

PROTECTING THE ORIGIN OF FOODSTUFFS IN THE EUROPEAN UNION

Indications of origin and trademarks as intellectual property tools¹

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I. INTRODUCTION

1. In a supermarket, when doing their groceries, consumers have the choice between many types and varieties of products. Besides the price, another important factor that may influence the consumers' decision to pick one product over another is the quality reputation related to the geographical origin of the product concerned. In particular, Millennials² want *'to know where their food is from. [They] want to know how it is made, who raised it, who grew it, nurtured it. [They] want to know how [the] ingredients came to be, the details of their origins.'*³

'Parma ham' or *'Belgian beer'*, for example, are well-known names which became synonyms for quality, based on their place of provenance. Both these names indeed indicate the geographical origin of the products; the province of Parma in Italy and the kingdom of Belgium respectively.

2. To prevent the misuse of these notorious geographical names, the European Union (EU) has established two different systems for the protection of the origin of foodstuffs and agricultural products: on the one hand, there is the system of protected designations of origin (PDO) and protected geographical indications (PGI) and, on the other hand, there is the figure of the collective European Union trade mark (EU trade mark)⁴ containing a geographical name.
3. This article explores and compares the specificities of each system. First, the applicable EU legal framework for PGI/PDO and collective EU trade marks is presented (I). Second, the notion and requirements to register a PGI/PDO or a collective EU trade mark is analysed (II). Third, the scope of protection offered by each system is explained and compared (III).
4. It is important to bear in mind that the scope of this article is limited to the protection of the origin of foodstuffs intended for human consumption in the EU. It does not concern the protection of the origin of other goods or services. Furthermore, for the sake of brevity, this article does not elaborate on the protection of the origin of wines and spirits that are subject to other comparable but still more specific rules.

² Generation of people who came of age in the beginning of the third Millennium; birth dates beginning 1980-1992 and ending 1995-2004.

³ E. TUROW, *A Taste of Generation Yum*, 2015, p. 281 (eBook version).

⁴ As from 23 March 2016, the name 'Community trade mark' has been replaced by 'European Union trade mark' ('EU trade mark') and the name 'Office for Harmonization in the Internal Market' has been replaced by 'European Union Intellectual Property Office' ('EUIPO'). These modifications were brought by Regulation (EU) No. 2015/2424 of the European Parliament and the Council, amending the Community trade mark Regulation (EC) No. 207/2009 ('Amending Regulation') of 16 December 2015, OJ L 341/21 24.12.2015.

II. EU LEGAL FRAMEWORK

5. The two main instruments for protecting the origin of foodstuffs in the EU by way of intellectual property rights are:
 - 1) Regulation 1151/2012 on Quality Schemes for Agricultural Products and Foodstuffs, which allows the registration of protected geographical names; and
 - 2) Regulation (EC) 207/2009 on the European Union trade mark, which allows the registration of collective trademarks containing geographical names.
6. Regulation 1151/2012 on Quality Schemes for Agricultural Products and Foodstuffs (hereinafter, 'Regulation 1151/2012')⁵ only covers agricultural products and foodstuffs intended for human consumption. By contrast, this Regulation does not apply to spirit drinks, aromatised wines or grapevine products that are regulated by more specific vertical regulations and that benefit from an even broader scope of protection.⁶
7. Regulation 207/2009 on the European Union trade mark (hereafter, 'Regulation 207/2009')⁷, for its part, concerns any good or service covered by a trademark, including but not limited to, agricultural or food products.

II.1. REGULATION (EU) 1151/2012 ON QUALITY SCHEMES FOR AGRICULTURAL PRODUCTS AND FOODSTUFFS

II.1.1. The three quality schemes of Regulation 1151/2012: PGI, PDO and TSG

8. Regulation 1151/2012 has established three different quality schemes to protect the quality and diversity of food products within the EU:
 - The Protected Geographical Indication (PGI)
 - The Protected Designation of Origin (PDO); and
 - The Traditional Specialities Guaranteed (TSG).

⁵ See Whereas 34 of Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs, *OJ L 343*, 14.12.2012, p. 1–29.

⁶ For wines: Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013 establishing a common organization of the markets in agricultural products and repealing Council Regulations (EEC) No 922/72, (EEC) No 234/79, (EC) No 1037/2001 and (EC) No 1234/2007. For spirit drinks: Regulation (EC) No 110/2008 of the European Parliament and of the Council of 15 January 2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks and repealing Council Regulation (EEC) No 1576/89. For aromatized wine: Regulation (EU) No 251/2014 of the European Parliament and of the Council of 26 February 2014 on the definition, description, presentation, labelling and the protection of geographical indications of aromatized wine products and repealing Council Regulation (EEC) No 1601/91.

⁷ Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark, as amended by Regulation (EU) No. 2015/2424 of the European Parliament and the Council, amending the Community trade mark Regulation (EC) No. 207/2009 ('Amending Regulation') of 16 December 2015, *OJ L 341/21* 24.12.2015.

9. PGIs or PDO directly concern the origin of food products, as exemplified above. The TSG quality scheme, for its part, relates to the traditional methods of production and recipes of some products, independently from the origin of their ingredients or the place where they are manufactured. In other words, the mention 'TSG' allows manufacturers to communicate not principally on the origin of their products but rather on the value-adding attributes of their traditional recipes.
10. A well-known example is the one of *Mozzarella*⁸ that was registered in 1998 in the EU as a product of specific character and is thus entitled to use the TSG label.⁹ Another historical example comes from Belgium where, also in 1998, the Confederation of Belgian Breweries applied for a certificate in order to protect the traditional method of production of *Kriek*, *Framboise-Lambic* and their derivatives (beer with cherry or other fruit taste).¹⁰ To qualify as *Mozzarella*, a cheese must not specifically be produced in Italy. Similarly, to qualify as a *Kriek*, a beer must not be produced in Belgium. The link with the territory is not an essential part of a TSG. What matters is that the specific method of production and/or composition of the products relate to a recognised traditional practice. In that sense, a TSG is a quality scheme that is to be distinguished from PGIs and PDO. Given the subject matter of this article, we will not further elaborate on the TSG label.



⁸ For a complete explanation of the specific traditional production or manufacturing method of 'Mozzarella', please consult <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:1998:317:0014:0018:EN:PDF>. The TSG 'Mozzarella' is not to be confused with the PDO 'Mozzarella di Bufala Campana'.

⁹ The certificate of specific character (or 'CSC') is the ancestor of the 'TSG' label. See Council Regulation (EEC) No 2082/92 of 14 July 1992 on certificates of specific character for agricultural products and foodstuffs, *OJ L 208*, 24.7.1992, p. 9–14, repealed and replaced by Council Regulation (EC) No 509/2006 of 20 March 2006 on agricultural products and foodstuffs as traditional specialties guaranteed, *OJ L 93*, 31.3.2006, p. 1–11, repealed and replaced by of Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs, *OJ L 343*, 14.12.2012, p. 1–29. In accordance with Article 7 of Council Regulation (EEC) No 2082/92 of 14 July 1992, the EU Member States forwarded to the Commission applications for the entry of certain names in the register of certificates of specific character and the names so registered were entitled to use the description 'traditional speciality guaranteed'.

¹⁰ Commission Regulation (EC) No 2301/97 of 20 November 1997 on the entry of certain names in the 'Register of certificates of specific character' provided for in Council Regulation (EEC) No 2082/92 on certificates of specific character for agricultural products and, *OJ L 319*, 21/11/1997, pp. 8 – 9. For a complete explanation of the specific traditional production or manufacturing method of 'Vieille Kriek', 'Framboise Lambic' and their derivatives, please consult: http://ec.europa.eu/agriculture/quality/door/documentDisplay.html?chkDocument=3607_1_en

11. For each of these quality schemes, the EU has established a quality symbol:¹¹



12. As of 4 January 2016, as an effect of Article 12 of Regulation 1151/2012 coming into force, the use of these symbols on the packaging or labelling of food products bearing a protected name became compulsory.¹² This obligation however only concerns products originating in the EU and therefore does not apply to products originating in third countries, such as India, China, Turkey or Colombia.¹³

As an illustration, the PDO symbol must now mandatorily appear on the packaging of Parma Ham, which originates in the region of Parma, Italy. By contrast, it is not compulsory to affix the PGI symbol on the packaging of Darjeeling tea, which originates in India, a non - EU country.

II.1.2. Material and territorial scope of application of Regulation 1151/2012

13. Regulation 1151/2012 establishes a comprehensive system for the application, registration, use, protection and official control of PGIs and PDO in the EU, so as to avoid fraud or counterfeiting of food products having a protected geographical origin.
14. Regarding the material scope of application of Regulation 1151/2012, Article 2.1 specifies that it covers agricultural products and foodstuffs intended for human consumption.

These products are listed in Annex I to the Treaty on the Functioning of the European Union (TFEU), which encompasses all products of the soil, of stock farming and of fisheries (e.g. fruits, vegetables, meat, fish) as well as products of first-stage processing relating to these products (e.g. dried fruits, smoked fish, cheeses, etc.).

¹¹ Annex X of Commission Implementing Regulation (EU) No 668/2014 of 13 June 2014 laying down rules for the application of Regulation (EU) No 1151/2012 of the European Parliament and of the Council on quality schemes for agricultural products and foodstuffs, *OJ L 343*, 14.12.2012, pp. 1–29.

¹² Without prejudice to products already placed on the market before that date.

¹³ Indeed Article 12.6 of Regulation 1151/2012 reads as follows: 'In the case of products originating in third countries marketed under a name entered in the register, the indications referred to in paragraph 3 or the Union symbols associated with them may appear on the labelling'. By contrast, Article 12.3 of the same Regulation provides: 'In the case of products originating in the Union that are marketed under a protected designation of origin or a protected geographical indication registered in accordance with the procedures laid down in this Regulation, the Union symbols associated with them shall appear on the labelling(...)'. (Emphasis added).

This list has been complemented by Annex I of Regulation 1151/2012 which added new categories of products, such as chocolate, bread, pastry, biscuits, pasta, salt, mustard paste but also beers or beverages made from plant extracts.

Furthermore, Annex I of Regulation 1151/2012 has also included some non-food agricultural products, such as essential oil, cotton, flowers and ornamental plants, fur, leather and wool.

By contrast and as already mentioned above, Regulation 1151/2012 does not apply to spirit drinks, aromatised wines or grapevine products that are regulated by separate legal instruments.¹⁴

15. Regarding the **territorial scope** of application of Regulation 1151/2012, Article 4 (b) provides that one of the objectives of the PGI/PDO system is to ensure a uniform and exhaustive system of protection of the names as intellectual property rights in the territory of the Union.¹⁵

However, it must be noted that both products manufactured in one of the 28 Member States and products manufactured in foreign countries may benefit from the EU schemes for PGI or PDO. Indeed, groups of producers not established in the EU may also apply for a PGI and PDO with the EU Commission in order to protect the geographical origin of their foreign product in the EU territory. Nevertheless, so far, rather few applicants based outside the EU have had recourse to this opportunity.

Examples of foreign products benefitting from a PGI/PDO in the EU include baklava from Turkey (*Antep Baklavası*, PGI),¹⁶ Longjing tea from China (*Longjing cha* PDO),¹⁷ coffee from Colombia (*Café de Colombia*, PGI)¹⁸ and Darjeeling black tea from India (PGI).¹⁹

¹⁴ See footnote 3.

¹⁵ In order to enjoy the protection afforded by geographical designations, an EU registration has to be obtained. In other words, there is no room for national protection systems providing for a similar geographical origin related protection of quality with a smaller territorial scope of application (e.g. limited to the national boundaries of one specific EU Member State). See ECJ, C-35/13, 8 May 2014, (*Assica & Kraft Foods Italia v. Associazione fra produttori per la tutela del 'salame felino'*), ECLI:EU:C:2014:306, paras 26, 27. In that sense the protection regime of trademarks within the EU differs from the one of geographical designations. For trademarks, a parallel system with a more limited (national or Benelux) territorial scope continues to exist alongside the EU trade mark regime (see below, under nr. 18)

¹⁶ *Antep Baklavası* is a Turkish pastry made of layers of filo dough, filled with cream and pistachios and sweetened with syrup, manufactured around the city of Gaziantep, still informally referred to as Antep. See Commission Implementing Regulation (EU) No 1399/2013 of 18 December 2013 entering a name in the register of protected designations of origin and protected geographical indications [*Antep Baklavası*/Gaziantep Baklavası (PGI)], OJ L 349/58, 21.12.2013.

¹⁷ Commission Implementing Regulation (EU) No 449/2011 of 6 May 2011 entering certain names in the register of protected designations of origin and protected geographical indications (Shaanxi ping guo) (PDO), (Longjing Cha) (PDO), (Guanxi Mi You) (PDO), (Lixian Ma Shan Yao) (PGI), OJ L 122/67, 11.05.2011.

¹⁸ Commission Regulation (EC) No 1050/2007 of 12 September 2007 registering certain names in the Register of protected designations of origin and protected geographical indications (Mejillón de Galicia or Mexillón de Galicia (PDO) — Café de Colombia (PGI) — Castagna Cuneo (PGI) — Asparago Bianco di Bassano (PDO)), OJ L 240/7, 13.9.2007.

¹⁹ Commission Implementing Regulation (EU) No 1050/2011 of 20 October 2011 entering a name in the register of protected designations of origin and protected geographical indications (Darjeeling (PGI)), OJ L 276/5 21.10.2011.



Once a foreign PGI or PDO has entered in the EU register, the Union symbols associated with these protections may, at the discretion of the producer, appear on the labelling of the imported foreign products.²⁰ By contrast and as already mentioned above, it became mandatory for EU products covered by a PGI/PDO to bear the corresponding symbol as from 4 January 2016.

II.2. REGULATION (EC) 207/2009 ON THE EUROPEAN UNION TRADE MARK

16. Regulation 207/2009 establishes a comprehensive system for the award of European Union trade marks by the European Union Intellectual Property Office ('EUIPO').²¹
17. The European Union trade mark (hereafter, the 'EU trade mark' or 'EUTM') has a unitary character. It requires no more than one single application to the EUIPO and, once granted, produces the same effects in all the 28 Member States of the Union.

Furthermore, it is possible to register an EUTM either as an individual EUTM or as a collective EUTM. According to the Regulation, a trademark may be 'collective' if it is capable of distinguishing the goods or services of the *members of an association* (rather than a single person or an entity).²²

18. Regulation 207/2009 does not establish an exclusive system for trademark registration and protection in the EU since it leaves the national trademark systems of Member States and the Benelux trademark system unaffected. Enterprises are therefore free to file a national trademark application, a Benelux trademark application and/or an EUTM application depending on the (geographical extent of the) protection sought.

²⁰ Article 12.6 of Regulation 1151/2012.

²¹ Please note that, as from March 23, 2016, the name 'Office for Harmonization in the Internal Market' (OHIM) has been replaced by 'European Union Intellectual Property Office' (EUIPO) following the adoption of Regulation (EU) No. 2015/2424 of the European Parliament and the Council, amending the Community trade mark Regulation (EC) No. 207/2009 ('Amending Regulation') of 16 December 2015, *OJ L 341/21 24.12.2015*. However, decisions rendered by the OHIM before March 23, 2016 are still referred to as OHIM decisions in this article.

²² Article 66.1 of Regulation 207/2009.

19. Regarding national trademarks, each Member State offers the possibility to apply for a national trademark at its own level.²³ The main difference is that national trademarks only produce their effect in the Member State where they have been registered. Their territorial scope of protection is therefore limited. Companies may still want to choose that route because it may not be necessary to protect their products and services in the 28 Member States and it may therefore sometimes be a less costly option.²⁴
20. Regarding the Benelux trademarks, based on the Benelux Convention on Intellectual Property,²⁵ the Benelux Office for Intellectual Property (BOIP) offers the possibility to apply for an individual or collective trademark that will be registered and protected in the Benelux territory (*i.e.* Belgium, the Netherlands and Luxembourg). This option is of particular interest for companies whose business activities are mainly or exclusively located in the Benelux.
21. For the sake of clarity and brevity, this article only focuses on the protection of the origin of foodstuffs by way of a collective EUTM. It should however be borne in mind that the Benelux trademark system and the national trademark systems of each Member State can be applied in parallel.

III. PGI AND PDO: NOTION, REQUIREMENTS AND COMPARISON

III.1. NOTION OF PGI AND PDO

22. PGIs/PDO are both quality schemes aiming at protecting the geographical origin of agricultural products and foodstuffs.
23. PGIs/PDO are most commonly applied on foodstuffs because the specificities and qualities of these products usually derive from the natural factors linked to their place of origin, such as the soil or the climate of the region. Foodstuffs are therefore more likely to benefit from a PGI/PDO than other goods. However, the quality and characteristics of non-food products may also sometimes be linked to their place of origin and can therefore also bear a PGI/PDO. Such is the case for cotton and wool that are both listed in Annex I of Regulation 1151/2012. In November 2011, for example, Native Shetland Wool was the first kind of wool to be registered as a PDO – and still the only one today.²⁶

²³ The national scope of protection has however been harmonized on the basis of Directive 2008/95/EC of 22 October 2008 to approximate the laws of the Member States relating to trade marks, <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2008:299:0025:0033:en:PDF>. With this directive the EU has opted, not for a full-scale approximation but for an approximation of national trademark laws limited to those national provisions of law that most directly affect the functioning of the internal market.

²⁴ See Regulation 207/2009 on the EUTM, cons. 6.

²⁵ Benelux Convention on Intellectual Property (trademarks and designs), adopted on 25 February 2005 at the Hague and entered into force on February 1, 2007 (http://www.wipo.int/wipolex/en/other_treaties/details.jsp?treaty_id=229).

²⁶ Commission Implementing Regulation (EU) No 1121/2011 of 31 October 2011 entering a name in the register of protected designations of origin and protected geographical indications (Native Shetland Wool (PDO)), L 289/14, 8.11.2011.

24. In practice, PGIs and PDO mostly consist of the name of a city, a region or, more exceptionally, a country, combined with the generic name of the product.

For example, the PGI '*Citron de Menton*' (Lemon of Menton) refers to the city of Menton that is located by the sea in south-eastern France. Other known examples are the PGI '*Jambon d'Ardennes*' (Ham from the Ardennes), that refers to a region in the south-east of Belgium, and the PGI '*Café de Colombia*' (coffee from Colombia) that refers to the country of Colombia.



25. In exceptional cases, it may happen that a denomination be protected under the EU regime of PGI/PDO although not mentioning, in its name, the place of origin of the product.

Feta, for example, is a PDO used for designating a white cheese originating in Greece.²⁷ Despite the fact that this PDO does not include the name of any place, region or country, it has been registered as a PDO because the name 'Feta' was deemed to suffice to identify the cheese as originating in (certain regions of) Greece.

26. By contrast it may happen that the geographical indication of a food product becomes so well-recognised by the public that it is self-sufficient and replaces the name of the product itself. Such is the case, for example, for Darjeeling black tea, which has been registered as a PGI under the simple name 'Darjeeling', without the need to add the words 'black tea'.²⁸

²⁷ Commission Regulation (EC) No 1829/2002 of 14 October 2002 amending the Annex to Regulation (EC) No 1107/96 with regard to the name 'Feta', OJ L 277/10, 15.10.2002.

²⁸ Commission Implementing Regulation (EU) No 1050/2011 of 20 October 2011 entering a name in the register of protected designations of origin and protected geographical indications (Darjeeling (PGI)), OJ L 276/5 21.10.2011.



27. Finally, it must be noted that some products, although bearing the name of a given place, do not qualify as a PGI/PDO. This is the case for products the name of which has become generic, such as Cheddar cheese, '*Moutarde de Dijon*' (Dijon mustard) or '*Schwarzwälder Kirschtorte*' (Black forest cake). These names have lost their capacity to be registered as a PGI/PDO because the public does no longer associate these products with the place referred to in their name.²⁹

III.2. REQUIREMENTS TO QUALIFY AS A PGI / PDO

III.2.1. Conditions to qualify as a PGI

28. Regulation 1151/2012 lays down the three main conditions for a PGI³⁰ to be granted, by stating that a 'geographical indication' is a name which identifies a product:

- (a) originating in a specific place, region or country;
- (b) whose given quality, reputation or other characteristics are essentially attributable to its geographical origin; and
- (c) at least one of the production steps of which take place in the defined geographical area.

29. These conditions can be considered as positive requirements since only products that comply with these requirements can be registered as a PGI.

III.2.2. Conditions to qualify as a PDO

30. Regulation 1151/2012 lays down the three main conditions for a PDO³¹ to be granted, by stating that a 'designation of origin' is a name which identifies a product:

- (a) originating in a specific place, region or, in exceptional cases, a country;

²⁹ See also below under nr. 33.

³⁰ Article 5.2 of Regulation 1151/2012.

³¹ Article 5.1 of Regulation 1151/2012.

- (b) whose quality or characteristics are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors; and
- (c) the production steps of which all take place in the defined geographical area.

III.2.3. Other (negative) requirements to qualify as a PGI/PDO

31. Besides the specific (positive) conditions laid down in article 5.1 or 5.2 of Regulation 1151/2012, a name will in any case not be registered as a PGI/PDO if it falls in one of the following categories:³²

- (a) if it is a generic name (e.g. 'Cheddar'³³ or 'Gouda'³⁴);
- (b) if it conflicts with a name of a plant variety or an animal breed and is likely to mislead the consumer as to the true origin of the product (e.g. 'Abundance');³⁵
- (c) if it is wholly or partially homonymous with a PGI/PDO already entered in the register, unless, in practice, there is sufficient distinction, so as to ensure that producers are equally treated and that consumers are not misled;³⁶

³² Article 6 of Regulation 1151/2012.

³³ Cheddar is the name of a village located in the county of Somerset, south of the United Kingdom. The word 'Cheddar' also refers to the famous yellow-orange cheese historically originating in that area. However, because Cheddar cheese was quickly manufactured and sold in other countries of the commonwealth and the USA, it lost its original meaning and the public stopped associating Cheddar with the British village it came from. As a consequence, Cheddar became a generic name for that kind of cheese. However, the fact that the name 'Cheddar' cannot be registered as a PGI or PDO anymore does not mean that this name cannot be part of a PGI/PDO. For example, the PDO « *West Country Farmhouse Cheddar Cheese* » has been validly registered in 1996 by Commission Regulation (EC) No 1107/96 of 12 June 1996 on the registration of geographical indications and designations of origin under the procedure laid down in Article 17 of Council Regulation (EEC) No 2081/92, *OJ L 148, 21.6.1996, p. 1–10*.

³⁴ Although 'Gouda' has become a generic name for that kind of cheese, the PDO 'Noord-Hollandse Gouda' and the PGI 'Gouda Holland' have been validly registered in 1996 and 2010 respectively. Regulation No 1122/2010 entering the PGI 'Gouda Holland' in the EU Register was contested by a German association of Gouda manufacturers and distributors that claimed that this would adversely affect their situation. However, the association lacked any interest or standing to bring proceedings and their action was therefore dismissed as inadmissible. The Court nevertheless emphasised that the registration of the PGI 'Gouda Holland' would not have any adverse effect on the use of the generic word 'Gouda' and was not, as such, giving a competitive advantage to some producers. See Case T-113/11, *Gouda Holland, (Schutzgemeinschaft Milch und Milcherzeugnisse eV v European Commission)*, Order of the General Court of 3 September 2014, ECLI:EU:T:2014:752. See also the similar case T-112/11, *Edam Holland (Schutzgemeinschaft Milch und Milcherzeugnisse eV v European Commission)*, Order of the General Court of 3 September 2014, ECLI:EU:T:2014:752 and the subsequent dismissal of the appeal by the ECJ, in C-517/14 P, Order of the Court of 6 October 2015, ECLI:EU:C:2015:700.

³⁵ The Commission gives as an example the name 'Abundance' which was registered as a PDO for cheese in 1996 although also designating a cattle breed. According to the Commission, the registration was accepted because it was considered that there could be no confusion between the cheese and the breed. Commission Regulation (EC) No 1107/96 of 12 June 1996 on the registration of geographical indications and designations of origin under the procedure laid down in Article 17 of Council Regulation (EEC) No 2081/92, *OJ L 148, 21.6.1996, p. 1–10*. See Working Document of the Commission Services, Guide to Community Regulation, Protected Geographical Indication, Designation of Origin and Certificates of Specific Character for Agricultural Products, 2nd edition of August 2004.

- (d) if it is a homonymous name which misleads the consumer into believing that products come from another territory, even if the name is accurate;³⁷
 - (e) if, in the light of a trademark's reputation and renown and the length of time it has been used, registration of the name would be liable to mislead the consumer as to the true identity of the product.³⁸
32. These requirements can be considered as 'negative' requirements, in the sense that a name cannot be registered as a PGI/PDO if it falls in one or the other category above.

III.3. COMPARISON BETWEEN PGIs AND PDO

33. It can be concluded from the above that the link between the product and the territory is stronger for PDO than for PGIs. This is clearly reflected in Regulation 1151/2012 which establishes more stringent positive requirements for PDO than for PGIs³⁹:
- **Regarding the quality and characteristics of the products:** for a PDO to be granted, the quality or characteristics of the concerned product must *essentially* or *exclusively* derive from the geographical environment with its inherent natural and human factors, such as the weather conditions, the shape of the landscape, the composition of the soil, the feed of the animals and/or the human skills with which the product is manufactured, stored, packaged or even sliced.⁴⁰

³⁶ One may give the following hypothetical example: 'Café de Colombia' is a registered PGI in the EU for coffee originating in Colombia, South America. However, Colombia is also the name of a municipality in Las Tunas, Cuba. If coffee producers from the municipality of Colombia in Cuba would apply for the homonymous PGI 'Café de Colombia', such an application may be refused on the grounds that it may mislead the consumers about the real origin of the product. Similarly, La Rioja is the name of a region in Spain and in Argentina, both producing wines. The Spanish wine 'Rioja' has been registered as a PDO since 1986 and is nowadays legally protected under Article 107 of Regulation (EU) No 1308/2013. This may prevent the registration of the Argentinian PDO 'La Rioja', unless it is ensured that consumers are not misled (for example, the PDO 'La Rioja Argentina' could, hypothetically, be accepted because it indicates that the product originates in Argentina).

³⁷ This ground for refusal is similar to the previous one, except that no homonymous PGI/PDO has been registered yet. Once again, registration will be refused if there is a risk that the consumers may be misled as to the true origin of the product, even if the geographical name is accurate.

³⁸ Following notification of the application for the PGI '*Bayerisches Bier*' (in English, Bavarian beer), the Dutch and Danish authorities informed the Commission of the existence of two trademarks used for beer that could conflict with such a PGI: the Dutch brand '*Bavaria*' and the Danish trademark '*Høker Bajer*'. However, it was considered that registration of the name '*Bayerisches Bier*' was not liable to mislead the consumer as to the true identity of the product. The PGI '*Bayerisches Bier*' nowadays coexists on the market with the trademarks '*Bavaria*' and '*Høker Bajer*'. Source: EU Commission, directorate-general for agriculture and food quality policy in the European union, *Protection of geographical indications, designations of origin and certificates of specific character for agricultural products and foodstuffs*, Working document, Guide to Community regulations, 2nd edition, August 2004.

³⁹ Compare articles 5.1 and 5.2 of Regulation 1151/2012.

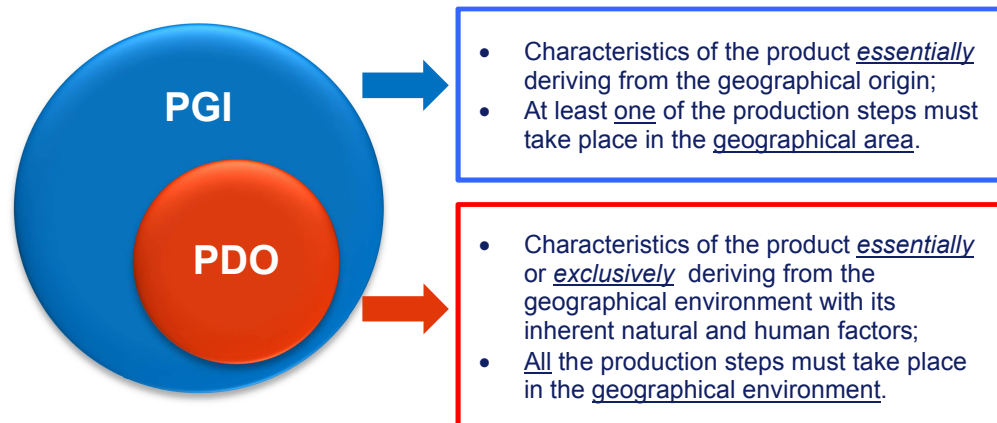
⁴⁰ The method of production of '*Prosciutto di Parma*' (PDO), for example, includes the way it should be sliced and packed. The product specifications provide under point 4.5 (method of production): '*After the logo is affixed, 'Prosciutto di Parma' may be marketed whole, boned and packaged into pieces of variable weights and shapes or sliced and properly packaged. In the case of the latter, slicing and packaging processes must be carried out in the production area and the PDO logo must be indelibly affixed to the package in accordance with the methods set out below in point 4.8. This is essential to ensure the qualitative characteristics of 'Prosciutto di Parma' and complete product traceability.*' EC No: IT/PDO/117/0067/09.06.1998.

By contrast, for a PGI to be granted, the quality or characteristics of the product must *essentially* be attributable to the geographical origin (without reference to a possible exclusive link with the geographical environment and without reference to the natural or human factors of that geographical environment).

- **Regarding the production steps:** for a PDO to be granted, *all production steps* must take place in the designated place of origin.

By contrast, in the case of a PGI, *at least one production step* must take place in the defined geographical area.

34. All in all, PDO can therefore be considered to constitute a stricter sub-category of PGIs.



35. In the field of foodstuffs, many products benefit from a PDO, such as *Roquefort*,⁴¹ *Prosciutto di Parma*,⁴² *Mozzarella di Bufala Campana*⁴³ or, as far as Belgian products are concerned, *fromage de Herve*⁴⁴ and *beurre d'Ardenne*.⁴⁵

36. In order to be entitled to use these names, manufacturers must comply with the stringent requirements attached to the PDO concerned. These requirements are specified and embedded in a legal document published by the EU Commission, commonly referred to as the product specifications.

⁴¹ Commission Regulation (EC) No 1107/96 of 12 June 1996 on the registration of geographical indications and designations of origin under the procedure laid down in Article 17 of Council Regulation (EEC) No 2081/92, *OJ L 148*, 21.6.1996, p. 1–10.

⁴² Ibid.

⁴³ Ibid.

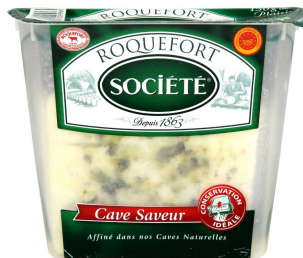
⁴⁴ Commission Regulation (EC) No 1263/96 of 1 July 1996 supplementing the Annex to Regulation (EC) No 1107/96 on the registration of geographical indications and designations of origin under the procedure laid down in Article 17 of Regulation (EEC) No 2081/92, *OJ L 163*, 2.7.1996, p. 19–21.

⁴⁵ Commission Regulation (EC) No 1107/96 of 12 June 1996 on the registration of geographical indications and designations of origin under the procedure laid down in Article 17 of Council Regulation (EEC) No 2081/92, *OJ L 148*, 21.6.1996, p. 1–10.

37. As an example of the strong link between a product and the geographical environment in which it originates, one may refer to the product specification of the PDO 'Roquefort', a well-known smooth and compact blue cheese originating in France.

According to the product specifications,⁴⁶ all the production steps of Roquefort must exclusively take place around the municipality of Roquefort-sur-Soulzon, a region of south-western France. Furthermore, Roquefort must be made from raw, whole sheep's milk from the Lacaune breed and cultured with specific spores called *penicillium roqueforti*. The cheese must ripen by being left exposed in the natural calcareous caves in Roquefort-sur-Soulzon for at least 14 days. Then it must age in a protective wrapping either in the same caves or in temperature-controlled cellars.

The breed and alimentation of the sheep, the calcareous caves in which the cheese must age, as well as the traditional manufacturing process of Roquefort, all give to this product its quality and specific characteristics, justifying the granting of a PDO.



38. It is interesting to note that the product specifications of PGIs/PDO, beyond the composition, the manufacturing process or the area of origin of the product, may also describe mandatory operations such as the slicing and the packaging of the product concerned, and the area in which such operations must take place.

According to the specification of *Prosciutto di Parma* (PDO), for example, the ham must be sliced and packed in the region of production. Although such a requirement causes discrimination between domestic trade and export trade, and therefore constitutes a measure having equivalent effect to a quantitative restriction, it has been considered as justified on the grounds that it helps preserving the reputation of *Prosciutto di Parma* and because the resulting restriction is necessary and proportionate for attaining the objective pursued.⁴⁷

⁴⁶ Publication of an amendment application pursuant to Article 6(2) of Council Regulation (EC) No 510/2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, 'ROQUEFORT', (2007/C 298/11), OJ C 298/28, 11.12.2007.

⁴⁷ ECJ, Case C-108/0, Judgement of 20 May 2003, *Consorzio del Prosciutto di Parma and Salumificio S. Rita SpA v Asda Stores Ltd and Hygrade Foods Ltd*, ECLI:EU:C:2003:296.

This shows how far the PGI/PDO system may reach in protecting the origin and characteristics of a product.

IV. EUROPEAN UNION TRADE MARK: NOTION, REQUIREMENTS AND COMPARISON

IV.1. NOTION OF (INDIVIDUAL OR COLLECTIVE) EU TRADE MARK

IV.1.1. *What is a trade mark?*

39. A trade mark is a sign that is used as a branding tool for differentiating a product (or service) from other similar products (or services). The company using the trade mark might make considerable investments for the product (and thus, the associated trade mark) to gain notoriety and become synonymous for quality. Hence, it is important to register a trade mark in order to protect it and prevent others from using it in the course of trade.
40. A trade mark mainly points to the company that manufactures the products covered by that trade mark. In that sense, a trademark also constitutes a tool for identifying the (commercial rather than geographical) origin of a product as well as its related characteristics and quality.
41. The system established under Regulation 207/2009 consists of one single registration procedure which grants to the owner of a European Union trade mark ('EU trade mark' or 'EUTM') an exclusive right to use the trademark throughout the 28 Member States of the EU.⁴⁸

IV.1.2. *What is an individual or collective EUTM?*

42. Regulation 207/2009 gives the possibility to register an EUTM either as an individual EUTM but also as a collective EUTM.

An individual EUTM is a sign that is capable of distinguishing the products manufactured by or under the control of one person – its owner – from those of other undertakings.

In contrast, a collective EUTM – as indicated in its name – is a trademark that is capable of distinguishing the products of all the members of the association that is the trademark proprietor from those of other undertakings. The owner of a collective EUTM may be an association, whose members have a commercial activity or a legal person governed by

⁴⁸ See also above under II.2.

public law.⁴⁹ This association or public institution is responsible for supervising its use by the members.⁵⁰

43. It is important to note that, contrary to an individual trademark, which may not be descriptive of the place of origin of the goods, a collective trademark may consist of a sign or indication that serves, in trade, to designate the geographical origin of the products.⁵¹

Such is the case, for example, for the collective EUTM '*Genuine Bavarian beer*'⁵² or for the collective Benelux trademark '*Belgian Beer*'⁵³.



44. As a counterpart, the owner of the collective trademark must not abuse from this right and therefore:
- the association owning a collective EUTM may not prevent any third-party from using a similar or identical name or sign if such use is made in accordance with honest practices in commercial matters, especially when the third-party is entitled to use the geographical name on the basis of a registered PGI or PDO⁵⁴;
 - the association must authorize any person whose products originate in the geographical area concerned to become a member of the association.⁵⁵

By way of illustration, the German association *Bayerischer Brauerbund e.V.*, which owns the collective EUTM '*Genuine Bavarian Beer*' (represented here above), cannot prevent any other third-party to use the terms 'Bavaria' or 'Bavarian' if such use is honest,

⁴⁹ Article 66.1 of Regulation 207/2009 provides: 'Associations of manufacturers, producers, suppliers of services, or traders which, under the terms of the law governing them, have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue and be sued, as well as legal persons governed by public law, may apply for EU collective marks'.

⁵⁰ BOIP, Individual and collective trademarks, available at www.boip.int.

⁵¹ Article 66.2 of Regulation 207/2009.

⁵² OHIM, EM Trademark, « *Genuine Bavarian Beer* » (collective) trade mark n°0214051.

⁵³ Benelux Office for Intellectual Property (BOIP), Benelux Trademark, « *Belgian Beer* » (collective) trade mark n° 0639821.

⁵⁴ Article 66.2 of Regulation 207/2009.

⁵⁵ Article 67.2 of Regulation 207/2009.

especially when the name 'Bavarian' (or '*bayerische*' in German) is registered as part of a valid PGI or PDO.⁵⁶

45. The creation of a collective EUTM goes hand in hand with the development of specific standards and criteria. When applying for an EUTM, the applicant must therefore submit a set of regulations governing the use of the EUTM.⁵⁷ This set of regulations includes (i) the persons authorised to use the mark, (ii) the conditions of membership of the association and (iii), when applicable, the conditions of use of the mark, including sanctions. Only persons and products complying with these regulations are allowed to use or bear the collective trademark.⁵⁸
46. The conditions of use of a collective EUTM may largely vary from one product to another. This could include, for example, a list of the specific ingredients, the quantities to be used and/or the place where the product must be manufactured.

For example, the collective EUTM '*Authentic Trappist Product*', owned by the international association TRAPPIST (in Dutch: *Internationale Vereniging TRAPPIST*) may only be used if the following conditions are fulfilled:⁵⁹

- 1) the products are manufactured in or around the vicinity of the monastery;
- 2) the monastic community is engaged in the management of and all the resources necessary for the business;
- 3) the business incomes largely sustain the needs of the monastic community and social work / charities.



47. Similarly to a PGI or a PDO, a collective EUTM may therefore serve as a tool for protecting the geographical origin of food products. This is particularly the case when the

⁵⁶ See also below under nr. 67 and following.

⁵⁷ Article 67.1 of Regulation 207/2009.

⁵⁸ Article 67.2 of Regulation 207/2009 ; see also WIPO, Collective marks, available at : http://www.wipo.int/sme/en/ip_business/collective_marks/collective_marks.htm

⁵⁹ Information available at : <http://www.trappist.be/fr/pages/logo-atp>.

collective EUTM consists of a sign designating a place or a geographical area and when the conditions for the use of the collective EUTM specify where the products must be manufactured.

IV.2. PROTECTION REQUIREMENTS FOR EU trade marks

IV.2.1. Main conditions: a sign capable of distinguishing products and of being represented in the EU Register

48. Article 4 of Regulation 207/2009⁶⁰ reads as follows:

‘An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

(a) distinguishing the goods or services of one undertaking from those of other undertakings; and

(b) being represented on the Register of European Union trade marks, (‘the Register’), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.’

49. Article 66.1 of Regulation 207/2009 further reads as follows: *‘A European Union collective mark shall be an EU trade mark which is described as such when the mark is applied for and is capable of distinguishing the goods or services of the members of the association which is the proprietor of the mark from those of other undertakings.’*⁶¹

50. There are thus two conditions for a sign to qualify as an EUTM:

- 1) the sign must be capable of distinguishing the products of *one undertaking* (for the individual EUTM) or the products *of the members of an association* (for the collective EUTM) from those of competitors;
- 2) the sign must be capable of being represented in a manner which enables to determine the clear and precise subject matter of the protection afforded to its proprietor.

51. There have been some attempts to register non-traditional signs as trade marks. This means that rather than words, design, symbols and/or colours – which are traditional

⁶⁰ As replaced by Regulation (EU) No. 2015/2424 of the European Parliament and the Council, amending the Community trade mark Regulation (EC) No. 207/2009 (‘Amending Regulation’) of 16 December 2015, *OJ L 341/21 24.12.2015*.

⁶¹ Article 66.1 of Regulation 207/2009 as modified by Regulation (EU) No. 2015/2424 of the European Parliament and the Council, amending the Community trade mark Regulation (EC) No. 207/2009 (‘Amending Regulation’) of 16 December 2015, *OJ L 341/21 24.12.2015*.

signs – companies have tried to get a trade mark on a *shape*, a *sound* and sometimes even a *taste* or a *scent*.

On the one hand, it has already been allowed to register the shape of a good or a packaging as a trade mark. In the EU, a famous shape that has been registered as an EUTM is the one of the chocolate box 'TOBLERONE', capable of distinguishing Toblerone chocolate from other kinds of chocolate because of its triangle shape.⁶²

On the other hand, the possibility to trademark a scent, a taste or a flavour of foodstuffs seems rather remote.

In the *Sieckman* case,⁶³ the European Court of Justice (ECJ) admitted that a trademark may consist of a sign which is not, in itself, capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is '**clear, precise, self-contained, easily accessible, intelligible, durable and objective**'. The ECJ considered in respect of an olfactory sign that '*the requirements of graphic representability were not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements*'.⁶⁴ In other words, it is difficult to imagine that a scent could be registered as an EUTM in the EU since the ECJ excluded most if not all of the representations one may give to such a scent.⁶⁵ The same assessment may be expected to apply to a flavour or a taste even after the modifications brought by Regulation (EU) No. 2015/2424⁶⁶ to Article 4 of Regulation 207/2009⁶⁷ in which the word '*graphically*' has recently been suppressed.

IV.2.2. Grounds for refusal / invalidity (negative requirements)

52. Not all signs capable of distinguishing products from those of competitors and of being represented in the EU Register can constitute a valid trademark. Indeed, besides these two positive conditions, some negative requirements also need to be met. Otherwise, the sign will be refused or invalidated as a trademark.

⁶² OHIM, EM Trademark, « TOBLERONE » (3-D), trademark n°000031203.

⁶³ ECJ, *Sieckmann*, judgment of 12 December 2002, case C-273/00, OJ C 19/3, 25.01.2003.

⁶⁴ Ibid.

⁶⁵ The US Patent and Trademark Office seems to have a more liberal approach on this question since several scents have already been trademarked (e.g. the '*Flowery musk scent*' in Verizon store, the '*Bubble gum scent for sandals*' of the Brazilian footwear company Grendene, etc.). However, the US courts have so far refused to trademark flavours: in October 2014, a Texan judge, Gregg Costa, refused to admit that the taste of a pizza could be registered as a TM. First, because it is difficult for flavours to be inherently distinctive and, second, because a taste on a pizza performs an utilitarian function and '*functional product features are not protectable*' (US District Court, Southern district of Texas, Galveston division, *New York Pizza Inc. vs Ravinder Syal et al*, civil action NO. 3:13-CV-335, 20 October 2014).

⁶⁶ Regulation (EU) No. 2015/2424 of the European Parliament and the Council, amending the Community trade mark Regulation (EC) No. 207/2009 ('Amending Regulation') of 16 December 2015, OJ L 341/21 24.12.2015.

⁶⁷ Former Article 4 of Regulation 207/2009 read as follows: '*A Community trade mark may consist of any signs capable of being represented **graphically**, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings*'. (Emphasis added).

53. Among these negative requirements, three are of particular relevance to food products and their geographical origin as a conveyor of a quality message:

- 1) First, Article 7(1)(j) of Regulation 207/2009, as recently amended,⁶⁸ now provides that: *'shall not be registered (...) trade marks which are excluded from registration, pursuant to Union legislation or national law or to international agreements to which the Union or the Member State concerned is a party, providing for protection of designations of origin and geographical indications'*.

When a trade mark is nonetheless registered in violation of this rule, the sanction is its invalidation.⁶⁹

These grounds for refusal and invalidation in relation to PGI/PDO were recently inserted to ensure consistency with the parallel relevant Union legislation providing for protection of those intellectual property titles.⁷⁰

- 2) Second, a sign cannot be registered/will be invalidated as a trademark if it consists exclusively of a sign or indication which may serve, in trade, to designate the geographical origin of the products concerned (this is a descriptive sign).

For example, the word sign *'Himalayan Goji'* for goji berries that grow in the Himalayas was refused for registration as an EUTM because it merely describes the origin of the product⁷¹.

On the other hand, it is perfectly possible to use fashionable geographical names for foodstuffs unrelated to the reason for which the concerned places are known (e.g. *'Hollywood'* for chewing gum, *'Champs Elysées'* for bottled water, *'Manhattan'* for tomatoes, etc.).⁷²

It is important to note that, when assessing whether a trade mark is descriptive of the geographical origin of a product, both the present and the future context must be taken into account. In other words, a trade mark is not valid if it contains a geographical name which may be considered by the public as designating the origin of the goods concerned, either at the present moment or if such could become the

⁶⁸ Article 1(9) of Regulation (EU) No. 2015/2424 of the European Parliament and the Council, amending the Community trade mark Regulation (EC) No. 207/2009 ('Amending Regulation') of 16 December 2015, *OJ L 341/21 24.12.2015*.

⁶⁹ Article 52.1 (a) and 53.1 (d) of Regulation 207/2009, as amended by Article 1(50)(a) of Regulation (EU) No. 2015/2424 of the European Parliament and the Council, amending the Community trade mark Regulation (EC) No. 207/2009 ('Amending Regulation') of 16 December 2015, *OJ L 341/21 24.12.2015*.

⁷⁰ See whereas 10 of Regulation (EU) No. 2015/2424 of the European Parliament and the Council, amending the Community trade mark Regulation (EC) No. 207/2009 ('Amending Regulation') of 16 December 2015, *OJ L 341/21 24.12.2015*.

⁷¹ OHIM, Board of Appeal, *Himalayan Goji*, R0888/2005-4, 3 February 2006.

⁷² Guidelines for examination in the Office for Harmonization in the Internal Market (trade marks and designs) on Community Trade Marks, Part B, Examination, Section 4, Absolute Grounds for Refusal, 01/02/2016, p.68. (<https://oami.europa.eu/ohimportal/en/manual-of-trade-mark-practice>).

case in the future.⁷³ The distinctive power of the trade mark must also be taken into consideration: indeed, a geographical name could gain a new significance and its connotation considered as no longer descriptive because of the distinctiveness of the trademark concerned. A long-standing and intensive use of the mark by its holder can help acquire this distinctiveness.⁷⁴

- 3) Third, a sign cannot be registered/will be invalidated as a trademark if it is of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the products.

For example, one may reasonably assume that the word trademark '*Colombiano Coffee House*' for coffee products will be refused as an EUTM if the coffee beans are actually sourced from Africa, since it may deceive the public as to the geographical origin of the products concerned.⁷⁵



V. SCOPE OF PROTECTION, RELATION AND COMPARISON BETWEEN PGIs, PDO AND EU TRADE MARKS

54. Some similarities and differences between PGIs/PDO and EUTMs for protecting the origin of food have already been highlighted. In deciding which system or combination of systems to adopt, (associations of) producers must also be aware of the differences existing between the respective scope of protection of PGIs/PDO or EUTMs.

V.1. THE SCOPE OF PROTECTION OF THE EUTM: Article 9 of Regulation 207/2009

55. An EUTM is to be considered as a private title owned by a (legal) person pursuing private (mainly economic) interests. The protection afforded to collective EUTMs and individual EUTMs against infringement is the same: it aims at preventing third-parties from using an identical or similar sign as the EUTM, with respect to identical or similar (or in certain

⁷³ Joined cases C-108/97 and C-109/97, *Windsurfing Chiemsee*, judgement of 4 may 1999, I-02779.

⁷⁴ *Ibid.*

⁷⁵ Cfr. OHIM, Board of Appeal, *Colombiano Coffee House*, judgment of 27 March 2014, R1200/2013-5.

circumstances even non similar) products, given the risk of confusion or the harmful association that would arise from such use.

56. Regulation 207/2009 defines the scope of protection of an individual and collective EUTM as follows:

'(...) The proprietor [of an EU trade mark] shall be entitled to prevent all third parties not having his consent from using in the course of trade:

- (a) any sign which is identical with the EU trade mark in relation to goods or services which are identical with those for which the EU trade mark is registered;*
- (b) any sign where, because of its identity with, or similarity to, the EU trade mark and the identity or similarity of the goods or services covered by the EU trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;*
- (c) any sign which is identical with, or similar to, the EU trade mark in relation to goods or services which are not similar to those for which the EU trade mark is registered, where the latter has a reputation in the EU and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the EU trade mark.'*⁷⁶

57. The owner of an EUTM is therefore in summary entitled to prevent any other company or person, who does not have its consent, from using (1) the same sign when marketing identical products within the EU and (2) the same sign for similar products or a similar sign for identical products if such use triggers a likelihood of confusion⁷⁷. Furthermore, an EUTM having '*a reputation in the Union*' enjoys an even broader scope of protection since the holder of a reputed EUTM can prevent any third-party from using the same or a similar sign when marketing dissimilar products (and *a fortiori* in case of similar products)⁷⁸, if by using that sign, this third-party takes unfair advantage of the EUTM (e.g. in terms of time and money investment) or if such use is detrimental to the distinctive character or to the repute of the EUTM (e.g. in terms of the image built)⁷⁹.

The collective EUTM 'PARMA'⁸⁰, for example, is owned by an association called the *Consorzio del prosciutto di parma* (hereinafter 'the Consortium'). Logically, only manufacturers of Parma ham meeting the conditions for the use of that collective EUTM

⁷⁶ Article 9.1 of Regulation 207/2009.

⁷⁷ Article 9.1 (a) and (b) of Regulation 207/2009.

⁷⁸ ECJ, *Davidoff & Cie SA, Zino Davidoff SA v Gofkid Ltd*, judgement of 9 January 2003, Case C-29/00, [2003] I-389; ECJ, *adidas v Fitnessworld*, judgement of 23 October 2003, Case-408/01, [2003] ECR-I2537.

⁷⁹ Article 9.1 (c) of Regulation 207/2009.

⁸⁰ OHIM, EU Trademark, « PARMA », (collective) trade mark n°001116201.

can become members of the Consortium and therefore put this sign on the packaging of their products, use it in advertising, etc.



Under Article 9.1 (a) and (b) of Regulation 207/2009, the Consortium (being the holder of the collective EUTM) is also entitled to prevent any third-party from using an identical or similar logo to market a non-complying dried ham or a similar product (such as for example a vegetarian substitute for dried ham), if such use creates a risk of confusion in the mind of the public between the real Parma ham and the other product. The latter condition is presumed to be met in case of an identical sign used for an identical product⁸¹.

Furthermore, provided that the 'PARMA' logo is an EUTM having a reputation in the Union in the sense of Article 9.1 (c) of Regulation 207/2009, the Consortium could also start legal proceedings against a manufacturer of (cheap) olive oil that markets its products under an identical or similar logo, if such practice amounts to taking unfair advantage of the collective EUTM 'PARMA' or would harm its distinctive power or repute.⁸²



However, the Consortium could not prevent other manufacturers based in Parma to fairly use the name 'Parma' as such to market products originating in the region, provided of course, that the logo or the sign used in association with that name is not similar to the

⁸¹ Article 9.1 (a) of Regulation 207/2009.

⁸² Hypothetical example.

'PARMA' crown image trademark and would thus arguably be used in accordance with honest practices in industrial or commercial matters.⁸³



58. In summary, and provided that certain conditions are met, EUTMs are thus protected against two levels of threat:

- 1) The first threat is the risk of confusion between the EUTM and a similar or identical sign, leading consumers to be possibly confused and therefore believing that the products covered by the similar/identical sign have the same origin as the products covered with the EUTM (direct confusion).

Confusion may also exist where the consumer believes that the undertakings manufacturing goods under the sign and the EUTM are economically linked (indirect confusion).⁸⁴

The likelihood of confusion between a sign and an earlier trademark must be considered globally, taking into account all the factors relevant to the circumstances of the case, such as the degree of similarity between the sign and the earlier trademark, the degree of similarity between the goods concerned by the sign and the earlier trademark, the distinctive character and the repute of the earlier trademark, as well as the relevant public.⁸⁵ The global assessment implies some interdependence between the relevant factors. Accordingly, a lesser degree of similarity between the goods concerned could be offset by the high repute of the earlier trademark, and *vice versa*.⁸⁶

In the case *Ferrero v Ferrò*, it has been ruled that, even if the registration of the mark Ferrò was sought for products and services that were not similar to the ones covered

⁸³ Hypothetical example based on Article 66.2 of Regulation 207/2009.

⁸⁴ Article 9.1 (a) and (b) of Regulation 207/2009.

⁸⁵ ECJ, *Canon*, judgement of 29 September 1998, Case C-39/97, [1998] ECR I-05507; ECJ, *Sabèl v Puma*, judgement of 11 November 1997, Case C-251/95, [1997] ECR I-06191.

⁸⁶ *Canon*, pt 17.

by Ferrero (*i.e.* low degree of similarity of the goods concerned),⁸⁷ there was still a risk of confusion between the sign 'Ferro' and the trademark 'Ferrero' because of the high repute of 'Ferrero'.⁸⁸ In other words, the low degree of similarity between the goods concerned is offset by the high repute of the trademark 'Ferrero'.

- 2) The second threat against which an EUTM is protected, is the actual association (evocation) between an EUTM and a similar sign, leading to the representation of the EUTM being triggered in the mind of the concerned public when confronted with the sign.

In other words, although knowing that the products covered by the sign and those covered by the EUTM do not have the same origin, the public nevertheless automatically associates the first with the latter. However, in order for this association to infringe on the rights of the owner of the EUTM, the latter must not only prove that the association actually occurs but also that by using that sign, the third-party is taking unfair advantage of, or that actual harm is caused to, the distinctive power or to the repute of the EUTM.⁸⁹

V.2. THE SCOPE OF PROTECTION OF PGIs/PDO: Article 13 of Regulation 1151/2012

59. A PGI/PDO, contrary to an EUTM, is not a private title controlled by one (legal) person to mainly protect its private, economic interests. Rather, it is a label attached to a product, reflecting its quality, characteristics but also its historical background, tradition and/or the culture linked to that product and the territory where it is manufactured. One just needs to look at the way the specifications of some PGIs/PDO are drafted to acknowledge the tradition and cultural heritage that they bear.⁹⁰

⁸⁷ Registration of the trade mark 'Ferro' was sought for goods and services in Classes 29, 30 and 42 of the Nice Agreement, which include, *inter alia*: for class 29: meat, fish, poultry and game, cooked fruits and vegetables, jellies, milk and milk products, edible oils and fats, etc; for class 30: coffee, tea, cocoa, sugar, rice, bread, biscuits, pastry and confectionery, pepper, vinegar, etc.; for class 42: providing of food and drink, temporary accommodation, medical, hygienic and beauty care, etc'.

⁸⁸ ECJ, *Ferrero Deutschland v OHIM*, judgement of 17 April 2008, Case C-108/07 P, ECLI:EU:C:2008:234.

⁸⁹ Article 9.1 (c) of Regulation 207/2009.

⁹⁰ As an example, the specification of the PDO Krokos Kozanis, a kind of saffron crocus from Greece, describe the early origin of the spice as follows: 'The word 'krokos' (...) is known from the earliest texts of world literature. Thus the word 'krokos' as an aromatic and flower is found in the Book of Proverbs and in Song of Solomon 3 in the Old Testament. It is also found denoting the flower or pigment in Homer (...), Sophocles, Theophrastes, Aristophanes, Hippocrates, etc. The saffron crocus as a plant with distinctive properties (pigment, medicine, herb, seasoning) was known both in Ancient Greece and to other ancient peoples. It is claimed that it was grown in Greece during the Middle Minoan period. This view is supported by a wall painting of the period (1600 BC) called the 'Saffron Gatherer' found in the Palace of Knossos on Crete showing a youth, a girl or, according to others, a monkey gathering crocus flowers into a basket. It is also claimed that the Greeks grew saffron crocuses in both Macedonian and Byzantine times and that it spread to the East with the campaign of Alexander the Great.' (as described in the publication of an application for registration pursuant to Article 6(2) of Council Regulation (EEC) No 2081/92 on the protection of geographical indications and designations of origin, 98/C 207/02, OJ C 207/2, 03.07.1998).

Therefore, PGIs/PDO, beyond protecting the private interests of a group of manufacturers, are also tools for protecting the cultural heritage (a matter of public interest) and, as such, are afforded a wider scope of protection than EUTMs.

60. Regulation 1151/2012 reads as follows:

'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.*

Where a protected designation of origin or a protected geographical indication contains within it the name of a product which is considered to be generic, the use of that generic name shall not be considered to be contrary to points (a) or (b) of the first subparagraph.⁹¹

61. Furthermore, Regulation 1151/2012 provides that: *'Protected designations of origin and protected geographical indications shall not become generic.'⁹²*

62. PGIs/PDO are therefore protected against four levels of threat:

- 1) the risk of confusion: it is prohibited to directly or indirectly make a commercial use of a PGI/PDO on a comparable product that does not meet the requirements enshrined in the specification sheet of the protected name. This protects consumers from being misled into believing that a product is a product covered by a PGI/PDO while this is actually not the case.

⁹¹ Article 13.1 of Regulation 1151/2012.

⁹² Article 13.2 of Regulation 1151/2012.

- 2) the actual association (evocation/imitation): it is also prohibited to make a commercial use of a name which exploits the reputation of the PGI/PDO by evoking or imitating the protected name, even when (i) the true origin of the product is indicated, (ii) the protected name is translated or (iii) the protected name is used with expressions such as ‘style’, ‘type’, ‘method’, ‘as produced in’, ‘imitation’ or similar. The product taking advantage of such association (evocation) does not even have to be comparable to the product with the protected name.

For example, the name ‘Cambozola’ for a cheese was deemed to evoke the name ‘Gorgonzola’ (PDO), irrespective of the fact that the packaging indicated the product’s true origin.⁹³ Even if the consumers know that ‘Cambozola’ is not the same product as Gorgonzola, the simple evocation of (association with) the protected name ‘Gorgonzola’ is prohibited as such. Similarly, the name ‘Parmesan’ was deemed to evoke the PDO *Parmigiano Reggiano*.⁹⁴

In its recent judgement of 21 January 2016 the ECJ has further clarified that in the given assessment ‘(...) *the national court is required to refer to the perception of the average consumer who is reasonably well informed and reasonably observant and circumspect, that concept being understood as covering European consumers and not only consumers of the Member State in which the product giving rise to the evocation of the protected geographical indication is manufactured*’; moreover ‘*the referring court must take into consideration the phonetic and visual relationship between those names and any evidence that may show that such a relationship is not fortuitous, so as to ascertain whether, when the average European consumer, reasonably well informed and reasonably observant and circumspect, is confronted with the name of a product, the image triggered in his mind is that of the product whose geographical indication is protected*’.⁹⁵

- 3) any other misleading indications or practices: even in the absence of any risk of confusion or of any association with (evocation of) the PGI/PDO, it is prohibited to use on the packaging or in advertising, a false or a misleading indication as to the true origin of the product.

For example, a flag or a typical landscape that could mislead the public into believing a product comes from a specific country or region while such is not the case.

⁹³ ECJ, *Gorgonzola*, judgment of 4 March 1999, Case C-87/97, [1999] I – 01301. The Court defined ‘evocation’ as follows: ‘the concept of evocation covers a situation where the term used to designate a product incorporates part of the protected designation, so that when the consumer is confronted with the name of the product, the image triggered in his mind is that of the product whose designation is protected.’.

⁹⁴ ECJ, *Commission v. Germany (Parmesan II)*, Judgment of 26 February 2008, Case C-132/05, [2008] I-00957, pt. 49.

⁹⁵ ECJ, *Viiniverla Oy v. Sosiaali- ja terveystieteiden tutkimuskeskus (Verlados)*, judgement of 21 January 2016, Case C-75/15, ECLI:EU:C:2016:35.

- 4) the risk of becoming generic: last but not least, once registered as a PGI/PDO, a name can *not* become generic.⁹⁶ This is not the case for trade marks that - when they consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade - are subject to invalidation.⁹⁷

63. To help the industry to better understand the scope of protection afforded by PGIs/PDO, the Commission has published a communication with voluntary guidelines on the labelling of foodstuffs using PGIs/PDO as ingredients.⁹⁸ The main issue indeed concerns the use of a PGI/PDO when the product is composed of various ingredients, among which a protected ingredient (e.g. 'Parma ham pizza' or 'Roquefort flammekueches').



According to the Commission, insofar as a product with a protected name (PGI or PDO) is indeed used in the preparation of a composite product:

- the PDO or PGI may legitimately be included in the list of ingredients of the composite product;⁹⁹
- the PDO or PGI may also be mentioned in or close to the trade name of the food product, as well as in the labelling, presentation and advertising relating to that product, provided that the following conditions are met:¹⁰⁰
 - The product in question should not contain any other 'comparable ingredient' to the PGI/PDO.

⁹⁶ Article 13.2 of Regulation 1151/2012.

⁹⁷ Article 7.1 (d) in connection with article 52.1 (a) of Regulation 207/2009.

⁹⁸ Commission Communication 2010/C 341/03, Guidelines on the labelling of foodstuffs using protected designations of origin (PDOs) or protected geographical indications (PGIs) as ingredients, OJ C 341/03, 16.12.2010.

⁹⁹ Ibid. Recommendation 2.1.1.

¹⁰⁰ Ibidem. Recommendation 2.1.2.

For example, blue-veined cheese (commonly known as 'blue cheese') is comparable to 'Roquefort' (PDO). A product could thus only be sold under the name '*Roquefort Flammekueches*' if solely Roquefort and no other blue-cheese is used in the preparation.

- The product with a PGI/PDO should be used in sufficient quantity to confer an essential characteristic on the finished product. However, given the wide range of products and PGIs/PDO, the Commission could not establish a minimum percentage to be uniformly applied.

For example, the incorporation of a small amount of a spice benefiting from a PDO/PGI in a foodstuff could be sufficient to confer an essential characteristic on that foodstuff. By contrast, the incorporation of a small amount of meat benefiting from a PDO/PGI in a foodstuff would not, *a priori*, be sufficient to confer an essential characteristic on a foodstuff.

- The percentage of incorporation of an ingredient with a PDO or PGI should ideally be indicated in or in close proximity to the trade name of the relevant foodstuff or, failing that, in the list of ingredients, in direct relation to the ingredient in question.
- In any case, it must be made clear that the product containing such a PGI/PDO is not the PGI/PDO *itself*. For example, the trade name '*Pizza prepared with Roquefort PDO*' would hardly give rise to a dispute in the eyes of the Commission. By contrast, the trade name '*Pizza Roquefort PDO*' would be ill-advised because it could give the consumer the impression that the pizza *as such* is the product benefiting from a PDO.¹⁰¹
- If an ingredient comparable to an ingredient benefiting from a PDO/PGI has been incorporated in a foodstuff, the name registered as a PDO/PGI should appear only in the list of ingredients, along with the other ingredients (using characters that are identical in terms of font, size, colour, etc.).¹⁰²

V.3. RELATION BETWEEN PGIs/PDO AND EU TRADE MARKS

- 64. The relation between PGIs/PDO and EUTMs may become ambiguous or problematic when they both contain the same geographical name. In such a case, the question that arises is which one will prevail over the other.
- 65. Two provisions of Regulation 1151/2012 on PGIs/PDO are particularly relevant in that regard:

¹⁰¹ Ibidem. Recommendation 2.1.3.

¹⁰² Ibidem. Recommendation 2.1.4.

- *'a name proposed for registration as a designation of origin or geographical indication shall not be registered if, in the light of a trade mark's reputation and renown and the length of time it has been used, registration of the name would be liable to mislead the consumer as to the true identity of the product'.*¹⁰³
- *'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.'*¹⁰⁴

However, *'Without prejudice to Article 6(4), a trade mark the use of which contravenes Article 13(1) which has been applied for, registered, or established by use (...), in good faith within the territory of the Union, before the date on which the application for protection of the designation of origin or geographical indication is submitted to the Commission, may continue to be used and renewed for that product notwithstanding the registration of a designation of origin or geographical indication, provided that no grounds for its invalidity or revocation exist under Council Regulation (EC) No 207/2009 of 26 February 2009 on the [EU] trade mark or under Directive 2008/95/EC. (...).'*¹⁰⁵

66. As a rule of thumb, PGIs/PDO thus prevail over trade marks. Indeed, a trade mark cannot be registered if it conflicts with a registered or applied for PGI/PDO (either if there is a risk of confusion, or if it evokes/imitates/misuses the PGI/PDO, or if it is misleading in any way). If such a conflicting trade mark is nonetheless registered, the sanction is its invalidation.

There are only two exceptions to this rule of thumb:

- First, a pre-existing trademark, which has been applied for or registered in good faith and for which no grounds for invalidation or revocation exist under Regulation 207/2009 or under Directive 2008/95/EC, may continue to be used, despite the registration of a conflicting PGI/PDO – in that case, the trademark and the associated PGI/PDO will coexist.
- Second, but only in rare cases, a long-standing and renowned trademark could prevent the registration of a 'new' misleading PGI/PDO.¹⁰⁶

¹⁰³ Article 6.4 of Regulation 1151/2012.

¹⁰⁴ Article 14.1 of Regulation 1151/2012.

¹⁰⁵ Article 14.2 of Regulation 1151/2012.

¹⁰⁶ Article 6 (4) of Regulation 1151/2012.

67. The Bavarian beer case illustrates the balance that the European legislator tried to establish between PGIs/PDO and trademarks.

'Bayerisches Bier' was registered as a PGI in 2001 following the adoption of Regulation No 1347/2001. Soon after registration, *Bayerischer Brauerbund e.V.* brought actions in Germany and Italy, challenging the validity of the trade mark *'Bavaria'* and *'Bavaria Holland Beer'* owned by the Dutch company Bavaria Nv and Bavaria Italia Srl.

After long battles at the European and national levels, the given *'Bavaria'* trade mark was held to be registered in good faith by the Italian court and could thus coexist with the PGI *'Bayerisches Bier'* in Italy.¹⁰⁷

68. At the time, taking into account the specific circumstances of the case, the ECJ ruled that the date to take into account for assessing whether the application for the *'Bavaria'* trade mark was submitted before or after the *'Bayerisches Bier'* PGI, was the date of entry into force of the registration of the PGI (2001) and not the date of the first application of this PGI (1993).¹⁰⁸

69. A provision was recently added to Regulation 207/2009 on the EU trade mark to establish a clearer framework for future conflicts between PGI/PDO and trade marks.¹⁰⁹

Article 8.4 (a) of Regulation 207/2009 now reads as follows:

'Upon opposition by any person authorised under the relevant law to exercise the rights arising from a designation of origin or a geographical indication, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Union legislation or national law providing for the protection of designations of origin or geographical indications:

- (i) *an application for a designation of origin or a geographical indication had already been submitted, in accordance with Union legislation or national law, prior to the date of application for registration of the EU trade mark or the date of the priority claimed for the application, subject to its subsequent registration;*
- (ii) *that designation of origin or geographical indication confers the right to prohibit the use of a subsequent trade mark'.*

¹⁰⁷ ECJ, *Bavaria NV, Bavaria Italia s.r.l v Bayerischer Brauerbund eV*, Judgement of 2 July 2009, Case C-343/07, [2009] I – 05491; ECJ, *Bavaria NV v Bayerisches Brauerbund eV*, Judgement of 22 December 2010, Case C-120/08, [2010] I – 13393; Court of Appeal of Turin, Italian IP Court, *Bavaria NV and Bavaria Italia S.r.l. v. Bayerischer Brauerbund e.V.*, Decision of 2 February 2011.

¹⁰⁸ ECJ, *Bavaria NV v Bayerisches Brauerbund eV*, Judgement of 22 December 2010, Case C-120/08, [2010] I – 13393.

¹⁰⁹ Article 1(10)(a) of Regulation (EU) No. 2015/2424 of the European Parliament and the Council, amending the Community trade mark Regulation (EC) No. 207/2009 ('Amending Regulation') of 16 December 2015, OJ L 341/21 24.12.2015.

V.4. COMPARISON BETWEEN PGIs/PDO AND EU TRADE MARKS

70. In conclusion, the scope of protection of PGIs/PDO and EU trade marks can be summarised and compared as follows:

PGI / PDO	EUTM (individual or collective)
<p>Protection against a risk of confusion: prohibition to make commercial use of the PGI/PDO on:</p> <ul style="list-style-type: none"> - identical products; - comparable (similar) products; or - different products, if it exploits the reputation of the PGI/PDO. 	<p>Protection against a risk of confusion: prohibition to make commercial use of a sign identical or similar to an EUTM on:</p> <ul style="list-style-type: none"> - identical products; or - similar products.
<p>Protection against association: prohibition to evoke / imitate a PGI/PDO <u>even if</u>:</p> <ul style="list-style-type: none"> - the PDO/PGI has no reputation in the EU - no unfair advantage is taken / it is not detrimental to the distinctive character or the repute of the PGI/PDO; - the PGI/PDO is accompanied by expressions such as 'type', 'style', etc. - the true origin of the products is indicated. 	<p>Protection against actual association: prohibition to make use of a sign identical or similar to an EUTM <u>but only if</u>:</p> <ul style="list-style-type: none"> - the EUTM has a reputation in the EU ; - unfair advantage is taken of / it is detrimental to the distinctive character or the repute of the EUTM
<p>Protection against any other false or misleading indications or practices as to the true origin of the products.</p>	/
<p>Protection against the risk of becoming generic: once registered, the protected name cannot become generic.</p>	<p>Becoming generic = ground for invalidation</p>
<p>No 'fair use' exception.</p>	<p>The fair use of a geographical name is not deemed to infringe upon an EUTM containing the same name.</p>

71. It clearly appears from the above table that PGIs/PDO enjoy a wider scope of protection than EUTMs. They do not only cover the risk of confusion but also any other false or

misleading indications or practices as to the true origin of the products, and the risk of the name becoming generic. Furthermore, as far as association (evocation) is concerned, Regulation 1151/2012 on PGIs/PDO does not require the protected name to have a '*reputation within the EU*', nor the litigious sign to take unfair advantage of or to be detrimental to the distinctive power or the repute of the PGI/PDO. Finally, there is no '*fair use*' exception diminishing the PGIs/PDO scope of protection.

72. This wider protection is justified on the grounds that PGIs/PDO are meant to protect public interests (e.g. cultural heritage) alongside private or purely economic interests. This is also reflected in the enforcement of these rights since the EU Member States must take appropriate administrative and judicial steps to prevent or stop the unlawful use of PGIs/PDO in their territories.¹¹⁰ To that end, Member States must designate one or several authorities responsible for taking these steps¹¹¹ and establish control procedures. The enforcement of Regulation 1151/2011 is thus also ensured by the public authorities and not only at the initiative of private persons whose rights are violated.
73. In Belgium, for example, there are different control authorities depending on the concerned region (Brussels Capital, the Flanders or Wallonia). As far as Wallonia is concerned,¹¹² the body in charge of controlling the proper use of PGIs/PDO is the agency 'PROMAG'.¹¹³

PROMAG reviews at least once a year, for all manufacturers concerned, if the requirements specifications of the products bearing a protected name are respected. It then draws up an annual report with a description of the control methods used as well as a synthesis of the results.

In parallel, the decision of the Flemish government of 19 October 2007 determines the legal framework for the registration and controls on PDO/PGIs/TSGs in the Flanders.¹¹⁴ In practice, it is the staff of the Federal Public Services Economy (FPS Economy) that undertakes official controls of producers and processors of PDO/PGI products in the

¹¹⁰ Article 13 (3) of Regulation 1151/2011.

¹¹¹ Article 13 (3) of Regulation 1151/2011 further provides that these authorities must offer '*adequate guarantees of objectivity and impartiality*', and must have at their disposal '*the qualified staff and resources necessary to carry out their functions*.'

¹¹² Walloon Decree of 19 December 2002 amending the Decree of 7 September 1989 on the allocation of the Walloon quality label, the name of local origin and the designation of origin, *Official Gazette* 05.02.2003; Walloon Decree of 25 September 2003 implementing Decree of 7 September 1989 on the designation of local origin and Walloon designation of origin and the implementation in Wallonia of Regulations (EEC) No 2081/92 and No 2082/92, *Official Gazette*, 26.01.2004.

¹¹³ PROMAG SPRL, Parc d'activités économiques d'Aye, 6900 Marche-en-Famenne, Belgium. PROMAG is accredited for part of its activities by BELAC, the official Belgian accreditation body (Belac accreditation numbers: 099-INSP, 099-PROD, 099-QMS). PROMAG carries on-site checks and controls all products certified to the Walloon Region as a PGI or a PDO and certifies compliant products.

¹¹⁴ Decree of the Flemish government of 19 October 2007 regarding the protection of PGI, PDO and TSG for agricultural products and foodstuffs, *Official Gazette* 07.11.2007. This decree specifies that the Minister of Agriculture of the Flanders can determine additional rules on controls. This has been done in the Ministerial Decree of 7 March 2008 implementing the Decree of the Flemish Government of the 19 October 2007, *Official Gazette* 25.03.2008.

Flanders, following an agreement between the Flemish Government and the FPS Economy, signed on 17 July 2006. The FPS Economy has also been designated as the control authority for the region of Brussels Capital.¹¹⁵

74. The number and the frequency of controls will of course largely depend on the resources of the competent authorities and their commitment to enforce the rules laid down in Regulation 1151/2012. Control procedures over PGIs/PDO may thus vary from one Member State to another.

VI. CONCLUSION

75. The geographical origin of foodstuffs is an increasingly important indication both for consumers and for food operators competing for the attention of those consumers.

Consumers pay more and more attention to the geographical origin of the products ending up in their shopping basket or on their plate in a restaurant. This is because of quality, cultural, environmental and sometimes even political considerations possibly linked to their geographical origin.

Food operators, from their side, have also realised that indicating the geographical origin on the label of products may make a difference on the market place. This is reflected in the preamble of EU Regulation 1169/2011 on Food Information to Consumers that points out that *'In some cases, food business operators may want to indicate the origin of a food on a voluntary basis to draw consumers' attention to the qualities of their product.'*¹¹⁶

76. Geographical origin is thus more and more developing into a value driver in the EU and on the global market place.¹¹⁷ As a consequence protecting such added value against abuse becomes increasingly important.

Within the EU in particular, two systems that both qualify as intellectual property tools, offer ways to protect the value of the geographical origin of foodstuffs: the PGI/PDO system and the collective EUTM system.

¹¹⁵ Decree of the Government of the Brussels Capital Region of 22 October 2009 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs and traditional specialties guaranteed for agricultural products and foodstuffs, *Official Gazette* 20.11.2009 and the Ministerial Decree of 27 April 2012 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs and traditional specialties guaranteed for agricultural products and foodstuffs, *Official Gazette* 23.05.2012.

¹¹⁶ Whereas 30 of Regulation (EU) No 1169/2011 of the European Parliament and of the Council of 25 October 2011 on the provision of food information to consumers, amending Regulations (EC) No 1924/2006 and (EC) No 1925/2006 of the European Parliament and of the Council, and repealing Commission Directive 87/250/EEC, Council Directive 90/496/EEC, Commission Directive 1999/10/EC, Directive 2000/13/EC of the European Parliament and of the Council, Commission Directives 2002/67/EC and 2008/5/EC and Commission Regulation (EC) No 608/2004, *OJ L 304*, 22.11.2011, p. 18–63.

¹¹⁷ See *Study on assessing the added value of PGI/PDO products*, written by Areté (Research & consulting in economics) and commissioned by the European Commission. Executive summary available at: http://ec.europa.eu/agriculture/external-studies/2013/added-value-pdo-pgi/exec-sum_en.pdf

77. At first sight, applying for a PGI/PDO may seem more attractive since the scope of protection of the PGI/PDO is broader than the one of the collective EUTM.

However, choosing one or the other system will depend on multiple factors, among which (i) whether the concerned product / the sign meets the requirements for being granted one or the other protection, (ii) the costs of the application and (iii) the capability to properly control the use, by others, of the protected name.¹¹⁸

The government of Ethiopia, for example, decided to protect the Sidamo coffee (a type of Arabica coffee) by way of a trademark rather than a PGI because Sidamo is grown on small plots of land by a large amount of Ethiopian farmers all over the country. As a consequence, the link between the quality or characteristics of the coffee and a defined geographical area would have been difficult to prove. Furthermore, the Ethiopian government might have lacked the resources to finance the authority in charge of controlling and protecting, on a preventive basis, the use of a PGI. Registering a trademark instead of a PGI was therefore more appropriate to their needs.¹¹⁹



78. On the other hand and if the respective requirements can be met, associations of food operators may be well advised to opt for a cumulative protection by both a PGI/PDO and a

¹¹⁸ For example, out of the 3500 products listed by the Public Administration of Italy as being traditional Italian products, only a few percentages meet the requirement to be protected by way of a PGI/PDO. As a consequence, the Italian Chambers of Commerce used the geographical collective mark as a solution for other products. See in this regard: Orazio Olivieri, *Using Collective Marks for the Protection of Traditional Products*, 2004, available at: http://www.wipo.int/sme/en/documents/collective_mark_fulltext.html.

¹¹⁹ Sidamo has been registered by the Government of Ethiopia as an individual trademark in three territories: the US (USPTO, n° 78589307), the EU (OHIM, n° 004348751) and Canada (CIPO, n° 916800-00). The Director General of the Ethiopian Intellectual Property Office, Mr. Getachew Mengistie, declared in that regard: 'You have to understand the situation in Ethiopia. Our coffee is grown on four million very small plots of land. Setting up a certification system would have been impracticable and too expensive. Trademarking was more appropriate to our needs. It was a more direct route offering more control.' Source: Intellectual Property Research Institute of Australia (IPRIA), *Sidamo, A teaching case for WIPO*, May 2009 (http://www.wipo.int/export/sites/www/academy/en/about/global_network/educational_materials/cs4_sidamo.pdf), citing Elizabeth March, 'Making the Origin Count: Two Coffees' (September 2007) 5 *WIPO Magazine*, accessed 1 January 2016, from http://www.wipo.int/wipo_magazine/en/2007/05/article_0001.html.

collective EUTM. This is the case, for example for *Parmigiano Reggiano*, which is both registered as a collective EUTM and a PDO.¹²⁰



79. Collective EU trade marks and PGIs/PDO are thus both susceptible of being very useful and effective tools for protecting the geographical origin of foodstuffs in the EU and also at the global level.¹²¹
80. This should definitely be kept in mind by the food business operators. Indeed, what consumers (and in particular Millennials) currently put in their baskets and/or want on their plates *'holds more meaning than ever before. Shopping can feel as though they're not only helping their bodies and satisfying their gastronomic needs but also, perhaps, contributing to the welfare of our planet, the well-being of farm-raised chickens and cows or the business of a small farmer. [...] As we are presented with so many options, eventually which apple you choose can become a comment on who you are, what you care about, what class you belong to.'*¹²²

This explains the ever-increasing value of geographical indications and collective trade marks as intellectual property tools for the food business operators.

¹²⁰ 'Parmigiano Reggiano' is registered as a PDO under Commission Regulation (EC) No 1107/96 of 12 June 1996 on the registration of geographical indications and designations of origin under the procedure laid down in Article 17 of Council Regulation (EEC) No 2081/92 and as a collective EUTM (OHIM, n°006103899).

¹²¹ Regarding the use of trademarks, certification marks or geographical indications at the international level, see UNIDO, *Adding value to traditional products of regional origin, a guide to creating a quality consortium*, 2010. Available at: https://www.unido.org/fileadmin/user_media/Publications/Pub_free/Adding_value_to_traditional_products_of_regional_origin.pdf

¹²² E. TUROW, *A taste of Generation Yum*, pp. 191-192 (eBook version).