

Geographical names as trademarks : a cheese full of holes???

Virginia Melgar
Member of the Fifth Board of Appeal
Larnaka 18 october 2019

Geographical names filed as collective marks

Case law

- 13/06/2012, T-534/10, HELLIM / HALLOUMI, EU:T:2012:292,
- 21/3/2013, C-393/12P Hellim/Halloumi,
- 13/07/2018, T-847/16, COWBOYS HALLOUMI, EU:T:2018:481,
- 13/07/2018, T-825/16, Pallas Halloumi, EU:T:2018:482,
- 25/09/2018, T-328/17, BBQLOUMI, EU:T:2018:594, **appeal pending**
- 23/11/2018, T-702/17 Papouis Halloumi,
- 23/11/2018, T-416/17, Fino Cyprus Halloumi(fig)

- 30/08/2016, R 3100/2014-4, ΧΑΛΛΟΥΜΙ / HALLOUMI.
- 15/02/2019, R2298/2017-4, HALLOUMI / Halloumi Vermion BELAS.

BUT

- 6/02/2014, R 861/2013-2, SEÑORÍO DE JIJONA / TURRON DE JIJONA

Conclusions a cheese with some holes...

- The Court's case law seems to be consistent,
- As regards the assessment of the **likelihood of confusion**, all the judgments/decisions, - except of very few isolated Board's decisions-, are based on the assumption that the distinctiveness of an EU collective mark designating a geographical origin is weak. Thus, the final outcome, whether it is likelihood of confusion or not, depends, to a great extent, on the other factual considerations of the case (level of similarity between the signs and the goods).
- Some decisions of the Fourth Board have been annulled by the Courts mainly due to the incorrect assessment of the **conceptual similarity of the signs**. In the Papouis Halloumi and fino Halloumi cases, the Board held that there is not any relevant conceptual similarity between the signs despite the presence of the common element 'Halloumi'.
- Based on the above cited decisions, the Fourth Board does not seem to always follow this case law, and even some **inconsistency** amongst the Fourth Board's decisions themselves (e.g. HALLOUMI / HALLOUMI (fig) case where the conceptual identity between two signs was confirmed).

The extent of protection of Geographical names

- 12/09/2007, T–291/03, Grana Biraghi, EU:T:2007:255,
- 14/12/2017, T–828/16, QUESO Y TORTA DE LA SERENA (fig.) / TORTA DEL CASAR et al, ECLI:EU:T:2017:918.
- 19/7/2019, R-2191/2018-2, Grana Padano

Pending case after remittal T-828/16: 14/12/2017, CRDO “Torta del Casar” v EUIPO/CRDO “Queso de La Serena” queso y torta de la Serena vs Torta del Casar

Consejo Regulador de la Denominación de Origen Protegida «Queso de La Serena»

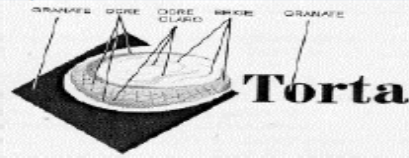
Consejo Regulador de la Denominación de Origen «Torta del Casar»



EU figurative Mark



Spanish mark



Protected DO (Regl 510/06) “Torta del Casar”

Classes 29 (Cheese from La Serena), 35 (Export-Import services of cheese of La Serena) y 39 (Transport & distribution of La Serena Cheese)

Cheese (from El Casar)

The concept of evocation

- 4/03/1999, C 87/97, Gorgonzola, EU:C:1999:115.
- 26/02/2008, C 132/05, Commission / Germany, EU:C:2008:117, hereinafter Parmigiano Reggiano.
- 2/05/2019, C 614/17, Queso Manchego, EU:C:2019:344.

Conclusions a cheese with almost no holes

- The term ‘**evocation**’ should be understood that ‘it covers a situation where a term used to designate a product incorporates part of the 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’. (Gorgonzola).
- - An evocation can be characterised even in the **absence of any likelihood of confusion** (Gorgonzola).
- - Geographical indications are protected from any ‘evocation’, ‘even if the true origin of the product is indicated or the geographical indication is used in translation or accompanied by an expression such as “like”, “type”, “style”, “made”, “flavour” or any other similar term’. (Scotch Whisky).
- -The **phonetic and visual similarity** between the disputed designation and the PGI and the partial incorporation of a PGI in the disputed designation are not ‘an essential condition’ but just one factor to be taken into account. The ‘decisive criterion’ is whether the ‘image triggered’ in the consumer’s mind, when he is confronted with the disputed designation, is that of the product whose GI is protected. In the absence of any phonetic and/or visual similarity and partial incorporation of a GI in the disputed designation, the ‘conceptual proximity’ between the designation and the geographical indication must be taken into account (Scotch Whisky).
- - There can be evocation through **partial incorporation of the GI** (as in Gorgonzola, Toscoro, Matprat) 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’ . This has not necessarily, though, to result in a certain visual and phonetic similarity between the two elements .

Conclusions(II)

- -A registered geographical indication may be also evoked through the use of **figurative signs**. It belongs to the national Court to assess specifically whether the figurative signs are capable of triggering directly in the consumer's mind the products whose names are registered (Queso Manchego).
- -The concept of '**misuse**' must be interpreted as referring to 'inappropriate use' or use of the protected name in an inappropriate context which could, for instance, tarnish the repute of a quality product name (COLOMBIANO COFFEE HOUSE decision).
- -The assessment of evocation is made taking the view of the European Union consumer (reasonably well informed and reasonably observant and circumspect). Such concept covers all the European consumers and not only the consumers of the Member State in which the product giving rise to the evocation is manufactured (Calvados, Queso Manchego).

Conceptual proximity

- -- The fact that a PDO does not constitute the exact translation from another language is irrelevant, What really matters is the conceptual proximity of the terms emanating from different languages and the phonetic and visual similarity which should be such as to bring in the consumer's mind the name of the PDO.
- - The concept of the 'conceptual proximity' has been recalled and applied , in a broader sense, in Queso Manchego where the GC held that a GI may be also evoked through the use of figurative signs

The concept of comparable products

- 25/01/2018, R 674/2017-1, Yorkshire Provender,

Preliminary rulings on cheese

9/6/1998- C 129/97 and C 130/97 époisses

4/3/1999 – C 87/97 Gorgonzola

25/6/2002 – C 66/00 – Parmiggiano Reggiano

20/5/2003 C 469/00 – Grana Padano

25/10/2005 - C-465/02 and C- 466/02 – Feta

26/2/2008 – C 132/05 – Parmiggiano

2/5/2019- C-614/17 Queso Manchego

C-569/18 Caseificio Cirigliana e.a., mozzarella buffala di Campania (pending)

C-490/19 Syndicat interprofessionnel de défense du fromage Morbier (pending)

EU Courts on EUIPO appeals

II) EUIPO appeals

- **ECJ**

- 21/03/2013, C-393/12P, HELLIM / HALLOUMI,

- **GC**

- Grana Biraghi 12/09/2007, T-291/03

- HELLIM / HALLOUMI, 13/6/2012, T-534/10

- Queso y Torta de la Serena vs. Torta del Casar 14/12/2017, T-828/16

- COWBOYS HALLOUMI vs Halloumi 13/07/2018, T-847/16,

- BBQLOUMI vs halloumi 25/09/2018, T-328/17,

- Pallas Halloumi 13/07/2018, T-825/16

- Papouis Halloumi, 23/11/2018, T-702/17

- Fino Cyprus Halloumi (fig) 23/11/2018, T-416/17

- **BOARDS**

R 3100/2014-4, XΑΛΛΟΥΜΙ / HALLOUMI, 30/08/2016.

R 723/2016-4 Queso tetilla ,12/1/2017

R- 0674/2017-1 Yorkshire Prevender – 25/1/2018

25/09/2018, T-328/17, BBQLOUMI vs halloumi 25/9/2018

R 2295/2017-4, Halloumi/ Halloumi Vermion BELAS, 15/02/2019

R-2191/2018-2 Grana Padano 19/7/2019

THANK YOU