

General Court confirms invalidity of TOSCORO based on earlier PGI 'Toscano'
European Union - **Carnelutti Studio Legale Associato**

Geographical indications/appellations of origin
Cancellation
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On February 2 2017 the General Court rendered its judgment in *Mengozzi v European Union Intellectual Property Office* (EUIPO) (Case T-510/15), which involved Roberto Mengozzi (as the applicant), the EUIPO (as the defendant), the Italian Republic (in support of the EUIPO) and Consorzio per la tutela dell'olio extravergine di olive toscano IGP (as the intervener).

The General Court recalled that a trademark that evokes a protected geographical indication (PGI) must be declared invalid, provided that it has been registered after the PGI and that it covers goods of the same type. The concept of 'evocation' covers a situation where a trademark used to designate a product incorporates part of the PGI, with the result that, when the consumer is confronted with the name of the product, the image triggered in his/her mind is that of the product the designation of which is protected.

The General Court held that the evocation of a PGI by a trademark must be assessed based on the similarities between the signs at issue, taking also account of the "conceptual proximity" between the terms. In particular, what matters is that an association of ideas regarding the origin of the products is not created in the mind of the public, and that a trader does not take undue advantage of the reputation of the PGI. For this reason, there might be evocation of a PGI in the absence of any likelihood of confusion between the concerned goods.

The dispute in question arose from the application for registration, filed by Roberto Mengozzi on June 17 2002 pursuant to [Regulation 40/94](#) (replaced by [Regulation 207/2009](#)), of the word mark TOSCORO for goods in the following classes of the [Nice Classification](#):

- Class 29: "Edible oils fats; edible vegetable oils, notably olive oils; creams for food and in particular nut creams, artichoke creams in truffle sauce, green and black olive creams; mushrooms in sauce and dried mushrooms";
- Class 30: "Coffee, coffee extracts and coffee-based preparations; coffee substitutes and extracts of coffee substitutes; tea, tea extracts and tea-based preparations; cocoa and preparations having a base of cocoa, chocolate, chocolate products, confectionery, sweets; sugar; natural sweeteners; bakery products, bread, yeast, pastries; biscuits; cakes, desserts, puddings; ices, products for making ices; honey and honey substitutes; breakfast cereals, rice, pastas, food products based on rice, flour or cereals, also in the form of pre-cooked dishes; products for flavouring or seasoning foodstuffs, salad dressing, vinegar, mayonnaise, pizza, sauces and in particular tomato sauces and vegetable sauces".

On November 17 2003 the word sign TOSCORO was registered as an EU trademark under No 002752509.

On December 10 2012 the intervener filed before the Cancellation Division of the EUIPO an application for a declaration that the contested trademark was invalid on the basis of Articles 7(1)(c), (g) and (k) of Regulation 207/2009, read in conjunction with Article 52(1)(a) of that regulation. The application was based on the PGI 'Toscano', registered in the European Union pursuant to [Regulation 2081/92](#) (replaced by [Regulation 1151/2012](#)). The registration of the PGI 'Toscano' was granted for "olive oil" by [Regulation 644/98](#), under the procedure set out in Article 17 of Regulation 2081/92.

On November 29 2013 the Cancellation Division granted the application for a declaration of invalidity for certain goods in Class 29 and in Class 30.

On January 27 2014 the applicant filed an appeal against the decision of the Cancellation Division, as provided for by Articles 58 to 64 of Regulation 207/2009. The intervener brought a cross-appeal.

By its decision of June 5 2015 the Second Board of Appeal of the EUIPO partially upheld the appeal and the cross-appeal. The Board of Appeal held that Articles 13(1) and 14(1) of Regulation 2081/92 were the applicable provisions, rather than Article 7(1)(k) of Regulation 207/2009. In fact, the latter was not in force at the date on which the application for the contested trademark was filed. On this basis, the Board of Appeal, by taking account of the visual and phonetic similarities between the signs at issue, held that the contested trademark amounted to an evocation of the PGI for certain goods in Class 29 (edible oil fats; edible vegetable oils; notably olive oils and green and black olive creams). Consequently, the EU trademark TOSCORO was declared invalid in relation to those goods.

The applicant appealed before the General Court, alleging:

1. infringement of Article 7(1)(k) of Regulation 207/2009 and of Article 6(1) of Regulation 1151/2012;
2. that the Board of Appeal had erred in its evaluation of the similarities between the signs at issue in the context of Article 13(1)(b) of Regulation 1151/2012; and
3. infringement of Article 15 of the [Agreement on the Trade-Related Aspects of Intellectual Property Rights](#) (TRIPs).

The General Court dismissed the first plea based on the reasoning that the summary of the pleas of law on which the application was based did not meet the requirement of sufficient clarity and precision necessary to enable the defendant to prepare its defence and the court to decide the case. Although the applicant had invoked in his summary of pleas the provision contained in Article 6(1) of Regulation 1151/2012, he had cited the provisions of Article 13(2) of that regulation instead. Moreover, nowhere in his application did the applicant state how the provisions he relied on in its submission should have been applied by the Board of Appeal, nor why it infringed Article 7(1)(k) of Regulation 207/2009.

The first plea was also dismissed based on the reasoning that, according to Article 65 of Regulation 207/2009, it is not the General Court's function to re-evaluate the factual circumstances of the proceedings in light of evidence adduced for the first time before it. In this respect, the applicant had never mentioned before EUIPO's adjudicating bodies the provisions of Article 6 of Regulation 1151/2012 on which he relied before the General Court.

With regard to the second plea, the applicant argued in substance that the two signs are different and, hence, the contested trademark does not evoke the PGI at issue. In this respect, the General Court first considered that the Board of Appeal had not applied Article 13(1)(b) of Regulation 1151/2012, as indicated by the applicant, but rather Article 13(1) and 14(1) of Regulation 2081/92. Article 13(1)(b) of Regulation 2081/92 provides that PGIs shall be protected against any "misuse, imitation or evocation, even if the true origin of the product is indicated or if the protected name is translated or accompanied by an expression such as 'style', 'type', 'method', 'as produced in', 'imitation' or similar".

Article 14(1) of Regulation 2081/92 establishes that:

"Where a designation of origin or geographical indication is registered in accordance with this regulation, the application for registration of a trademark corresponding to one of the situations referred to in Article 13 and relating to the same type of product shall be refused, provided that the application for registration of the trademark was submitted after the date of the publication provided for in Article 6(2).

Trademarks registered in breach of the first subparagraph shall be declared invalid."

By taking into consideration the relevant provisions, the General Court dismissed the second pleading, stating that the trademark TOSCORO evoked the PGI 'Toscano' for the following reasons:

- the two signs are visually and phonetically similar;
- the fact that the trademark TOSCORO is a made-up word, while the PGI 'Toscano' conveys the concept of olive oil from Tuscany, cannot exclude that the former evokes the latter;
- the link between a PGI and the protected product is inherent to the nature of the PGI and cannot have the result of weakening its protection;
- the two signs covered the same type of products, as they shared some common characteristics;
- the reputation of a PGI is not a condition for its protection.

Finally, the General Court dismissed the third plea based on the reasoning that, according to Article 188 of the Rules of Procedure of the General Court, the parties' pleadings cannot change the subject matter of the proceedings before the Board of Appeal.

In this respect, the applicant argued that its trademark should continue to stand on the register of the EU trademarks, as the two registration schemes set out by Article 15 and 22 of the TRIPs Agreement are mutually exclusive. However, the court stated that this argument had not been invoked before the Board of Appeal and, therefore, that plea had to be rejected.

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