

# THE LEGAL REGIME OF NAMES EXCLUDED FROM PROTECTION BY INDICATIVE SIGNS

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## Abstract

*This study aims to analyse the legal regime of names that cannot be registered for protection by indicative sign, either because they do not meet the conditions provided for by Regulation (EU) no.1151/2012, whether they can mislead the consumer regarding the geographical origin of the product that designates it and at the same time analyse the various situations that may arise in the event of a conflict between the indicative signs and these names through the lens of the CJEU jurisprudence.*

*In a mercantile society based on the circulation of goods, an important factor in choosing a quality product originating in a certain regions is the sign or name that appears on the label and that gives the product „added value”, the consumer being thus aware of his choice and at the same time protected against deceptive practices.*

*But not all names can be registered and protected by indicative signs, Regulation (EU) no. 1151/2012 stipulating by art. 6 the exceptions from registration, the most common situation being that of generic names, names of products which, although related of the place or country where the product was originally produced or marketed, became the common name of a product in the Union.*

*In its jurisprudence, CJEU has shown that in order to determine whether or not a name has become generic, the purpose for which a geographical indication or a designation of origin is registered under Regulation (EU) no. 1151/2012, namely that of avoiding abuse of a name by those who aim to benefit from the acquisition of a product protected by an indicative sign and for this the situation in the Member State of origin of the name and of consumption, the situation in other member states and the national or Community legislation must be taken into account.*

*Likewise, a name proposed for registration as a designation of origin or geographical indication cannot be protected which, given the reputation and renown of a mark, as well as the duration of its use, is likely to induce in the consumer the true identity of the product.*

*Although less common in practice as well as in the jurisprudence of the Court of the European Union, Regulation (EU) no. 1151/2012 also provides that there are also some other names that cannot be protected as a geographical indication or designation of origin, such as the name that coincides with the name of a plant variety or an animal breed and that may mislead the consumer as to the true origin of the product, such as and the homonymous or non-homonymous name which is likely to mislead the consumer regarding the true identity of the product.*

**Keywords:** *geographical indications, designations of origin, traditionally guaranteed specialties, generic names, marks, deceptive practices.*

## 1. Introduction

The idea of protecting the origin of a product is increasingly common throughout the world, justified by technological innovations and market evolution on the one hand, as well as by the constantly evolving expectations of consumers on the other, in order to guarantee the appearance that the product has special qualities due to its origin or is the result of manufacturing methods that have their origin in the traditional practices existing in the past in a certain community.

In the context of the existence on the market of a multitude of signs, names and symbols, the development of trade offering many alternatives to the consumer, indicative signs prove to be a determining factor in the choice, hence the importance of their protection at international, European and national level.

In recent years, there has been a trend of consumers around the world to appreciate agricultural products whose origin is determined, increasingly consumers are looking for products that come from precisely determined and delimited areas or that are based on traditional production techniques, context in which the manufacturer, in turn, is willing to ensure the protection of his products against abusive or deceptive practices.

It has been shown that the geographical origin of a product can be carried by several signs, different from a legal point of view, between which there is a certain competition at the international level.<sup>1</sup>

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<sup>1</sup> D. Rochard, *International protection of geographical indications*, PUF 2002, p. 18.

Starting from the definition given to geographical indications by art. 5 para. 2 of Regulation (EU) no. 1151/2012<sup>2</sup>, it can be established that in order to be eligible to benefit from the protection conferred by the geographical indication, a product must meet cumulatively three criteria: the product must originate in a certain place, region, locality or country; at least one of the stages of production should take place in this geographical area, and the quality, reputation or other characteristic of the product can be mainly attributed to this geographical origin. As such, it must be demonstrated that the geographical origin is an essential factor for the quality, reputation or other characteristic of the product.

The Regulation also defined the designation of origin<sup>3</sup> as the name, which can be used traditionally, and which identifies a product originating in a certain place, region or, in exceptional cases, country, whose quality or whose characteristics are due in mainly or exclusively to a certain geographical environment with its own natural and human factors and whose production stages all take place in the delimited geographical area.

According to art. 18 para. 1 of Regulation (EU) no. 1151/2012, a name is eligible to be registered as a guaranteed traditional specialty when it describes a specific product or a food that: results from a production process, processing or a composition that corresponds to traditional practice for that product or food or is produced from raw materials or ingredients traditionally used.

As such, in order to be registered, the guaranteed traditional specialty name must: have been traditionally used to designate the specific product or indicate the traditional character or specific character of the product.

Geographical indications, designations of origin and names of traditional specialties guaranteed allow consumers to trust and distinguish quality products, also helping producers in their marketing, in the case of the former, the connection between the specific geographical region and the name of the product being highlighted, in the case of in which a certain quality, reputation or other characteristic can be attributed essentially or exclusively to its geographical origin, in the case of traditional specialties guaranteed, the link referring to the production method used over time in the determined geographical region with the quality and characteristics of the product protected by indicative sign.

In this context, the protection must be approached as the right to use an indicative sign as well as the right to prevent their illegal use, the main purpose being that of protecting the consumer against products that may mislead him about its true geographical origin or the method of processing, as well as protecting producers against unfair competition.

## **2. The legal regime of names excluded from protection by indicative signs**

It can be said that an indicative sign represents a commitment to consumers regarding the quality of a product, and for producers it is a guarantee of fair competition conditions.

The name to be protected as a geographical indication or designation of origin can be a geographical name of the place of production of a specific product or a name used in commercial exchanges or in common language to describe the specific product in the delimited geographical area.

The reputation of designations of origin depends on the image they enjoy among consumers, an image that depends in particular on particular characteristics and, in general, on the quality of the product.<sup>4</sup>

As such, with regard to geographical indications and designations of origin, all the technical information necessary to describe a product and the production area, and in the case of guaranteed traditional specialties, the production methods, must be provided by the producers at the time of submitting the application for registration of indicative sign. And this aspect is important because the product specifications are a determining factor in the registration procedure and guarantee the stability of the product quality, without imposing a certain level of quality.

At the same time, it is obvious that when the consumer notices the PDO, IGP or STG sign on the product label, he trusts that the product is of quality and that it cannot be counterfeited, imitated and cannot be misled about the true geographical origin of the product or the traditional method of production.

Therefore, the label of the products protected by an indicative sign may include graphic representations of the geographical area of origin and which must have a counterpart in the specifications, a text, graphic representations or symbols that refer to the member states or the region in which they are located the geographical area of origin of the protected product.

The facts that the food product originates from the delimited geographical area is proven by existence of a traceability system implemented from the entry of the raw material into the factory until the finished product

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<sup>2</sup> Regulation (EU) no. 1151/2012 of the European Parliament and of the Council of 21.11.2012 regarding systems in the field of quality of agricultural and food products, published in OJ L 343 of 14.12.2012.

<sup>3</sup> See art. 5 para. 1 of Regulation (EU) no. 1151/2012.

<sup>4</sup> CJUE, Judgment of 16.05.2000, *Kingdom of Belgium v. Kingdom of Spain*, case C-388/95, ECLI:EU:C:2000:244, point 56.

(the traceability tracking sheet, the equipment sheet, the raw material concentration monitoring sheet are drawn up), as well as by the agreement between the amount of products sold under the protected name and the amount of raw material transformed.

It is unanimously accepted that the added value conferred by the indicative signs is based on the trust of consumers and only an effective protection system can guarantee them that a certain quality, characteristic or reputation of the products protected by an indicative sign are maintained for the entire duration of the protection period.

The right to indicative signs in the agricultural and food field is acquired and protected by their registration under the conditions provided by the legislation in force at the level of each state, in the case of national protection, as well as by their registration under Regulation (EU) no. 1151/2012, in the case of protection at community level.

Although apparently any name can be registered as a geographical indication or designation of origin, if it meets the criteria provided by art. 5 para. 1 and 2 of Regulation (EU) no.1151/2012, however, there are some names that cannot be protected by an indicative sign, either because they are generic or because they can mislead the consumer regarding the true origin of the product.

Thus, according to art. 6 of Regulation (EU) no. 1151/2012, generic terms are not registered as protected designations of origin or as protected geographical indications, and a name cannot also be registered when it coincides with the name of a plant variety or a breed of animals and may mislead the consumer as to the true origin of the product.

A name proposed for registration that is homonymous or partially homonymous with a name already registered may not be registered as a designation of origin or geographical indication, unless there is, in practice, sufficient distinction between the conditions of local and traditional use and presentation of the registered homonymous name subsequently, on the one hand, and the name already registered, on the other hand, taking into account the need to ensure a fair treatment of the producers in question and not to mislead consumers. A homonymous name that gives consumers the wrong impression that the products originate in another territory shall not be registered, even if it is accurate in terms of the territory region or locality in which the said products originate.

At the same time, a name proposed for registration as a designation of origin or geographical indication is not registered in the situation where, given the reputation and reputation of a mark, as well as the duration of its use, the registration of the proposed name as a designation of origin or geographical indication is likely to misleads the consumers to the true identity of the product.

First of all, referring to the names/generic terms, Regulation (EU) no. 1151/2012 expressly stipulates through art. 6 para. 1 that they cannot be registered as protected designations of origin or as protected geographical indications, also providing a definition of them as representing product names which, although are related to the place, origin or country where the product was initially produced or marketed, have become the common name of a product in the Union.

The reservation of certain generic names cannot be allowed as it would give an undue advantage to certain producers over their competitors, therefore it has been appreciated that they are part of the public domain, without imperative laws being able to regulate their use, no right or reservation can be exercised over them, thus being able to be used freely, provided, however, that the use does not mislead the consumer regarding the true geographical origin of the product.<sup>5</sup>

The problem of generic names/mentions has been addressed, over time, differently through international agreements and treaties.

Thus, the Madrid Agreement on indications of origin<sup>6</sup> deals with this issue in a limited framework, leaving it to the discretion of the courts of the state's party to this agreement to decide which names, due to their generic nature, do not fall within the scope of this arrangement, while „regional names of origin of wine products” are expressly excluded from this rule according to the provisions of art. 4 of the Agreement.

The Lisbon Agreement<sup>7</sup> provides for the prohibition of the illegal use of a designation of origin that is the subject of an international registration in all states party to the agreement, to the extent that the competent authority of a contracting party has not declared that it could not ensure the protection of such a designation of origin.

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<sup>5</sup> C. Le Goffic, *The protection of geographical indications*, LexisNexis Litec, Paris, 2010, p. 409.

<sup>6</sup> The Arrangement regarding penalties for false or misleading indications of the origin of products was concluded at Madrid on April 14, 1891, and entered into force on July 15, 1892. The arrangement was revised at Washington on June 2, 1911, at Hague on November 6, 1925, at London on June 2, 1934, in Lisbon on October 31, 1958 and in Stockholm on June 14, 1967.

<sup>7</sup> The Arrangement for the Protection of Appellations of Origin and their International Registration was signed in Lisbon on October 31, 1958 and was revised in Stockholm on June 14, 1967 and is administered by WIPO.

According to art. 3 of the Lisbon Agreement, protection is granted against any attribution or imitation even in cases where the true origin of the product is indicated or in cases where the indication is used in translation or is accompanied by expressions such as „of the type”, „of the model”, „imitation”.

The agreement also provides that a designation of origin admitted for protection in one of the countries parties to the agreement, in accordance with the procedure set out in art. 5, cannot be considered generic there, as long as it is protected as a designation of origin in the country of origin.

Regulation (EEC) no. 2081/1992<sup>8</sup> provided a clearer definition of generic names, stipulating that „name that has become generic” means the name of an agricultural or food product which, even if it refers to the place or region where this agricultural or food product was originally produced or marketed, has become the common name of an agricultural or food product.

The TRIPS Agreement<sup>9</sup> defined by art. 24.6 the generic terms as the usual terms used in the current vocabulary as a common name of those products or services on the territory of a member state.

A geographical sign must be to fix the meaning of „geography”, in relation to physical, natural or human phenomena located on the globe. These phenomena are generally identified by precise terms, but these are not necessarily available to provide an indication of origin, either because it is possible that some terms have lost their geographical quality in current language and become generic or semi-generic, or because there are homonyms and the same term can describe different places.<sup>10</sup>

Geographical indications or designations of origin which are no longer understood by the population of a Member State as indicating the particular origin of a product, but which indicate a certain type or category of products, may cease to operate as indicative signs.

The generic character of a name can be due either to the name itself, because it has always been generic, or because it has become generic over time through its use. In other words, it is the case of those names that have either never had the function of indicating the origin, or have lost this function so that they can no longer establish the link with the area of origin, in the case of these terms the geographical link between the product and the area of origin disappears, although indirectly, they suggest the origin of the product from which certain of its qualities or characteristics derive.

One of the most important conditions required, before registering a name as a geographical indication or designation of origin is that the name is not already widely used as a generic name for a similar product. The transformation of a geographical indication or a designation of origin into a generic term can take place in different countries and at different times. This may lead to situations where a particular indication is considered to constitute a very specific term for a well-known local specialty in a country (most often in the country origin), may constitute a generic term or a generic trademark for that type of product, in other words, the problem arises when products are marketed under a certain indication that is understood differently in different countries. For example, Parmigiano cheese from Italy is known generically as Parmesan cheese in Australia and the United States.

As such, in this context, a balance must be found between the interests of consumers and producers in countries where the geographical indication is considered to indicate the geographical origin and particular qualities of a product, on the one hand, and those of producers and consumers in countries where this geographical indication has become the symbol of a kind of products and can be used freely by anyone.

It has been shown<sup>11</sup> that the degeneration of a geographical sign can be explained by various factors, the first is its very reputation, a kind of redemption for the glory that also affects certain trademarks whose last stage of notoriety would have turned into a common name and therefore the disappearance as a sign indicating the geographical origin, other justifications reside in the fact that the connection between a certain place and the qualities of the product is not absolute and this explains why in most cases generic names are found for manufactured products or even cheeses.

Also, linguistic transformations are a sign of detachment from territorial roots and certain geographical indications are generic because they have autonomous development in relation to a specific place and at the

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<sup>8</sup> Regulation (EEC) no. 2081/1992 on the quality systems of other agri-food products, published in the Official Journal of the European Union L 208 of 24.07.1992, p. 1, repealed by Regulation (EC) no. 510/2006 of the Council of March 20, 2006 regarding the protection of geographical indications and designations of origin of agricultural products and food, this is turn repealed by Regulation (EU) no. 1151/2012 of the European Parliament and of the Council of 21.11.2012 regarding systems in the field of quality of agricultural and food products.

<sup>9</sup> The agreement on aspects of intellectual property rights related to trade, also called the TRIPS Agreement (Trade Related Aspects of Intellectual Property), represents Annex IA of the Marrakech Agreement of April 15, 1994 and was ratified by Romania through Law no. 133/1994, published in the Official Gazette of Romania no. 360/27.12.1994. It is considered to be the most important international convention in the field of intellectual property protection. The TRIPS Agreement introduced intellectual property law into the multilateral trading system for the first time and remains the most comprehensive multilateral agreement on intellectual property to date.

<sup>10</sup> N. Olszak, *Law of designations of origin and indications of source*, Tec&Doc Lavoisier, Paris, 2001, p. 16.

<sup>11</sup> *Idem*, p. 16.

same time, the role of producers in the distribution of their products can explain this dilution of the identity of the signs that indicate origin because for those who sell products wholesale, grouping by types is easier to manage. In this context, an example was given of the multitude of wines on supermarket shelves, without being placed according to quality criteria, which makes it difficult for the consumer to choose a wine with a geographical indication at the expense of another product of lower quality and dilutes the consumer's perception of a product that offers qualities and characteristics due to its geographical origin or the production method used in its production.

It was also stated that the degeneration is based on a material escape, physically characterized by a constant and repeated use of the term to designate products manufactured in various places foreign to the original place and that in this sense the decisions that recognize the generic character of a name it is often based on the observation that products bearing this name are mostly manufactured outside the place of origin.<sup>12</sup>

In another opinion, the degeneration of indicative signs was attributed to the negligence of the interested parties, who failed to defend the geographical name in question<sup>13</sup>, noting that this reasoning was applied in French and Community law, in the matter of degeneration of trademarks<sup>14</sup>; it is about penalizing the holder of a trademark that has become common only if this evolution has occurred due to this owner, who did not show sufficient diligence to maintain the distinctive character of his marks.<sup>15</sup>

At the same time, the question arose whether the uses of generic terms are not made in bad faith, invoking an „aggregation of defects” on the part of a few unscrupulous manufacturers, the degeneration resulting from a generalized original abuse, several competitors committing the same fraud at the origin.<sup>16</sup>

In order to determine whether or not a name has become generic, the provisions of art. 41 para. 2 of Regulation (EU) no. 1151/2012 are relevant, which stipulate that all relevant factors will be taken into account in this approach, in particular by: the existing situation in the member state where the name originates and in the areas of consumption; the existing situation in other member states; relevant national or community legislation.

In this context, the purpose for which a geographical indication or a designation of origin is registered under Regulation (EU) no. 1151/2012 should be highlighted, namely to avoid the abusive use of a name by those who aim to benefit from the reputation acquired by these names and implicitly to avoid their disappearance due to general use outside its geographical area or outside the specific quality, notoriety or other characteristic that can be attributed to that origin and which justifies the registration of that name.

Thus, art. 41 para. 1 of Regulation (EU) no. 1151/2012 stipulates that without prejudice to art. 13, the use of terms that are generic in the Union is not affected, even if the generic term is part of a name that is protected under a quality system.

It is possible for a name to induce expressions that originally had a territorial meaning but that lost it over time as a result of its widespread use away from characterizing products of a determined geographical origin.

Generic terms such as „beaujolais” which is a common name to describe a slightly fruity red wine or „chablis” used to describe a dry white wine are product names which, although linked to place, region or country in which the product was originally produced or marketed, have become the common name of a product in the Union.

Obviously, the question was asked what is the legal regime of generic names in this sense, the provisions of art. 6 and art. 7 para. 1 of the Lisbon Agreement regarding the protection of appellations of origin and their international registration are which provide that the appellation of origin registered under the Agreement cannot be considered generic as long as it is protected as an appellation of origin in the country of origin.

It takes into account the aspect that generic names cannot be registered, as otherwise protected names cannot become generic, and the generic elements of a registered name cannot be protected.

It is undisputed that a geographical name could, to the extent that it is used, become a generic name, in the sense that it could be regarded by consumers as an indication of a certain type of product rather than as an indication of the geographical origin of the product, examples in this sense being the names „Camembert” and „Brie”.

The problem of names/generic mentions was and is the subject of many disputes and debates and was also addressed in the CJEU jurisprudence.

Thus, in the assessment of the generic character of a name, it was established that the places where the

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<sup>12</sup> C. Le Goffic, *op. cit.*, p. 410.

<sup>13</sup> G. Bonet, *The mark constituted by a geographical name in French law*, JCP E, 1990.

<sup>14</sup> C. Le Goffic, *op. cit.*, p.412.

<sup>15</sup> F. Luxembourg, *The forfeiture of rights, Contribution to the study of civil sanctions*, Editions Pantheon Assas, Theses, Paris, 2007, pp. 153-157.

<sup>16</sup> L. Lorvellec, *The international protection of quality signs*, in *Writings on rural and agri-food law*, Dalloz, 2002, p. 385.

respective product was produced both inside and outside the member state that obtained the registration of the name in question must be taken into account, the consumption of this product and of the way in which this name is perceived by consumers inside and outside the respective member state, by the existence of a special national legislation regarding the mentioned product, as well as by the way in which this name was used according to community law.<sup>17</sup>

The Court was called upon to rule on this aspect in *Bavaria I*<sup>18</sup> case, ruling that a name becomes generic only if the direct link between, on the one hand, the geographical area of the product and, on the other hand, a specific quality disappears of this product, its notoriety or another characteristic that can be attributed to that origin, and the name does nothing more than describe a genre or type of products.

At the same time, it was shown that generic names are part of the general cultural and gastronomic heritage and that, in principle, can be used by any producer and include names that are not related to production in a specific place and therefore to the geographical origin of the product, but only with the properties of the product, which are based on the use of similar production processes.<sup>19</sup>

As far as a protected geographical indication is concerned, a name becomes generic only if the direct connection between, on the one hand, the geographical origin of the product and, on the other hand, a specific quality of that product, the reputation of this or another characteristic of this product, attributable to that origin, has disappeared and that the name only describes a genus or type of products.<sup>20</sup>

At the same time, it was considered that regarding the presence on the market of some marks and labels of some commercial companies that contain the word „Bayerisches“ or its translations, as synonyms of the old Bavarian method with reduced fermentation, that circumstance does not allow to deduce the fact that the name in question had become generic at the time of filing the application for registration.

It was thus concluded that the protected geographical indication did not become generic and that, consequently, the direct link existing between the reputation of Bavarian beer and the geographical area did not disappear, such a finding could not be considered to be manifestly inappropriate only because of the presence on the market of marks and labels of commercial companies that contain a word component of the protected geographical indication or its translations as synonyms of the old Bavarian method with reduced fermentation.<sup>21</sup>

The Court considered, on the other hand, that to the extent that geographical indication is not generic and that there is a significant link between the designated product and the origin, a link that can reside only in the local reputation, the protection of the indication of origin can benefit from the exception provided for in art. 30 TEU which makes it possible to circumvent the principle of free movement of goods, the Court establishing the conditions that a product must meet in order to benefit from an indication of origin.<sup>22</sup>

The prohibition to protect generic names is justified by the aspect that they no longer fulfil the essential function of indicating the geographical origin of the product, in other words, they have lost touch with the area of origin.

It should be noted that in the case of a geographical indication or a designation of origin consisting of a compound name that contains a term considered generic, the use of this term does not constitute a direct or indirect commercial use or an abusive use, imitation or evocation within the meaning of art. 13 para. 1 letters a and b of Regulation (EU) no. 1151/2012.

The protection that must be granted to the various components of a name, and in particular that of determining whether it is a generic name or a component protected against direct or indirect commercial use or abusive use, imitation or evocation, are the subject of an assessment based on a detailed analysis of the factual situation existing in each individual case.<sup>23</sup>

Such an analysis requires the verification of a certain number of conditions, which requires, to a large extent, in-depth knowledge both regarding the specific elements of the concerned member state<sup>24</sup> and regarding the existing situation in other member states.<sup>25</sup>

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<sup>17</sup> CJEU, Judgment of July 2, 2009, *Bavaria NV, Bavaria Italia Srl v. Bayerischer Brauerbund eV*, case C-343/07, ECLI:EU:C:2009:415, point 101; CJEU, Judgment of February 26, 2008, *Commission/Germany*, case C-132/05, ECLI:EU:C:2008:117, point 53, CJEU, Judgement of October 25, 2005, *Germany and Denmark v. Commission*, case C-465/02, C-466/02, ECLI:EU:C:2005:636, point 76-99.

<sup>18</sup> CJEU, *Bavaria NV, Bavaria Italia Srl v. Bayerischer Brauerbund eV*, case C-343/07, previously cited, point 107.

<sup>19</sup> See the conclusions of Advocate General Saggio in the case *Public Ministry v. Guimont*, C-448/98, point 11.

<sup>20</sup> CJEU, *Bavaria NV, Bavaria Italia Srl v. Bayerischer Brauerbund eV*, case C-343/07, previously cited, point 107.

<sup>21</sup> *Idem*, point 108.

<sup>22</sup> CJEU, Judgement of November 10, 1992, *Exportur SA v. LOR SA and Confiserie du Tech*, case C-3/91, ECLI:EU:C:1992:420.

<sup>23</sup> CJEU, Judgement of June 9, 1998, *Yvon Chiciak and Fromagerie Chiciak and Jean-Pierre Fol*, case C-129/97 and C-130/97, ECLI:EU:C:1998:274, point 38.

<sup>24</sup> CJEU, Judgement of December 6, 2001, *Carl Kuhne GmbH & Co. KG and others v. Jutro Konservenfabrik GmbH & Co. KG*, C-269/99, ECLI:EU:C:2001:659, point 53.

<sup>25</sup> CJEU, Judgement of March 16, 1999, *Denmark and others/Commission*, C-289/96, case C-293/96, C-299/96, ECLI:EU:C:1999:141, point 96.

The detailed analysis of all the factors that could determine the generic character concerns the legal, economic, technical, historical, cultural and social indicators and refers to the relevant national and community legislation, including their evolution over time, the perception that the average consumer has of allegedly generic names, including the fact that the notoriety of the name remains linked to the traditional product manufactured in a certain area as a consequence of the fact that it is not commonly used in other regions of the Member State or of the European Union, the fact that a product has been legally marketed with the respective name in certain member states, the fact that a product was legally manufactured with the respective name in the country from which the name originates, even without respecting traditional production methods, the fact that such operations have endured over time, the quantity of products having the respective name and being manufactured outside the method their traditional by referring to the amount of products manufactured according to the respective methods, the fact that the products manufactured outside of the traditional methods are presented in such a way as to refer to the places of production of the products manufactured according to the respective methods, the protection of the respective name through international agreements and the number of member states which possibly invokes the alleged generic character of the respective name.<sup>26</sup>

The Court also ruled that when a name is considered generic in the common market, a member state does not have the right to limit its use to national products that have certain characteristics and, apart from the generic nature of the name, a state cannot, by applying its own rules regarding the designation of food products, to prohibit the entry into its territory of a product that is labelled with the same name used in accordance with the relevant rules applicable in the country of origin.<sup>27</sup>

Secondly, a name proposed for registration as a designation of origin or geographical indication is not registered in the situation where, given the reputation and reputation of a mark, as well as the duration of its use, the registration of the proposed name as a designation of origin or geographical indication is likely to mislead the consumer as to the true identity of the product.

Thus, the relationship between the names registered in Regulation (EU) no. 1151/2012 and trademarks is regulated, establishing according to the different rules of conflict with scope, with effects and with different recipients.

This second situation concerns the conflict between a protected name or protected geographical indication and an earlier trademark, in the event that the registration of the name in question would be likely to mislead the consumer as to the real identity of the product in view of the reputation, notoriety, duration of use of the trademark.

The existence of the trademark can thus be threatened when the protection of a geographical indication or a designation of origin is subsequently considered, consisting of a sign identical to the one constituting the trademark or having characteristics close to it. Such a conflict is similar, in this case the risk of confusion increases for consumers.

But the conflict can also arise from the coexistence of a trademark and a similar geographical indication that designates different or similar products, the only hypotheses that are excluded being, on the one hand, that in which the previous trademark is a collective trademark that protects a geographical indication, since in this case there is no legitimate reason to subsequently protect a similar indication, and on the other hand, the one in which the geographical indication is included in a complex mark designating products that have the right to be protected by the geographical indication.<sup>28</sup>

The complexity of conflicts between geographical indications and earlier trademarks is due to the tension between two principles, on the one hand the respect of rights acquired, more precisely the property right of the owners of the trademarks, and on the other hand, the general interest that can lead to the geographical indication, prevailing over the previous trademark. In the context of this conflict, three situations can arise, either the previous trademark prevents the validity of the geographical indication, or due to the special legal nature recognized for it, the geographical indication, more precisely the designation of origin, invalidates the previous trademark, or finally, the two signs are authorized to coexist.<sup>29</sup>

In the hypothesis of such a conflict, the effect is the refusal to register the names, but it has been shown<sup>30</sup> that the refusal must be based on an analysis prior to the registration of the protected designation of origin and

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<sup>26</sup> CJEU, Denmark and others/Commission, C-289/96, case C-293/96, C-299/96, previously cited, points 95, 96, 99 and 101, CJEU, Judgement of June 25, 2002, *Dante Bigi v. Consorzio del Formaggio Parmigiano Reggiano*, C-66/00, ECLI:EU:C:2002:397, point 20, CJEU, *Germany and Denmark v. Commission*, C-465/02, C-466/02, previously cited, points 75, 77, 78, 80, 83, 86, 87, 93 and 94, CJEU, Judgement of September 12, 2007, *Consorzio per la tutela del formaggio Grana Padano*, T-291/03, ECLI:EU:T:2007:255, point 65.

<sup>27</sup> CJEU, Judgement of July 11, 1974, *Procureur du Roi v. Benoit and Gustave Dassonville*, case C-8/74, ECLI:EU:C:1974:82.

<sup>28</sup> C. Le Goffic, *op. cit.*, p. 343.

<sup>29</sup> *Idem*, p. 344.

<sup>30</sup> CJEU, *Bavaria NV, Bavaria Italia Srl v. Bayerischer Brauerbund eV*, case C-343/07, previously cited, point 120.

the protected geographical indication and which must be limited to the possibility of a possible consumer error regarding the actual identity of the product due to the registration of the name in question, based on an examination of the name to be registered and the earlier mark, taking into account the fame, notoriety and duration of use of the latter.

The absence of a risk of confusion in the perception of the consumer between the name in question and the earlier mark does not exclude the possibility that the use of the latter may be the subject of direct or indirect commercial use, abusive uses, imitations, evocations or a false or misleading indication of provenance, origin, the nature or qualities of the product or even if there are good reasons for cancelling or revoking the respective mark. At the same time, the mentioned absence of the risk of confusion does not relieve the obligation to check whether the trademark in question was registered in good faith before the date of submission of the application for registration of the protected designation of origin or the protected geographical indication.

Likewise, a name that coincides with the name of a plant variety or an animal breed and that may mislead the consumer as to the true origin of the product cannot be protected as a designation of origin or geographical indication.

However, Regulation (EU) no. 1151/2012<sup>31</sup> also provides exemptions, namely that the introduction to the market of products whose labels contain a protected or reserved name or mention under a quality system that contains or includes the name cannot be prevented a plant variety or an animal breed, when the following conditions are met: the product in question contains or is derived from the mentioned variety or breed; consumers should not be misled; the use shall not exploit the reputation of the protected designation; in the case of designations of origin and geographical indications, the product and marketing of the product has exceeded its area of origin before the date of the application for registration of the geographical indication.

It is obvious that the product whose label contains or includes the name of a plant variety or an animal breed must have the ability not to mislead consumers as to the true origin of the product and also not to exploit the reputation of the protected name by indicative sign.

Regulation (EU) no. 1151/2012 also stipulates that a name proposed for registration that is homonymous or partially homonymous with a name already registered in the Register of Appellations of Origin and Protected Geographical Indications cannot be registered, unless it exists, in practice, a sufficient distinction between the conditions of local and traditional use and the presentation of the subsequently registered homonymous name, on the one hand, and the name already entered in the register, on the other hand, taking into account the need to ensure fair treatment of the producers concerned and not to mislead consumers.

Homonymous geographical indications are those that are written or pronounced the same, but which identify products originating from different regions or countries.

A geographical indication for which an application for registration has been submitted after a homonymous or partially homonymous name has been the subject of an application for a geographical indication or has been protected as a geographical indication in the European Union shall not be registered, unless there is sufficient distinction in practice between the conditions of local and traditional use and the presentation of the two homonymous names, taking into account the need to ensure a fair treatment of the producers of such products and to avoid misleading of consumers regarding the identity or geographical area of the products.

At the same time, a homonymous or partially homonymous name that leaves consumers with the erroneous impression that the products originate from another territory cannot be the object of protection, although the homonymous name is accurate in terms of the territory, region or locality from which the respective products originate.<sup>32</sup>

The TRIPs agreement stipulates in art. 23.3 that in the case of geographical indications for wines, protection can be granted to each indication subject to the provisions of art. 24.4, namely that the protection will be applicable against a geographical indication which, even if it is literally accurate in terms of the territory, region or locality from which the products originate, makes it wrongly understood by the public that the products originate from another territory.

For this purpose, each member state will establish the practical conditions in which the respective homonymous indications would be differentiated from each other, taking into account the need to ensure a fair treatment of the respective producers and it will be done in such a way that consumers are not misled.

It has been shown that a final form of homonym inconvenient for geographical indication can be represented by surnames identical to geographical names, as in the case of noble families, because of the feudal connection between the title and a land and since it is mandatory to identify in professional activity and legitimate to use the name to designate its production, there may be an accidental collision with an indication of

<sup>31</sup> See art. 42 para. 1 of Regulation (EU) no. 1151/2012.

<sup>32</sup> See art. 6 para. 3 of Regulation (EU) no. 1151/2012.



provenance or a temptation to deliberately engage in activities where this name is profitable because of notoriety.<sup>33</sup>

In the case of guaranteed traditional specialties, starting from the definition given to them as a name describing a specific product or a food resulting from a production process, processing or a composition that corresponds to the traditional practice for that product or food or is produced from raw materials or ingredients traditionally used<sup>34</sup>, to be registered, it must have been traditionally used to designate the specific product or indicate the traditional character or specific character of the product.<sup>35</sup>

A guaranteed traditional specialty name cannot be registered if it refers only to claims of a general nature used for a set of products or to claims provided for by specific Union legislation, in other words, it is necessary that the name refers to a process of production determined, to a certain way of processing or of a precisely defined composition, these must correspond to the traditional practice for the respective product or food or in the case of raw materials or ingredients traditionally used, they must be clearly and unequivocally listed in specifications.

It should be noted that in the case of guaranteed traditional specialties names, unlike geographical indications and designations of origin, in the situation where the name is also used in another member state or in a third country to distinguish comparable products or products that have an identical or similar name, the decision on registration may stipulate that the name of the guaranteed traditional specialty is accompanied by the mention „made according to traditions” immediately followed by the name of the respective country or region.<sup>36</sup>

### 3. Conclusions

It is obvious that the sign symbolizing the geographical origin or the production method has a considerable impact on the purchase of a product, so it is necessary to protect it by establishing a quality system with strict rules in terms of registration, marketing and protection of products that offer own qualities and characteristics due to the geographical environment from which it originates or to local traditions related to the manufacturing method.

That is why it is important that the suppliers of the products for which protection by an indicative sign is requested provide all the technical information necessary to describe the product and the production area, in the case of geographical indications and designations of origin, as well as the production methods, in the case of traditional specialties guaranteed.

But not every name can be registered as a geographical indication or designation of origin, either because they are generic or because they can mislead the consumer as to the true origin of the product, it is the case of generic terms, of names that coincide with the name of a plant variety or an animal breed, of the name proposed for registration that is homonymous or partially homonymous with an already registered name and finally of the name proposed for registration that, given the reputation and reputation of a mark, as well as the duration of its use, it is likely to mislead the consumer as to the true identity of the product.

In the case of generic terms, the transformation of a geographical indication or a designation of origin into a generic term can take place in different countries and at different times, as such, situations may arise where when products are marketed under a certain indication, this should be considered a specific term in the country of origin and respectively a generic term in another country for that type of product.

In its jurisprudence, CJEU ruled that in assessing the generic character of a name, the places where the respective product was produced both inside and outside the member state that obtained the registration of the name must be taken into account in question, the consumption of this product and the way in which this name is perceived by consumers inside and outside the respective Member State, the existence of a special national legislation regarding the said product, as well as the way in which this name has been used according to community law.

It was also shown that a name proposed for registration as a designation of origin or geographical indication cannot be registered in the situation where, given the reputation and reputation of a mark, as well as the duration of its use, the registration of the proposed name as a designation of origin or geographical indication is likely to mislead the consumer as to the true identity of the product.

As such, the existence of the trade mark may thus be threatened when the protection of a geographical indication or a designation of origin is subsequently considered, consisting of a sign identical to that which

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<sup>33</sup> N. Olszak, *op. cit.*, p. 16.

<sup>34</sup> See art. 18 para. 1 of Regulation (EU) no. 1151/2012.

<sup>35</sup> *Idem*, art. 18 para. 2.

<sup>36</sup> *Idem*, art. 18 para. 3.

constitutes the trade mark or having characteristics close to it, the risk of confusion for consumers being higher in the situation where the products designated by the two conflicting signs are similar.

Less common in practice as well as in the CJEU jurisprudence, the name that coincides with the name of a variety of plants or a breed of animals as well as the homonymous or partially homonymous name, both likely to mislead the consumer regarding the true identity of the product cannot be protected as a geographical indication or designation of origin.

It was also shown that a guaranteed traditional specialty name cannot be registered if it refers to statements of a general nature used for a set of products or to the statements provided for by a specific Union legislation, in its case, it is necessary that the name refers to a specific production process, to a specific processing method or to a precisely defined composition, these having to correspond to the traditional practice for the respective product or food or in the case of raw materials or ingredients traditionally used, these must be clearly listed and unequivocal in the specifications.

It can thus be concluded that the added value conferred by the indicative signs is based on the trust of consumers and only an effective protection system can guarantee them that a certain quality, characteristic or reputation of the products protected by the indicative sign are maintained for the entire duration of the protection period and that in this context the name proposed for registration does not increase the risk of confusion regarding the true origin of the product, the qualities or characteristics due to its origin or the production methods used.

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