European Communities Trade Mark Association

Brussels, 10 January 2014

# ECTA Position paper on the notion of "*comparable goods*" in the practice of the OHIM (on absolute and relative grounds)

In a position paper released in 2012, ECTA expressed its support to the new practice implemented by the OHIM in the field of Geographical Indications. Indeed, instead of limiting its practice to a literal application of the absolute grounds for refusal listed in Article 7 of the CTM Regulation, the Office announced that it would apply indirectly the absolute grounds for refusal listed in the existing EU GI Regulations. This change of practice implies, notably, the application of Article 7.1.j CTMR "*in conjunction with*" the relevant EU legislation, in the areas of wines and spirits.

As part of its commitment to support OHIM in its tasks, ECTA, and in this specific field its Geographical Indications Committee, is willing to provide its feedback on how the new policy of OHIM could be implemented, in practice.

In this context, one of the areas of particular interest is the scope of refusal of CTMs which are found to reproduce, imitate or evocate GIs. To a large extent, the refusal should apply to "**comparable goods**" (whether on absolute or relative grounds for refusal), a notion which has barely been analyzed by the courts so far, and which can therefore be subject to divergent interpretations in practice.

The purpose of this position paper is therefore to try to formulate practical recommendations as to how the concept of "comparable goods" should be applied in the fields of foodstuff, wine and spirits.

In this respect, it is believed that the current practice of the Office, as detailed in the Manual, might be considered too restrictive. While it is certainly true that there is currently very little

ECTA Secretariat, Rue des Colonies 18/24, 9th Floor, BE- Brussels, Belgium
Tel 32/2-513 52 85 Fax 32/2-513 09 14 E-Mail ecta@ecta.org Internet http://www.ecta.eu

guidance from the courts, in general terms ECTA advocates for a wider approach, i.e. a wider scope of refusal whenever a CTM is deemed to reproduce, imitate or evocate a GI.

In any case, this is a very complex area, and by submitting this position paper ECTA does not aim to provide for an exhaustive overview of the notion of "comparable goods" and its implementation in the daily practice. ECTA will be very happy, though, if this document can be used as a first one in a wider project in this field: GI could fit in the cooperation fund!

We also wish to make it clear that the notion of "comparable goods" is relevant both on absolute and relative grounds for refusal. In this respect we note that, while this notion is analyzed in the OHIM Manual on absolute grounds, it is not mentioned at all in the part of the Manual dedicated to Relative Grounds (and more particularly the part dedicated to Article 8.4 CTMR, in relation with Geographical Indications). It is of the essence that the concept of "comparable goods" be applied in the same manner on absolute grounds and relative grounds for refusal.

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## 1. Trying to understand the concept of "comparable goods"

### *1.1 A really confusing legal framework*

Unfortunately, the legal framework is very inconsistent, not only in the wording itself, but also in the basic scope of protection granted to GIs:

The GI Regulation for **foodstuff** is the only one referred to expressly in the CTMR. Basically and in accordance with Article 7.1.k CTMR, a CTM must be refused if it reproduces, imitates or evocates a GI, and designates "the same type of product". In the foodstuff regulation itself, article 13 (scope of protection of GIs) refers to "comparable goods", while article 14 (relation with trade marks) mentions "goods of the same type".

In the field of **wines**, and in accordance with article 118l (relationship with trademarks) of Regulation no. 1234/2007, the ex-officio protection against abusive trade mark registrations is limited to the goods listed in Annex XIb. However, a broader scope of protection is available on relative grounds (through article 8.4 CTMR), with a reference in article 118m (protection) to the notion of "comparable products".

**Spirits** are subjects to a very favourable treatment, when compared with other GIs: in this area, GIs are to be protected, ex-officio, insofar a CTM designates products that are "comparable", or insofar the use of that CTM would exploit the reputation of the GI (combination of Articles 16 (protection of geographical indications) and 23 (relation between trade marks and geographical indications) of Regulation 110/2008).

These different approaches raise serious difficulties for the daily practice of the Office. In this respect, ECTA wishes to make two comments:

#### *1.1.1 Do the notions of "products of the same type" and "comparable products", in the foodstuff regulation, cover the same situation?*

First, it is not clear at all whether the notions of “products of the same type” or “comparable products”, referred to in the CTMR and in the foodstuff regulation, cover identical or different situations.

Some may take the view that these variations simply reflect a lack of consistency of wording, while others may think that the legislator has really introduced a two steps approach (thus following the approach of the wine regulation, which makes a distinction between the goods listed in an Annex, and the wider range of “comparable goods”): i.e. basic ex officio protection limited to “goods of the same type”, and wider protection, based on relative grounds for refusal (through article 8.4 CTMR), for “comparable goods” (without prejudice, of course, of a third grade of protection whenever the use of the CTM would exploit the reputation of a GI, but this is not the subject matter of this position paper).

This is a very important question, which is still in the air at the moment. In any case, this does not preclude ECTA from making recommendations as far as the notion of “comparable goods” is concerned.

#### *1.1.2 Should OHIM extend its ex-officio examination to situations were a CTM could take advantage of the reputation of a GI, even for products which are not comparable?*

This delicate question is not directly linked to this position paper. If one reads the spirits regulation, which is directly enforceable before the OHIM, then clearly CTMs that could exploit the reputation of a GI should be rejected ex-officio, even if they designate goods which are not comparable. The OHIM should take position in this respect, and eventually adapt its practice.

### ***1.2 The increasingly restrictive approach of the OHIM to the notion of “comparable goods”***

It is not about missing the “good old times”. Still, we note that the approach of the Office is increasingly restrictive, as one can see from the Manual and from the practice of the examiners.

Decisions issued some years ago applied widely the concept of “comparable goods”. For example, in its decision known as RONCARIFORT II (609C, 06/10/2004), the Office extended its refusal to a very large number of products based on the fact that they all belonged “*to the food and agricultural sector*”.

However, today, the Manual states that “*the notion of comparable goods is considered to be a fairly restrictive one*”.

And indeed, in its daily practice, it seems as the Office is limiting its assessment to identical or nearly identical goods.

For example, CTM application for FRATELLI PARMIGIANI no. 11958221, examined in 2013, was solely refused for cheese (list limited to “Cheeses which conform to the specific requirements of the protected indication 'parmigiano reggiano'), but it was accepted for many other products, including milk and milk products.

Now, the current approach within the Office is not necessarily uniform, which is perfectly understandable. For example, in the decision of 17 May 2013 (case R 757/2012-5), the Fifth Board of Appeal indicated that “*cheese*” and “*butter*” were examples of comparable goods: “*they have a similar appearance, are often consumed together, are both dairy products, have been elaborated in a comparable manner and have the same channels of trade*”.

### ***1.3 Defining the contours of the concept of “comparable goods”***

We will not attempt to propose a definition of the concept of “comparable goods”. We will, however, offer some thoughts which may assist the Office in approaching the contours of this notion, and in adapting its practice.

At this stage, the main guidance for the Office is provided for by the Court of Justice in COGNAC II (judgment of 14/07/2011 in joined cases C-4/10 and C-27/10). This judgment provides several non cumulative, and non exhaustive, elements in order to assess whether goods are comparable (par. 54):

- Products which have common objective characteristics;

- Products which are consumed, from the point of view of the relevant public, on largely identical occasions;

- Goods that are frequently distributed through the same channels and subject to similar marketing rules.

While the guidance provided for by the Court is useful, its importance must not be overestimated: analysing the concept of "comparable goods" was solely a side element in its judgment (actually the litigious product was itself a "spirit").

### *1.3.1 Where should "comparable goods" be positioned with respect to "similar goods"?*

From a theoretical point of view, it makes no sense to compare "comparable goods" and "similar goods", as these concepts apply in different circumstances.

Yet, in practice, one cannot help but wonder whether the scope of the grounds for refusal based on "comparable goods" should be narrower, equal, or wider than the scope of the grounds for refusal based on "similar goods".

ECTA favours an approach of the notion of "comparable goods" which, in practice, would imply a scope of refusal at least equivalent to that of a refusal issued against goods considered to be "similar".

This interpretation is justified in particular by the political, social and economic relevance of GIs in Europe. Promoting a sui-generis scheme for the protection of GIs makes no sense if, at the end of the day, their scope of protection is narrower than a mere trade mark registration.

Goods that are comparable are goods that can share common characteristics, and/or be consumed on the same occasions, and/or are distributed through the same channels. This implies that goods are comparable not only when they are "substitutable". Therefore, goods with the same raw materials are comparable (all dairy products, for example), or beverages are also comparable (whether alcoholic or not).

It remains to be seen whether compliance with a minimum number of objective criteria (at least two different criteria) should be required in order to conclude that two goods are "comparable", as a means of introducing some legal certainty and to rely on a purely objective approach. By way of example, should we consider that "*cheese* and "*ice cream*" are comparable goods, based on the fact that these goods, 1/ share one important ingredient, i.e. milk, and 2/ can fulfil the function of a dessert or a snack? While not endorsed at this stage, this approach is interesting and should be reviewed further.

### *1.3.2 Does the notion of "comparable goods" extend to ingredients?*

Maybe the right answer to this question should be "it depends"! Indeed, it would probably not be justified to consider that any product containing a GI as one ingredient is a good "comparable" to the goods allowed to bear this GI. Due account must be given to objective circumstances, on a case by case basis.

For example, it is reasonable to argue that a fresh fruit for which a GI protection has been granted, is comparable to a fruit-based drink. The fruit is indeed an essential element in the fruit juice.

On the other hand, considering whether a spirit and a chocolate product are "comparable" is more delicate. There is clearly a risk of deceptiveness for the consumers if a box of chocolates bears an imitation of a GI whereas the chocolates do not actually contain any ingredient allowed to use this GI, but this has more to do with another general ground for refusal: article 7.1.g CTMR.

### *1.3.3 Does the notion of "comparable goods" extend to services?*

The answer to this question could be "unfortunately not". "Product" means what it says, and accordingly it excludes the notion of "services". Unlike for "comparable", there is no difficulty in interpreting this word.

However, it is worth mentioning here that, as amended in 2009 and 2012, respectively, the current wine and foodstuff regulations refer to the notion of services when defining the scope of protection of GIs.

The wine regulation, no. 1234/2007, refers to "services" in its article 118m 2.b. Likewise, article 13.1.b of the foodstuff regulation, no. 1151/2012, states that GIs should be protected against "*any misuse, imitation or evocation, even if the true origin of the products or services is indicated (...)*".

This has a practical impact: while the Office is not allowed to refuse ex officio, i.e. at the examination stage, a CTM which reproduces or imitates or evocates a GI, insofar it designates services, it could do so if the GI is relied upon as a relative ground for refusal. In other words, in an opposition based on article 8.4, a producer association of a GI protected for foodstuff is entitled to request the refusal of a CTM also for services. For example, the retail services of products either covered by, or comparable to, a GI, should be included in a refusal based on article 8.4 CTMR.

### ***1.4 Should the concept of "comparable goods" be flexible, meaning that the scope of refusal of a CTM can depend on other elements?***

As is the case in the framework of the assessment of "similarity" in a pure trade mark case, products can be comparable to a lesser or to a larger extent. Hence the question: can there be, in the practice of the Office, room for flexibility when determining the scope of refusal of a CTM, depending on other factors? This implies introducing the equivalent to a principle of "interdependence", with which we are very familiar under trade mark practice. If a GI is fully reproduced in a CTM application, then it could be rejected for all the comparable goods, including goods for which the degree of "comparability" is low. On the contrary, if a GI is lightly evoked, then it could be refused solely for those goods for which the degree of comparability is significant.

This is again a difficult question, which is left in the air at this moment.

## 2. "Comparable goods" in the field of foodstuff

Before presenting some recommendations, we deem appropriate to recall the relevant legal framework.

### *2.1 Legal framework*

**CTM Regulation**

**Article 7 Absolute grounds for refusal**

1. The following shall not be registered:

(k) *trade marks which contain or consist of a designation of origin or a geographical indication registered in accordance with Council Regulation (EC) No 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs when they correspond to one of the situations covered by Article 13 of the said Regulation and regarding the same type of product, on condition that the application for registration of the trade mark has been submitted after the date of filing with the Commission of the application for registration of the designation of origin or geographical indication.*

**Regulation No 1151/2012 on quality schemes for agricultural products and foodstuffs**

***Article 13 (1) Protection***

*1. Registered names shall be protected against:*

*(a) any direct or indirect commercial use of a registered name in respect of products not covered by the registration where those products are comparable to the products registered under that name or where using the name exploits the reputation of the protected name, including when those products are used as an ingredient;*

*(b) any misuse, imitation or evocation, even if the true origin of the products or services is indicated or if the protected name is translated or accompanied by an expression such as 'style', 'type', 'method', 'as produced in', 'imitation' or similar, including when those products are used as an ingredient;*

*(c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product that is used on the inner or outer packaging, advertising material or documents relating to the product concerned, and the packing of the product in a container liable to convey a false impression as to its origin;*

*(d) any other practice liable to mislead the consumer as to the true origin of the product.*

*(...)*

***Article 14 - Relations between trade marks, designations of origin and geographical indications***

*1. Where a designation of origin or a geographical indication is registered under this Regulation, the registration of a trade mark the use of which would contravene Article 13(1) and which relates to a product of the same type shall be refused if the application for registration of the trade mark is submitted after the date of submission of the registration application in respect of the designation of origin or the geographical indication to the Commission. Trade marks registered in breach of the first subparagraph shall be invalidated (...).*

### ***2.2 Practical recommendations***

Please refer to the table below, which is not exhaustive (it does not contain, at this stage, all the goods that can be granted protection as PDOs or PGIs in the framework of Regulation no. 1151/2012).

The table contains indications as to what categories of goods are "comparable" in the opinion of ECTA, but it is of course not a closed list. Besides, the reference to OHIM practice in the

second column is solely inserted for information purposes, but we are well aware of the fact that there is no uniform established practice as such. And, as already stated in previous developments, the practice has evolved over time.

| **Product for which the GI is protected** | **Scope of refusal of the CTM (comparable goods)** | |
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| | **Illustrations of OHIM practice** | **Proposal of ECTA** |
| **Cheeses** | A. Cheese and cheese preparations.<br>(class 29)<br><br>OHIM Cancellation Division, BERGAZOLA (FIG.) - 279C of 12/12/2003<br><br>B. Cheeses; meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; compote; eggs, milk and milk products; edible oils and fats.<br>(class 29)<br><br>Agricultural, horticultural and forestry products and grains (not included in other classes); living animals; fresh fruits and vegetables; seeds, natural plants and flowers; substances for the animals feeding; malt.<br>(class 31)<br><br>Storing and delivery services of food products and beverages.<br>(class 39)<br><br>OHIM Cancellation Division, RONCARIFORT - 609C of 6/10/2004 : " *the products covered by the mark all belong to the food and agricultural sector; the services covered as well" – our translation – p 9 decision*)<br><br>C. Dairy products, cheese.<br>(class 29)<br><br>NOT REJECTED FOR: Charcuterie (except raw ham), meat, fish, poultry and game; jellies, jams, eggs, milk and milk products, cheese, edible oils and fats, preserves, pickles (class 29).<br><br>OHIM Cancellation Division, TRADIZIONI DI PARMA (FIG.) – 6890C of 8/07/2013 – *APPEAL PENDING* | **Cheese** (class 29)<br><br>products that contain or may contain cheese and cheese products as an ingredient: (e.g. potato chips – class 29; fats – class 29;<br>seasonings, spices – class 30;<br>pastry – class 30;<br>sauces/condiments – class 30;<br>pickles – class 30;<br>**prepared meals** – class 29 and 30), substances for the animals feeding – class 31)<br><br>**Dairy products**, including:<br><br>**Milk** (class 29)<br>**Milk products** (class 29)<br>(e.g. **whey, cream, butter, buttermilk, butteroil, caseins, anhydrous milkfat (AMF), yogurt, kephir, koumiss, viili/fil, smetana, fil** : see annex XII of single CMO Regulation No 1234/2007)<br><br>products that are consumed, from the point of view of the relevant public, on same occasions, e.g. ice cream and ice cream substitutes, chocolate and chocolate substitutes – class 30: often consumed as a desert or snack)<br><br>Products that are frequently distributed through the same channels and subject to similar marketing rules, e.g. meat extracts, charcuterie – class 29) |

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| | D. Dairy products<br>(class 29)<br><br>NOT REJECTED FOR:<br>Preserved, dried and cooked fruits and vegetables (class 29)<br><br>Bread and pastry (class 30)<br><br>Agricultural products not included in other classes (class 32)<br><br>OHIM Opposition Division, DANAZOLA – B001496275 of 7/12/2010 | |
| **Fresh meat (and offal)**<br><br>**Meat products (cooked, salted, smoked, etc.)** | OHIM BoA, FRATELLI PARMIGIANI.. SALAME DI PARMA (FIG.) - 659/2012-5 of 16/1/2013<br><br>OHIM Cancellation Division, LARDO DI COLONNATA – 2260C of 15/07/2009<br><br>OHIM, BoA, NUERNBERGA - R 1331/2011-4 of 01/02/2012<br><br>„Nürnberger Bratwürste“ protected<br><br>**REJECTED FOR:**<br>Class 29: Meat, meat products, meat, ham and sausage, both in fresh and in durable and preserved form; convenience foods and ready to eat snack products, mainly consisting of meat and / or sausage, meat products, sausage products<br><br>**NOT REJECTED FOR:**<br>Class 29: Ham, fish, poultry, game; convenience foods and ready to eat snack products, mainly consisting of fish and / or game and / or poultry and / or vegetables and / or potato products; milk and milk products; cheese and cheese products; eggs; cheese products each in the form of snacks; salads, included in class 29; convenience foods and ready to eat snack products and / or desserts, mainly consisting of eggs, milk and / or milk products; soups; all the aforesaid goods also deep-frozen, preserved or cooked; convenience foods and ready to eat snack, consisting primarily of potatoes, also in combination with rice and / or flour products, and / or cereal preparations and / or pasta<br><br>Class 30: Pasta; convenience foods and ready to eat snack products, mainly consisting of rice | **Fresh meat and offal** (class 29)<br><br>Products that contain or – from the perspective of the average consumer – may contain fresh meat and offal as a main or at least substantial ingredient<br><br>(e.g. **chemical additives for meat processing; meat tenderizers** – class 1; **Meat, meat products, offal, ham, sausage and sausage products, both in fresh and in durable and preserved form; convenience foods and ready to eat snack products; sandwiches; pie fillings; gelatines; food pastes** – class 29;<br>**pies; sauces** – class 30;<br>**Prepared meals**<br>**substances for the animals feeding** – class 31)<br><br>Services related to the above products.<br><br>(e.g. **butchery, butchering** – class 40; services for providing food – class 43) |

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| | and / or flour and / or cereal preparations and / or pasta each in combination with potatoes; all the aforesaid also frozen, preserved or cooked; the aforesaid goods not containing baked goods, sandwiches and pastries; puddings; mainly of rice and / or flour and / or cereal preparations existing desserts; sauces, seasoning sauce, chutneys (condiments), fruit sauces, salad dressings, ice cream; yeast, spices, spice blends, salt, mustard, vinegar<br><br>Class 43: Accommodation services and catering for guests | |
| **Beers** | | **Beers** (class 32)<br>**Alcoholic beverages, including wine and spirits** (class 33)<br>**Non-alcoholic beverages** (class 32)<br>**Foodstuff where beer is a significant ingredient**. |
| **Beverages made from plant extracts** | | **Alcoholic and non-alcoholic beverages**,<br>**Foodstuff (including sauces) where plant extracts are a significant ingredient** |
| **Natural gums and resins** | | **Gum Arabic** (class 1)<br><br>**Resins** (class 2)<br><br>Products that contain or – from the perspective of the average consumer – may contain natural gums / resins as a main or at least substantial ingredient<br><br>(e.g. **preservatives and chemicals for pharmaceuticals and natural remedies** in class 1;<br>**gum resins** – class 2;<br>**creams** – class 3;<br>**Dental resins** – class 5;<br>**gums [adhesives] for stationary or household purposes** – class 16;<br>**synthetic resins** – class 17;<br>**Pharmaceuticals and natural remedies; intermediates for pharmaceuticals and natural remedies** – class 5;<br>**chewing gums; fruit gums** [other than for medical use] – class 30 |
| **Mustard paste** | | **Plants**<br>**Condiments** and, more widely, **all foodstuff** |
| **Pasta** | | **Cereals**, **eggs**, **prepared meals**, and more widely **all foodstuff** |
| **Essential oils** | | **Essential oils** (class 3)<br>**Cosmetics** (class 5)<br>**Pharmaceutical products** (class 5) |

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| **Flowers and ornamental plants** | | **Flowers**<br>**Plants**<br>**Artificial plants** |
| **Wool** | | **Wool**<br>**Clothing** (class 25)<br>And more widely **any product likely to contain wool or other textiles**, such as blankets, mattresses, carpets |

## 3. "Comparable goods" in the field of wines

In this context as well, we will first recall the current legal framework, and then present our proposals.

### *3.1 Legal framework*

Regulation 1234/2007 establishing a common organisation of agricultural markets and on specific provisions for certain agricultural products (Single CMO Regulation)

***Article 118l Relationship with trademarks***

*1. Where a designation of origin or a geographical indication is protected under this Regulation, the registration of a trademark corresponding to one of the situations referred to in Article 118m(2) and relating to a product falling under one of the categories listed in Annex XIb shall be refused if the application for registration of the trademark is submitted after the date of submission of the application for protection of the designation of origin or geographical indication to the Commission and the designation of origin or geographical indication is subsequently protected. Trademarks registered in breach of the first subparagraph shall be invalidated.*

*(...)*

***Article 118m Protection***

*(...)*

*2. Protected designations of origins and protected geographical indications and the wines using those protected names in conformity with the product specification shall be protected against:*

*(a) any direct or indirect commercial use of a protected name:*

*(i) by comparable products not complying with the product specification of the protected name; or*

*(ii) in so far as such use exploits the reputation of a designation of origin or a geographical indication;*

*(b) any misuse, imitation or evocation, even if the true origin of the product or service is indicated or if the protected name is translated or accompanied by an expression such as 'style', 'type', 'method', 'as produced in', 'imitation', 'flavour', 'like' or similar;*

*(c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product, on the inner or outer packaging, advertising material or documents*

*relating to the wine product concerned, and the packing of the product in a container liable to convey a false impression as to its origin;*

*(d) any other practice liable to mislead the consumer as to the true origin of the product.*

### ***3.2 Practical recommendations***

In the field of wines, there is clearly a two steps approach (even three steps, if one considers the extra protection granted if the reputation of a given GI is likely to be misappropriated): the first level of protection is provided for by reference to Annex XIb of the Regulation (ex-officio refusal on absolute grounds). The second level is defined by the concept of "comparable goods" (refusal at the initiative of the producer association on the basis of article 8.4 CTMR).

As far as the first step of protection (absolute grounds for refusal only) is concerned, we agree with the approach of the Office, as explained in the Manual (The Manual Concerning Proceedings Before the Office, Part B, 1.6.4.4.2, Examination Page 42): *"In the case of wines, protection for comparable goods is limited to those set out in Annex XIb of Regulation EC 1234/2007. This annex lists the categories of 'grapevine products', including various types of wines, liquor wines, sparkling wines and wine-based products, such as must and vinegar. 'Must' and 'vinegar' are clearly 'comparable' to 'wines' insofar as they are also vineyard products. Therefore, a CTM application that conflicts with a PGI/PDO for wines must also be refused for must (Class 32) or vinegar (Class 30)."*

As far as the second step of protection (relative grounds for refusal) is concerned, for which we have found no indication in the Manual (for wines), the proposals of ECTA are the following:

| **Product for which the GI is protected** | **Scope of refusal of the CTM (comparable goods)** | |
|---|---|---|
| | **Illustrations of OHIM practice** | **Proposal of ECTA** |
| **Wine** | OHIM OD, Champarty, B1545956, 31/01/2012: in this matter the Office considered that "*The contested goods mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit* | All the goods caught up in Annex XIb of Reg. 1234/2007, i.e. notably:<br><br>**Wine**, **new wine still in fermentation**, **liqueur wine**, **sparkling wine** (including |

| | | |
|---|---|---|
| | *juices; syrups and other preparations for making beverages are all non-alcoholic beverages which are intended to quench thirst or products to be used in the making of these non-alcoholic beverages. Therefore, they are different in nature because the opponent's goods are restricted to Champagne wines which are alcoholic beverages. As a consequence, they also serve different purposes. Wines and spirits are drunk on special occasions and for enjoyment and much less frequently than non-alcoholic beverages. However, in some markets, mixed beverages are very popular, consumers mix alcoholic and non-alcoholic beverages. The goods to be compared are also marketed through the same channels and targeted to the same end user. It is undeniable that there is a certain link between them which leads to a low degree of similarity. Beers are similar to Champagne wines as they have the same nature. They can coincide in producer, end user and distribution channels.*" (case based on a assessment of similarity, but under a provision of the French rural code dealing with the protection of GIs). | any subcategory of sparkling wine), **wine from raisined grapes**, **wine of overripe grapes** (all in class 33).<br>**Grape must** (and sub-categories) in class 32.<br>**Wine vinegar** in class 30.<br><br>And also:<br><br>**Beverages containing wine** (class 33)<br>**Alcohol-free wine** (class 32)<br>**Alcoholic beverages other thank wine** (class 33)<br>**Non-alcoholic beverages** (class 32)<br>**Beers** (class 32)<br>**Confectionary having wine filings** (class 30), and more widely **foodstuff where wine is a very significant ingredient**. |

## 4. "Comparable goods" in the field of spirits

Likewise, we will first review the legal framework, and then issue practical recommendations.

### *3.1 Legal framework*

Regulation 110/2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks

***Article 16 Protection of geographical indications***

*"Without prejudice to Article 10, the geographical indications registered in Annex III shall be protected against:*

*(a) any direct or indirect commercial use in respect of products not covered by the registration in so far as those products are comparable to the spirit drink registered under that geographical indication or insofar as such use exploits the reputation of the registered geographical indication;*

*(b) any misuse, imitation or 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;*

*(c) any other false or misleading indication as to the provenance, origin, nature or essential qualities on the description, presentation or labelling of the product, liable to convey a false impression as to its origin;*

*(d) any other practice liable to mislead the consumer as to the true origin of the product.*

***Article 23 Relation between trade marks and geographical indications***

*1. The registration of a trade mark which contains or consists of a geographical indication registered in Annex III shall be refused or invalidated if its use would lead to any of the situations referred to in Article 16.*

*(...)"*

### *3.2 Practical recommendations*

| **Product for which the GI is protected** | **Scope of refusal of the CTM (comparable goods)** | |
|---|---|---|
| | **Illustrations of OHIM practice** | **Proposal of ECTA** |
| **Spirit** | According to the current version of the Manual, *"spirits and spirit-based mixtures (alcoholic drinks), are 'comparable' pursuant to the 'COGNAC criteria'. On the other hand, spirits and fruit juices (e.g. CALVADOS, an apple-based brandy, and apple juice) cannot be considered comparable."* | **Spirits**, **spirit-based mixtures** (class 33)<br>**Alcoholic drinks, including wine** (class 33)<br>**Beers** (class 32)<br>**Foodstuff where the main ingredient is a spirit** (classes 29 or 30)<br>**Non-alcoholic beverages** (class 32) |