

Geographical Indications are strong IP-rights - or should be...

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In the latest judgement of the General Court (hereafter GC) on Geographical Indications (hereafter GIs or GI) T 510/15 TOSCORO (versus the GI TOSCANO) the mark applied for was declared partially invalid.

In the European Union (hereafter EU) GIs for wine, spirits, agricultural products and foodstuffs are protected as *sui generis* intellectual property rights that act as certification that certain products possess particular qualities, characteristics or reputation essentially attributable to their geographical origin and method of production.

The applicant, Mr Roberto Mengozzi, filed an application for registration of an EU trademark for the word sign TOSCORO for goods in Classes 29 and 30, inter alia for *edible oils fats; edible vegetable oils, notably olive oils; green and black olive creams*.

In 2003 TOSCORO was registered as an EU trademark under number 002752509 for all the applied for goods. Not until 9 years later, on 10 December 2012, the intervener, Consorzio per la tutela dell'olio extravergine di oliva Toscano IGP, filed an application for a declaration that the contested mark was invalid on the basis of Article 7(1)(c), (g) and (k) of Regulation No 207/2009, read in conjunction with Article 52(1)(a) of that regulation.

The application for a declaration of invalidity was based on the protected geographical indication (PGI) 'Toscano' registered in the EU for the product 'olive oil'.

The first plea in law – the alleged infringement of Article 7(1)(k) of Regulation No 207/2009 and of Article 6(1) of Regulation No 1151/2012 – was set aside by the Court as inadmissible as these provisions were not in force on the date on which the contested mark was filed.

The decision becomes more GI-interesting as the Court looks into the second plea in law, namely the alleged error of assessment in the analysis of the similarity of the signs TOSCORO and TOSCANO. The comparison of signs should be done in accordance with Article 13(1)(b) of Regulation No 2081/92, which provides that 'registered names shall be protected against ... any misuse, imitation or evocation, even if the true origin of the product 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".'

The concept of 'evocation', set out in Article 13(1)(b) of Regulation No 2081/92, covers a situation where the term used to designate a product incorporates part of a protected designation, with the result that when the consumer is confronted with the name of the product, the image triggered in his mind is that of the product of which the designation is protected. As the signs at issue hold five out of seven letters in common with identical positioning, the Court finds the signs visually highly similar.

As regards the goods at issue the relevant criterion is that the product at issue does not necessarily need to be identical to the product which was the subject of the PGI, but it must share some common characteristics with that product. On this basis the Court finds that olive oil is included in the goods '*edible oils fats*'; '*edible vegetable oils, notably olive oils*' and '*green and black olive creams*' covered by the contested mark and featuring in Class 29 and therefore declares the contested mark invalid in relation to those goods.

The Observatory at EUIPO has conducted an interesting study '[Infringement of Protected Geographical Indications for wine, spirits, agricultural products and foodstuffs in the European Union](#)', April 2016 which shows that consumption of products labelled with GIs and designations of origin in the EU amounted to €48

billion in 2014 and that the main production and consumption of these products are shared by France, Germany and Italy. Nearly 32 p.c. of EU GI products are sold in France and more than 20 p.c. of EU GI products are exported to third countries.

The study shows a close connection between the values of GIs consumed in each member state with the number of GIs registered. Consumption activity depends on GI “culture” and attachment to regional products in different countries.

GIs are – when granted the right protection – a strong tool for regional development. Thus, the study by the Observatory also shows that the average price of a GI product is 2.21 times the price of the corresponding non-GI product, as the consumer is willing to pay more for the quality connected with GI-products.

The poor conditions granted to GIs in Denmark would most likely change if the Danish Government (Fødevarestyrelsen) and the agricultural trade organisations would take a more active attitude towards Danish brands which are actually already used as GIs such as FEJØ ÆBLER, BONHOLMER SILD, and LIMFJORDSMUSLINGER etc.