

**DECISION**  
**of the Fifth Board of Appeal**  
**of 15 November 2023**

In Case R 1073/2022-5

**Consorzio for the protection of Grana Padano cheese**

Via XXGiugno, 8

25015 Fraz. San Martino della Battaglia

Desenzano del Garda (BS)

Italy

Applicant/Appellant

represented by Perani & Partners S.p.A., Piazza Armando Diaz 7, 20123 Milan, Italy

Appeal relating to the application for registration of European Union trade mark No 18 358 002

**THE FIFTH BOARD OF APPEAL**

composed of V. Melgar (Chairperson), S. Rizzo (Rapporteur) and A. Pohlmann (Member)

Registrar: H. Dijkema

gives the following

## Decision

### Summary of the facts

- 1 By an application filed on 18 December 2020, CONSORZIO PER LA TUTELA DEL GRANA PADANO ('the applicant') sought to register the European Union figurative mark No 18 358 002



in respect of the following goods, as amended on 7 July 2021:

Class 29: *Cheese complying with the specifications of the protected designation of origin 'Grana Padano'.*

- 2 On 28 October 2021, the examiner issued a provisional refusal of registration on the grounds of Article 76(2) EUTMR in respect of all of the goods claimed by the applicant. The objection was mainly based on the following observations:
  - The sign you have applied for contains the protected designation of origin ('PDO') GRANA PADANO is a logo almost identical to that contained in the specifications of the PDO in question.



- The logo contained in the product specification of a protected designation of origin or a protected geographical indication must be used by any producer whose products comply with the specifications, regardless of whether they are members of the association of protection of that PDO or PGI.
  - Therefore, the public may be misled as regards the character or the meaning of the mark, since this element may be regarded as a protected designation of origin rather than a collective mark, the function of which is to indicate membership of an association.
- 3 On 22 December 2021, the applicant responded to the objections raised by the examiner. The observations can be summarised as follows:
- The registration of the collective mark is the responsibility of the entity in charge of protecting ‘Grana Padano’ cheese.
  - The mark applied for represents the restyling of the existing European Union collective mark No 1 753 284 that will no longer be used and therefore abandoned. The new restyling has been requested to amend the specifications of the PDO; once approved, producers and members of the group will need to adopt the new figurative mark (logo).
  - There will be no limits to those who will be able to use the sign: anyone who complies with the specifications and the regulations will be able to use the sign, as required by Article 4 of the regulations of use.
  - The Special-Purpose Association is voluntary and operates for the purposes laid down by Law No 526 of 21 December 1999, including the protection and promotion of the PDO, the supervision of the production and marketing of cheese, and their exploitation.
  - The Special-Purpose Association is the holder of collective marks filed in accordance with the law and grants them in use to those entitled to them.
  - The Special-Purpose Association may decide, as in the present case, to vary the graphics of the trade mark and protect a particular phont, as well as a degree of colour. These elements are not protected by the PDO, but by the collective figurative mark.
  - The purpose of this trade mark is not to prevent the use of the sign by persons complying with the provisions of the regulations governing use and the specifications, but rather to prevent the use of confusingly similar trade marks, which might not include the expression ‘GRANA PADANO’.
  - The public, when dealing with the trade mark under examination, can only believe that it belongs to the Consortium for the Protection of the Formcan PDO ‘Grana Padano’.
  - The protection granted by the PDO refers only to the name GRANA PADANO and not to a particular graphic or colour mark.

- Not all EU countries allow you to file an action on the basis of the PDO (e.g. Estonia, where oppositions are based only on earlier trade marks). In addition, other countries, such as Austria, Croatia or Greece, do not provide for an incompatibility between the protection of the PDO and the collective mark.
  - Since the trade mark was filed by the Consorzio per la tutela del formaggio ‘Grana Padano’, the ground set out in Article 13 is not applicable. There is no deceptiveness as to the true origin of the product designated by the trade mark, since the sign can only be used by producers who comply with the requirements of the Regulation and the specifications.
  - The application for registration complies with the provisions of Italian national law and does not contradict European legislation, since it represents an additional form of protection for PDOs, PGIs and TSGs, a tool for Consorzi to enforce rights over distinctive signs, and finally protection for consumers.
  - It cannot be argued that the public will be misled as to the nature of the sign when it has been the national legislature itself which provides that symbols identifying PDOs, PGIs and TSGs may be registered as collective marks.
  - It is in accordance with Italian law for the Consorzi to own, use and register collective trade marks identifying PDOs, PGIs and TSGs.
  - A number of EU collective marks containing PDOs have been granted.
- 4 By a decision of 5 May 2022 (‘the contested decision’), the examiner refused the registration of the trade mark applied for in its entirety, pursuant to Article 76(2) EUTMR.

*The entitlement of the applicant Association*

- The Office does not call into question the applicant’s suitability to be the proprietor of a collective mark. What is disputed is the nature of the trade mark and how it is perceived by the relevant public.
- In the present case, the collective mark may be confused with the specific product logo contained in Article 8 of the specifications for the PDO ‘Grana Padano’ No PDO-IT-0011 for cheese, registered on 21 June 1996. In actual fact, the applicant itself indicates that this is a restyling, not only an earlier collective mark, but also the logo contained in the product specification for ‘Grana Padano’ cheese, the amendment of which has also been requested from the European Commission. It is, and will therefore, mandatory for all operators producing cheese of the PDO ‘Grana Padano’.
- The relevant public would see in the sign in question only a logo that is essentially used to identify the product ‘Grana Padano’ as originating from a specific geographical area and having particular qualities attributable to it. Indeed, the logo is mandatory, as can be seen from Article 8 of the product specification. For that reason, the relevant public will associate the logo with the PDO ‘Grana Padano’. The misleading nature referred to in Article 76 (2) EUTMR therefore lies in the perception of the average consumer, who would perceive the sign as a designation

of geographical origin and not as a collective mark capable of guaranteeing the collective commercial origin of the goods.

- In addition, collective marks are owned by the applicant association and can only be used by their members. On the other hand, according to Article 12 of Regulation (EU) No 1151/2012, PDOs/PGIs may be used by any operator on the market producing its products in compliance with the specifications for the particular PDO/PGI. It follows that they are intellectual property rights that do not belong to any owner and must be freely available to all operators operating in the geographical area indicated in the specifications.
- Here, the confusion created about the collective character of the trade mark applied for. While the collective mark may be used only by the members of the applicant association authorised to do so under the regulations governing use, in order to distinguish their products, the PDO and the logo provided for as mandatory for packaging by the specifications may be used by any person who produces cheese in accordance with its specifications. In addition, the logo included in the specification is very similar to that applied for as a collective mark and will become identical following the amendment of the said specification, as reported by the applicant (resulting from the *restyling* of both collective marks and logo in the specification).
- In this sense, the collective mark at issue in this application would mislead the public because it gives the impression that it can be used by anyone who meets the production criteria laid down in the specifications of the PDO, when in reality it can only be used by authorised persons who are members of the association. If the regulations governing use allowed the collective mark to be used by persons who are not members of the association, this would not accord with the nature of the collective mark.
- In conclusion, the relevant public would perceive the collective mark applied for as an indicator of a product, namely cheese, having a specific geographical origin and characteristics associated with it, in essence as a PDO and not as an indicator of collective commercial origin.

#### *Defence of the PDO under collective mark*

- The applicant considers that the relevant public, when faced with the trade mark, can only identify it as belonging to the Consortium itself. Nevertheless, the trade mark makes no reference to the applicant association in its verbal or figurative elements. On the contrary, the figurative and word parts are almost identical to the logo contained in the product specification for ‘Grana Padano’ cheese placed on the shapes and packaging of that cheese.
- Regulation (EU) No 1151/2012 of 21 November 2012 on quality schemes for agricultural products and foodstuffs concerning the PDO ‘Grana Padano’ in Article 13(1) (b), (c) and (d) indicates that PDOs/PGIs are protected against any misuse, imitation or evocation from any other false or misleading indication and any other practice liable to mislead the consumer.
- As a result, PDOs/PGIs are not only protected against direct or indirect commercial use, but also against other situations that exploit and damaging the image of

PDOs/PGIs. This protection has long been supported by the GC and the Court of Justice. By way of example, the judgments of 07/06/2018, C-44/17, Scotch Whisky, EU:C:2018:415 and 02/05/2019, C-614/17, Queso Manchego, EU:C:2019:344, found evocation of PDOs/PGIs in signs that did not contain any of the word elements of the associated PDOs/PGIs.

- As regards the applicant's argument that in some countries of the European Union oppositions can only be filed on the basis of earlier trade marks, the Office considers this to be a flaw. PDOs are a law applicable to opposition and cancellation proceedings in all Member States of the European Union, including Estonia.

#### *Deceptive character*

- The applicant reiterates that the consumer will not be misled as to the true origin of the product. In this respect, the Office has never taken a position to the contrary.
- In addition, the applicant cannot rely, in support of its argument, on Articles 13 and 14 of Regulation No 1151/2012, which relate to the protection of protected geographical indications and which lay down conflicts with trade marks.
- Deceptive character is also examined in relation to the meaning and collective nature of the mark, in accordance with Article 76(2) EUTMR, and not only to the nature, quality or origin of the goods and services, as required by Article 7(1)(g) EUTMR.
- The collective mark is almost identical to the logo contained in the specifications of the PDO 'Grana Padano' and is likely to mislead the public to the point of identifying it with the same protected designation of origin, which may also be used by anyone producing in the geographical area in accordance with the criteria contained in its specifications, and will not see there as a collective mark whose function is to indicate the collective commercial origin that may be used by the members of the association alone.
- For this reason, the Office reiterates that the collective trade mark applied for, consisting of an almost identical reproduction of the logo contained in the specifications for the protected designation of origin for 'Grana Padano' cheese, is liable to mislead the public as to its collective character and is not capable of serving its commercial purpose.

#### *National legislation in force on PDOs/PGIs*

- The applicant refers to national legislation on PDOs/PGIs. On the one hand, it indicates that in accordance with the law, the distinctive signs of the PDO/PGI products are those indicated in the respective specifications; on the other hand, it indicates that any collective trade marks identifying PDO/PGI products are held by the protection associations as they are registered by them.
- It follows that protection groups may be proprietors of collective trade marks that identify products protected by PDOs/PGIs.
- The Office takes note of the Italian national legislation. Nevertheless, it must be taken into account that in accordance with European legislation, which establishes a

protection scheme with common objectives and provisions, the protection of PDOs/PGIs is granted to protect, inter alia, the legitimate interests of consumers and producers. In particular, it pursues the specific objectives of providing farmers and producers with a fair return for the qualities and characteristics of a given product or its method of production, and providing clear information on products having specific characteristics linked to geographical origin, thus enabling consumers to make more informed purchasing choices (Recital 18 of Regulation (EU) No 1151/2012). Moreover, their protection is intended to ensure their correct use and to avoid practices that may mislead consumers (Recital 29 of Regulation (EU) No 1151/2012).

- In this sense, protected designations of origin, protected geographical indications and their respective logo provided for as mandatory for packaging by the specifications may be used by any operator marketing a product complying with the corresponding specifications (Article 12 of Regulation (EU) No 1151/2012). Therefore, this name must remain free so that any producer may use it together with the mandatory logo of use in order to identify products complying with the corresponding specifications.
- Therefore, a PDO/PGI cannot be registered as a collective mark because it would rule out the right of non-member producers to use it. At the same time, if the regulations governing use allowed the collective mark to be used by persons who are not members of the association, this would not accord with the nature of the collective mark.
- The registration of the sign in question as a collective European Union trade mark would therefore lead to confusion as to the nature of the sign itself, since the relevant consumer would not know whether he would perceive it as a collective mark or as the logo used to identify the product ‘Grana Padano’ as genuine.

#### *Other registered trade marks containing PDOs*

- The sign forming the subject of the application was examined, on the basis of its own merits and circumstances, as established by the EUTMR. These merits and circumstances may have been different at the time of the application for the trade marks cited by the applicant, which contain a PDO or a PGI.
- In fact, some of the earlier trade marks refer, in their word elements, to the applicant association and, therefore, are capable of identifying the goods or services as originating from the members of the association; Others do not at most contain a PDO/PGI in their elements.
- Lastly, the collective marks mentioned do not reproduce the PDO/PGI logo contained in their specifications in such a way that the public, when compared with these signs, cannot distinguish whether it is a collective mark or a logo to distinguish the goods in accordance with the respective PDO/PGI specifications.

- 5 On 16 June 2022, the applicant filed a notice of appeal against the contested decision, requesting that it be annulled in its entirety. The Office received the statement of grounds of appeal on 30 August 2022.

## Grounds of appeal

- 6 The arguments put forward in support of the appeal may be summarised as follows:
- The collective mark in question belongs to the officially tipped entity responsible for protecting ‘Grana Padano’ cheese, who also owns the trade marks.
  - The use of the name ‘GRANA PADANO’ and the associated trade mark (*sic*) on the shapes is allowed — as it is a PDO — for all producers who comply with the specifications. Such use cannot be denied if we comply with the specifications. On the other hand, it would not be possible to see the trade mark fired on the packaged goods (i.e. the pieces of ‘Grana Padano’). In this case, the possible solutions are as follows:
    - a) The entity that packages ‘Grana Padano’ cheese designates the PDO on the *packaging* and possibly reproduces the trade mark that is also affixed to the shapes;
    - b) The individual who packages the cheese wants to use the yellow logo of ‘Grana Padano’, a logo developed by the Special-Purpose Association for *restyling* the packaging, which allows easy visual identification. In this case, the person must request authorisation to use the mark. In such cases, persons authorised to packaging are therefore allowed to use the sign forming the subject of the application under examination, which is a collective mark.
  - Use of the [collective] mark on packaging is not mandatory: indeed, it is sufficient to insert the PDO and the trade mark on the shape. However, when used (subject to the necessary authorisation), it enables the product ‘Grana Padano’ to be identified visually quickly and easily, enabling immediate recognition to be given to the public and represents a guarantee for the consumer.
  - Authorisation to use that trade mark, which is reproduced on the packaging and not on the shapes, is granted on application to persons who apply for it and who adhere to the agreement concluded with the Special-Purpose Association, the only proprietor of the trade marks ‘GRANA PADANO’. Use of the mark is granted to applicants who comply with the specifications and adhere to the Convention.
  - The fact that the collective trade mark is used only on the packaging of ‘Grana Padano’ and that such use is granted only with the authorisation of the Special-Purpose Association, within the meaning of the agreement entered into between the manufacturing companies and the Consortium, was not sufficiently clear to the Examination Division, which did not take account of the fact that the figurative mark was developed by the Special-Purpose Association, for use for only the packaged product.
  - The use of the trade mark, unlike that of the PDO, whose use is sufficient to comply with the specifications of use (and whose application is mandatory to mark ‘Grana Padano’ cheese) is the subject of a specific authorisation. Authorisation must be granted if the producer complies with the specifications and joins the Agreement with the Consortium. This sign is an additional element to the PDO and aims to immediately identify the packaging of the product ‘Grana Padano’.




- In order to confirm the above, an agreement model is attached in Annex 1, which is signed by the Special-Purpose Association and the producer concerned. Similar authorisation is required for use of the trade mark on grated product (Annex 2).
- The agreement referred to in Annexes 1 and 2 is signed by each entity wishing to use the collective trade mark in question and has a stricter approach than that provided for in the specifications, insofar as it wishes to introduce uniform provisions on the graphic elements (trade mark, colours, dimensions, mandatory indications) that must be present on the packaging, in order for the product to be immediately identifiable on shelves.
- While the trade mark, affixed to the shape, is also used by entities that are not members of the association, packaging marks, including the trade mark under examination, are used only by authorised parties: protection in the form of a collective mark is therefore correct. In this respect, reference is made to the specifications (Annex 3).
- The Convention, therefore, is the way in which the Special-Purpose Association formalises authorisation for packaging within *the* meaning of Article 7 of the specifications and established by Law No 526 of 21 December 1999.
- It is also highlighted that checks on compliance with the specifications and use of the collective mark on packaged products are carried out by the Consortium's Supervisory Body. There is therefore direct control of compliance with the specifications and convention by those applying for authorisation to use the collective mark.
- Therefore, the use of the collective mark in question on the packaging of 'Grana Padano' is not free for all cheese producers complying with the PDO (as is the case for the PDO and for use of the trade mark affixed on the shape that does not bear the colours), but is granted as a result of an authorisation granted to only those persons who, in accordance with the established requirements, require authorisation to use and sign the Agreement with the Consortium.
- The pre-existing collective trade mark No 1 753 284 must be used on cheese and, together with the name 'Grana Padano', will appear in the signs that must be used in accordance with Article 8 of the specifications, unlike the trade mark applied for, the use of which on the packaging is reserved only to those who have requested authorisation to do so.
- Registration of this trade mark is in no way intended to prevent the PDO 'Grana Padano' from being used by persons complying with the provisions of the regulations governing use and the specifications, but rather to harmonise the product packaging so that it is immediately recognisable, which benefits the consumer *first* of all.
- The office is relieving the Consorzio of a form of protection provided for by law, not having understood the ways in which it is used, which are not exactly the same as those of the PDO, but rather ancillary to it. The trade mark applied for is in addition to the indication of the PDO, which encourages immediate visual identification, but there is no obligation for anyone who produces 'Grana Padano' to use it.

- There is no conflict with Article 74(1) EUTMR, insofar as registration of the expression ‘GRANA PADANO’, protected by PDO, as a collective mark is not sought, but of a specific trade mark, subject to certain conditions of use that are not only those laid down in the specifications.
- The new version of Article 8 of the specifications indicates that the trade mark identifying the official sign certifying that it meets the requirements that justify the use of the PDO ‘Grana Padano’ must be affixed to the shapes. There is no longer any provision for the official mark to be used on the product packaged and on the grated packaging, since the latter have been expected to use the sign that is the subject of this collective trade mark application, for which it is necessary to submit a request to the Special-Purpose Association and to sign the agreement of use. The graphic trade mark to which reference is made, and which can be used by all producers even in the absence of an authorisation, is also the trade mark reproduced on the shape. For this trade mark, the specification provides that it must be affixed to the product, whether it is whole or packaged. However, for the collective mark in *question*, use on the packaging is subject to authorisation by the Special-Purpose Association, in the manner described.
- The authorisations for packaging are also given to persons who, although not formally party to the Special-Purpose Association (and therefore do not have the status of a member of the association), have nevertheless signed the agreement with the Consortium itself. It is a trade mark that may also be used by non-member entities under an agreement to that effect (provided that they meet the requirements for use of the PDO).
- The granting of the trade mark under examination would not alter the use of the PDO and the figurative mark on the shapes, which may be used by anyone who produces cheese in accordance with its specifications, but also represents protection for the sign GRANA PADANO.
- The fact that the trade mark applied for is the responsibility of the Consorzio, that is to say, the officially appointed body responsible for protecting and promoting ‘Grana Padano’ cheese (a mission assigned by the Ministry and periodically renewed) rules out any deceptiveness on the part of the public, since it is natural that the trade mark in question is held by the official party responsible for protecting and promoting cheese.
- It would not be possible to invoke the PDO against trade marks that could be confused with the protected trade mark, but only the trade mark that is the subject of this application for registration. Therefore, if the latter were refused, the Consortium and the consumer would be adversely affected, with a clear deceit, not liable to prosecution, than assumed in the present refusal. Indeed, it is emphasised that the protection granted by the PDO refers only to the name GRANA PADANO or to the trade mark placed on the shapes and not to a particular combination of graphics and colours.
- In the present case, the Special-Purpose Association sought to protect, solely for the packaged product, a complex word and graphic form corresponding to the *restyling*

of the collective figurative mark ‘GRANA PADANO’, which is already in existence and registered in the European Union.



- If a person files a trade mark that is similar to , without the expression GRANA PADANO or with another expression, it would not be possible to sue the PDO. The failure to grant the trade mark therefore casts doubt as to whether the public is properly protected, in a sector as important as food.
- As regards the *restyling* of the trade mark, a number of articles taken from the website are attached, showing the changes made (Annex 4).
- None of the grounds for refusal set out in Article 13 is applicable here, since the collective trade mark application belongs to the Consortium for the Protection of Formula Grana Padano and not to a third party who has filed the application on its own behalf.
- If national legislation allows protection groups to be proprietors of collective marks, the EU law on which the refusal is based, namely Article 76(2) EUTMR, does not indicate an incompatibility of protection, but indicates that the application will be refused if the public is liable to be misled as regards the character or the meaning of the mark, in particular when it does not appear to be a collective mark. However, the application of Article 76(2) EUTMR is the result of an interpretation by the Office. The Office considers that the mark may not appear to be a collective mark; it is certainly difficult for the public to make this distinction.
- Having assessed the content of the Law establishing the Consorzi and the legislation in force, we consider that it cannot be argued that the public will be misled as to the nature of the sign when it has been the national legislature itself which provides that symbols identifying PDOs, PGIs and TSGs may be registered as collective marks.
- In the law establishing the protection syndicates and containing the ‘Provisions for the fulfilment of obligations deriving from Italy’s membership of the European Communities’, the Italian legislature laid down that the associations owned, use and register collective trade marks identifying PDOs, PGIs and TSGs. Now, having assessed that provision, the present case under Article 76(2) EUTMR, which refers to a case of deceptiveness, which does not exist in any way whatsoever, cannot be considered applicable to the cases under examination, as demonstrated by the legislation in force in Italy. If the system allows registration of the collective mark identifying the PDO, it is not clear why the EUIPO should find an absolute ground for refusal.
- The EU trade mark No 14 249 981 that appears as an example of a collective mark in the EUIPO section on collective and certification marks bears the reference to the substantially illegible association. Therefore, if the Office’s reasoning were to be followed, the public would not even see the written signature of the association and would also be deceived.

- All of the trade marks cited by the applicant contain registered PDOs and are on an equal footing with the trade mark *in question*. These marks have been granted by EUIPO, which now refuses the granting of the application in question. It is therefore considered that the Office should maintain the approach followed so far, ensuring appropriate protection for the trade mark under examination.
- 7 On 14 February 2023, the Rapporteur sent a communication in order to obtain clarification of the use of the collective mark. In its statement of grounds of appeal, the applicant claimed that, according to the regulations governing use, the collective trade mark applied for was not used on the shapes of ‘Grana Padano’ cheese, but solely and exclusively on the packaging of that portioned product, thus supplementing the use of the geographical indication ‘Grana Padano’ on the product ‘nudo’, namely on the shapes. However, Article 3 of the version of the regulations governing use in force at the time, entitled ‘Use of Collectives Trade Marks’, indicated that collective marks (including that forming the subject of these proceedings) were to be reproduced on the shapes and packaging of ‘Grana Padano’ PDO cheese. Similarly, Article 4 (1) of the regulations governing use, entitled ‘Apposition of the Collettivo Trade Mark’, reiterated that the sign was to appear on the entire shapes of ‘Grana Padano’ cheese PDO and that, in Article 7 of that regulation, entitled ‘Costs and rights of the members of the association’, the members of the association were entitled to place collective marks (including that forming the subject of these proceedings) on forms of cheese.
  - 8 It was then observed that the trade mark would be deceptive in the eyes of consumers who would not be able to distinguish between the aforesaid sign and the sign identifying the geographical indication ‘Grana Padano’, which is governed by a different set of rules and has a different function from that of the collective mark.
  - 9 The Rapporteur also expressed serious doubts as to the possible registration of the trade mark due to the alleged lack of a minimum degree of distinctive character under Article 7(1)(b) EUTMR due to the fact that the collective mark in question consists exclusively of an almost identical reproduction of the sign contained in the specifications of the PDO ‘Grana Padano’, did not contain any other elements capable of indicating the commercial origin (collective, in this case) of the relevant goods, and therefore could not fulfil the essential function of a trade mark.
  - 10 The applicant responded on 13 March 2023 as follows:
    - Registration of the trade mark is in no way intended to prevent the PDO ‘Grana Padano’ from being used by persons complying with the provisions of the regulations governing use and the specifications, but rather to harmonise product packaging with certain graphic characteristics, *in order to be immediately recognisable first and foremost* by the consumer. A sign that is additional to the PDO and the figurative mark on shapes, the use of which (understood as the use of the trade mark forming the subject of this collective trade mark application) is only on packaging and only upon authorisation.
    - The purpose of creating the sign is related to the need to harmonise packaging, enabling the public to immediately identify the product visually. The grant of the collective mark registration would allow the Consortium to have a title that could be easily invoked against the use of trade marks liable to be confused with the sign applied for, which might not include the expression ‘GRANA PADANO’.

- Following the Rapporteur’s comments, the regulations governing use of the collective mark applied for have been amended. The updated text now refers only to the trade mark in question (and not, in general, to the collective marks of the Consortium) and provides that the aforesaid sign should be affixed only and exclusively on the cheese packaging, not on the shapes.
- The PDO identification sign, as indicated in Article 8 (1) of the specifications, is available to all producers who comply with the conditions set out in the above specifications (in black and white on the left), whereas, according to Article 3 of the specifications, use of the sign to be affixed on the packaging (figure on the right in colour) is granted only with the authorisation of the Consorzio. These signs are clearly not identical.



- A reading of the regulations governing use of the collective mark confirms that it is used only on the packaging of ‘Grana Padano’ cheese. In fact, Article 7 (5) of the regulations governing use of the collective mark stipulates that ‘the members of the association *are entitled, subject to signature of the appropriate agreement and subsequent authorisation by the Consortium, to use the collective trade mark on the product packaging GRANA PADANO complying with the Grana Padano production specifications*’, while the geographical indication to be affixed on the shapes remains at the disposal of all producers who meet the quality requirements set out in the specification.
- The Communication clearly indicates that the provisions of the EUTMR and the current legislation on EU geographical indications do not contain any provisions prohibiting the cumulative protection (or overlap of protection) of the same term or figurative element through these two distinct industrial property rights. Nevertheless, it is argued that the collective mark consists exclusively of a PDO and that it cannot therefore perform the essential function of a trade mark, since it has no other elements capable of indicating the commercial (collective) origin of the goods, and is therefore devoid of any distinctive character within the meaning of Article 7(1)(b) EUTMR.
- The cheese can be portioned and grated only by authorised parties: in fact, only those parties can benefit from the logo, which has the specific function of identifying the product, in the event (very likely and frequent) that the trade mark on the shape (which we repeat is not its exclusive and identical reproduction) is not visible.
- A series of word and figurative marks, registered with the EUIPO despite the coincidence in existence of identical or almost identical PDOs, including:



- EUTM No 18 452 142 figurative ‘SALAME FELINO’ SALAME FELINO — Salame Felino is Protected Geographical Indication (PGI-IT-0597);
  - EUTM No 18 303 169 word mark ‘CESANESE DEL PIGLIO’ — Cesanese del Piglio is Denominazione d’Origine Protetta (PDO-ITA0680);
  - EU collective mark No 18 189 793 ‘COLLI EUGANEI’ in the name of the Voluntary Association for the Protection of Colli Euganei wines, which reproduces the registered PDO ‘COLLI EUGANEI’ (PDO-IT-A0454);
- All the trade marks cited above contain registered PDOs and are on an equal footing with the trade mark under examination. These marks have been granted by EUIPO, which now refuses the granting of the application in question, based on unfounded grounds. It is therefore considered that the Office should maintain the approach followed so far, ensuring appropriate protection for the trade mark under examination. Otherwise, it would constitute a clear difference in treatment to the



detriment of the Consortium, which would not be granted the rights to the distinctive sign in its nature as a collective mark and, indirectly, of consumers.

### Reasons

- 11 All references made in this decision should be seen as references to the EUTMR (EU) 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 12 The appeal complies with Articles 66 and 67 EUTMR and Article 68(1) EUTMR. It is therefore admissible.

#### *Article 76(2) EUTMR*

- 13 According to Article 76(2) EUTMR, an application for an EU collective mark must be refused if there is a risk that the public will be misled as to the character or the meaning of the mark, in particular if it is likely to create the impression that it is not a collective mark.
- 14 According to Article 74(1) EUTMR, the essential function of European Union collective marks is to distinguish the goods or services of the members of the association that is the proprietor thereof from those of other undertakings (20/09/2017, C-673/15 P & 674/15 P & -C-675/15 P & C-676/15 P, DARJEELING (fig.)/DARJEELING et al., EU:C:2017:702, § 63; 12/12/2019, C-143/19 P, EIN Kreis MIT ZWEI PFEILEN (fig.), EU:C:2019:1076, § 26,-57), not of guaranteeing their geographical origin (20/09/2017, C-673/15 P & C-674/15 P & C-675/15 P & C-676/15 P, DARJEELING (fig.)/DARJEELING et al., EU:C:2017:702, § 57).

- 15 Pursuant to Article 74(2) EUTMR, EU collective marks that are descriptive of geographical origin must also be capable of fulfilling the essential function of a collective mark, which is to indicate the collective commercial origin of the goods sold under that mark (20/09/2017, C-673/15 P & C-674/15 P & -676/15 P, DARJEELING (fig.)/DARJEELING et al., EU:C:2017:702, § 54 et seq.; 05/03/2020, C-766/18 P, BBQLOUMI (fig.)/HALLOUMI, EU:C:2020:170, § 74). In addition, an EU collective mark is typically used by companies, together with their individual trade marks, to indicate that they are members of a certain association (12/12/2019, C-143/19 P, EIN Kreis MIT ZWEI PFEILEN (fig.), EU:C:2019:1076, § 54).
- 16 In accordance with general principles of trade mark law, the deceptiveness referred to in Article 76(2) EUTMR must be assessed in relation to the perception that the relevant public will have when coming into contact with the mark, for example at the time of the purchase decision.
- 17 The contested decision refused the application for a collective mark on the grounds that this trade mark could mislead consumers as to its nature and essential function, since this is ‘almost identical’ to the sign of the same designation of origin. The nature of those rights is, in fact, at variance, given that the geographical indication is freely used by all producers meeting the requirements of the specifications, whereas use of the collective mark is subject to prior authorisation by the association that owns the trade mark. This would result in confusion on the part of consumers, who would not be able to discern before which sign they are, if that of the PDO or the collective mark.
- 18 The fact that the sign of the PDO ‘Grana Padano’ may be freely used by all producers of ‘Grana Padano’ cheese and that they may place it on the shapes of cheese produced in accordance with the requirements set out in the specifications, contrary to what was concluded in the contested decision, does not necessarily preclude the presence on the market of such a collective mark, which may only be used with the authorisation of the Consorzio, since it is also the entity responsible for protecting and promoting ‘Grana Padano’ cheese, as the applicant has noted, and as is apparent from the current wording of the collective mark, which is also the body responsible for protecting and promoting ‘Grana Padano’ cheese, as noted by the applicant, and as is clear from Article 10 of the current collective mark.
- 19 As a preliminary point, it is emphasised that the EUTMR does not lay down an express prohibition of the combination of the protections conferred by the collective mark and the geographical indication, even where the signs in question are similar or identical. Moreover, there are no judgments of the Court, known by this Board, that have denied any relevance of the regulations governing use of the collective mark in order to clarify its scope of protection, nor have they denied any overlap between the scope of protection of geographical indications and those trade marks.
- 20 First of all, it should be noted that the signs in question are not identical but only partially similar. In fact, they merely share the same rhomboid shape in which the written expression ‘GRANA PADANO’ appears in the centre. Only the black and white sign bearing the PDO (to be affixed to the shapes of cheese, according to Article 8(a), product specification Grana Padano PDO) contains, within the upper and lower triangles forming the rhombot, the letters ‘G’ and ‘P’, respectively, which do not appear in the yellow collective mark applied for. In addition, the written expression ‘GRANA PADANO’ although it is in both signs at the centre of the rhomboo, in the PDO sign, is delimited by two parallel lines for

each side, upper and lower, whereas in the collective mark sign by a single line for each side, upper and lower.


- 21 It cannot be ruled out a priori that the consumer may be able to notice such differences, especially those relating to the absence of the letters ‘G’ and ‘P’ in the collective mark. In any case, the similarity of the signs is not sufficient in itself to confuse the consumer with regard to the nature of the trade mark in question, but will be perceived as a further reassuring of the fact that the packaged ‘Grana Padano’ cheese originates from the Consortium sector and therefore inherently falls under the processing standards of the Consorzio, complementary to the guarantee of quality provided by the geographical indication. This is further confirmed by the fact that the signs in question are also used differently and are affixed to different goods, as will be shown below.
- 22 The (different) ways in which the collective mark and the sign of the geographical indication are used are, in fact, another relevant factor for the purposes of ruling out the application of the prohibition of registration set out in Article 76(2) EUTMR, namely that the mark is deceptive as to its nature in the eyes of the relevant public.
- 23 The Board is of the opinion that the regulations governing use of a collective mark may occasionally help to understand its scope of protection. In fact, the methods of use of the trade mark with which the consumer will come into contact actually depend on the rules laid down by the regulations governing its use (in this case, *inter alia*, Article 10).
- 24 In the present case, Article 10 of the regulations governing use of the collective mark provides that it is to be affixed, with the authorisation of the Consortium, only to the packages of Grana Padano cheese, whereas the sign of the geographical indication will be affixed to the shapes. It is therefore clear that the ways in which the sign in question is used are not the same as those of the sign of the geographical indication. Indeed, the contents of the regulations governing use are in line with the provisions of Article 8 (A) and (B) of the Grana Padano PDO specification (the latest version, in force on 7 November 2023), according to which the sign of the PDO may be freely used by anyone who meets the quality requirements set out in the specifications, whereas the sign to be affixed to the packages of Grana Padano cheese (collective mark) will be used only after authorisation (by the Consorzio) and only on the packaging of the portioned product(sic). Although it may be debatable whether the specifications of a PDO allow the use of a sign upon authorisation, the fact that it does so in this case and that this version of the specification (Official Gazette of the Italian Republic of 11 August 2022, General series No 187) was drawn up on the basis of a single document previously approved by the EU Commission (published in Official Journal EU, C 263/24, of 8 July 2022) appears to confirm the recognition of the existence of the collective trade mark and fixes its validity within a more extensive protection scheme provided by the PDO.
- 25 It is important to point out that, in the event that, as indicated in the contested decision, the signs in question are necessarily dissimilar, in order to avoid any deceptiveness on the part of the public as to the nature of the collective mark, consumers might be led to believe that there is some inherent difference (origin, quality, ingredients, etc.) between the ‘whole’ product and the portioned product, thus affecting the unitary nature of the system of protection, in the present case, of the name ‘Grana Padano’.
- 26 In order to preserve that unitary nature and with the main aim of protecting the consumer, it is appropriate to allow such cumulative protection of the sign, taking into account that



these are not identical signs, but only similar signs, used in different ways and on different goods (one on cheese as such, the other on ported and packaged cheese), depending on the type of protection that they belong to.

- 27 It is important to point out that, in fact, any amendment to the collective mark regulations that may align the aforementioned forms of use of the mark with those of the geographical indication must in any case be carefully examined and, if it does not comply with the requirements of Article 79(2) EUTMR, the amendment is not recorded in the Register, that is to say, it is refused.
- 28 Lastly, the fact that the applicant for the trade mark application in question is the officially appointed body responsible for protecting and promoting 'Grana Padano' cheese, although not in itself sufficient to rule out any deceptiveness of the sign in relation to the relevant public, undoubtedly contributes to that result, since it is for the consumer to further guarantee that the applicant for the collective mark application in question is the person officially responsible for protecting the 'Grana Padano' cheese.



- 29 Article 8(b) of the Grana Padano PDO specification provides that the  sign may be affixed to cheese packaging by authorised parties. Article 10 of the regulations governing use specifies who are authorised to use the mark and what are the conditions of membership of the association ('Consorzio' in this case). Therefore, any individual wishing to become a member of the Protection Association for 'Grana Padano' cheese, the applicant, in order to use the trade mark, will necessarily be a person who, on its own, is entitled to use the sign on the shape of the cheese. This signifies the existence of an additional level of protection afforded by the collective mark by guaranteeing, in the eyes of the public, the origin of the product wrapped by the Consorzio itself. This would be a form of added value that cannot be guaranteed or brought about by the geographical indication alone, and only the collective mark can grant.
- 30 In light of the above, it is therefore concluded that the sign forming the subject of the trade mark application is not misleading to the relevant public as to its nature within the meaning of Article 76(2) EUTMR.

*Article 7(1)(b) EUTMR*

- 31 Pursuant to Article 76(1) EUTMR, absolute grounds for refusal apply to European Union collective marks to the extent that the section on European Union collective marks does not provide otherwise. In particular, Article 74(2) EUTMR does not constitute an exception to the requirement of distinctiveness. Articles 7 (1) (b) and 7 (3) EUTMR also apply to EU collective marks. Therefore, where an association applies for registration as an EU collective mark of a sign capable of designating a geographical origin, it is required to ensure that that sign contains elements which enable the consumer to distinguish the goods or services of its members from those of other undertakings (05/03/2020 C-766/18 P, BBQLOUMI (fig.)/HALLOUMI, EU:C:2020:170, §-72).
- 32 In light of the reasons given above regarding the lack of deceptiveness of the contested trade mark, the arguments put forward in the contested decision in support of its lack of distinctive character are also lost. The Board is, in fact, of the opinion that the relevant

public will not confuse the collective mark in question with the PDO Grana Padano, not only because those signs are not identical, but also because their methods of use are different. For that reason, there is no reason to conclude that the trade mark has no distinctive character.

- 33 In fact, as per the regulations governing use, the public will always see only one sign on the packaging of 'Grana Padano' cheese, and that sign will identify it as originating from the Consorzio, therefore from the sector making it. The collective mark will confirm to the consumer the origin of that product by fully fulfilling its essential function and completing the framework of protection offered by the geographical indication, which, on the contrary, will appear only on cheese and never on its packaging.
- 34 In addition, the figurative element consisting of two triangles with the rounded toe, above and beneath the word element, far from being purely ornamental, given its characteristic shape which appears to evoke precisely two examples of stylised cheese, can only contribute to the conclusion that the collective mark GRANA PADANO is actually distinctive.
- 35 In light of the relevance of the ways in which the collective mark is used, fully in accordance with the specifications of the geographical indication, from which it emerges that the collective mark is fully recognised, and the distinctiveness of the figurative element, there is no possibility that the trade mark could not fulfil its essential function in



the eyes of the public. For these reasons, the Board considers that the sign is perfectly capable of distinguishing the goods forming the subject of the application since it has distinctive character and that, therefore, the trade mark application may *proceed* to registration.

**Order**

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision in its entirety.**
- 2. Remits the file to the examiner for further registration.**

Signed

V. Melgar

Signed

S. Rizzo

Signed

A. Pohlmann

Registrar:

Signed

H. Dijkema

