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Traditional Names – The “Torta” Battle

Carolina Pina (Garrigues) · Friday, September 14th, 2018

The debate about the traditional terms, such as “torta”, has occupied Spanish case law for a long time and now the saga continues on an EU level. The main discussion is about whether the expression “torta” can be classified as a Traditional Designation.

Background:

The Regulatory Body for the Protected Designation of Origin of Queso de la Serena (“**Queso de la Serena**”) applied for the registration of the following European Union Trademark (“**Trademark at Issue**”) to protect goods and services in classes 29, 35 and 39:



The Trademark At Issue states “Cheese and Torta of La Serena”

The Regulatory Body for the Protected Designation of Origin Torta del Casar (“**Torta del Casar**”) filed an opposition on the basis of several earlier trademarks including the term “Torta del Casar” for goods in class 29 (cheese) and the Designation of Origin “Torta del Casar”. It is this last prior right that has caused the controversy.

The Board of Appeal considered that the Designation of Origin “Torta del Casar” is comprised of (i) the term “torta”—which describes the form of the cheese in Spanish (cheese with rounded and crushed shape)—and (ii) the geographical indication “del Casar” –which identifies the geographical area in which the cheese is produced. For the Board of Appeal, the Designation of Origin refers to the term “Torta del Casar” as a whole and not to each of its terms separately. As a result, the protection conferred by the Designation of Origin does not cover the term “torta” individually.

Moreover, the Board of Appeal rejected the generic character of the word “torta” on the following

grounds: (i) it does not identify a geographical area, and (ii) the shape and visual features of a product are not protected by Designations of Origin. EUIPO concluded that the Spanish public would associate the term “torta” with a shape and not with the geographical origin of a cheese or the specific factors used in its production.

Finally, EUIPO did not consider the term “torta” as being a Traditional Designation in relation to article 2.2 of the Regulation 510/2006. For the EUIPO the key point in this case was whether the European legislation protects a Designation of Origin at an European level against the use of a later trademark when the similarity between those two elements (designation of origin and trademark) was produced in a term (“torta”) that merely describes the shape of the product and is not geographically relevant.

Subject-matter

With two defeats under its belt, Torta del Casar appealed to the EGC, which has finally annulled the EUIPO’s Decision ([link](#)). In a nutshell the EGC concluded that EUIPO did not analyze properly whether the term “torta” is a traditional name.

The EGC states that a Designation of Origin can be comprised of a traditional non-geographical name designating a foodstuff. The EGC bases its conclusions on article 1.2 of Regulation 510/2006 and the judgment by the Court of First Instance (Fourth Chamber) of 12 September 2007, *Consorzio per la tutela del formaggio Grana Padano v Office for Harmonization in the Internal Market*, case T-291/03 ([link](#)), which ruled: “Article 2(3) of Regulation No 2081/92, a PDO may also be constituted by a traditional non-geographical name designating a foodstuff originating in a region or specific place which presents homogenous natural factors which distinguish it from the areas adjoining it”.

The EGC considers that the EUIPO did not carry out a proper analysis of whether the term “torta” was a traditional name despite the evidence given by Torta del Casar. As a result, the EGC annulled EUIPO’s decision. For the EGC, an evocation may occur even if the term used is not geographically relevant. EUIPO must now decide whether the term “torta” is a traditional name.

Spanish case law

The High Court of Justice of Extremadura ruled that the term “torta” is considered a general term to describe a kind of cheese with a rounded shape and semiliquid texture (judgement by the High Court of Justice of Extremadura, No.26/2007 of 22 January 2007). In the same ruling, the High Court held that “*the evidence provided demonstrates that this name for this type of cheese is used not only in Spain in general but in Extremadura in particular*” (it should be borne in mind that both cheeses—Torta del Casar and Queso de la Serena—are from the Spanish region of Extremadura).

This understanding of the meaning of “torta” was also accepted by the Caceres Court of Appeal in a later decision (judgement by the Caceres Court of Appeal, No. 467/2016 of 14 December).

In addition, the Madrid High Court has ruled in three decisions (judgement no. 45/2018 of 24 January 2018; judgement No.196/2016 of 9 March 2016; and judgement no. 429/2011 of 10 March 2011) that the term “torta” itself is protected by the Designation of Origin Torta del Casar when that term designates cheese.

Conclusion:

To sum up, the EGC has held that a Designation of Origin can be comprised of a traditional non-geographical name designating a foodstuff. As a result, the term “torta” can be protected under Regulation 510/2006 as a traditional name. Now the ball is on EUIPO’s court, which has to decide whether the Trademark at Issue can be registered.

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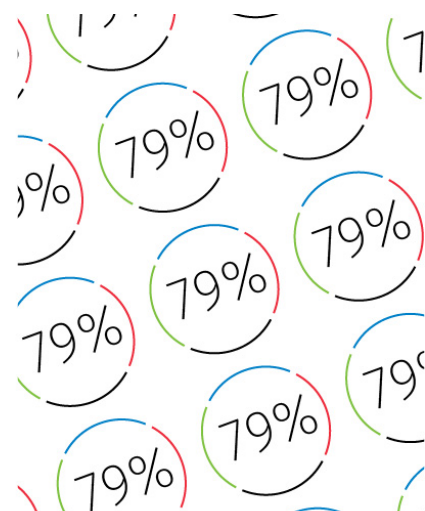
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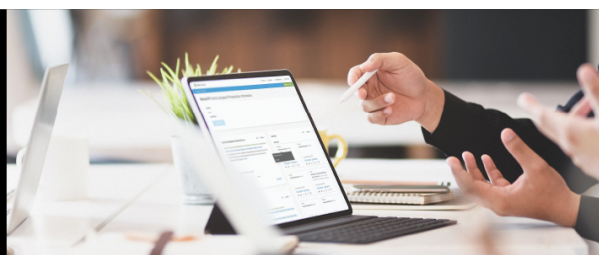


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