

THESIS

GI PROTECTION AGAINST EVOCATION IN THE EU: ASSESSMENT OF THE CJEU'S INTERPRETATION AND COMPARISON WITH REPUTED EUROPEAN TRADEMARK PROTECTION

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Words: 10979

Date of Submission: 9 August 2022.

Maastricht University, Faculty of Law

Advanced Master in Intellectual Property Law and Knowledge Management

2021-2022

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INTRODUCTION

The past decade has seen a growing trend towards the registration of geographical indications (GIs) in the European Union (EU). By January 2021, 3,306 GIs had been registered in eAmbrosia, the European register of geographical indications. This figure represents an increase of 27% on 2010 when 2,595 GIs were registered¹. From an economic point of view, the total sales value of GIs products in 2017 was estimated to be 74.76 billion Euros in the European Union, accounting for 6.8% of total food and drink sales². The growing importance of GIs in the EU can be explained by the establishment throughout the years of a European GI scheme affording protection to GIs, but is this protection always in line with its initial objectives, and how far does it extend?

A geographical indication is “*an indication (name) used on products from a specific geographical origin that have a certain quality, reputation or other characteristic that is essentially attributable to that origin*”³. Within the EU, the main GI legislation includes Regulation 1151/2012 for agricultural products and foodstuffs, Regulation 1308/2013 for wines, Regulation 2019/787 for spirit drinks, and Regulation 251/2014 for aromatized wines. Additionally, two proposals for a Regulation on GIs have been recently presented in 2022⁴. This European GI scheme is intended to protect the names of products originating from a specific region and having specific qualities or enjoying a reputation linked to the production territory, by granting those names a “geographical indication”⁵. Once a product’s name is registered as a GI, the producers in a defined geographical area have the right to use the registered name as long as they comply with the product specification⁶. These geographical indications are designed to promote fair competition amongst producers by preventing

¹ European Commission, ‘Evaluation of Geographical Indications and Traditional Specialities Guaranteed Protected in the EU’, SWD (2021) 427 final, p. 14, <<https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=SWD:2021:427:FIN>> accessed 2 April 2022.

² Ibid., p. 16.

³ Ibid., p. 7.

⁴ Proposal for a Regulation of the European Parliament and of the council on European Union geographical indications for wine, spirit drinks and agricultural products, and quality schemes for agricultural products, amending Regulations (EU) No 1308/2013, (EU) 2017/1001 and (EU) 2019/787 and repealing Regulation (EU) No 1151/2012; Proposal for a Regulation of the European Parliament and of the Council on geographical indication protection for craft and industrial products and amending Regulations (EU) 2017/1001 and (EU) 2019/1753 of the European Parliament and of the Council and Council Decision (EU) 2019/1754.

⁵ European Commission, ‘Quality schemes explained’, <<https://ec.europa.eu/info/food-farming-fisheries/food-safety-and-quality/certification/quality-labels/quality-schemes-explained>> accessed 19 April 2022.

⁶ European Commission, ‘Evaluation of Geographical Indications and Traditional Specialities Guaranteed Protected in the EU’, SWD (2021) 427 final, p. 7, <<https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=SWD:2021:427:FIN>> accessed 19 April 2022.

deceptive practices and bad-faith uses, to guarantee authenticity to consumers, and to distinguish products in the market⁷. Thereby, GIs may offer an added value to the producers by securing higher-value sales and exports⁸.

To avoid behaviors that could undermine those functions, the GI Regulations give GI owners the right to prohibit various uses of protected names, one of which is the “evocation” of a protected name. According to *Merriam-webster*, evocation is “*the act or the fact of evoking*”⁹. Due to the lack of a definition in the law, the Court of Justice of the European Union (CJEU) had to intervene to clarify the meaning of “evocation”. In 1999, the CJEU gave initial indications by specifying that (i) evocation “*covers a situation where the term used to designate a product incorporates part of a protected designation, so that when the consumer is confronted with the name of the product, the image triggered in his mind is that of the product whose designation is protected*”¹⁰, and that (ii) likelihood of confusion between the products concerned was not required to find evocation¹¹.

Since then, the CJEU has significantly broadened the interpretation of evocation, which leads to potential problems. Firstly, in September 2021, the CJEU held that the GI protection against evocation extends to products and services, regardless of whether the product covered by the GI and the product or service covered by the disputed name are similar¹². By extending the scope of evocation to dissimilar products and services, such an interpretation may arguably be problematic for the competition in the market. Indeed, fair competition implies that there must still be room for the other actors in the market to use fairly the protected names. With its recent interpretation, the question arises as to whether these actors can still make fair use of names that evoke a GI for non-similar goods and services without fear of infringement. Secondly, the current interpretation of evocation does not allow producers whose products do not comply with existing GI specifications coming from the same geographical area to refer to this

⁷ *Ibid.*

⁸ *Ibid.*

⁹ Merriam-webster dictionary, <<https://www.merriam-webster.com/dictionary/evocation>> accessed 20 July 2022; The French and Italian terms used in the Regulations, respectively “*évocation*” and “*evocazione*”, can be defined in the same way as the English term. In the Dutch version of the GI Regulations, “evocation” is translated as “*voorstelling*”, which slightly differs from “evocation” in that it means “*imagination*”.

¹⁰ Case C-87/97 *Consorzio per la tutela del formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH & Co. KG and Eduard Bracharz GmbH* [1999] ECR I-01301, para. 25.

¹¹ *Ibid.*, para. 26.

¹² Case C-783/19 *Comité Interprofessionnel du Vin de Champagne v GB* [2021].

geographical area, even if the reference is true¹³. This prohibition can be problematic for the freedom of expression of producers, thereby amounting to unfair competition. Thirdly, “evocation” is not incompatible with the absence of explicit (even partial) use of the protected name, as long as it is possible to derive a speculative link between the problematic product and the GI¹⁴. This interpretation is arguable as GI protection is theoretically limited to the name of the product¹⁵ and is not intended to protect all the elements which are structurally or circumstantially present in a product as such¹⁶.

By way of comparison, the protection for reputed European trademarks may not reach that far¹⁷. The protection of GIs (which are presumed intrinsically reputed¹⁸) and reputed trademarks (whose reputation must be established to benefit from the protection) both offer the possibility to protect a name and indicate origin¹⁹. In reputed trademark cases, the protection also extends to dissimilar goods and services, but under the condition that the contested use takes unfair advantage of, or is detrimental to, the distinctive character or reputation of the trademark²⁰ (this condition is also required for identical/similar goods and services). Further, a third party can use an indication which concerns the geographical origin of the good or service concerned even if this geographical indication is registered as a trademark, but only where the use made by the third party is in accordance with honest practices in industrial or commercial matters²¹. In

¹³ Valeria Paganizza, ‘More Holes than Cheese: PDOs, Evocation and a Possible Solution’ in *EFFL*, 2013, p. 225; Vito Rubino, ‘The “indirect” or “conceptual” evocation of a protected designation of origin and its practical and juridical effect after ECJ case Queso manchego’ in *Revista de Derecho Comunitario Europeo*, 64, 2019, p. 974.

¹⁴ See Case C-44/17 *Scotch Whisky Association v Michael Klotz* [2018], and 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* [2019]; Vito Rubino, ‘The “indirect” or “conceptual” evocation of a protected designation of origin and its practical and juridical effect after ECJ case Queso manchego’ in *Revista de Derecho Comunitario Europeo*, 64, 2019, p. 971.

¹⁵ Case C-490/19 *Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois SAS* [2019], para. 36.

¹⁶ Vicente Zafrilla Díaz-Marta and Anastasiia Kyrylenko, ‘The ever-growing scope of Geographical Indications’ evocation: from Gorgonzola to Morbier’, in *Journal of Intellectual Property Law & Practice*, 2021, Vol. 16, No. 4-5, p. 448.

¹⁷ See the comparison provided in Chapter III, Section III of this thesis.

¹⁸ GIs are considered intrinsically reputed by the mere fact that they are registered, see EUIPO trademark Guidelines, Part C, Section 6, Chapter 3, Subsection 1.1. This assumption implies that no evidence of the reputation of the GI is required. However, the strength of the reputation can be a factor in the assessment of evocation.

¹⁹ With the difference that trademarks are used to differentiate the goods or services of one entity from that of another.

²⁰ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, Articles 8(5) and 9(2)(c); Guy Tritton, *Tritton on Intellectual Property in Europe* (5th edn Sweet & Maxwell 2018), First Supplement to the Fifth Edition (Sweet & Maxwell 2020), p. 37.

²¹ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, Article 14(1)(b).

addition, trademark law differentiates between a word trademark, a figurative trademark, and a shape trademark.

In light of these elements, the present thesis intends to analyze the trend of the CJEU's interpretation of "evocation", assess this interpretation with the rationales and object of GI protection as a benchmark, and compare the GI protection with the protection granted to reputed trademarks (the choice of reputed trademarks is explained by the similarity of the rationales and protection with that of GIs against evocation). In particular, the thesis seeks to answer the following questions:

- How are geographical indications protected against "evocation" in the European Union?
- Is the CJEU's interpretation of "evocation" consistent with the rationales and object of GI protection?
- Does the GI protection against evocation differ from the reputed European trademark protection?
- In light of (i) the rationales and object of GI protection and (ii) the protection of reputed European trademarks, where could the limit of the GI protection against evocation lie?

To answer these questions, both the doctrinal analysis method and the comparative method are used. Chapter I provides an overview of the current European interpretation of evocation by analyzing the GI protection against evocation provided by Regulation 1151/2012²² and the main CJEU's rulings on evocation. Once the current interpretation of evocation has been established, Chapter II discusses the rationales of the GI scheme to assess whether this interpretation of evocation is in line with the rationales and object of GI protection. This assessment allows for the establishment of the potential problems arising with the current interpretation of evocation. Chapter III then focuses on the reputed European trademark protection to provide a comparison with the GI protection against evocation and to determine whether there is a significant difference between the two schemes. Specifically, Chapter III discusses the conditions for

²² The thesis focuses on Regulation 1151/2012, but the comments apply to the other GI Regulations, except where stated otherwise.

reputed European trademark protection, gives a practical example to illustrate how the protection applies in practice, and lastly provides a comparison of the two schemes. Finally, Chapter IV discusses where the limit of the interpretation of evocation could lie in light of the conclusions made in Chapters II and III.

Several doctrinal articles or summaries of the CJEU's case-law on evocation are already available in the literature²³. This thesis intends to go further than the state of the art by assessing the CJEU's interpretation of evocation with the rationales and object of GI protection as a benchmark, by taking into account the latest CJEU's decisions, by comparing the GI protection against evocation with protection available for reputed European trademarks, and by giving suggestions on the limit of the interpretation of evocation.

²³ Guidelines on the interpretation of "evocation" are provided by the EUIPO trademark Guidelines, Part B, Section 4, Chapter 10, Subsection 4.2.2. Further support can also be found in the following papers: Organisation for an International Geographical Indications Network (oriGIn), 'The protection of PDO, PGI and GIs against "evocation" in the EU regulations and case law', <https://www.origin-gi.com/wp-content/uploads/2021/09/oriGIn-paper-Evocation-14_09_2021.pdf> accessed 24 May 2022; These two sources do not critically analyze the CJEU's interpretation, but several doctrinal articles provide analysis of the different relevant case law, such as Vicente Zafrilla Díaz-Marta and Anastasiia Kyrylenko, 'The ever-growing scope of Geographical Indications' evocation: from Gorgonzola to Morbier', in *Journal of Intellectual Property Law & Practice*, 2021, Vol. 16, No. 4-5, p. 442 to 449; Manon Verbeeren and Olivier Vrins, 'The protection of PDOs and PGIs against evocation: a 'Grand Cru' in the CJEU's cellar?' in *Journal of Intellectual Property Law & Practice*, Volume 16, Issue 4-5, April-May 2021, p. 316 to 330.

CHAPTER I: EUROPEAN PROTECTION OF GEOGRAPHICAL INDICATIONS AGAINST EVOCATION

This Chapter intends to provide an overview of the European interpretation of evocation. To this end, the first Section discusses the GI protection against evocation provided by Regulation 1151/2012²⁴. The second Section focuses on the CJEU's cases on evocation and is intended to assess (i) how the CJEU interprets "evocation" and (ii) whether there is a trend of a broad interpretation of "evocation".

I. EVOCATION IN REGULATION 1151/2012

The scope of protection of products' names registered as GIs is provided by Article 13 (called "*Protection*") of Regulation 1151/2012. Under this Article, names of products registered as geographical indications are protected against (i) use of the protected name for identical and comparable products, (ii) use that exploits the reputation of the protected name, (iii) evocation, misuse and imitation on products or services, (iv) false or misleading indication, and (v) any practice liable to mislead the consumer²⁵.

The prohibition of "evocation" is provided by paragraph 1(b) of Article 13, which states that GIs shall be 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 an expression such as 'style', 'type', 'method', 'as produced in', 'imitation' or similar, including when those products are used as an ingredient (...)*". Due to the lack of information on "evocation" provided by this Article (e.g., there is no explanation on how to assess evocation), the analysis of the CJEU's case-law on evocation provided in Section II helps for a better understanding of this concept.

²⁴ Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs; The following statements apply to all GI Regulations, except when otherwise stated.

²⁵ European Commission, 'Evaluation of Geographical Indications and Traditional Specialities Guaranteed Protected in the EU', SWD (2021) 427 final, p. 27, <<https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=SWD:2021:427:FIN>> accessed 19 April 2022.

II. CJEU'S (BROAD) INTERPRETATION OF EVOCATION

This Section intends to provide an overview of the CJEU's interpretation of "evocation". Specifically, it analyzes the relevant cases to show how the CJEU has refined the concept of evocation over the cases and to determine whether there is a trend towards a broad interpretation.

1. The starting point: The *Cambozola* case

The *Cambozola* case was held by the CJEU on March 4, 1999, and was the first case that provided clarification on the assessment of evocation²⁶. It concerned the marketing in Austria of a blue cheese, similar in appearance to the cheese "*Gorgonzola*"²⁷, under the trademark "*Cambozola*". Considering that "*Cambozola*" infringed the GI "*Gorgonzola*", the Consorzio per la Tutela del Formaggio Gorgonzola applied for an order to prohibit the marketing in Austria of the cheese "*Cambozola*" and to cancel the "*Cambozola*" trademark. The case ended up before an Austrian Commercial Court, which referred two questions to the CJEU for a preliminary ruling.

In that case, the CJEU had to determine whether the use of the name "*Cambozola*" for cheese constituted an evocation of the GI "*Gorgonzola*". The Court first held that evocation "*covers a situation where **the term** used to designate a product **incorporates part of a protected designation**, so that when the **consumer** is confronted with the name of the product, the **image triggered in his mind** is that of the **product** whose designation is protected*"²⁸. It subsequently added that a protected name may be evoked even when there is no likelihood of confusion between the products concerned and even where no European protection extends to the parts of that designation that are echoed in the term or terms at issue²⁹. In its assessment of evocation, the CJEU then found that a protected name may be evoked where the term used to designate a product "*ends in the same two syllables and contains the same number of syllables, with the result that the phonetic and visual similarity between the two terms is obvious*"³⁰. Therefore,

²⁶ Case C-87/97 *Consorzio per la tutela del formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH & Co. KG and Eduard Bracharz GmbH* [1999] ECR I-01301.

²⁷ *Ibid.*, para. 27.

²⁸ *Ibid.*, para. 25.

²⁹ *Ibid.*, para. 26.

³⁰ *Ibid.*, para. 27.

visual and phonetic similarity are two relevant criteria for the assessment of evocation. The CJEU concluded that the term “*Cambozola*” could evoke the designation “*Gorgonzola*”³¹ and specified that the fact that the packaging for the cheese “*Cambozola*” indicated the product’s true origin had no bearing on the application to that product of the concept of evocation³². Through this case, the Court laid down the basic principles for the assessment of evocation.

2. Conceptual proximity is relevant: The *Parmesan* case

The *Parmesan* case was held by the CJEU on February 26, 2008³³. The Court had to determine whether the use of the name “*Parmesan*” for a cheese which did not comply with the specification for the Protected Designation of Origin (PDO)³⁴ “*Parmigiano Reggiano*” constituted an evocation of that PDO. To this end, the Court recalled the principles laid down in *Cambozola*³⁵ but added that in the assessment of evocation, the “*conceptual proximity*” between the contested term and the GI must also be taken into account³⁶. Since only the phonetic and visual similarity criteria were mentioned in *Cambozola*, this specification on conceptual proximity was a new element brought by the Court. The CJEU subsequently noted that the conceptual proximity must be taken into account regardless of whether the name “*Parmesan*” is or is not an exact translation of the PDO “*Parmigiano Reggiano*” or of the term “*Parmigiano*”³⁷, and concluded that the use of the name “*Parmesan*” in that situation must be regarded as an evocation of the PDO “*Parmigiano Reggiano*”³⁸.

3. Who is the average consumer? The *Verlados* case

The *Verlados* case was held by the CJEU on January 26, 2016³⁹. In this case, an undertaking established in Finland that manufactured and marketed apple spirits named “*Verlados*” was

³¹ Ibid., para. 43.

³² Ibid., para. 28.

³³ Case C-132/05 *Commission of the European Communities v Federal Republic of Germany* [2008] ECR I-00957.

³⁴ The general notion of “geographical indications” encompasses two specific indications: the protected designation of origin (PDO) and the protected geographical indications (PGI). The difference between the two of them is the strength of the link between the terroir and the qualities of the foodstuffs; See Richard Davis and Others, *Tritton on Intellectual Property in Europe* (5th edn Sweet & Maxwell 2018), p. 537.

³⁵ Case C-87/97 *Consorzio per la tutela del formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH & Co. KG and Eduard Bracharz GmbH* [1999] ECR I-01301.

³⁶ Case C-132/05 *Commission of the European Communities v Federal Republic of Germany* [2008] ECR I-00957, para. 47.

³⁷ Ibid.

³⁸ Ibid., para. 49.

³⁹ Case C-75/15 *Viiniverla Oy v Sosiaali- ja terveystieteiden tutkimuskeskus* [2016].

prohibited from doing so due to the existence of the French GI “*Calvados*” for apple spirit. The undertaking brought a lawsuit before a Finnish Market Court which referred questions on evocation to the CJEU for a preliminary ruling.

The new element in this case concerned the notion of “consumer” that must be taken into account when assessing evocation. The CJEU had already established that evocation requires that when the consumer is confronted with the problematic product’s name, “*the image triggered in his mind is that of the product whose designation is protected*”⁴⁰, but no indication had been given on the notion of “consumer”. In *Verlados*, the CJEU specified that in its assessment, “*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*”⁴¹. Therefore, the evocation assessment can be detached from the Member State in which the product giving rise to the evocation of the GI is manufactured⁴².

4. Clear and direct link, and non-essential condition: The *Scotch whisky* case

The *Scotch Whisky* case was held by the CJEU on June 7, 2018⁴³. It concerned the Scotch Whisky Association (SWA), an organisation that seeks to protect the trade in Scottish whisky (“*Scotch Whisky*” is a protected PGI)⁴⁴, which brought an action in Germany to prohibit the marketing of a German whisky under the sign “*Glen Buchenbach*” on the ground that the use of that designation infringed the PGI “*Scotch Whisky*”⁴⁵. According to the SWA, the designation “*Glen*” was widely used in Scotland instead of the word “*valley*” and, in particular, as an element of the trademark in the names of Scottish whiskies. Therefore, the SWA claimed that even if the label specified that the product at issue was of German origin, the name “*Glen Buchenbach*” evoked an association with Scotland and Scotch Whisky⁴⁶.

⁴⁰ Case C-87/97 *Consortio per la tutela del formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH & Co. KG and Eduard Bracharz GmbH* [1999] ECR I-01301, para. 25.

⁴¹ Case C-75/15 *Viiniverla Oy v Sosiaali- ja terveystieteiden tutkimuskeskus* [2016], para. 28.

⁴² Annalisa Volpato, ‘Case Report On Consumer, Evocation and Cider Spirit’ in *EFFL*, 2016, p. 143.

⁴³ Case C-44/17 *Scotch Whisky Association v Michael Klotz* [2018].

⁴⁴ *Ibid.*, para. 8.

⁴⁵ *Ibid.*, para. 11.

⁴⁶ *Ibid.*, para. 12.



The Glen Buchenbach whisky
Source [here](#)

Questions on evocation were referred to the CJEU, which had to establish whether the phonetical and/or visual similarity between the disputed element and the GI was an essential condition to find evocation. The CJEU first recalled the principles laid down in its previous case-law. It then specified that neither identifying phonetic and visual similarity between the disputed designation and the protected GI nor partial incorporation of the GI in the disputed designation was an essential condition to establish evocation⁴⁷. According to the Court, they are only factors to take into account in the assessment⁴⁸. In absence of (i) any phonetic or visual similarity or (ii) partial incorporation of the GI in the disputed designation, the examination of evocation must consider (iii) any conceptual proximity between the GI and the disputed designation⁴⁹.

Lastly, the CJEU noted that what is essential in assessing evocation is that consumers must establish a sufficiently “*clear and direct link*” between the contested element and the indication concerned⁵⁰. This requirement of a “*clear and direct link*” is included in the Proposal to review the GIs system for wine, spirit drinks and agricultural products⁵¹.

⁴⁷ Ibid., para. 49.

⁴⁸ Ibid., para. 49.

⁴⁹ Ibid., para. 50; EUIPO Guidelines Part B, Section 4, Chapter 10, Subsection 4.2.2.

⁵⁰ EUIPO Guidelines Part B, Section 4, Chapter 10, Subsection 4.2.2; Case C-44/17 *Scotch Whisky Association v Michael Klotz* [2018], para. 53.

⁵¹ Proposal for a Regulation of the European Parliament and of the Council on European Union geographical indications for wine, spirit drinks and agricultural products, and quality schemes for agricultural products, amending Regulations (EU) No 1308/2013, (EU) 2017/1001 and (EU) 2019/787 and repealing Regulation (EU) No 1151/2012; Its Article 27 provides that “(...) 2. For the purposes of [evocation], the evocation of a geographical indication shall arise, in particular, where a term, sign, or other labelling or packaging device presents **a direct and clear link** with the product covered by the registered geographical indication in the mind of the reasonably circumspect consumer, thereby exploiting, weakening, diluting or being detrimental to the reputation of the registered name (...)”.

5. Figurative elements may evoke a GI: The *Manchego* case

The *Manchego* case was held by the CJEU on May 2, 2019⁵². It concerned the marketing of three cheeses, “*Adarga de Oro*”, “*Super Rocinante*” and “*Rocinante*”, with a label depicting a character similar to Don Quixote, a bony horse, a landscape with windmills (a typical feature of the landscape of La Mancha⁵³) and sheep⁵⁴. According to the owners of the PDO “*Queso Manchego*” (a protected PDO for cheeses made in the Region of La Mancha in Spain), the three cheeses evoked the PDO “*Queso Manchego*”. For a better understanding, one should know that Don Quixote is a famous fictional character from La Mancha. Don Quixote has a small leather shield for which the old archaic word in Spanish is “*adarga*”⁵⁵ and a horse named Rocinante. At the request of the Spanish Supreme Court, the CJEU had to determine whether figurative elements could lead to the evocation of a GI.



The defendant's cheeses
Source [here](#)

The CJEU held that Article 13(1)(b) of Regulation 510/2006⁵⁶ protects registered names against **any** evocation, which implies that it also refers “to any figurative sign capable of evoking in the mind of the consumer products whose designation is protected”⁵⁷. The Court justified its decision by stating that the GI Regulations aim to ensure that the consumer has clear, succinct and credible information regarding the origin of the product, and that such an objective is further

⁵² 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* [2019].

⁵³ Guy Tritton, *Tritton on Intellectual Property in Europe* (5th edn Sweet & Maxwell 2018), First Supplement to the Fifth Edition (Sweet & Maxwell 2020), p. 36.

⁵⁴ 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* [2019], para. 41.

⁵⁵ Guy Tritton, *Tritton on Intellectual Property in Europe* (5th edn Sweet & Maxwell 2018), First Supplement to the Fifth Edition (Sweet & Maxwell 2020), p. 36.

⁵⁶ The same reasoning applies to other GI Regulations.

⁵⁷ 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* [2019], para. 18.

guaranteed if the registered name cannot be evoked through the use of figurative signs⁵⁸. Such an interpretation broadens the scope of evocation. Indeed, in *Cambozola*, the CJEU considered that evocation covered a situation where **the term** used to designate a product incorporates part of a protected designation⁵⁹. Today, if there is a sufficiently clear and direct conceptual proximity between a figurative sign and a GI, and if the link between the figurative sign and the GI is sufficiently clear and direct that that name is brought to the mind of the consumer in their presence, **a figurative sign** can evoke a GI even if there is no incorporation of the registered name⁶⁰. The Proposal to review the GIs system for wine, spirit drinks and agricultural products takes into account the ruling of the CJEU⁶². In its ruling, the CJEU also specified that “*the fact that a producer of similar or comparable products to those protected by a designation of origin is established in a geographical area associated with that designation cannot exclude that producer from the scope of [evocation]*”⁶³.

6. Evocation of a GI through the shape of a product? The *Morbier* case

The *Morbier* case was held by the CJEU on December 17, 2020⁶⁴. In this case, the producer of the cheese “*Montboissie*” was accused of infringing the cheese PDO “*Morbier*”. According to the claimant, the high visual similarity between the cheese “*Montboissie*” and the cheese “*Morbier*” constituted an infringement of the PDO. The case was finally brought before the French Cour de Cassation, which referred preliminary questions to the CJEU. The CJEU did

⁵⁸ Ibid., para. 29 and 30.

⁵⁹ Case C-87/97 *Consorzio per la tutela del formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH & Co. KG and Eduard Bracharz GmbH* [1999] ECR I-01301, para. 25.

⁶⁰ Guy Tritton, *Tritton on Intellectual Property in Europe* (5th edn Sweet & Maxwell 2018), First Supplement to the Fifth Edition (Sweet & Maxwell 2020), p. 37.

⁶¹ After the CJEU’s ruling, the Spanish Supreme Court held that the use of signs in cheese labelling which reproduce Don Quixote figure, his horse Rocinante and landscape and images typical of La Mancha region (such as windmills and sheep) constitute an evocation of the PDO “*Queso Manchego*”; See Vicente Zafrilla Díaz-Marta and Anastasiia Kyrylenko, ‘The ever-growing scope of Geographical Indications’ evocation: from Gorgonzola to Morbier’, in *Journal of Intellectual Property Law & Practice*, 2021, Vol. 16, No. 4-5, p. 445; Spanish Supreme Court: STS 2464/2019 *Queso Manchego* [2019].

⁶² Proposal for a Regulation of the European Parliament and of the Council on European Union geographical indications for wine, spirit drinks and agricultural products, and quality schemes for agricultural products, amending Regulations (EU) No 1308/2013, (EU) 2017/1001 and (EU) 2019/787 and repealing Regulation (EU) No 1151/2012: its Article 27 provides that “(...) 2. For the purposes of [evocation], the evocation of a geographical indication shall arise, in particular, where **a term, sign, or other labelling or packaging device** presents a direct and clear link with the product covered by the registered geographical indication in the mind of the reasonably circumspect consumer, thereby exploiting, weakening, diluting or being detrimental to the reputation of the registered name (...)”.

⁶³ 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* [2019], para. 36.

⁶⁴ Case C-490/19 *Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois SAS* [2019].

not rule on “evocation” *per se*⁶⁵ and focused on Article 13(d) of Regulation 1151/2012⁶⁶, but the Advocate General discussed evocation in its opinion.



The cheese PDO “Morbier”
Source [here](#)



Cheese “Montboissié”
Source [here](#)

According to the Advocate General, the shape of a product may evoke a GI only in exceptional circumstances if three conditions are met⁶⁷:

- (i) The element which has been reproduced must appear in the specification of the registered name as a distinctive characteristic of the product covered by that name⁶⁸;
- (ii) The element which has been reproduced must not be intrinsically linked to a production process that, as such, must remain freely available for use by any producer⁶⁹;
- (iii) Evocation must be established based on a case-by-case assessment that takes into account, in addition to the shape or appearance of the product with a protected name that has been reproduced, “*all other elements deemed to be relevant*”⁷⁰.

⁶⁵ However, the CJEU held that “Article 13(1) of Regulation No 1151/2012 [does] not prohibit solely the use by a third party of a registered name”, see Case C-490/19 *Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois SAS* [2019], para. 31.

⁶⁶ The CJEU held that “Article 13(1)(d) of Regulation No 1151/2012, must be interpreted as **prohibiting the reproduction of the shape or appearance characterising a product covered by a registered name** where that reproduction is liable to lead the consumer to believe that the product in question is covered by that registered name. It is necessary to assess whether such reproduction may mislead the European consumer, who is reasonably well informed and reasonably observant and circumspect, taking into account all the relevant factors in the case”, see Case C-490/19 *Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois SAS* [2019], para. 41.

⁶⁷ Case C-490/19 *Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois SAS* [2019], Opinion of AG M. GIOVANNI PITRUZZELLA, para. 42.

⁶⁸ *Ibid.*, para. 43.

⁶⁹ *Ibid.*, para. 44.

⁷⁰ *Ibid.*, para. 45: The Advocate General said that should be taken into account “*all other elements deemed to be relevant, either because of their potentially evocative nature or, conversely, because they exclude or reduce the*

Furthermore, there must be an intention to take unfair advantage of the protected name⁷¹;

Consequently, according to the Advocate General, the shape of a product may evoke a registered name under specific conditions. If those conditions are not met, the Advocate General considered that the shape, appearance or packaging of a product may still be taken into consideration, as contextual factors, for the overall assessment of the existence of an evocation⁷². The CJEU did not rule on this matter, but if this interpretation is accepted, the scope of evocation would be further expanded. The relevance of this interpretation is discussed in Chapter II, Section II, Subsection 3.

The reason why only the Advocate General discussed the question of evocation may be the fact that he felt compelled to do so as almost all the interested parties who submitted written observations to the CJEU argued on evocation in their submissions⁷³. By contrast, the CJEU may have decided not to discuss evocation because nothing in the Cassation Court's request to the CJEU specifically referred to the concept of evocation⁷⁴.

7. Extension to (non-comparable) goods and services: The *Champanillo* case

The *Champanillo* case was held by the CJEU on September 9, 2021⁷⁵. It concerned a tapas bar in Spain that used the sign "*Champanillo*"⁷⁶ to designate and promote its establishments. In the advertising for the bar, an image was used of two champagne coupes containing a sparkling beverage⁷⁷. The Comité Interprofessionnel du Vin de Champagne, an organisation that safeguards the interests of champagne producers, claimed that the use of the word "*Champanillo*" infringed the PDO "*Champagne*", and therefore brought an action before a

possibility that the consumer could make a clear and direct association between an ordinary product and the product bearing the protected name".

⁷¹ Ibid.

⁷² Ibid., para. 46.

⁷³ Vicente Zafrilla Díaz-Marta and Anastasiia Kyrylenko, 'The ever-growing scope of Geographical Indications' evocation: from Gorgonzola to Morbier', in *Journal of Intellectual Property Law & Practice*, 2021, Vol. 16, No. 4-5, p. 447; Case C-490/19 *Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois SAS* [2019], Opinion of AG M. GIOVANNI PITRUZZELLA, para. 18.

⁷⁴ Ibid.

⁷⁵ Case C-783/19 *Comité Interprofessionnel du Vin de Champagne v GB* [2021].

⁷⁶ The term "*Champanillo*" in Spanish means "little Champagne".

⁷⁷ Case C-783/19 *Comité Interprofessionnel du Vin de Champagne v GB* [2021], para. 15.

Spanish court to prohibit this use. The Spanish court requested the CJEU to interpret EU law on the protection of products covered by a PDO where the term “*Champanillo*” is used in the course of trade to designate services⁷⁸.



The sign “*Champanillo*”
Source [here](#)

In its decision, the Court first held that “*the regulation protects PDOs vis-à-vis conduct in respect of both products and services*”⁷⁹. To justify its decision, the Court relied on Article 103(2)(b) of Regulation 1308/2013⁸⁰ which provides that a protected name shall be protected against evocation “*even if the true origin of the product or service is indicated*”⁸¹, but also on the objectives of the GI scheme. Indeed, the Court noted that an interpretation that does not grant protection to a PDO where the disputed sign designates a service would be inconsistent with the broad scope granted to the protection of registered GIs and would prevent the protection objective from being fully attained, since the GI protection - in general, not only against evocation - is intended⁸² to be extended to all uses which take advantage of the reputation enjoyed by products covered by a GI⁸³. The Court subsequently added that evocation “*does not require that the product covered by the PDO and the product or service covered by the disputed name be identical or similar*”⁸⁴. Consequently, the CJEU broadened the concept

⁷⁸ Ibid., para. 24.

⁷⁹ Ibid., para. 52.

⁸⁰ The reasoning also applies to Regulation 1151/2012.

⁸¹ Case C-783/19 *Comité Interprofessionnel du Vin de Champagne v GB* [2021], para. 45; The same reasoning applies to other GI Regulations.

⁸² Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013 establishing a common organisation of the markets in agricultural products and repealing Council Regulations (EEC) No 922/72, (EEC) No 234/79, (EC) No 1037/2001 and (EC) No 1234/2007, Recital 97.

⁸³ Case C-783/19 *Comité Interprofessionnel du Vin de Champagne v GB* [2021], paras. 50 and 51.

⁸⁴ Ibid. para. 61; A similar conclusion was reached in the *Champagnola* case held on April 17, 2020, by the EUIPO Board of Appeal (EUIPO DECISION of the Fourth Board of Appeal, Case R 1132/2019-4 *Comité Interprofessionnel Du Vin De Champagne, loi de 1941 v BREADWAY* [2020]). This case concerned the registration of the European trademark “*Champagnola*” for bakery products and services. CIVC filed an opposition on the ground that the use of the term “*Champagnola*” evoked the PDO “*Champagne*”, even if the trademark was sought for products and services not similar to “*Champagne*” products. The Board of Appeal came to the conclusion that “*the term “evocation” is a condition for protection both against comparable goods and against different goods (or even services)*” and that “*Champagnola*” evoked the PDO “*Champagne*”.

of evocation by specifying that the name of a service can also evoke a GI, even if that service is not similar to the product whose name is protected⁸⁵.

III. CONCLUSION

Due to the lack of a definition in the law, the CJEU intervened to clarify the meaning of “evocation”. Today, the concept of “evocation” covers a situation where a term, sign, or other labelling or packaging device presents a direct and clear link with the product covered by the registered GI in the mind of the consumer who should be considered as an average European consumer reasonably well informed and reasonably observant and circumspect. In their assessment, national courts must take into account the following non-cumulative conditions: (i) the partial incorporation of a GI in the disputed name, (ii) any phonetic and/or visual similarity, or (iii) any conceptual proximity, between the contested element and the GI. Evocation extends vis-à-vis conduct in respect of both products and services, and does not require the product covered by the GI and the product or service covered by the disputed element to be identical or similar.

Consequently, the CJEU has clarified the concept of evocation and its assessment through various cases, but above all it has broadened it. The CJEU has gone from an initial interpretation according to which a product’s name may evoke a GI to an interpretation under which any name, sign or figure of a dissimilar product or service may evoke a GI even if there is no partial incorporation of the registered name. This broad interpretation is assessed regarding the rationales and object of the GI protection in Chapter II, and is compared to the reputed European trademark protection in Chapter III.

⁸⁵ The outcome of the case is that the Spanish court found that there was an evocation of the PDO “*Champagne*”.

CHAPTER II: ASSESSMENT OF THE CJEU’S INTERPRETATION IN LIGHT OF THE GI RATIONALES AND OBJECT OF PROTECTION

This Chapter intends to assess the CJEU’s interpretation of “evocation” with the GI rationales and object of protection⁸⁶ as a benchmark. To this end, Section I discusses the rationales of the GI scheme in order to establish the needed benchmark. Section II then assesses the current interpretation of evocation in light of the established benchmark⁸⁷.

I. RATIONALES OF GI PROTECTION

As will be shown in this Section, the three main rationales of the GI scheme are (i) promoting rural developments, (ii) indicating geographical origin and preventing confusion of the consumer, and (iii) protecting producers against misappropriation.

1. Promoting rural developments

Promoting rural developments is considered as the most fundamental rationale for protecting GIs in the EU⁸⁸ and is expressed in Recital 4 of Regulation 1151/2012⁸⁹. The underlying idea is that GIs stimulate all components of the rural economy and thereby protect the resources of a region⁹⁰. Indeed, regional resources are protected through GIs by making them part of the product specification: “*production techniques, varieties and species, the landscape and environment of the region as well as cultural and historical resources, and local savoir-faire*”

⁸⁶ As explained in the Introduction, the object of the GI protection is theoretically limited to the name of the product and is not intended to protect all the elements which are structurally or circumstantially present in a product as such; See Vicente Zafrilla Díaz-Marta and Anastasiia Kyrylenko, ‘The ever-growing scope of Geographical Indications’ evocation: from Gorgonzola to Morbier’, in *Journal of Intellectual Property Law & Practice*, 2021, Vol. 16, No. 4-5, p. 448; See also Case C-490/19 *Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois SAS* [2019], para. 36;

⁸⁷ This benchmark also includes the object of the GI protection.

⁸⁸ Anke Moerland, ‘Geographical Indications and Innovation: what is the connection?’ in: J. Drexler & A. Kamperman Sanders (eds.), *The Innovation Society and Intellectual Property*, Edward Elgar, 2019, p. 74.

⁸⁹ Recital 4 of Regulation 1151/2012 provides that “*Operating quality schemes for producers which reward them for their efforts to produce a diverse range of quality products can benefit the rural economy. This is particularly the case in less favoured areas, in mountain areas and in the most remote regions, where the farming sector accounts for a significant part of the economy and production costs are high. In this way quality schemes are able to contribute to and complement rural development policy as well as market and income support policies of the common agricultural policy (...)*”.

⁹⁰ Anke Moerland, ‘Geographical Indications and Innovation: what is the connection?’ in: J. Drexler & A. Kamperman Sanders (eds.), *The Innovation Society and Intellectual Property*, Edward Elgar, 2019, p. 75.

*are described in detail and will have to be complied with by all producers of the origin-labelled product*⁹¹.

Additionally, these regional resources are reflected in the product qualities and lead to differentiating those products from the others in the market. This product differentiation can create a niche market where the added value of product differentiation is transformed into an economic rent by (i) providing higher incomes for the producers of the GIs products thanks to premium prices, and (ii) creating supply restrictions and barriers to entry (by delimiting the area of origin and establishing defined practices)⁹². The advantage of those limitations is that competitors from outside the region and producing similar products which do not comply with the product specifications are not allowed to use the protected name and therefore do not benefit from the premium price the product may receive⁹³. Finally, a successful GI should help preserve cultural heritage and conserve agricultural and biodiversity systems, as producers will be interested in preserving them to earn the money they get from using them⁹⁴.

2. Indicating geographical origin and preventing confusion of the consumer

The GI scheme guarantees the geographical origin of goods and the special qualities inherent in them to consumers⁹⁵, thereby reducing the search cost for consumers and preventing their deception as to the geographical origin and the inherent qualities of the product⁹⁶. This specific function is essential when it comes to agro-food products. Indeed, these kinds of products usually do not provide information on their quality before purchase and can therefore be classified as experience goods, meaning that consumers prefer to ensure their quality after purchase by using and experiencing them themselves⁹⁷. This specific characteristic of agro-food implies that consumers do not always have the relevant information - that producers have - on the price, quality, origin, or other characteristics of the products before buying them⁹⁸. This

⁹¹ Ibid.

⁹² Ibid.

⁹³ Ibid., p. 75 and 76.

⁹⁴ Ibid.

⁹⁵ Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs, Article 4.

⁹⁶ Anke Moerland, 'Geographical Indications and Innovation: what is the connection?' in: J. Drexl & A. Kamperman Sanders (eds.), *The Innovation Society and Intellectual Property*, Edward Elgar, 2019, p. 76.

⁹⁷ Ibid.

⁹⁸ Ibid.

asymmetry of information between producers and consumers can lead to market distortions⁹⁹, as consumers risk buying an inferior product due to adverse selection¹⁰⁰, and producers maintaining the quality of their products are exposed to unfair competition from producers who sell lower quality products at the same price¹⁰¹. GIs are one of the tools that allow producers to provide all this relevant information to consumers and thereby differentiate GI products from the others, which ultimately enables consumers to make choices on the relevant characteristics of the product¹⁰².

3. Protecting producers against misappropriation

The third rationale behind the GI scheme is to protect producers against misappropriation. The underlying idea is that any misuse of GIs should be prevented in the interests of producers who have created a reputation and made a genuine effort to guarantee the expected quality of products whose names are protected¹⁰³. Indeed, producers have a significant contribution to the production of GI products as they play a crucial role in developing, maintaining and producing those products¹⁰⁴. Therefore, they should be granted some advantages to promote and protect their investments in the production of distinct authentic products¹⁰⁵.

By protecting producers against misappropriation, GIs also ensure fair competition for farmers and producers of protected products¹⁰⁶. To achieve this fair competition, there must be a

⁹⁹ Cerkia Bramley, Estelle Biénabe and Johann Kirsten, ‘The economics of geographical indications: Towards a conceptual framework for geographical indication research in developing countries’ in WIPO (ed.), *The Economics of Intellectual Property: Suggestions for Further Research in Developing Countries and Countries with Economies in Transition* (Geneva: WIPO, 2009), p. 114.

¹⁰⁰ Ibid. p. 115; Anke Moerland, ‘Geographical Indications and Innovation: what is the connection?’ in: J. Drexl & A. Kamperman Sanders (eds.), *The Innovation Society and Intellectual Property*, Edward Elgar, 2019, p. 76.

¹⁰¹ Cerkia Bramley, Estelle Biénabe and Johann Kirsten, ‘The economics of geographical indications: Towards a conceptual framework for geographical indication research in developing countries’ in WIPO (ed.), *The Economics of Intellectual Property: Suggestions for Further Research in Developing Countries and Countries with Economies in Transition* (Geneva: WIPO, 2009), p. 115.

¹⁰² Anke Moerland, ‘Geographical Indications and Innovation: what is the connection?’ in: J. Drexl & A. Kamperman Sanders (eds.), *The Innovation Society and Intellectual Property*, Edward Elgar, 2019, p. 77.

¹⁰³ Ibid., p. 78; See also Case C-44/17 *Scotch Whisky Association v Michael Klotz* [2018], Opinion of AG SAUGMANDSGAARD ØE, para. 38: “it appears to me that the aim of the provisions of Regulation No 110/2008, and in particular Article 16, is to prevent the misuse of protected geographical indications, not only in the interests of consumers, but also producers who have made a genuine effort to guarantee the expected quality of products bearing such indications”.

¹⁰⁴ Anke Moerland, ‘Governance Systems of Geographical Indications: An Example of Institutions Enabling Trust and Cooperation among Producers’ in: D. Prévost, I. Alexovicova, & J. Hillebrand Pohl (Eds.), *Restoring Trust in Trade: Liber Amicorum In Honour of Peter Van den Bossche*, Hart Publishing. (1 ed.), 2018, p. 74.

¹⁰⁵ Ibid.

¹⁰⁶ Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs, Article 1.

European-level scrutiny of applications which ensures the homogeneity of treatment of the applications submitted by the different Member States¹⁰⁷, and an effective control in the different Member States at all stages, from farmers to consumers, because such controls can guarantee that farmers or producers involved in the GI scheme do not compete on the market with other producers who use the protected names without complying with the GIs rules¹⁰⁸.

4. Conclusion

When the CJEU determines the scope of “evocation”, it is crucial that it does so with the GI rationales in mind. These rationales are (i) promoting rural developments, (ii) indicating geographical origin and preventing confusion of the consumer, and (iii) protecting producers against misappropriation. Overall, the rationales of the GI scheme focus on the protection of producers, consumers and the rural economy.

II. ASSESSMENT OF THE CJEU’S INTERPRETATION IN LIGHT OF THE GI RATIONALES AND OBJECT OF PROTECTION

This Section intends to assess the CJEU’s interpretation of evocation by highlighting the potential problems of this interpretation. The assessment is done in light of the GI rationales ((i) promoting rural development, (ii) indication of origin and preventing confusion of consumer, (iii) protecting producers against misappropriation) and object of GI protection (a product’s name).

1. Evocation extends to dissimilar goods and services

In *Champanillo*, the CJEU held that evocation protects GIs vis-à-vis conduct in respect of both products and services, even if the product covered by the GI and the product or service covered by the disputed name are neither identical nor similar¹⁰⁹. In light of the current interpretation of evocation, the question arises of whether there is still room for actors in the market to use fairly a name evoking a GI for dissimilar products or services without fear of infringement¹¹⁰. Indeed,

¹⁰⁷ Ibid.

¹⁰⁸ Ibid.

¹⁰⁹ Case C-783/19 *Comité Interprofessionnel du Vin de Champagne v GB* [2021].

¹¹⁰ Max Walters, ‘GI owners toast success as evocation threshold ‘lowered’’, <<https://www.managingip.com/article/b1tz2p2l2bdt35/gi-owners-toast-success-as-evocation-threshold-lowered>>

the CJEU has not yet pronounced itself on whether the exploitation of the reputation of a GI is *per se* a condition to find evocation¹¹¹. If the exploitation of the GI's reputation is not a mandatory condition to find evocation, there can theoretically¹¹² be situations where the use of a name for a service or product is prohibited because it evokes a dissimilar GI even though there is no unfair exploitation of the GI's reputation, thereby going beyond the rationale of protecting producers against misappropriation and being problematic for the competition¹¹³. The applicability of this condition would ensure that all prohibited uses under evocation are unfair, in the sense that those uses would exploit the reputation of GIs¹¹⁴.

By contrast, a systematic argument can be raised against the applicability of such a condition under the scope of evocation: Article 13(a) of Regulation 1151/2012 explicitly mentions the exploitation of reputation¹¹⁵ as a criterion to protect GIs, but such a mention does not exist in Article 13(b). If the legislator had wanted to protect the reputational function of GIs under evocation, it would have included a mention of it as it did in Article 13(a)¹¹⁶. However, in light of the Proposal to review the GIs system for wine, spirit drinks and agricultural products, the concept of evocation seems to be intended to protect the reputational function¹¹⁷.

accessed 13 June 2022; Recital 97 of Regulation 1308/2013 states that protection should extend to products and services “to promote fair competition and not to mislead consumers”.

¹¹¹ Manon Verbeeren and Olivier Vrins, ‘The protection of PDOs and PGIs against evocation: a ‘Grand Cru’ in the CJEU’s cellar?’ in *Journal of Intellectual Property Law & Practice*, Volume 16, Issue 4-5, April-May 2021, p. 328; In the *Champagner Sorbet* case, the Advocate General said in his Opinion that there is a **presumed intention** to exploit the reputation of a GI for uses falling under the scope of evocation, but the CJEU did not rule on this point (Case C-393/16 *Comité Interprofessionnel du Vin de Champagne v Aldi Süd Dienstleistungs-GmbH & Co. OHG* [2017], Opinion of AG CAMPOS SÁNCHEZ-BORDON, para. 46).

¹¹² In practice, however, it is unlikely that the name of a service or a good evokes a dissimilar GI product without exploiting the reputation of a GI, but a clarification of the CJEU or the legislation on this matter would be relevant.

¹¹³ By way of comparison, as will be discussed in Chapter III, the protection of reputed European trademarks also extends to dissimilar goods or services, but the trademark owner must prove that the contested sign takes **unfair advantage** of, or is detrimental to, the distinctive character or **the reputation** of the trademark.

¹¹⁴ If this condition comes into force, Article 13(b) of Regulation 1151/2012 would still differ from Article 13(a) in that Article 13(a) requires the “use” of the GI or a similar name, where Article 13(b) requires any similarity that can evoke the GI; See Richard Davis and Others, *Tritton on Intellectual Property in Europe* (5th edn Sweet & Maxwell 2018), p. 541.

¹¹⁵ Article 13(a) of Regulation 1151/2012 prohibits any direct or indirect commercial use of a registered name in respect of products not covered by the registration where using the name exploits the reputation of the protected name, including when those products are used as an ingredient, and the prohibition extends to dissimilar products; According to Case C-393/16 *Comité Interprofessionnel du Vin de Champagne v Aldi Süd Dienstleistungs-GmbH & Co. OHG* [2017], para. 40, “*exploitation of the reputation of a PDO entails use of the PDO that seeks to take undue advantage of the reputation enjoyed by the PDO*”.

¹¹⁶ Vicente Zafrilla Díaz-Marta and Anastasiia Kyrlyenko, ‘The ever-growing scope of Geographical Indications’ evocation: from Gorgonzola to Morbier’, in *Journal of Intellectual Property Law & Practice*, 2021, Vol. 16, No. 4-5, p. 446.

¹¹⁷ Proposal for a Regulation of the European Parliament and of the Council on European Union geographical indications for wine, spirit drinks and agricultural products, and quality schemes for agricultural products, amending Regulations (EU) No 1308/2013, (EU) 2017/1001 and (EU) 2019/787 and repealing Regulation (EU) No 1151/2012, Article 27.

2. No exception for producers based in the same region as a GI

Under the current interpretation of evocation¹¹⁸, any reference to a geographical area by a producer whose products do not comply with existing GI specifications coming from the same geographical area may constitute an evocation, even if the reference is true¹¹⁹. As an example, if a producer coming from the Champagne region wants to market a sparkling wine without complying with the existing Champagne specifications, this producer is not allowed to make any reference to the Champagne region as such a reference can lead to the evocation of the GI “*Champagne*”. As it follows from the *Mancheogo* case, even the use of a figure referring to the Champagne region may lead to the evocation of the GI “*Champagne*”¹²⁰. This prohibition is problematic for the freedom of expression of producers who cannot indicate to consumers the true origin of their products, thereby amounting to unfair competition¹²¹. Indeed, unlike producers of GI products, producers of non-GI products are prevented from indicating the geographical origin of their products to consumers. Furthermore, such a prohibition does not fully fulfill the rationale of protecting rural development/economy: GI producers are not the only representatives of the EU rural economy, which means that overprotecting¹²² GI producers at a high cost for the other producers operating in the EU rural economy does not contribute to the full attainment of this rationale¹²³.

The CJEU justified this absence of exception by specifying that such an exception would allow producers whose products do not comply with existing GI specifications coming from the same geographical area to take unfair advantage of the reputation of that GI¹²⁴. It also specified that

¹¹⁸ 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* [2019], para. 36.

¹¹⁹ Valeria Paganizza, ‘More Holes than Cheese: PDOs, Evocation and a Possible Solution’ in *EFFL*, 2013, p. 225; Vito Rubino, ‘The “indirect” or “conceptual” evocation of a protected designation of origin and its practical and juridical effect after ECJ case Queso manchego’ in *Revista de Derecho Comunitario Europeo*, 64, 2019, p. 974.

¹²⁰ 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* [2019].

¹²¹ Valeria Paganizza, ‘More Holes than Cheese: PDOs, Evocation and a Possible Solution’ in *EFFL*, 2013, p. 225; Irene Calboli, ‘Geographical Indications of Origin at the Crossroads of Local Development, Consumer Protection and Marketing Strategies’ in *International Review of Intellectual Property and Competition Law*, 2015, p. 771; Vito Rubino, ‘The “indirect” or “conceptual” evocation of a protected designation of origin and its practical and juridical effect after ECJ case Queso manchego’ in *Revista de Derecho Comunitario Europeo*, 64, 2019, p. 974.

¹²² In the sense that any reference to a geographical area by a producer whose products do not comply with existing GI specifications coming from the same geographical area may constitute an evocation.

¹²³ Vicente Zafrilla Díaz-Marta and Anastasiia Kyrlylenko, ‘The ever-growing scope of Geographical Indications’ evocation: from Gorgonzola to Morbier’, in *Journal of Intellectual Property Law & Practice*, 2021, Vol. 16, No. 4-5, p. 447.

¹²⁴ 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* [2019], para. 35; In its opinion, the

when a GI is a compound name, the rule is different. In such a situation, the CJEU held that “*in the absence of specific circumstances pointing to the contrary, the protection afforded by [Article 13 of Regulation 1151/2012] covers not only the compound name as a whole, but also each of its constituent parts, that will be the case only if that constituent part is not a generic or a common term*”¹²⁵. Therefore, if an element of a compound GI is a generic/common term, the use of that term by a third party may not on its own evoke a GI¹²⁶. For example, a producer from the Parma region can use the word “prosciutto” to describe his product even though “*Prosciutto di Parma*” is a protected GI. Nevertheless, the use of a generic or a common term with other words or figurative elements can possibly evoke a GI¹²⁷.

3. The future of the *Morbier* case

As explained in Chapter I, the CJEU did not rule on evocation in the *Morbier* case even though the Advocate General admitted it in his opinion¹²⁸. If the CJEU were to confirm in a future case that the appearance of a product may lead to the evocation of a GI, as has already been done by a court at the national level¹²⁹, this interpretation may arguably go beyond the object of GI

Advocate General added that “*allowing producers which operate in the geographical area associated with a given PDO, but do not comply with the relevant requirements, to use signs evoking that geographical area for products identical or similar to those covered by the PDO would weaken the assurance of quality conferred by that name (...). Furthermore, not to extend the protection from evocation to conduct by local producers that do not comply with the requirements would undermine the rights that must be reserved for producers who have made a genuine effort to improve quality in order to be able to use a registered designation of origin (...), exposing them, (...), to the consequences of unfair competition which, precisely because they come from producers established in the same geographical area, are potentially more harmful*”: see 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* [2019], Opinion of AG PITRUZZELLA, para. 43.

¹²⁵ Case C-432/18 *Consorzio Tutela Aceto Balsamico di Modena v Balema GmbH* [2019], para. 26; According to Article 3(6) of Regulation 1151/2012, generic term “*means the names of products which, although relating to the place, region or country where the product was originally produced or marketed, have become the common name of a product in the Union*”; Additionally, Article 13(2) of Regulation 1151/2012 provides that “*protected designations of origin and protected geographical indications shall not become generic*”.

¹²⁶ Case C-432/18 *Consorzio Tutela Aceto Balsamico di Modena v Balema GmbH* [2019], Opinion of AG M. GERARD HOGAN, para. 28; Manon Verbeeren and Olivier Vrans, ‘The protection of PDOs and PGIs against evocation: a ‘Grand Cru’ in the CJEU’s cellar?’ in *Journal of Intellectual Property Law & Practice*, Volume 16, Issue 4-5, April-May 2021, p. 322.

¹²⁷ *Ibid.*; For example, if a producer uses the word “prosciutto” with figurative elements representing the territory of Parma.

¹²⁸ Case C-490/19 *Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois SAS* [2020].

¹²⁹ For example, the Commercial Court of Appeal of Alicante (October 2013, case No 419/13) found that the PDO “*Queso tetilla*” protected a traditional name that consumers associated with the conical shape of the product in question, and held that the marketing of an identically shaped cheese constituted an infringement of Article 13(1)(b) of Regulation No 1151/2012; See Case C-490/19 *Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois SAS* [2019], Opinion of AG M. GIOVANNI PITRUZZELLA, footnote 42; Organisation for an International Geographical Indications Network (oriGIn), ‘The protection of PDO, PGI

protection. As confirmed by the CJEU, the protection provided by Article 13 of Regulation 1151/2012¹³⁰ concerns the registered name and not the product covered by that name, and the purpose of that protection is not to prohibit the characteristics indicated in the specification of a product covered by a registered name¹³¹. Whereas the GI protection is theoretically limited to the name of the products, the practical consequence of considering that the shape of a product can evoke a protected name is to protect the appearance of GI products. It can be argued that the only situation where the shape of a product may evoke a GI is where a protected name contains an express reference to the typical shape of the product which it designates¹³², but in other situations the shape of a product should only be only a contextual factor for the overall assessment of the existence of an evocation¹³³. Under the Proposal to review the GIs system for wine, spirit drinks and agricultural products, the shape of a product is not mentioned as an element that may evoke a GI¹³⁴.

By way of comparison, the trademark scheme differentiates between a word trademark and a shape trademark. If person A wants to protect the shape of a product, A must file a trademark registration for the product's shape. If person A wants to protect the name of a product, A must file a trademark registration for the product's name. Both registrations can be cumulative. The question of whether a shape can infringe a word trademark is discussed in Chapter III, Section III, Subsection 2.

In summary of the above, even if the shape of a product whose name is protected by a GI should receive some protection, the current wording of the GI Regulations does not seem to grant that

and GIs against “evocation” in the EU regulations and case law’, p. 4, <https://www.origin-gi.com/wp-content/uploads/2021/09/oriGIIn-paper-Evocation-14_09_2021.pdf> accessed 24 May 2022.

¹³⁰ This Article provides that “**Registered names shall be protected (...)**”; Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs, Article 13.

¹³¹ Case C-490/19 *Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois SAS* [2020], para. 36.

¹³² Case C-490/19 *Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois SAS* [2019], Opinion of AG M. GIOVANNI PITRUZZELLA, para. 41; The Commission referred to the following example: the Commercial Court of Appeal of Alicante found that that PDO “*Queso tetilla*” protects “*a traditional name that consumers associated with the conical shape of the product in question, and held that the unauthorised marketing of an identically shaped cheese constituted an infringement of Article 13(1)(b) of Regulation No 1151/2012*”, see Case C-490/19 *Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois SAS* [2019], Opinion of AG M. GIOVANNI PITRUZZELLA, footnote 42.

¹³³ *Ibid.*, para. 46.

¹³⁴ Proposal for a Regulation of the European Parliament and of the Council on European Union geographical indications for wine, spirit drinks and agricultural products, and quality schemes for agricultural products, amending Regulations (EU) No 1308/2013, (EU) 2017/1001 and (EU) 2019/787 and repealing Regulation (EU) No 1151/2012, Article 27.

protection as Article 13 of Regulation 1151/2012 clearly states “**Registered names** shall be protected”.

III. CONCLUSION

The current GI protection against evocation poses various problems in light of the GI rationales and object of protection. First, it may prevent actors of the market from using fairly geographical names for dissimilar products or services without fear of infringement, thereby amounting to unfair competition. Further, producers whose products do not comply with existing GI specifications coming from the same geographical area cannot indicate to consumers the true origin of their products, thereby amounting to unfair competition and being problematic for their freedom of expression. In addition, the GI scheme intends to protect the rural economy, but GI producers seem to be protected at a high cost for the other producers also operating in the EU rural economy. Lastly, the current interpretation of evocation under which the shape of a product may potentially evoke a GI seems to go beyond the object of GI protection (registered names).

CHAPTER III: COMPARISON OF THE CJEU'S INTERPRETATION WITH THE PROTECTION OF REPUTED EUROPEAN TRADEMARKS

A trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises¹³⁵. Within the European Union, the relevant trademark legislation is Directive (EU) 2015/2436¹³⁶ and Regulation (EU) 2017/1001¹³⁷. Trademarks can be registered by anyone at the national or European level if different conditions are met¹³⁸. Once a trademark is registered, it gives its owner the right to exclude others from using that trademark or a similar sign and to oppose the trademark registration of similar signs in specific situations.

Such as geographical indications, trademarks can consist of a simple word, thereby protecting a specific term. However, trademarks differ from GIs in that they may also consist of figurative signs, shapes, colors, sounds, and many other signs. All kinds of trademarks are protected in the same way, except for reputed trademarks. Indeed, reputed European trademarks have broader protection than “not reputed” trademarks, in the sense that the former enjoys an additional ground of protection.

This Chapter intends to analyze the European legal framework of reputed trademarks to use this framework as an additional benchmark to compare the extent of GI protection against evocation with that of reputed European trademark. To this end, Section I discusses the conditions of reputed European trademark protection. Section II shows how the theoretical principles discussed in Section I apply in practice. Lastly, Section III compares the GI protection against evocation with the European reputed trademark protection.

The use of reputed European trademark protection as a benchmark is relevant for three reasons. First, as will be discussed in Section III of this Chapter, the conditions of reputed European trademark protection have similarities with those of GI against evocation. Second, all GIs are considered intrinsically reputed¹³⁹. Third, the rationales for protecting (reputed) trademarks are

¹³⁵ World Intellectual Property Organization, ‘Trademarks’, <<https://www.wipo.int/trademarks/en/>> accessed 10 May 2022.

¹³⁶ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks.

¹³⁷ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark.

¹³⁸ Ibid.

¹³⁹ GIs are considered intrinsically reputed by the mere fact that they are registered, see EUIPO trademark Guidelines, Part C, Section 6, Chapter 3, Subsection 1.1.; This assumption implies that no evidence of the

similar to the rationales for protecting GIs: both schemes are designed to allow product differentiation on the market¹⁴⁰ and indicate an origin (thereby preventing consumer confusion¹⁴¹), such a differentiation enables producers/trademark owners to benefit from premium prices, and both schemes aim to reward producers/trademark owners for their contribution and effort invested in the GI/trademark by avoiding any misappropriation¹⁴².

I. PROTECTION OF REPUTED EUROPEAN TRADEMARKS

Under Article 9(2)(c) of Regulation 2017/1001, the owner of a reputed European trademark is entitled to prevent all third parties from using a sign when the following cumulative conditions are fulfilled:

- (i) Use of the sign takes place without the consent of the trademark owner;
- (ii) Use occurs within the course of trade. This condition implies that the use must “*take place in the context of commercial activity with a view to economic advantage and not as a private matter*”¹⁴³;
- (iii) Use needs to be in relation to goods or services. This condition means that the sign must be used as an indication of origin¹⁴⁴, “*for the purpose of distinguishing goods or services*”¹⁴⁵;
- (iv) The contested sign and the reputed trademark are similar or identical. The assessment of similarity requires a global appreciation of the visual, aural and

reputation of the GI is required. However, the strength of the reputation can be a factor in the assessment of evocation.

¹⁴⁰ For trademarks, see Richard Davis and Others, *Tritton on Intellectual Property in Europe* (5th edn Sweet & Maxwell 2018), p. 283 and 287.

¹⁴¹ For trademarks, see Richard Davis and Others, *Tritton on Intellectual Property in Europe* (5th edn Sweet & Maxwell 2018), p. 280; Case C-487/07 *L'Oréal SA v Bellure NV* [2009] ECR I-05185, para. 7; Case C-102/77 *Hoffmann-La Roche & Co. AG v Centrafarm Vertriebsgesellschaft Pharmazeutischer Erzeugnisse mbH* [1978] ECR1978 -01139, para. 7.

¹⁴² For trademarks, see Frank I. Schechter, ‘The Rational Basis of Trademark Protection’, in *Harvard Law Review* Vol. 40, No. 6 (Apr., 1927), p. 825 to 829; See also Richard Davis and Others, *Tritton on Intellectual Property in Europe* (5th edn Sweet & Maxwell 2018), p. 291;

¹⁴³ Case C-206/01 *Arsenal Football Club plc v Matthew Reed* [2002] ECR I-10273, para. 40.

¹⁴⁴ Richard Davis and Others, *Tritton on Intellectual Property in Europe* (5th edn Sweet & Maxwell 2018), p. 421.

¹⁴⁵ Case C-206/01 *Arsenal Football Club plc v Matthew Reed* [2002] ECR I-10273, para. 35.

conceptual similarity of the signs¹⁴⁶. It must be based on the overall impression given by the signs, bearing in mind their distinctive and dominant components¹⁴⁷, and even a low degree of similarity can be sufficient¹⁴⁸. In the absence of similarity, the assessment stops without the trademark owner having the possibility to argue that other relevant factors could lead the relevant public to make a link between the contested sign and its trademark with a reputation¹⁴⁹;

- (v) The goods or services must not be similar or identical: the prohibition extends to dissimilar goods and services¹⁵⁰;
- (vi) When seeing the two signs, the relevant public must establish a link between the two of them. This condition is not provided by the Regulation but has been established by the CJEU¹⁵¹. This link does not mean that there must be a likelihood of confusion, but only that the contested sign calls the reputed trademark to the mind of the relevant public¹⁵². The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case¹⁵³;
- (vii) The trademark owner must prove the reputation of his trademark. This condition implies a certain degree of knowledge of the trademark among the public¹⁵⁴, meaning that it must be known by a significant part of the public concerned by the

¹⁴⁶ Case C-251/95 *SABEL BV v Puma AG* [1997] ECR I-06191, para. 23.

¹⁴⁷ *Ibid.*; See EUIPO trademark Guidelines, Part C, Section 5, Chapter 3, Subsection 2.

¹⁴⁸ Joined Cases C-581/13 P and C-582/13 P *Intra-Press SAS v Golden Balls* [2014], para. 76.

¹⁴⁹ Louis Louembé, Pierre Massot and Mythili Thaya, 'For a clarification of the concept of similarity—a critical look at European case law on the infringement of trade marks with a reputation' in *Journal of Intellectual Property Law & Practice*, 2021, Vol. 16, No. 8, p. 813.

¹⁵⁰ However, the similarity of the goods can be a factor to take into account when assessing the “link” condition, see EUIPO trademark Guidelines, Part C, Section 5, Chapter 3, Subsection 3.

¹⁵¹ Case C-408/01 *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd.* [2003] ECR I-12537, para. 29.; According to Case C-301/07 *PAGO International GmbH v Tirolmilch registrierte Genossenschaft mbH* [2009] ECR I-09429, para. 22, “*The relevant public is that concerned by the Community trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public*”.

¹⁵² Case C-408/01 *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd.* [2003] ECR I-12537, para. 29.

¹⁵³ *Ibid.*, para. 30; According to Case C-252/07 *Intel Corporation Inc. v CPM United Kingdom Ltd.* [2008] ECR I-08823, para. 42, these relevant factors are “*the degree of similarity between the conflicting marks, the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public, the strength of the earlier mark’s reputation, the degree of the earlier mark’s distinctive character, and the existence of the likelihood of confusion on the part of the public*”.

¹⁵⁴ Case C-375/97 *General Motors Corporation v Yplon SA.* [1999] ECR I-05421, para. 23; See also EUIPO trademark Guidelines, Part C, Section 5, Chapter 3, Subsection 1.1.

goods or services covered by that trademark¹⁵⁵ and in a substantial part of the territory of the EU¹⁵⁶;

- (viii) Use of the sign takes unfair advantage of the distinctive character or the repute of the EU trademark¹⁵⁷, or is detrimental to the distinctive character¹⁵⁸ or the repute¹⁵⁹ of the EU trademark;
- (ix) Use of the sign must be able to affect one or more functions of the reputed trademark, but the application of this condition to reputed trademarks is not clear¹⁶⁰;
- (x) Use of the sign is without due cause. The existence of a cause that justifies the use of the trademark applied for is a defense that a potential infringer may raise¹⁶¹.

¹⁵⁵ Ibid.; According to Case C-375/97 *General Motors Corporation v Yplon SA*. [1999] ECR I-05421, para. 27, examples of the relevant factors are “*the market share held by the trademark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it*”.

¹⁵⁶ Case C-301/07 *PAGO International GmbH v Tirolmilch registrierte Genossenschaft mbH* [2009] ECR I-09429, para. 27.

¹⁵⁷ According to Case C-487/07 *L'Oréal SA v Bellure NV* [2009] ECR I-05185, para. 41, taking unfair advantage of the distinctive character or the repute of the EU trademark covers cases “*where a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of his own in that regard, the marketing effort expended by the proprietor of that mark in order to create and maintain the image of that mark*”; In para. 44 of this case, the CJEU specified that to determine whether there is unfair advantage, “*it is necessary to undertake a global assessment, taking into account all factors relevant to the circumstances of the case, which include the strength of the mark's reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods or services concerned*”.

¹⁵⁸ According to Case C-252/07 *Intel Corporation Inc. v CPM United Kingdom Ltd.* [2008] ECR I-08823, para. 29, use detrimental to the distinctive character of the reputed trademark covers cases where the reputed trademark's ability to “*identify the goods or services for which it is registered and used as coming from the proprietor of that mark is weakened, since use of the later [sign] leads to dispersion of the identity and hold upon the public mind of the earlier mark*”; In para. 77 of that case, the CJEU specified that “*evidence of a change in the economic behaviour of the average consumer of the goods or services for which the reputed mark was registered consequent on the use of the later sign, or a serious likelihood that such a change will occur in the future*” is required.

¹⁵⁹ According to Case C-487/07 *L'Oréal SA v Bellure NV* [2009] ECR I-05185, para. 40, use detrimental to the repute of the reputed trademark covers cases “*where the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark's power of attraction is reduced*”; In para. 40 of that case, the CJEU specified that “*the likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark*”.

¹⁶⁰ Richard Davis and Others, *Tritton on Intellectual Property in Europe* (5th edn Sweet & Maxwell 2018), p. 411.; Examples of the functions of a trademark are the origin function (guaranteeing to consumers the origin of the goods, see Case C-206/01 *Arsenal Football Club plc v Matthew Reed* [2002] ECR I-10273, para. 51), advertising function (proprietor's use of the trademark as a factor in sales promotion or as an instrument of commercial strategy, see Joined cases C-236/08 to C-238/08 *Google France SARL and Google Inc. v Louis Vuitton Malletier SA and others* [2010] ECR I-02417, para. 92), and investment function (proprietor uses its trademark to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty, see Case C-323/09 *Interflora Inc. and Interflora British Unit v Marks & Spencer plc and Flowers Direct Online Ltd.* [2011] ECR I-08625, paras. 60 and 61).

¹⁶¹ EUIPO trademark Guidelines, Part C, Section 5, Chapter 3, Subsection 5.

In addition to this right, Article 8(5) of Regulation 2017/2001 grants the owner of a reputed trademark the right to oppose the registration of a sign as a trademark if all of the above conditions are fulfilled, with the exception of the second and third conditions (use in the course of trade in relation to goods and services).

The right of the trademark owner is subject to derogations, however. One of these derogations is the use in the course of trade, by a third party, of a sign or indication which concerns “*the kind, quality, (...) geographical origin, (...) or other characteristics of the goods or services*”¹⁶². In other words, a trademark owner cannot prohibit a third party from using an indication which concerns the geographical origin of a good or service, even if this indication is a registered trademark. This use made by a third party must be in accordance with honest practices in industrial or commercial matters¹⁶³.

In conclusion, the owner of a reputed trademark can prevent third parties from using or registering a similar sign when the required conditions are met, but third parties can raise defenses or exceptions to this prohibition.

II. PRACTICAL EXAMPLE

This Section shows how the principles discussed in Section I are applied in practice. To this end, an example inspired by a real case is used¹⁶⁴.

“*Calvin Klein*” is a figurative registered trademark for goods in Class 25¹⁶⁵. Person Y files a trademark registration for the word trademark “*GHLAIN KLAIN*” (for goods identical to those

¹⁶² Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, Article 14(1)(b).

¹⁶³ Ibid., Article 14(2); The CJEU held in Case C-100/02 *Gerolsteiner Brunnen GmbH & Co. and Putsch GmbH* [2004] ECR I-00691, para. 24, that “*The condition of honest practice constitutes in substance the expression of a duty to act fairly in relation to the legitimate interests of the trade mark owner*”; In Case C-228/03 *Gillette Group Finland Oy v LA-Laboratories Ltd Oy* [2005] ECR I-02337, para. 49, the CJEU specified in the context of the “accessories/spare part” defense that “*Use of the trade mark will not be in accordance with honest practices in industrial and commercial matters if, for example: – it is done in such a manner as to give the impression that there is a commercial connection between the third party and the trade mark owner; – it affects the value of the trade mark by taking unfair advantage of its distinctive character or repute; – it entails the discrediting or denigration of that mark; – or where the third party presents its product as an imitation or replica of the product bearing the trade mark of which it is not the owner*”; See also Richard Davis and Others, *Tritton on Intellectual Property in Europe* (5th edn Sweet & Maxwell 2018), p. 429 to 431.

¹⁶⁴ EUIPO DECISION of the Fourth Board of Appeal, Case R 1548/2021-4 GHLAIN KLAIN / Calvin Klein (fig.) et al. [2022].

¹⁶⁵ Specifically, the trademark is registered for men’s, boy’s, women’s and girl’s underwear.

of the “*Calvin Klein*” trademark). Considering that the sign “*GHLAIN KLAIN*” should not be registered as a trademark, the owner of the “*Calvin Klein*” trademark files an opposition against the registration of the word trademark “*GHLAIN KLAIN*” based on Article 8(5) of Regulation 2017/2001. Can Y’s sign be registered as a trademark? It is assumed that the trademark owner has not consented to the use of the sign “*GHLAIN KLAIN*”.

<i>Contested sign</i>	<i>Earlier mark</i>
GHLAIN KLAIN	Calvin Klein

This image comes from the EUIPO decision¹⁶⁶

First, the similarity between the signs must be assessed¹⁶⁷. Visually, the two signs have a similar structure: they are both composed of 2 elements, with the same number of letters in both signs, and the second elements only differ with the third vowel. Therefore, the two signs are visually similar to a low degree¹⁶⁸. Then, it can be claimed that the two signs are aurally similar to a below-average degree: the second elements of the conflicting signs are almost identical, but the first elements are pronounced differently¹⁶⁹. In this situation, the possible conceptual similarity between the two signs is negligible¹⁷⁰.

Then, the owner of the trademark “*Calvin Klein*” has to demonstrate that his trademark has a reputation for the public in the EU in respect of the goods in Class 25. It can be concluded that the trademark “*Calvin Klein*” has been subject to a long-standing and intensive use, and is generally known by the public in the EU in respect of the goods in Class 25¹⁷¹. Therefore, the trademark “*Calvin Klein*” has acquired a high degree of distinctiveness through its use on the market.

¹⁶⁶ EUIPO DECISION of the Fourth Board of Appeal, Case R 1548/2021-4 *GHLAIN KLAIN / Calvin Klein (fig.) et al.* [2022]
¹⁶⁷ *Ibid.*, paras. 20 to 23.
¹⁶⁸ *Ibid.*, para. 21.
¹⁶⁹ *Ibid.*, para. 22.
¹⁷⁰ *Ibid.*, para. 23.
¹⁷¹ *Ibid.*, para. 24; According to Case C-375/97 *General Motors Corporation v Yplon SA*. [1999] ECR I-05421, para. 27, examples of relevant factors to take into account are “the market share held by the trademark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it”.

The next condition to assess is whether the consumer, upon seeing the trademark “*GHLAIN KLAIN*” used in relation to the goods covered by it, will call to mind the trademark “*Calvin Klein*”¹⁷². Due to the similarity between the two signs, the high degree of distinctiveness acquired by the trademark “*Calvin Klein*”, and the degree of closeness between the conflicting goods (they are identical), it seems that when seeing the two signs, the relevant public will establish a link between the two of them.

Finally, the owner of the trademark “*Calvin Klein*” must establish that the use of the trademark “*GHLAIN KLAIN*” will take unfair advantage of, or be detrimental to, the distinctiveness or reputation of his trademark. In this example, the applicant chose the trademark “*GHLAIN KLAIN*” to ride on the coat-tails of the reputed trademark “*Calvin Klein*”, benefitting from the power of attraction, reputation and prestige of the reputed trademark and exploiting, without paying any financial compensation, the marketing effort expended by the proprietor of the trademark to create and maintain the image of that trademark¹⁷³. Consequently, the use of the sign “*GHLAIN KLAIN*” takes unfair advantage of the distinctiveness and reputation of the trademark Calvin Klein. There is no due cause or exception applicable in this situation.

Consequently, the sign “*GHLAIN KLAIN*” cannot be registered as a trademark.

III. COMPARISON WITH THE PROTECTION OF GIs AGAINST EVOCATION

This Section intends to compare the reputed European trademark protection with the GI protection against evocation. To this end, this Section firstly compares the conditions of and exceptions¹⁷⁴ to the GI protection against evocation with that of reputed European trademarks, and then compares their scope of protection by assessing whether an image or a shape can infringe a word trademark.

¹⁷² EUIPO DECISION of the Fourth Board of Appeal, Case R 1548/2021-4 *GHLAIN KLAIN* / *Calvin Klein* (fig.) et al. [2022], paras 25 to 29.

¹⁷³ *Ibid.*, para. 31.

¹⁷⁴ This thesis only focuses on the exception(s) relevant for the comparison between GIs and reputed European trademarks.

1. Comparison of the conditions and exceptions

The table displayed below serves to compare the conditions of and exceptions¹⁷⁵ to the protection of GIs against evocation and reputed European trademarks.

	<u>GIs against evocation</u>	<u>Reputed trademarks</u>
	Conditions	Conditions
1)	No compliance with the product's specifications. Consent irrelevant.	No consent of the proprietor
2)	/	Use in the course of trade
3)	For both similar and dissimilar products and services	For both similar and dissimilar products and services
4)	Partial incorporation of a GI in the disputed sign, phonetic and/or visual similarity, or any conceptual proximity between the contested element and the GI are factors to take into account	The two signs are similar or identical (phonetic, aural and conceptual similarity)
5)	Clear and direct link between the contested element and the product covered by the GI in the mind of the consumer. No likelihood of confusion necessary	The contested sign calls the reputed trademark to the mind of the consumer ("link" condition). No likelihood of confusion necessary
6)	Reputation is inherent in GIs ¹⁷⁶	Proof of the reputation is mandatory
7)	The CJEU has not yet pronounced itself on whether the exploitation of	Unfair advantage of, or detriment to, the distinctive character or the reputation of the EU trademark

¹⁷⁵ This thesis only focuses on the exception(s) relevant for the comparison between GIs and reputed European trademarks.

¹⁷⁶ GIs are considered intrinsically reputed by the mere fact that they are registered, see EUIPO trademark Guidelines, Part C, Section 6, Chapter 3, Subsection 1.1.; This assumption implies that no evidence of the reputation of the GI is required. However, the strength of the reputation can be a factor in the assessment of evocation.

	the reputation of a GI is <i>per se</i> a condition to find evocation ¹⁷⁷	
8)	/	No infringement if due cause
	Exception	Exception
1)	No reference to a geographical area by a producer whose products do not comply with existing GI specifications coming from the same geographical area. Exception if an element of a compound GI is a generic element ¹⁷⁸	Exception for indications of characteristics of goods and services, such as the geographical origin ¹⁷⁹

a. Comparison

Several elements can be drawn from this table. First, the similarity between the goods or services concerned is not a condition for either protection¹⁸⁰, which implies that the two scopes of protection are identical on this matter. Second, neither scheme requires a likelihood of confusion from consumers. In reputed trademark cases, the contested sign must call the reputed trademark to the mind of the consumer¹⁸¹, and this link is sufficient¹⁸². In GI evocation cases, the national court must assess whether there is a clear and direct link between the contested element and the product covered by the GI in the mind of the consumer, and it is irrelevant whether a likelihood of confusion can be established or not¹⁸³.

¹⁷⁷ Manon Verbeeren and Olivier Vrins, ‘The protection of PDOs and PGIs against evocation: a ‘Grand Cru’ in the CJEU’s cellar?’ in *Journal of Intellectual Property Law & Practice*, Volume 16, Issue 4-5, April-May 2021, p. 328.

¹⁷⁸ See Chapter II, Section II, Subsection 2.

¹⁷⁹ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, Article 14(b).

¹⁸⁰ For GIs, see Case C-783/19 *Comité Interprofessionnel du Vin de Champagne v GB* [2021]; For trademarks, see Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, Article 9(2)(c).

¹⁸¹ EUIPO trademark Guidelines, Part C, Section 5, Chapter 3, Subsection 3.

¹⁸² The threshold is lower than that required for likelihood of confusion, see Case C-408/01 *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd.* [2003] ECR I-12537, para. 31: “*The protection conferred (...) is not conditional on a finding of a degree of similarity between the mark with a reputation and the sign such that there exists a likelihood of confusion between them on the part of the relevant section of the public. It is sufficient for the degree of similarity between the mark with a reputation and the sign to have the effect that the relevant section of the public establishes a link between the sign and the mark*”.

¹⁸³ According to EUIPO trademark Guidelines, Part B, Section 4, Chapter 10, Subsection 4.2.2, “*it is irrelevant whether a likelihood of confusion can be established or not in order to find that there is evocation of the GI (...), there can be ‘evocation’ even in the absence of any likelihood of confusion*”.

Third, in reputed trademark cases, the trademark owner can consent to the use of his trademark, while the consent is irrelevant in GI cases: the question is whether there is compliance with the GI product's specifications. Fourth, in reputed trademark cases, the use of the contested sign must occur in the course of trade, whereas such a condition does not have to be established in GI law. However, this condition seems to be subject to a lenient test in practice. For example, the CJEU held that the use “*by an advertiser of a sign identical with a trade mark as a keyword in the context of an internet referencing service*”¹⁸⁴ and “*an operation consisting, on the part of the third party, of removing signs identical to the trade mark in order to affix its own signs*”¹⁸⁵ meet this condition.

Fifth, unlike GIs that are considered intrinsically reputed¹⁸⁶, the owner of a reputed trademark must establish that his trademark has a reputation. This difference implies that while the GI protection against evocation extends to all GIs, the reputed trademark protection only applies to trademarks whose reputation has been proven¹⁸⁷. Sixth, the owner of a reputed trademark must establish that the use of the contested sign takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of his trademark. By contrast, in GI cases against evocation, the CJEU has not yet pronounced itself on whether the exploitation of the reputation of a GI is *per se* a condition to find evocation¹⁸⁸. In the Proposal to review the GIs system for wine, spirit drinks and agricultural, evocation requires that the contested element exploits, weakens, dilutes or is detrimental to the reputation of the registered name¹⁸⁹, which is similar to the condition in reputed trademark cases.

¹⁸⁴ Joined cases C-236/08 to C-238/08 *Google France SARL and Google Inc. v Louis Vuitton Malletier SA and others* [2010] ECR I-02417, paras. 52 and 73.

¹⁸⁵ Case C-129/17 *Mitsubishi Shoji Kaisha Ltd and Mitsubishi Caterpillar Forklift Europe BV v Duma Forklifts NV and G.S. International BVBA* [2018], para. 48.

¹⁸⁶ Manon Verbeeren and Olivier Vrins, ‘The protection of PDOs and PGIs against evocation: a ‘Grand Cru’ in the CJEU’s cellar?’ in *Journal of Intellectual Property Law & Practice*, Volume 16, Issue 4-5, April-May 2021, p. 328.

¹⁸⁷ As a reminder, this condition implies a certain degree of knowledge of the trademark among the public, meaning that it must be known by a significant part of the public concerned by the goods or services covered by that trademark and in a substantial part of the territory of the EU; See Chapter III, Section I.

¹⁸⁸ Manon Verbeeren and Olivier Vrins, ‘The protection of PDOs and PGIs against evocation: a ‘Grand Cru’ in the CJEU’s cellar?’ in *Journal of Intellectual Property Law & Practice*, Volume 16, Issue 4-5, April-May 2021, p. 328.

¹⁸⁹ Proposal for a Regulation of the European Parliament and of the Council on European Union geographical indications for wine, spirit drinks and agricultural products, and quality schemes for agricultural products, amending Regulations (EU) No 1308/2013, (EU) 2017/1001 and (EU) 2019/787 and repealing Regulation (EU) No 1151/2012, Article 27 provides that “(...)For the purposes of [evocation], the evocation of a geographical indication shall arise, in particular, where a term, sign, or other labelling or packaging device presents a direct and clear link with the product covered by the registered geographical indication in the mind of the reasonably circumspect consumer, **thereby exploiting, weakening, diluting or being detrimental to the reputation of the registered name**”.

Lastly, another difference between the two schemes lies in the existence of a due cause defense and of an exception to the right. As regards the due cause defense provided in trademark law, there is nothing similar for GI evocation cases. Concerning the exception, as explained in Section I of this Chapter, the owner of a (reputed) trademark cannot prohibit a third party from using an indication that concerns the geographical origin of a good or service. For example, let us assume that “*Coffee from Peru*” is a registered trademark¹⁹⁰. Due to the limitation provided by Article 14(b) of Regulation 2017/1001, the owner of the trademark would be unable to prohibit third parties from using a term such as “*Peruvian type coffee*” if this use is in accordance with honest practices in industrial or commercial matters¹⁹¹. This exception does not exist in the GI scheme¹⁹². If “*Coffee from Peru*” were a registered GI, any reference that could evoke that GI, such as “*Peruvian type coffee*”, could potentially be prohibited.

b. What can be learned from the comparison?

The conditions of protection of reputed European trademarks and GIs against evocation are similar, but also differ in the sense that there are more conditions in reputed trademark law than in GI law against evocation. As the main differences, unlike GI owners, the trademark owner must prove (i) the reputation of his trademark and (ii) that the contested use, without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of his trademark - it is still unclear whether or not exploiting the GI’s reputation is a condition for evocation. As regards the exceptions, there is an important difference. A trademark owner cannot prohibit a third party from using an indication which concerns the geographical origin of a good or service even if this indication is a registered trademark, while in GI evocation cases any reference to a geographical area by a producer whose products do not comply with existing GI specifications coming from the same geographical area is prohibited¹⁹³. This difference implies that in the same situation, an indication may evoke a GI but not infringe a trademark identical to the GI.

¹⁹⁰ Gail Elizabeth Evans, ‘The Comparative Advantages of Geographical Indications and Community Trade Marks for the Marketing of Agricultural Products’ in *Yearbook of European Law*, Volume 29, Issue 1, 2010, p. 255.

¹⁹¹ Ibid.

¹⁹² As explained in Chapter II, Section II, Subsection 2, there is an exception to the evocation rule when an element of a compound GI is a generic element; Case C-432/18 *Consorzio Tutela Aceto Balsamico di Modena v Balema GmbH* [2019].

¹⁹³ Except if an element of a compound GI is a generic element, see Chapter II, Section II, Subsection 2.

2. Can a word trademark be infringed by an image or a shape?

As explained in Section II of Chapter I, (i) it follows from the *Manchego*¹⁹⁴ case that an image can evoke a GI, and (ii) the CJEU held in *Morbier*¹⁹⁵ that a shape can infringe a GI¹⁹⁶. Those two interpretations have broadened the scope of “evocation”, and the latter case has raised some questions as GI protection is theoretically intended to protect a product’s name. Are these GI rulings applicable to reputed word trademark cases? Despite the differences in the conditions for protection with that of GI against evocation, can an image or a shape (a representation of a good) also infringe a reputed word trademark¹⁹⁷? This subsection discusses this issue by assessing whether the conditions for protection can be met.

First, the trademark owner must prove that the use of the contested image/shape takes place without his consent, which should be easy to establish. Second, it must be established that the use occurs within the course of trade in relation to goods and services. As explained in the previous subsection, the latter condition seems to be subject to a lenient test in practice¹⁹⁸. Third, the trademark owner must prove that the contested image/shape and his trademark are similar. This condition can be met even if there is a weak similarity (e.g., a conceptual similarity¹⁹⁹) between the contested image/shape and the trademark²⁰⁰. Fourth, it must be shown that when seeing the two signs, the relevant public establishes a link between the two of them. This

¹⁹⁴ 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* [2019].

¹⁹⁵ Case C-490/19 *Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois SAS* [2020].

¹⁹⁶ As a reminder, the Court did not rule on evocation *per se*, but a shape can potentially evoke a GI; For example, the Commercial Court of Appeal of Alicante (October 2013, case No 419/13), found that the PDO “*Queso tetilla*” protected a traditional name that consumers associated with the conical shape of the product in question, and held that the marketing of an identically shaped cheese constituted an infringement of Article 13(1)(b) of Regulation No 1151/2012; See Case C-490/19 *Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois SAS* [2019], Opinion of AG M. GIOVANNI PITRUZZELLA, footnote 42; Organisation for an International Geographical Indications Network (oriGIn), ‘The protection of PDO, PGI and GIs against “evocation” in the EU regulations and case law’, p. 4, <https://www.origin-gi.com/wp-content/uploads/2021/09/oriGIn-paper-Evocation-14_09_2021.pdf> accessed 24 May 2022.

¹⁹⁷ A word trade mark “*consists exclusively of words or letters, numerals, other standard typographic characters or a combination thereof that can be typed*”, see EUIPO, ‘Trademark definition’, <<https://euipo.europa.eu/ohimportal/en/trade-mark-definition>> accessed 23 July 2022.

¹⁹⁸ See Chapter III, Section III, Subsection 1.a; For example, the CJEU held that the use “*by an advertiser of a sign identical with a trade mark **as a keyword** in the context of an internet referencing service*”¹⁹⁸ or “*an operation consisting, on the part of the third party, of **removing signs** identical to the trade mark in order to affix its own signs*” meets this condition.

¹⁹⁹ EUIPO trademark Guidelines, Part C, Section 2, Chapter 4, Subsection 3.4.4.5; As a fictitious example, a conceptual proximity could be established between a reputed word trademark “TIGER” for bikes and the image of a tiger by a competitor to sell bikes.

²⁰⁰ EUIPO trademark Guidelines, Part C, Section 5, Chapter 3, Subsection 2: in that situation, “*a global assessment must be carried out to ascertain whether, notwithstanding the low degree of similarity, other relevant factors such as the reputation or recognition enjoyed by the earlier mark serve to establish a link between the marks*”.

condition seems rather easy to establish as a weak similarity between the two signs can be sufficient to create the required link²⁰¹. Fifth, the reputation of the European trademark must be established. Lastly, the trademark owner must prove that the use of the contested image/shape, without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trademark²⁰².

In light of the above, like an image or a shape can evoke a GI, it is possible under trademark law that an image or a shape infringes a reputed word trademark. As explained, even a weak similarity between an image/a shape and the word trademark can be sufficient: other factors can also be used to assess whether the relevant public will establish a link between the two of them. The main difference is that contrary to GI cases on evocation, the trademark owner must prove that his trademark has a reputation and that the contested image/shape takes unfair advantage of or is detrimental to the distinctive character or the reputation of the trademark. Further, even if those conditions are met, it does not always imply that there is a trademark infringement as there can be a due cause²⁰³.

In summary, despite the differences in the conditions for protection, the scope of protection of GI against evocation and of trademark with a reputation is similar: in both schemes, an image or a shape can infringe a word (GI's name/word trademark).

IV. CONCLUSION

The reputed European trademark protection is similar to that of GI against evocation: they both extend to dissimilar goods and services, a shape and an image can potentially evoke a GI and

²⁰¹ Case C-408/01 *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd.* [2003] ECR I-12537, para. 31; As a reminder, to establish the link, the following factors can be taken into account: the strength of the reputation of the earlier trademark, the degree of similarity between the conflicting marks, the nature of the goods or services for which the earlier trademark is reputed and the contested image/shape is used, the degree of similarity or the dissimilarity between the goods and services, the degree of distinctive character of the earlier reputed trademark, and the existence of likelihood of confusion on the part of the public. This list is not exhaustive, See Chapter III, Section I of this thesis and EUIPO trademark Guidelines, Part C, Section 5, Chapter 3, Subsection 3.

²⁰² On the use of a sign identical to a trademark as a keyword, the CJEU held in Case C-323/09 *Interflora Inc. and Interflora British Unit v Marks & Spencer plc and Flowers Direct Online Ltd.* [2011] ECR I-08625, para 91, that “(...) where the advertisement displayed on the internet on the basis of **a keyword corresponding to a trade mark with a reputation** puts forward – without offering a mere imitation of the goods or services of the proprietor of that trade mark, without causing dilution or tarnishment and without, moreover, adversely affecting the functions of the trade mark concerned – an alternative to the goods or services of the proprietor of the trade mark with a reputation, it must be concluded that **such use falls, as a rule, within the ambit of fair competition** in the sector for the goods or services **concerned and is thus not without ‘due cause’** (...)”.

²⁰³ *Ibid.*

infringe a word trademark, and the conditions of protection are quite similar. The main differences between the two schemes lie in the additional conditions and defenses/exceptions existing in trademark law. Indeed, unlike GI evocation cases, the owner of a reputed trademark must prove that his trademark has a reputation and that the contested use takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trademark²⁰⁴ - it is still unclear whether or not exploiting the GI's reputation is a condition for evocation. Further, trademark law provides a defense (the due cause) and an exception (indicating the geographical origin) that do not exist in GI law, thereby allowing the use of some contested signs.

Therefore, the broad interpretation of evocation does not greatly differ from the protection afforded to the owners of reputed European trademarks, but the latter requires the establishment of additional conditions and provides more defenses/exceptions.

²⁰⁴ Even if, as a reminder, the CJEU has not yet pronounced itself on whether the exploitation of the reputation of a GI is *per se* a condition to find evocation.

CHAPTER IV: SUGGESTIONS: WHERE COULD THE LIMIT LIE?

This Chapter intends to give suggestions on where the limit of GI protection against evocation could lie in light of the analysis provided in the two previous Chapters.

First, GI protection against evocation should extend to dissimilar goods and services, but exploiting the GI's reputation could be a mandatory condition to find the evocation of a GI²⁰⁵. This condition would ensure that all prohibited uses under evocation are unfair, in the sense that those uses exploit the reputation of GIs. The current version of the GI Proposal for wine, spirit drinks and agricultural products seems to bring the solution to this problem²⁰⁶.

Second, there could be an exception for producers whose products do not comply with existing GI specifications coming from the same geographical area. Indeed, these other producers are also actors of the EU rural economy and should be allowed to indicate to consumers the true origin of their products without fearing evoking a GI. To prevent these other producers from unfairly using this exception, one of the conditions could be that the indication by a third party must be in accordance with honest practices in industrial or commercial matters, as is the case in trademark law²⁰⁷. Introducing such an exception would ensure fair competition between the competitors in the market²⁰⁸.

Finally, except when a protected name contains an express reference to the typical shape of the product which it designates, the CJEU or a future Regulation could specify that the shape of a product cannot *per se* evoke a GI. As explained, if it is accepted that a product's shape may evoke a GI, it results in that the shape of a product is protected even though the GI Regulations expressly provides that "*Registered names*" shall be protected²⁰⁹.

²⁰⁵ As it is required in trademark law under Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, Articles 8(5) and 9(2)(c).

²⁰⁶ Proposal for a Regulation of the European Parliament and of the Council on European Union geographical indications for wine, spirit drinks and agricultural products, and quality schemes for agricultural products, amending Regulations (EU) No 1308/2013, (EU) 2017/1001 and (EU) 2019/787 and repealing Regulation (EU) No 1151/2012, Article 27 provides that "(...)the evocation of a geographical indication shall arise, in particular, where a term, sign, or other labelling or packaging device presents a direct and clear link with the product covered by the registered geographical indication in the mind of the reasonably circumspect consumer, **thereby exploiting, weakening, diluting or being detrimental to the reputation of the registered name**".

²⁰⁷ With the exception provided in Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, Article 14.

²⁰⁸ In the sense that all producers would be able to indicate the true origin of their products to consumers.

²⁰⁹ Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs, Article 13.

CONCLUSION

This thesis has sought to determine (i) how geographical indications are protected against evocation in the EU, (ii) whether the CJEU's interpretation of "evocation" is consistent with the rationales and object of GI protection, (iii) to compare the GI protection against evocation with the reputed European trademark protection, and (iv) to discuss where the limit of the GI protection against evocation could lie. To answer these questions, Article 13 of Regulation 1151/2012 and the CJEU's interpretation of evocation have first been analyzed. This analysis has shown that due to the lack of information on "evocation" in the GI Regulations, the CJEU intervened to clarify this concept. Throughout its different cases, the CJEU has strengthened the GI protection against evocation as it has gone from an initial interpretation according to which a product's name may evoke a GI to an interpretation under which any name, sign or figure of a dissimilar product or service may evoke a GI even if there is no partial incorporation of the registered name.

In light of the three main rationales of the GI scheme ((i) promoting rural developments, (ii) indicating geographical origin and preventing confusion of the consumer, and (iii) protecting producers against misappropriation) and the GI object of protection (a product's name), three problems arise from the CJEU's interpretation of evocation. First, as the CJEU has not yet pronounced itself on whether the exploitation of the reputation of a GI is *per se* a condition to find evocation, the risk exists that the use of a name for a product or service evoking a dissimilar GI is prohibited even though there is no unfair appropriation of a GI, thereby going beyond the rationale of protecting producers against misappropriation and being problematic for the competition. Second, producers whose products do not comply with existing GI specifications coming from the same geographical area cannot indicate to consumers the true origin of their products, even if the reference is true. This prohibition is problematic for the freedom of expression of producers and amounts to unfair competition. Third, the CJEU in *Morbier* held that the shape of a product can infringe a GI (without specifying if a shape can evoke a GI). If such an interpretation applies to GI evocation cases, it results in the shape of that product being protected even though the GI Regulations expressly provides that "*Registered names*" shall be protected.

Following this assessment, the thesis has focused on the reputed European trademark protection in order to provide a comparison with the GI protection against evocation. This comparison has

shown that the reputed European trademark protection is similar to that of GI against evocation: they both extend to dissimilar goods and services, a shape and an image can potentially evoke a GI and infringe a word trademark, and the conditions of protection are quite similar. The main differences are that the former requires the establishment of additional conditions and provides more defenses/exceptions. Specifically, contrary to GI cases, a trademark owner must prove (i) the reputation of his trademark, and (ii) that the contested use takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of his trademark - it is still unclear whether or not exploiting the GI's reputation is a condition for evocation. In addition, only trademark law provides an exception that allows a third party to use an indication which concerns the geographical origin of a good or service, even if this indication is a registered trademark, and provides a due cause defense (implying that there is no trademark infringement even if all the other conditions are met).

In conclusion, the notion of evocation has been interpreted broadly by the CJEU but does not differ greatly from the protection afforded to the owners of reputed European trademarks. The suggestions about the potential limitations of the interpretation of evocation provided in this thesis ((i) extension of the protection to dissimilar goods and services only under the condition that the contested use exploits the GI's reputation, (ii) establishment of an exception for producers whose products do not comply with existing GI specifications coming from the same geographical, (iii) no evocation of a GI through the shape of a product under the current wording of the GI Regulation) could help overcome the identified problems of this interpretation and make it more in line with its rationales and object of protection. It will be interesting to follow potential new GI cases on evocation or the adoption of new GI Regulations to see how this interpretation evolves.

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