

Reasons and result from the Board of Appeal

The trademark application VA 2019 02327 JOHN A. McLAREN DISTILLERS 1831 <w> was filed on 14 October 2019 for the following goods and services:

Class 33: Alcoholic beverages except beers; alcoholic preparations for making beverages;

In its decision of 25 August 2021, the Danish Patent and Trademark Office has upheld the trademark application, which was previously object of opposition from the complainant. The opposition was based on the trademark being misleading as to the origin, "SCOTCH WHISKY" being a protected geographical indication of origin, cf. the European Parliament and European Council Regulation (EU) 2019/787 of 17 April 2019 (GI Regulation). According to the complainant, registration of the mark is contrary to section 15(3)(iii) of the Danish Trade Marks Act, and Article 21(2)(b) and (c) of the GI Regulation. The complainant has referred the decision of the Office of 25 August 2021 to the Board of Appeal with the following three claims:

1. The Office's decision be changed so that the application for registration of the trademark JOHN A. McLAREN DISTILLERS 1831 <w> is rejected in its entirety,

2. In the alternative: the application for registration of the trademark JOHN A. McLAREN DISTILLERS 1831 <w> be accepted for registration, but only for the limited list of goods "whisky; whisky-based preparations for making beverages; all aforementioned goods in accordance with the geographical indication "SCOTCH WHISKY",

3. In the second alternative: the decision of the Office be changed and the case be referred to the Office for renewed examination of the following issues:

- The evocation of the trademark of the geographical indication (GI) SCOTCH WHISKY
- The trademark as a form of false or misleading indication as to the provenance, origin, nature or important qualities of the product, liable to convey a false impression as to the origin of the product
- The trademark as suitable for misleading the consumers as to the real origin of the products for which the mark is applied.

The Office maintains its statement of 21 February 2022 to the Board of Appeal that the application can be upheld in unchanged form regardless of the fact that the mark can be perceived as an evocation of, or reference to, the goods associated with the mark being "SCOTCH WHISKY".

For the purpose of the examination of the case by the Board of Appeal, by letter of 29 September 2022, the Board of Appeal has requested the Office to make a supplementary statement on the basis of the complainant's comments on the Office's statement of 21 February 2022. In its supplementary statement of 24 October 2022 to the Board of Appeal, the Office upholds its decision of 25 August 2021 and i.a. notes that a decision has merely been made that the provisions of the GI Regulation and Section 15(3)(iii) of the Danish Trade Marks Act, are not applicable, as registration of the mark has been applied for a term encompassing the product "whisky", and the complainant has not documented or rendered

probable that the trademark is or will be used for a product that is not produced in accordance with the product specification for the protected indication "SCOTCH WHISKY".

By letter of 24 November 2022, the complainant has presented remarks to the supplementary statement of the Office. The complainant has i.a. argued that the Danish translation of Article 36(1) of the GI Regulation is inaccurate.

Like the complainant, the Board of Appeal finds that the trademark VA 2019 02327 JOHN A. McLAREN DISTILLERS 1831 <w> applied for may evoke associations to "SCOTCH WHISKY", which is a protected indication of origin, which is protected according to the GI Regulation on the common market organization of spirit drinks. Registration of the trademark must therefore respect the protected indication, cf. Section 15(3)(iii) of the Danish Trade Marks Act.

According to Section 15(3)(iii) of the Danish Trade Marks Act, a trademark can after opposition be excluded from registration to the extent that the mark is in conflict with older geographical indications. As to the geographical indication "SCOTCH WHISKY", protection should be sought in said GI Regulation, Article 21(2)(b) and (c):

2. Geographical indications protected under this Regulation shall be protected against:

b) 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 an expression such as 'style', 'type', 'method', 'as produced in', 'imitation', 'flavour', 'like' or similar, including when those products are used as an ingredient [*italics added*].

(c) any other false or *misleading indication* as to the provenance, origin, nature or essential qualities of the product in the description, presentation or labelling of the product liable to convey a false impression as to the origin of the product [*italics added*].

Article 36(1), of the GI Regulation:

1. The registration of a trade mark the use of which *corresponds or would correspond* to one or more of the situations referred to in Article 21(2) shall be refused or invalidated [*italics added*].

The Board of Appeal finds that all provisions of the GI Regulation, as cited above, are relevant to the specific problem. Thus, it is the view of the Board of Appeal that practice from both the EUIPO and the EU Court of Justice has shown that the enumeration in Article 21(2), including (b) and (c), is not cumulative. The EU Court of Justice has decided that the use of a trademark can be contrary to Article 21(2)(b), when the trademark in question indicates a GI (geographical indication) even if the consumers have not been misled. Whether a trademark constitutes an evocation of a GI depends on whether the trademark will evoke sufficient direct and unambiguous association with the GI in question with the consumer

(thus case C-44/17 Glen Buchenbach, grounds 45, 53 and 65 and case C-614/17 Queso Manchego).

The Board of Appeal can concur with the view that the Danish translation of Article 36(1) of the GI Regulation is inaccurate. The wording of Article 36(1) of the Regulation "will correspond" should thus read as "would correspond", and therefore no documentation can be required for the trademark already being used contrary to the GI Regulation nor probability that such use will take place.

With this reference, the decision of the Danish Patent and Trademark Office of 25 August 2021 is thus reversed, and VA 2019 02327 JOHN A. McLAREN DISTILLERS 1831 <w> is registered for the following goods in Class 33 alone: whisky; whisky-based preparations for making beverages; all goods mentioned above in accordance with the geographical indication "SCOTCH WHISKY".

Accordingly it is decided that

The decision of the Danish Patent and Trademark Office of 25 August 2021 is reversed, and VA 2019 02327 JOHN A. McLAREN DISTILLERS 1831 <w> is registered for the following goods in Class 33 alone: whisky; whisky-based preparations for making beverages; all goods mentioned above in accordance with the geographical indication "SCOTCH WHISKY".

Danish Patents and Trademarks Board of Appeal

[Signed]
Henrik Rothe
Chair