

Trademarks (TMs) applications in conflict with Geographical Indications (GIs)

Case 1 - JP portion of IR 1423490 "AGASIO" Class 29: Cheese

V. The grounds for refusal

Ground 1

This trademark application is not eligible for registration under Section 4(1)(xvi) of the Trademark Law because the applied trademark is likely to deceive the public as to the source and quality, especially the geographical origin, as follows:

The trademark consists of the word "AGASIO" in a plain/standard font. This trademark is identical with or similar to the mark of "ASIAGO" which is a name of the area of Vicenza in the Veneto region in northern Italy and has been widely recognized as an indication of the well-known place or origin of Italian cheese.

The use of this trademark would cause confusion as to the origin and/or quality of the designated goods in case where the trademark is used with regard to the goods not made in/originated in "ASIAGO" among the designated goods.

Ground 2

The trademark of this application is not eligible for registration under Section 4(1)(xix) of the Trademark Law because of the following reason:

The trademark consists of the word "AGASIO" in a plain/standard font. This trademark is identical with or similar to the mark of "ASIAGO" which is a name of the area of Vicenza in the Veneto region in northern Italy and used by "CONSORZIO PER LA TUTELA DEL FORMAGGIO ASIAGO" in relation to "cheese" and has been recognized as a well-known Italian cheese among the consumers in European countries before filing this application.

With regard to the terms of "AGASIO" and "ASIAGO", the first letter "A" and the last letter "O" are common and as for the different parts between "GASI" and "SIAG", it is considered that the strings of characters are only rearranged.

With regard to the adoption and use of this trademark for the applicant's trademark, it is considered that the trademark would be used to gain an unfair profit by taking advantage of a well-known mark rather than as a result of being happened to be similar to the well-known trademark. Accordingly, it is considered that this trademark with the said intention would be used for unfair purposes.

Confirmation of total provisional refusal under Rule 18ter(3): 2020/44 Gaz, 12.11.2020, JP

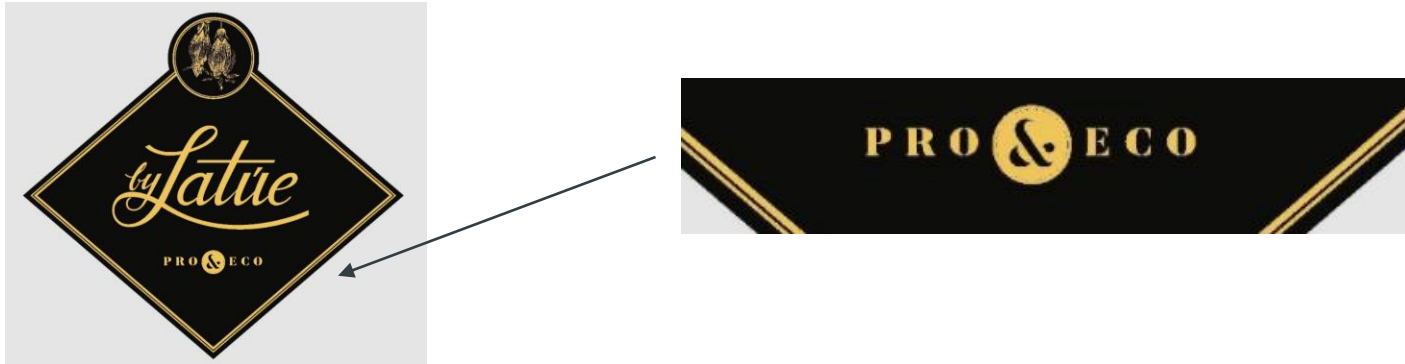
PDF JP

450 Publication number and date

2020/44 Gaz, 12.11.2020

Case 2 – Assessment of the TM/GI conflict

R 425/2019-1 on Opposition to EUTMA 016721491



Class 33

Wine, Sweet wines, Low-alcoholic wine, Sparkling wines, Wine-based drinks; Alcoholic beverages (except beer)

Class 40

Preservation, preparation and transformation or processing of goods relating to the industrial activities of a company making wine and other alcoholic beverages; Production, for others, of wines of all kinds and wine-based beverages; Processing and transformation of grapes for the production of wines of all kinds and wine-based beverages; Distillery and preparation of alcoholic beverages; Preservation of drink; Preservation, manufacture and transformation or processing of goods related to the industrial activity of a company dealing in wine and other alcoholic beverages; Pressing of grapes for obtaining must and wine.

Case 2 - R 425/2019-1

Grounds of opposition:

Article 8(6) EUTMR

PDO 'PROSECCO' (wine)

Article 103(2) Regulation (EU) No 1308/2013

Article 8(1)(b) and Article 8(5) EUTMR



EUTM No. 011619764

("Prosecco", in class 33)

(Italian Registration No. 1550925)

(Wines, sparkling wines, in class 33)

Case 2 - R 425/2019-1



Decision of the Board of Appeal (14 November 2019): upheld

"the use of the contested mark (...) amounts to 'direct or indirect use' which exploits the reputation of the reputed PDO 'PROSECCO' and (...) would evoke the PDO 'PROSECCO'"

Case 2 - R 425/2019-1

Decision of the First Board of Appeal (14 November 2019)

Preliminary remarks

- The contested decision applied EUIPO Guidelines as at 01/10/2017 version, but the decision must be in accordance with the interpretation of the relevant regulations, as interpreted by the EU judicature
- the element  in the opposed mark  is clearly visible and plays an independent distinctive role in the contested trade mark
- the addition of figurative or word elements does not preclude that a conflict may be established under points (a) and (b) of Article 103 of Regulation 1308/2013

Case 2 - R 425/2019-1

Decision of the First Board of Appeal (14 November 2019)



Preliminary remarks

- the conflict situations of Article 103(2) must be assessed throughout the territory of the Union, from the perspective of consumers in all Member States
- a conflict assessed by reference to the consumers of a single Member State is sufficient to trigger the protection provided in Article 103(2) of Regulation (EU) No 1308/2013

Case 2 - R 425/2019-1

Decision of the First Board of Appeal (14 November 2019)



On the substance: Direct or indirect use (Article 103(2)(a))

- It cannot be excluded that the  of  might be perceived as a stylised handwritten 'S'
- "PRO&ECO" would be read and pronounced as "proşieco" or "proéseco" in some EU countries: linguistic differences throughout the European Union must be taken into account
- The potential meaning of "PRO" and "ECO" (in other contexts) is not relevant

Case 2 - R 425/2019-1

Decision of the First Board of Appeal (14 November 2019)


On the substance: Direct or indirect use (Article 103(2)(a))

- by size and position, the element  is close to the way in which many producers use the PDO 'PROSECCO' on their own labels
-  could be perceived as a misspelling of "PROSECCO"
- surrounding circumstances supports the finding that the relationship is not fortuitous

Case 2 - R 425/2019-1

Decision of the First Board of Appeal (14 November 2019)

On the substance: Evocation (Article 103(2)(b))

- the element  is not to be assessed in the abstract but in the context of wines and related services
- various circumstances, including the outstanding reputation of the earlier PDO, support the view that for a substantial part of EU consumers, the sign 'PRO&ECO' will bring to the mind the PDO 'PROSECCO'
- surrounding circumstances strengthen the link with the earlier PDO

Alessandro Francesco Sciarra
alessandro.sciarra@twobirds.com

Studio Legale Bird & Bird
www.twobirds.com