines. The relevant public is likely to associate the term 'bull' with an animal and not with wines from the region of Toro.

Expressions used as 'de-localisers'

According to Article 103(2)(b) of Regulation (EU) No 1308/2013, Article 20(2)(b) of Regulation (EU) No 251/2014, Article 16(b) of Regulation (EC) No 110/2008 and Article 13(1)(b) of Regulation (EU) No 1151/2012, PDOs/PGIs are protected 'even if the true origin of the product ... is indicated or if the protected name is ... accompanied by an expression such as "style", "type", "method", "as produced in", "imitation" ... or similar'.

Therefore, the fact that the PDO/PGI reproduced or evoked in the EUTM is accompanied by these expressions does not cancel out application of Article 7(1)(j) EUTMR.

In other words, **even if the public is thereby informed about the actual origin of the product, an objection will still be raised** under Article 7(1)(j) EUTMR. Notwithstanding this, the trade mark will be **misleading** under Article 7(1)(g) EUTMR since there is a contradiction between the goods (restricted to the specific PDO/PGI) and the message conveyed by the mark (that the goods are not 'genuine' PDO/PGI products), which will thus necessarily lead to a further objection under that article.



PDO/PGI	European Union trade mark (invented examples)	Explanation
<p>RIOJA (PDO-ES-A0117)</p>	<p>RIOJA STYLE RED WINE</p>	<p>An EUTM that contains an expression such as ‘Rioja Style Red Wine’ will be considered to evoke the PDO ‘Rioja’ even if it conveys the idea that the product in question is not a ‘genuine’ PDO Rioja wine .</p>
<p>FETA (EL/PDO/0017/0427)</p>	<p>GREEK STYLE PLAIN FETA ARABIAN FETA</p>	<p>An EUTM that contains expressions such as ‘Greek Style Plain Feta’ or ‘Arabian Feta’, will be considered to evoke the PDO ‘Feta’, even if it conveys the idea that the product in question is not a ‘genuine PDO Feta’ cheese .</p>

Where the applicant has its legal seat is irrelevant for assessing Article 7(1)(j) EUTMR. Article 103(1) of Regulation (EU) No 1308/2013, Article 20(1) of Regulation (EU) No 251/2014 and Article 12(1) of Regulation (EU) No 1151/2012 set out that PDOs/PGIs may be used by any operator marketing a product that conforms to the corresponding specification. Hence, provided that the goods comply with the specification of the PDO/PGI in question (which is guaranteed by restricting the goods appropriately), **the location of the applicant’s legal seat as indicated in the EUTM application is irrelevant.** For example, a company with legal domicile in Poland can own a vineyard located in Spain that produces *wine* complying with the product specification of the PDO ‘Ribera del Duero’.

Similarly, a company with its legal domicile in Lithuania can own a factory located in Spain that elaborates products complying with the PGI ‘Chorizo de Cantimpalos’.