

# WEBINAR: RECENT CASE-LAW ON PGIs

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# INTRODUCTION

## Introduction

## JUDGMENTS OF THE GENERAL COURT

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- [T-510/15](#), TOSCORO
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## JUDGMENTS OF THE GENERAL COURT

### T-510/15, TOSCORO

TM 'TOSCORO' vs. PGI 'TOSCANO' (Invalidity)

**BOA:** partial invalidity

Dispute under former Regulation 40/94, but with direct applicability of GI EU Regulations

**Applicant:** 'Toscano' is descriptive and generic (plea inadmissible)

## JUDGMENTS OF THE GENERAL COURT

### T-510/15, TOSCORO

#### **GC:**

- Reminds the concept of evocation set out in previous case-law
- Describes the criteria for the analysis of ‘evocation’: visual and phonetic comparison, ‘conceptual proximity’
- No need of likelihood of confusion between goods
- EU consumer
- The ‘descriptive connotations’ of a PGI are not an argument to weaken its protection

## JUDGMENTS OF THE GENERAL COURT

### T-696/15, TEMPOS VEGA SICILIA

TM 'TEMPOS VEGA SICILIA' vs. PDO 'SICILIA' (Examination AG)

**Examiner** rejects application under Article 7(1)(j) of Regulation 207/2009

**BOA:** confirms refusal

**GC:**

- Article 7(1)(j) of Regulation 207/2009 does not involve likelihood of confusion, nor error on the part of the public: simply that the TM 'contains or consists of' the PDO
- Family of marks is not relevant in AG
- Reputation of the (applied) TM is not relevant in AG



## JUDGMENTS OF THE GENERAL COURT

### T-696/15, TEMPOS VEGA SICILIA

**GC:** Article 7(1)(j) of Regulation 207/2009 does not involve likelihood of confusion, nor error on the part of the public: simply that the TM ‘contains or consists of’ the PDO

#### **Regulation 207/2009:**

- Article 7(1)(j): ‘contain or consist of’ a PGI for wines or spirits → ‘automatic’ application, no further analysis (scope of protection is more limited?)
- Article 7(1)(k): remission to the EU Regulations on PGIs for foodstuffs → analysis of ‘evocation’ (broader scope?)

#### **Regulation 2017/1001:**

Article 7(1)(j): remission to the EU Regulations on PGIs for wines, spirits and foodstuffs → analysis of ‘evocation’ (broader scope?)

## JUDGMENTS OF THE GENERAL COURT

### T-206/16, TRES TOROS 3

TM 'TRES TOROS 3' vs. PDO 'TORO' (Examination AG)

- **Examiner** rejected the application under Article 7(1)(j) of Regulation 207/2009
- **BOA**: confirms refusal
- **Applicant**: claims that a global assessment is necessary: the TM is a reference to bull fighting, not to a PGI

## JUDGMENTS OF THE GENERAL COURT

### T-206/16, TRES TOROS 3

#### GC:

- Reminds that Article 7(1)(j) of Regulation 207/2009 does not involve likelihood of confusion, simply that the TM contains or consists of a PDO
- The concept of PGI under Article 7(1)(j) must be interpreted in relation to the EU Regulations on PGIs
- The PDO 'TORO' is included in 'TRES TOROS 3'
- Relevant public is the EU public (Spanish and not Spanish-speaking)
- There is no evidence that the public will perceive the TM as meaningful unit
- It is irrelevant whether the public knows the PDO: they will identify 'TORO' in 'TRES TOROS 3'

## JUDGMENTS OF THE GENERAL COURT

### T-828/16, QUESO Y TORTA DE LA SERENA

TM 'QUESO Y TORTA DE LA SERENA' vs. PDO 'TORTA DEL CASAR' (Opposition)

- **Opposition** dismissed
- **BOA:** protection extends to the PDO as a whole and not to its constituent elements. 'Del Casar' is the only element geographically relevant, therefore no evocation by the contested TM

## JUDGMENTS OF THE GENERAL COURT

### T-828/16, QUESO Y TORTA DE LA SERENA

#### **GC:**

- Application of Regulation 510/2006 via Article 8(4) of former CTMR
- The generic part of a PDO does not enjoy protection → factual assessment of the generic character
- However, a PDO may contain a traditional non-geographical name which enjoys protection (Article 2(2) of Regulation 510/2006) → factual assessment
- BOA fails to make those assessments
- Evocation cannot be excluded when the TM only includes a non-geographical part of a PDO

## JUDGMENTS OF THE ECJ

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- [C-56/16](#), PORT CHARLOTTE
- C-393/16, Preliminary Ruling (Champagne)

## JUDGMENTS OF THE ECJ

### C-56/16, PORT CHARLOTTE

TM 'PORT CHARLOTTE' vs PDO 'PORT' (opposition)

#### **GC:**

- Regulation 1234/2007 governs PGIs under EU Law in a uniform and exclusive manner but can benefit from supplementary protection under national law
- Contested TM is a conceptual unit and is not an evocation of the PDO



## JUDGMENTS OF THE ECJ

### C-56/16, PORT CHARLOTTE

#### ECJ:

- Parallelism between EU PGI systems for foodstuffs and for wines
- The EU PGI system for wines is also uniform and exclusive in nature: it precludes national systems of protection for GIs which are protected under EU law
- Assessment of the evocation of the PDO is factual and not subject to revision by ECJ

## JUDGMENTS OF THE ECJ

### C-393/16, Preliminary Ruling (Champagne)

- PDO 'CHAMPAGNE' vs TM 'CHAMPAGNER SORBET'
- Product under the TM contains 12% of champagne
- Infringement of the PDO?

## JUDGMENTS OF THE ECJ

### C-393/16, Preliminary Ruling (Champagne)

#### Question 1 (rephrased):

Is there a possible infringement of the PDO if the product itself bearing the TM with the indication 'Champagne' is not 'Champagne' but contains an ingredient which is 'Champagne'?

#### Answer:

That situation falls under the scope of Article 118m(2)(a)(ii) of Regulation (i.e., when the TM exploits the reputation of the PDO)

## JUDGMENTS OF THE ECJ

### C-393/16, Preliminary Ruling (Champagne)

#### Question 2 (rephrased):

Is there an exploitation of the reputation of the PDO if the product itself bearing the TM with the indication 'Champagne' is not 'Champagne' but contains an ingredient which is 'Champagne' and the ingredient has enough quantity to give the product one of its essential characteristics?

#### Answer:

There is exploitation of the reputation if the ingredient does not constitute one of the essential characteristic of the product

## JUDGMENTS OF THE ECJ

### C-393/16, Preliminary Ruling (Champagne)

#### **Question 3 (rephrased):**

Is there a possible misuse, imitation or evocation of the PDO if the product itself bearing the TM with the indication 'Champagne' is not 'Champagne' but contains an ingredient which is 'Champagne'?

#### **Answer:**

It is not misuse, imitation or evocation of the PDO, but direct use which eventually may exploit the reputation of the PDO

## JUDGMENTS OF THE ECJ

### C-393/16, Preliminary Ruling (Champagne)

#### **Question 4 (rephrased):**

Is Article 118m(2)(c) of Regulation 1234/2007 applicable to misleading indications as to the geographical origin of the product and also to the nature or essential qualities of the product?

#### **Answer:**

Yes, to both

## BOARDS OF APPEAL DECISIONS

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[R 1320/2017-2](#)

TM 'BLANC DE BLANCS CENTINELA CONO SUR'  
vs Chilean PGI 'Region del Sur'

Examiner's decision annulled



## BOARDS OF APPEAL DECISIONS

[R 1972/2016-5](#)

TM 'VERDI'

vs PDO 'Vinho Verde'

Examiner's decision annulled

## BOARDS OF APPEAL DECISIONS



Campeonatos del Mundo FIS  
Freestyle Ski & Snowboard Sierra Nevada 2017

## BOARDS OF APPEAL DECISIONS

[R 186/2017-4](#)

TM 'ANDALUCÍA SIERRA NEVADA' (Class 33)  
vs PGI 'ALTIPLANO DE SIERRA NEVADA'

Examiner's decision confirmed



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Thank you