

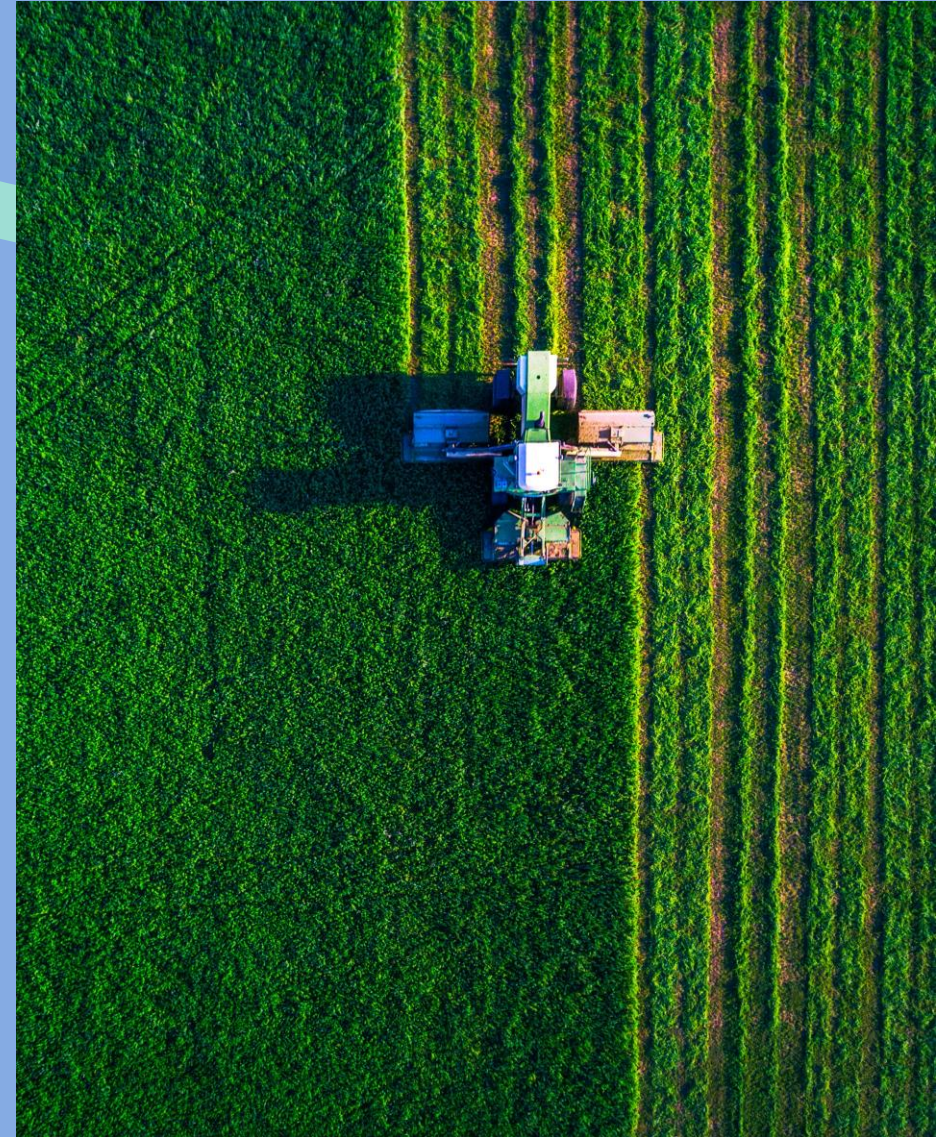
Bird & Bird

Navigating the case law developments on evocation and registration of trademarks for goods complying with the GI specifications

oriGIn 2023 Biennial Meeting, Geneva

Thematic informal GI sessions

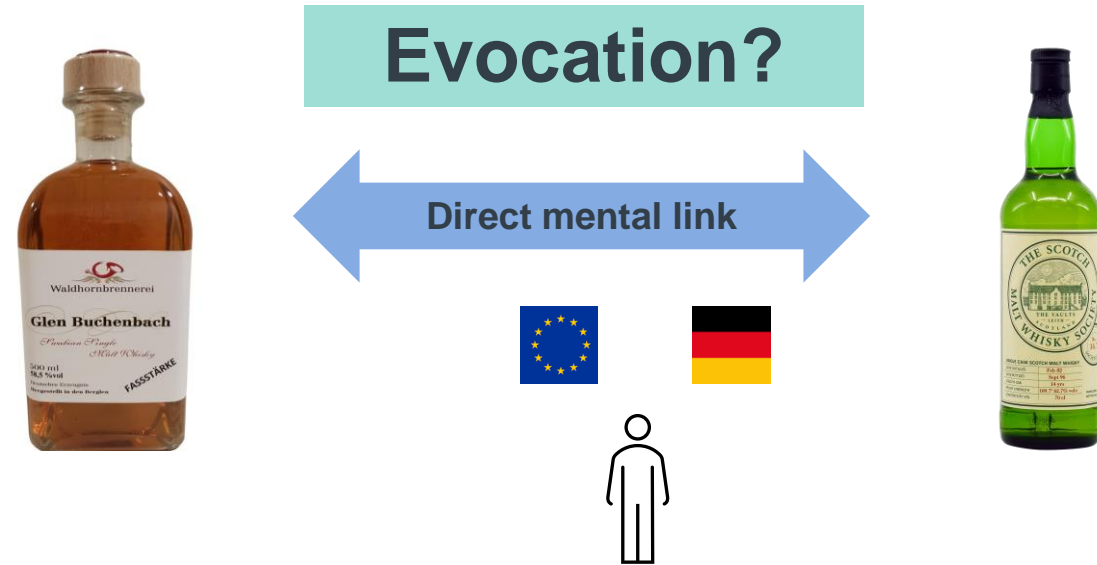
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I. Evocation and the difficulties to prove it

Example: Hamburg Higher Regional Court 5 U 43/19 - *Glen Buchenbach*

- Core issue of the case:



- How to prove it? – What evidence was presented in favour of evocation?

- Market data: Apart from very few exceptions all whiskeys sold on the German market including the term "Glen" in their product name are Scotch Whiskey; similar data was presented for other EU markets, as well
- Legal survey: Covering Germany, Austria, France, Sweden, Poland, the Netherlands and Italy: an average of 14% of respondents overall make links between "Glen" and such goods bearing the protected geographical indication "Scotch Whisky"
- Use of "Glen" was intentional

I. Evocation and the difficulties to prove it

Hamburg Higher Regional Court 5 U 43/19 - *Glen Buchenbach*

- **Findings of the court:**

- Perspective of consumers in one EU market suffices (in line with GJEU decision in *Queso Manchego* and *Champanillo*)
- The relevant group of consumers has to be narrowed down to consumers who are **factually or potentially interested in whiskey**
- The evidence on evocation may not completely prove the existence of evocation, **but** provides a **sufficient amount of indicators** to assume that evocation takes place
- **Result:** The court found in favour of Scotch Whiskey Association

- **Relevance:**

- When evocation cannot be demonstrated through similarities between the relevant terms a sufficient body of evidence is necessary to demonstrate evocation before a court
- In some cases it may be possible to narrow down the circle of relevant consumers not only to one EU country but also to a specific group of consumers. Whether or not a court accepts this, though, will very much depend on the circumstances

II. Can Disclaimers in Lists of Goods/Services of TM Applications neutralise the collision with a GI? – Situation in Germany

- **Practice by German Patent and Trade Mark Office (GPTO):** Disclaimers are only acceptable for trade mark applications
 - incorporating GIs identically or terms that infringe GI rights in another way (including evocation) and
 - only for goods identical to the goods protected by the respective GI
- Trade mark applications that only consist of a GI are generally considered as descriptive and thus will not be granted protection as a trade mark.
- **A recent decision by GPTO** dealing with opposition based on the PDO "Prosecco" against the trade mark "**Prosexxo**" (DE-302019026285) with a disclaimer in the list of goods/services held that the disclaimer supported the existence of evocation rather than neutralising it.
- The opposition was upheld. The case has been appealed to the German Federal Patent Court.

II. Can Disclaimers in Lists of Goods/Services of TM Applications neutralise the collision with a GI? – Situation in Italy

- **Practice by the Italian and Patent and Trade Mark Office:**
 - TM applications that only consist of a GI are generally considered as descriptive/devoid of distinctive character
 - Trade mark applications that feature a GI or signs evoking or otherwise infringing GI rights are objected
 - Disclaimers / restriction of goods are **not** accepted
 - Depending on the circumstances, the objection can be overcome by eliminating the GI from the mark

II. Can Disclaimers in Lists of Goods/Services of TM Applications neutralise the collision with a GI? – Situation in Italy

- "New" additional absolute ground of refusal based on the collision with a GI that **extends to any goods/services** 😊

"The following cannot be registered as a trade mark: (...)

*(b) (...) **signs that evoke, imitate or misuse a geographical indication or a designation of origin** protected under national or European Union legislation, including international agreements to which the European Union or Italy is party"*

(Art. 14.1 IP Code as amended by Law 24 July 2023, n. 102, OJ 08/08/2023, n. 184)

- For GIs corresponding to **country names**: additional objection (Art. 10 IP Code)

III. Can Disclaimers in Lists of Goods/Services of TM Applications neutralise the collision with a GI? – Situation in the UK

- **Practice by the UKIPO:**

- TM applications that only consist of a GI are generally considered as descriptive/devoid of distinctive character
- Trade mark applications that feature a GI or signs evoking or otherwise infringing GI rights are objected
- Restriction of goods is accepted, also in case of evocation 😞

Section 3(4)(4a)

The designation is not acceptable in Class 33 as there is an objection under section 3(4)(4a) of the Act as the mark contains the word **LIGHTSECCO**, being evocative of and brings to mind **PROSECCO** or a **light version of PROSECCO**. The term PROSECCO is registered as Protected Designations of Origin (PDOs) in respect of Wine.

Overcome Objections

The objections relating to Section 3(3)(b) and 3(4)(4a) **can be overcome by adding the following limitation:**

“Alcoholic beverages, except beers; but in so far as wine and beverages containing wine are concerned complying with the specifications of the PDO PROSECCO”.

II. Can Disclaimers in Lists of Goods/Services of TM Applications neutralise the collision with a GI? – EUIPO

- **Practice by the EUIPO:**

- TM applications that only consist of a GI are considered as descriptive/devoid of distinctive character
- TM applications that feature a GI or signs evoking or otherwise infringing GI rights are objected for **comparable goods**
- Restriction of goods is accepted, **also in case of evocation** 😞

"besecco" EUTMA No. 018180352

The sign is refused registration under Article 7(1)(j) EUTMR because it is associated with the protected designation of origin "PROSECCO" (PDO-IT-A0516-Prosecco).

The ground for refusal may be removed by restricting the category of goods (...) as follows:

Class 33: Wines complying with the specification for the protected geographical indication
"Prosecco"

"Der elegante italienische Perlwein entstammt, wie der große Bruder Prosecco aus der Glera Traube"
Translation: "Like its big brother Prosecco, the elegant Italian sparkling wine comes from the Glera grape"



II. Goods restriction does not avoid evocation

- use of GIs must be in compliance with the Product Specification
- scope of protection of GIs **extends to improper use by GI producers / operators**
- misspellings / variations of GIs intended to be used as "brands" coined to exploit / take unfair advantage of the reputation of the GI name
- PDO/PGIs are protected against **any** misuse, imitation or evocation
(Cognac / Cognapea - INPI, 26/08/2022; Côtes du Rhône / Newrhône, Court of Appeal Paris, 26/05/2023)
- deception of consumers

III. Evocation – Assessment (multiple meaning of the disputed sign)

MORELLINO DI SCANSANO / MORELLONE LE CANIETTE

(EUIPO BoA R2242/2020-1, 26/11/2022)

*"The fact that the term 'Morellino' refers to a colour and (...) and that, as such, it does not correspond to the name of a geographical indication **in no way excludes that it may constitute a significant part of the PDO 'Morellino di Scansano'**."*

*"(...) it is equally true that the **evidence on record shows that this term is exclusively associated with wines with the PDO 'Morellino di Scansano'**" and not to other wines (10/06/2021, R 2885/2019-2, Amicone / Amarone della Valpolicella et al., § 35)."*

*[the public] **'is accustomed to the frequent presentation of wines with the 'Morellino di Scansano' PDO simply by using the term 'Morellino' tout court** (10/06/2021, R 2885/2019-2, Amicone v Amarone della Valpolicella et al., § 38)."*

III. Evocation – Assessment (multiple meaning of the disputed sign)

BOLGARÉ / BOLGHERI (Case T-300/22, 23/03/2023)

"(...) it must be held that, when confronted with the mark applied for, the image triggered directly in the mind of the relevant public will be that of the product covered by the PDO 'Bolgheri'. Thus, it must be held that the Board of Appeal correctly found that that mark evoked that PDO pursuant to Article 103(2)(b) of Regulation No 1308/2013.

"That conclusion cannot be called into question by the fact, alleged by the applicant, that the relevant public will perceive the mark applied for as a reference to Bulgaria. That fact, even if it were established, is not sufficient to prevent that public from also having in mind, when confronted with that mark, the image of the product covered by the PDO 'Bolgheri'".

IV. Evocation - Relevance in the GI registration process

General Court T-34/22 - *Jambon sec (et al) de l'Île de Beauté*

- **Core issue of the case:**

- Refused application by EU Commission for approval of specifications for new PGIs
 - „Jambon sec de l'Île de Beauté“
 - „Lonzo de l'Île de Beauté“
 - „Coppa de l'Île de Beauté“
- Grounds of refusal: Use of the terms would be an évocation of the existing PDOs
 - „Jambon sec de Corse“/„Jambon sec de Corse – Prisuttu“,
 - „Lonzo de Corse“/„Lonzo de Corse – Lonzu“ and
 - „Coppa de Corse“/„Coppa de Corse – Coppa di Corsica“



- **Findings:**

- Assessing the name of the prospective GI as part of the draft specifications includes the question whether or not that name could be in breach of provisions protecting GIs, i.a. the protection against evocation. Granting new GIs that infringe existing GIs would practically restrict the scope of protection of existing GIs
- The EU Commission has the power and discretion to assess GI applications in this respect and is not bound by the findings of the member state



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