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TOPIC
PROTECTION AGAINST MISUSE, IMITATION OR EVOCATION OF GEOGRAPHICAL
INDICATIONS

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INTRODUCTION

The relevance of the final thesis. In the age of increased globalization and intense market competition, individualization of manufacturing can be accomplished via a number of different approaches. The most prevalent method of individualization in intellectual property law is through the use of trademarks. Nevertheless, collective distinguishing signs also play an essential part in the law. And geographical indications (GIs), are among the collective signs that are the most commonly recognized since they denote the distinctive attributes of a product that are associated with the particular region in which it was manufactured.

Article 22 of TRIPS agreement define Geographical indications as: *“indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.”*¹

In a general sense, a GI is a denomination that identifies a good or product as being produced in a certain geographic location. This type of indication is known as a geographical indication. It is only due of the specific features, whether they be human or natural aspects, that are present in the chosen territory that the good can be achieved, and as a result, it develops a distinctive quality.²

When it comes to registering a trademark in a specific region, you may run into a situation in which the name of your product or the product itself may conflict with a geographical indication registered in that specific region. This name or designation identify the product as such that is connected with that territory to the extent that it cannot be named like that, produced or copied anywhere else, and you can't indicate that your goods have the same or even similar name that is registered as a geographical indication in that specific region. We need to differentiate geographical indications not only from trademarks, which are distinctive signs for individual use, but also from other distinctive signs for collective use, such as collective marks, certification marks, appellations of origin, and indications of source, all of which, at first glance, might appear to be quite similar to GIs but, in reality, have their own distinct characteristics.

The great importance especially in EU has the concept of protection against evocation of GIs. A unique European concept which bans the use of terms that can evoke or be reminiscent of protected GI, even in cases where consumers are unlikely to be confused or misled. The purpose

¹ Marrakesh Agreement Establishing the World Trade Organization “Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)”, Apr. 15, 1994, WTO, accessed 5 March 2023, https://www.wto.org/english/docs_e/legal_e/27-trips_01_e.htm.

² Alessandra Cavalieri, “The conflict between Geographical Indications and EU Trademarks in the light of the recent developments in Community Law and jurisprudence: a GIs’ overprotection?”, (University of Turin, 2019), 2.

of this concept is to prevent situations where a registered trademark, whether in its visual presentation, name, or quality, can create confusion among consumers by resembling a registered GI without actually being one. This relatively new concept is rapidly developing both within the European Union and beyond. This concept is explained mostly through the court decisions and every day there are more and more decisions of the courts that clarify this concept and answer controversial questions that may arise in its application. The challenge lies in the lack of clarity provided by the ECJ's broad interpretation of the concept, leaving market players uncertain about what specific actions are prohibited and when they might be found in violation of GIs. Having a clear and precise definition in this context would greatly assist in addressing this issue.

In EU protection of GIs occurs through regulations which deals with certain types of products and various case law, in which the decisions of the Court of Justice are of particular importance. And considering this issue in the context of court decisions today is very important and their comprehensive review will help to create a definition of the evocation which is one of the aims of the thesis. Case law is an essential element of the EU legal system, and as the legal system develops rapidly and there are more and more judicial precedents, this issue becomes especially important.

Given the rapid development of competition, there is a need for legal protection of GIs from such violations as misuse, imitation and particularly evocation because there a lot of cases where GI were violated and these violations have existed for many years misleading people without even knowing that something has been violated. But the EU regulation which deals with the GIs do not include definitions of such concepts as misuse, imitation, and evocation and because of that different manufacturers may have some difficulties when producing their goods. That is why, this topic is very important in our time and it is vital to distinguish GI among other signs, to know the scope of protection from such violations, the level of protections, what is protected the name, the product or both, the possibility to produce similar products using another name and many other problems which are not fully answered which will help to propose possible definitions for the above concepts..

That issue is vitally essential because the problem of protection of GIs is always relevant and every year it is registered plenty of geographical indications and a lot of disputes arise from the already registered indications which in different situations can be resolved differently and can set a precedent which will be mandatory for further court decisions on similar issue. The new concepts such as evocation can be created in any time and in order to understand all the new term, we need to remember previous aspects of GIs and be aware of practice of the courts on that issue because the practice shows us the main problems which were already resolved and which can help to resolve new problems that have arisen.

During the current research that is devoted to the issues of the protection against misuse, imitation, or evocation of GIs the substantial attention will be paid to the above issues of conflicts between Geographical Indications and EU Trademarks, distinctiveness of the GIs, the concept of evocation and comparison of protection of GIs according to different systems of protection as well as proposing possible definitions for these terms.

Scientific research problem. An analysis of the literature and regulations related to the topic of the master's thesis indicates that there is a gap of the issue of definitions of misuse, imitation and evocation in the EU legal system namely, their absence. Therefore, the question arises **whether legal definitions of these terms are needed and how this will affect the practice of resolving disputes related to these concepts.** These issues resolve mainly through practice of the courts and such a distribution of these concepts throughout the case law of a given issue may lead to improper application of the protection of these concepts, complicating the litigation and, as a result, infringement of rights to GIs and harm to consumers. I consider that there is a significant need to define these concepts in a separate legal act or in Regulations concerning certain products that already exist, which will include the definition of the concepts and the scope of protection against these violations. It will greatly simplify the judicial process and harmonize the legislation as well as enable courts to make clearer and faster decisions.

Therefore, in current research, on the basis of judicial practice, current regulatory legal acts and experience gained by studying foreign legal norms related to this issue, I will try to answer this question.

The level of the analysis of the research problem. The scope of the dissertation research includes an analysis of the general understanding of GIs, distinction and similarities between GIs and Trademarks, between GIs and other signs of collective use such as collective, certification marks, appellations of origin, indications of source, conception of protection against evocation of GIs, as well as analysing the main issue of the dissertation - necessity of defining the misuse, imitation and evocation and possible effect of it on the practice of resolving disputes related to these concepts. This study includes a review of the literature of leading scholars in the field of industrial property law in the EU such as Dev Gangjee, Matteo Gragnani, Burkhardt Goebel, Manuela Groeschl, Vadim Mantrov and others, an analysis of major cases of the Court of Justice, other case law and a study of the literature of scholars outside the European Union.

Scientific novelty of the master thesis. Now there is a fairly large number of scientific works that are related to the issue of protection against misuse, imitation or evocation of GIs, as well as questions in this area find many answers in numerous court decisions that have set precedents and are now used by other courts and competent authorities to resolve issues associated with this problem. But given the rapid development of competition, there are more and more

situations that require the definition of these concepts, which has not yet been done in the law of the European Union, in such situation there is a need to compare best practices on this issue and determine the pros and cons of developing these concepts. Therefore, the research of the current problem seems to be useful.

The aim of the master thesis - to determine the major problems connected with protection against misuse, imitation or evocation of GIs, the scope of protection of such indications, the level of their protections. To answer on the question whether specific definitions of misuse, imitation and evocation are needed and how this will affect the practice of resolving disputes related to these concepts and to propose possible definitions and solutions for the more effective regulation of that concepts.

The objectives of the master thesis. In order to achieve established aim of this master thesis the following tasks have to be carried out:

- to analyze the relevant legal acts of EU, recommendations and guidelines of EU authorities, identify the distinction between GIs and similar concepts and highlight the scope of protection against misuse, imitation and evocation.
- to analyze and compare different regimes for the protection with the EU *sui generis* regime for protection from misuse, imitation and evocation and to define the pros and cons of every approach.
- to analyze the practice of the courts on the relevant issue, define court decisions that have set precedents, define the scope of protection of GI and to answer on main question of the research.

The practical significance of the master thesis. The current research will be useful for legislator because it serves as a basis for improvement of regulation and can assist courts and other institutions in interpretation and application of the protection against misuse, imitation and evocation of GIs because these issues resolve mainly through practice of the courts and such a distribution of these concepts throughout the case law of may lead to improper application of the protection of these concepts, complicating the litigation and, as a result, infringement of rights to GIs and be hazardous for consumers. And the definition of these concepts in a separate legal act or in Regulations concerning certain products that already exist, will greatly simplify the judicial process and harmonize the legislation as well as enable courts to make clearer and faster decisions.

The study can also be useful for the students studying intellectual property law who wants to deepen their knowledge in such issues as the protection against misuse, imitation and evocation of GIs.

As regards scientists and practitioners that research will be useful for scholars in the field of industrial property law and especially for those who work in the field of protection of GIs

because this study provides the possible legal definition and the scope of protection of such concepts as misuse, imitation and evocation.

The defence statements.

There is a need of improvement of the existing regulations for the protection of GIs and including in them definitions of misuse, imitation and evocation.

Methods used in the master thesis. In the current scientific research will be used several methods.

The first and the main method I will use – is a combination of method of data collection and data analysis and comparative method. These approaches are essential due to the need for studying and analyzing a significant volume of case law, legal documents, and scientific articles. As a result, the gathered data will be analyzed, structured and summarized in reasonable conclusions. In addition to the analysis of various legal texts, case law, and scholarly articles of EU will be conducted the analysis of legal acts of other states and jurisdiction and will be made a comparative analysis of EU and other legal systems of protection against misuse, imitation and evocation of GIs.

Second crucial method which will be used is a linguistic method which helps to define the important notions used by the legislative authorities in different jurisdictions when regulating some particular issues related to the topic of the ongoing study. It enables to avoid the unnecessary misconceptions during the analysis of legal concepts and adds clarity to the interpretation of the intention of the legislator.

Third essential method that I decided to choose is a logical method which can be considered as a kind of link between all other methods and let to make a full observation of the problem to be analyzed and develop certain ways to solve it.

The structure of the master thesis. It consists of the following parts:

The first part of the master thesis will consist of the general description concerning the protection of GIs, analysis of the relevant legal acts of EU, recommendations and guidelines of EU authorities, identification of the distinction between GIs and similar concepts.

During the second part of the study, I will tell you general description concerning the protection against misuse, imitation, and evocation. I will analyze and compare EU legal regime for protection from misuse, imitation and evocation. The analysis of the practice of the Court of Justice of the European Union (CJEU) on the relevant issue will be conducted, as well as the history of the concept of evocation through court decisions that have major importance for the relevant issue.

And the final part consists of the answer to the main question of the project the importance of defining misuse, imitation, and evocation as well as possible options for definitions

LIST OF ABBREVIATIONS

GI(s) – Geographical Indication(s)

CJEU, Court – Court of Justice of the European Union

IPRs – Intellectual Property Rights

TRIPS –Trade-Related Aspects of Intellectual Property Rights Agreement

CAP – Common Agricultural Policy

EU – European Union

WIPO – World Intellectual Property Organization

IGO – Indication of Geographical Origin

PDO – Protected Designation of Origin

PGI – Protected Geographical Indication

TSG – Traditional Speciality Guaranteed

EUIPO – The European Union Intellectual Property Office

EUTM – The European Union Trademark

EUTMR – The European Union Trademark Regulation

SWA – The Scotch whiskey Association

1. GENERAL OVERVIEW OF THE CONCEPT OF GI'S AND SCOPE OF THEIR PROTECTION

1.1 Introduction to GIs and legal framework for their protection in the European Union

The territorial borders and local marketplaces of nations are being replaced by a broader, global market in the age of globalization. Nowadays, businesses from all over the world sell their goods and services, giving consumers worldwide a broad range of possibilities. Consumers are also confused as a result of this because of false information regarding the nature and quality of the products. In this vast and frequently unpredictable market, certain remedies should be put into place in addition to competition laws to address this issue.³

GIs have become an essential tool for achieving the objectives of a globalized society, encompassing economic development, policymaking, and safeguarding of individual rights.⁴

GIs are recognized as Intellectual Property Rights (IPRs) under the World Trade Organization's Trade-Related Aspects of Intellectual Property Rights Agreement (TRIPS), and the EU has a responsibility to protect them as mandated in its Charter of Fundamental Rights. GI schemes are a part of the Common Agricultural Policy (CAP), regulated by the EU through various steps, including regulations for quality wines, agricultural products, foodstuffs, spirit drinks, and aromatized wine products. Although the current rules are coherent in terms of name protection, they contain sector-specific rules that need to be streamlined. The current CAP reform process aims to align agri-food procedures with the rules for wines and spirits and integrate aromatized wine products under the agri-food Regulation while repealing GI provisions from the Regulation on aromatized wine products.⁵

The protection of GIs is essential not just for individual producers and regions, but also for the broader economy. GIs are an important segment of the worldwide economy, representing a diverse range of agricultural products, foodstuffs, wines, spirits, handicrafts, and other distinctive regional products. On this legal basis, there were 1385 names successfully registered under the EU system as of February 2022 (641 PDOs and 744 PGIs), highlighting the scope of this sector and the significance of effective protection.⁶ Which is in my opinion quite a huge number that emphasizes the extensive reach of GIs. And this extensive protection reflects the value placed on

³ Alessandra Cavalieri, "The conflict between Geographical Indications and EU Trademarks in the light of the recent developments in Community Law and jurisprudence: a GIs' overprotection?," (University of Turin, 2019), 2-3.

⁴ Ibid.

⁵ Commission, "Evaluation of Geographical Indications and Traditional Specialities Guaranteed Protected in the EU," EUR-LEX, accessed 2 March 2023, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=SWD:2021:427:FIN>.

⁶ Andrea Zappalaglio et al, *Study on the Functioning of the EU GI System*, 2022.

preserving the unique characteristics and heritage associated with specific regions and their products.

If we are talking about definition of GIs, it should be noted that there are plenty of them given by different institutions and lawyers but the most popular among the other especially in the EU are definitions mentioned in the TRIPS Agreement and the definitions mentioned in EU law for quality schemes.

As already were mentioned TRIPS Agreement defines GIs as those that indicate a good as coming from the territory of a member of the agreement, or a specific area or locality thereof, and in which a particular quality, reputation, or other aspect of the good is essentially attributable to its geographic origin.⁷

It seems to provide a minimum standard of protection for GIs, which centers around the concept of "reputation" rather than location and seems to be a bit low. This standard emphasizes the subjective perception of the product by third parties, rather than a direct link to a specific geographic location because this reputation should be "essentially attributable" to the geographical origin, rather than exclusively so.⁸

In simple words, in order for a sign to serve as a GI, it needs to explain that the product in question originates from a particular location. The reputation of the product or the qualities it possesses should be mostly related to the location from whence it originated. It is essential to keep a connection between the product and the location where it was initially manufactured.⁹

For instance, Parmigiano Reggiano cheese may only be made in certain regions of Italy, and the cows whose milk is required to manufacture the cheese must also originate from certain regions. The specific properties of the cheese can be attributed, in part, to the local environment, particularly the climate and the soil conditions. Because of this, the term "Parmigiano Reggiano" can only be applied to cheese if it has been produced in the specified area and satisfies the stringent conditions outlined above.¹⁰

⁷ Marrakesh Agreement Establishing the World Trade Organization, "Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)", Apr. 15, 1994, WTO, accessed 5 March 2023, https://www.wto.org/english/docs_e/legal_e/27-trips_01_e.htm.

⁸ Alessandra Cavalieri, "The conflict between Geographical Indications and EU Trademarks in the light of the recent developments in Community Law and jurisprudence: a GIs' overprotection?", (University of Turin, 2019), 2-3.

⁹ World Intellectual Property Organization, "Geographical Indications: An Introduction, 2nd edition," 7, accessed 5 April 2023, <https://www.wipo.int/publications/en/details.jsp?id=4562>.

¹⁰ Consorzio Formaggio Parmigiano Reggiano Via Kennedy, "Parmigiano Reggiano guidelines," 1-3, accessed 5 April 2023, <https://www.parmigianoreggiano.com/>.

European Commission defines them in similar way and states that geographic indication is a label applied to goods with a particular quality, reputation, or other attribute essentially linked to their geographical origin. However, Regulation (EU) No 1151/2012 extend these definitions and apply different requirements to different EU quality schemes. The GI scheme grants manufacturers in a certain geographic region the ability to use the registered name provided they adhere to the product standard and gives intellectual property rights.¹¹

It is possible to find GIs in a wide variety of formats, but the most common one is simply the name of the place or region where the product was manufactured. Examples of well-known geographical indications include Darjeeling tea and Jamaica Blue Mountain coffee. Both beverages are produced in specific regions. However, names that are not geographical, such as Vinho Verde, Cava, or Argan Oil, may also be protected as GIs if they are tied to a specific region in some way.¹²

In addition to this, a geographical indication can also be made up of symbols that are generally understood to be connected with a particular region or location. For instance, the kangaroo logo is used to distinguish wines that are made in Australia from those made in other countries.

The government or competent authorities play a significant role in formulating and defining the unique qualities and standards related with a given GI in the case of GIs. This comprises creating the initial specifications that specify the geographical area, production processes, and quality criteria for GI-branded products.¹³

In essence, whether a sign acts as a GI are dependent on the respective national law as well as the perception of the consumer. A geographical indication, for instance, may be protected in the European Union under a variety of quality schemes.¹⁴

Dev Gangjee a professor at University of Oxford defines Indications of Geographical Origin (IGOs) which is the same as GI as signs that indicate that a product originates from a certain

¹¹ European Commission, "Evaluation of Geographical Indications and Traditional Specialities Guaranteed Protected in the EU," EUR-LEX, accessed 2 March 2023, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=SWD:2021:427:FIN>.

¹² World Intellectual Property Organization, "Geographical Indications: An Introduction, 2nd edition," 7, accessed 5 April 2023, <https://www.wipo.int/publications/en/details.jsp?id=4562>.

¹³ Anselm Kamperman Sanders, "Geographical Indications as Property: European Union Association Agreements and Investor-State Provisions," in *Cambridge University Press*, (2017), 175.

¹⁴ "Quality schemes explained," European Commission, accessed 5 April 2023, https://ec.europa.eu/info/food-farming-fisheries/food-safety-and-quality/certification/quality-labels/quality-schemes-explained_en/.

geographical location, proving its provenance, as well as the quality and reputation associated with it.¹⁵

Also, it is important to define and find the difference between GIs and appellation of origin. Appellations of origin are a type of GIs that designate a product's place of origin and the qualities that are unique to that location. This definition is outlined in the Article 2 of the Lisbon Agreement: *“(1)... the geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors.”*¹⁶

Both appellations of origin and GIs inform consumers about the origin and qualities of a product, although there is some debate regarding the requirement that a quality be exclusively linked to the place of origin. The key distinction is that an appellation of origin requires a stronger connection between the product and its place of origin, with the product's qualities or characteristics deriving exclusively or primarily from its geographical origin. In contrast, a single criterion attributable to geographical origin suffices for a GI, which does not necessitate that the entire production process occurs in the defined geographical area. The term appellation of origin is frequently utilized in laws that establish particular rights and protection systems for GIs. Geographical indication is a broad concept that does not specify a particular protection mechanism. In Europe appellation of origin are protected as PDOs.¹⁷

From the other hand there are no specific and unified definition for GIs in a broad meaning in the EU laws, however EU protects them since 1992 as indications of geographical origin or quality schemes, from unlawful use and divide them into this such schemes: Protected Designations of Origin (PDOs) and Protected Geographical Indications (PGIs) in the agri-food and wine sectors, and Geographical Indications for the spirit drinks and aromatised wine products. Separate scheme which is not GI per se is s Traditional speciality guaranteed (TSG) which is also protected from some violations in EU.¹⁸ The schemes are similar however there are some differences about which I will tell you later.

In the context of protecting GIs, there are three primary ways utilized worldwide: the sui generis system, which involves the adoption of legal acts specifically designed to protect GIs,

¹⁵ Dev S. Gangjee, *Research Handbook on Intellectual Property and Geographical Indications*, (Cheltenham: Edward Elgar Publishing, 2016), 1.

¹⁶ World Intellectual Property Organization, “Geographical Indications: An Introduction, 2nd edition,” 11, accessed 5 April 2023, <https://www.wipo.int/publications/en/details.jsp?id=4562>.

¹⁷ *ibid.*

¹⁸ European Commission, “Quality schemes explained,” accessed 5 April 2023, https://ec.europa.eu/info/food-farming-fisheries/food-safety-and-quality/certification/quality-labels/quality-schemes-explained_en/.

protection through trademark law and the use of collective or certification marks and unfair competition laws. It is important to thoroughly define and compare each of these approaches, as they offer unique and distinct ways of protecting GIs.

If it concerns the European Union, then it should be noted that by establishing various regulations regarding GIs chose the *sui generis* path of protection.

The legal basis for the *sui generis* protection of GIs at the EU level is represented by four Regulations of the European Parliament, which are similar in terms of protection of GIs but relate to the protection of different products and have some other differences.

Regulation (EU) No 1151/2012 establishes quality schemes for agricultural products and foodstuffs, including above mentioned Protected Designation of Origin (PDO), Protected Geographical Indication, and Traditional Specialities Guaranteed. These schemes work to promote and safeguard agricultural goods and commodities that are known for having a particular quality, reputation, or feature derived from their place of origin or traditional methods of production.¹⁹

In addition to putting in place quality schemes, Regulation (EU) No. 1151/2012 lays out the processes and requirements that must be met to apply for protection under these schemes and to obtain that protection. The procedure entails applying to the appropriate national authority, which is followed by an evaluation of the application considering the criteria outlined in the regulation. If the application is approved, the product or food item in question will be registered and given protection under the appropriate program.²⁰

Since the regulation forbids the use of protected names for products that do not fulfill the requirements for that protection, it also contributes to the maintenance of equitable competition in the market. This prevents the misuse, imitation, and evocation of geographical indications (which I will tell you more about in the second part of the thesis), as well as traditional specialties, by producers who may seek to exploit their reputation for the purposes of financial gain.²¹

Regulation (EU) No 1308/2013 establishes a common organization of the markets in agricultural products, which includes measures to ensure fair competition and support for

¹⁹ "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," EUR-LEX, accessed 5 March 2023, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32012R1151>.

²⁰ Ibid.

²¹ Ibid.

agricultural producers. The regulation also includes rules on market intervention, supply management, and promotion measures.²²

Protection of Geographical Indications for agricultural products and foodstuffs is also an essential aspect of Regulation (EU) No. 1308/2013. The provisions in that Regulation that are connected to GIs mainly concern the use of GIs in the marketing and labeling of agricultural products.²³

The regulation also provides an EU database of registered GIs, which enables better transparency and protection for customers who are interested in purchasing legitimate products. In addition, the legislation permits for the preservation of geographical indications that are not associated with agriculture, such as handicrafts or industrial items that have a strong connection with a particular region or tradition.²⁴

Regulation (EU) No 251/2014 concerns the definition, description, presentation, labeling, and protection of geographical indications for aromatized wine products. This regulation aims to protect the reputation and quality of aromatized wine products with a specific geographical origin and traditional production method.²⁵

According to the regulation, the designation of aromatized wine goods must relate to a particular geographical location or region, which is the place where the product has developed its qualities or gained its features. The production process, which must adhere to traditional methods that have been utilized in that geographical area for a predetermined amount of time, is also specified by the regulation.²⁶

In addition, the European Union's Regulation (EU) No. 251/2014 lays out stringent rules regarding the manner in which GIs for aromatized wine products can be used on product labels and in promotional materials. A clear and unmistakable indication of the product's geographical origin and the traditional production method must be included on the label in accordance with the regulation, which orders that the labeling of the product must be accurate and must not mislead customers.²⁷

²² "Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013 establishing a common organisation of the markets in agricultural products," EUR-LEX, accessed 5 March 2023, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=celex%3A32013R1308>.

²³ Ibid.

²⁴ Ibid.

²⁵ "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 aromatised wine products," accessed 5 March 2023, <https://eur-lex.europa.eu/legal-content/en/ALL/?uri=CELEX:32014R0251>.

²⁶ Ibid.

²⁷ Ibid.

Regulation (EU) 2019/787 focuses on the definition, description, presentation, and labeling of spirit drinks, as well as the protection of geographical indications for such drinks. The law also regulates the use of ethyl alcohol and distillates of agricultural origin in alcoholic beverages and prohibits the use of certain misleading information in the presentation and labeling of spirit drinks.²⁸

The regulation establishes standards for the use of geographical indications on the labels of spirit drink products. These requirements include the necessity to clearly state the name and location of the entity producing the spirit drink as well as the origin of the raw materials used in the production process. In addition to this, the rule creates a framework for the registration and protection of geographical indications applicable to alcoholic beverages throughout the European Union.²⁹

In addition, Regulation (EU) 2019/787 establishes rules on the use of traditional terms for spirit drinks and prohibits the use of certain misleading information on product labels. For example, the use of terms like "whiskey" or "vodka" for products that do not satisfy the relevant criteria for those designations is prohibited by the regulation.³⁰

As we can see these regulations share a common goal of promoting and protecting agricultural products and foodstuffs with specific qualities or characteristics linked to their geographical origin or traditional production method. However, each regulation has a unique focus, addressing different aspects of the common goal. Regulation (EU) No 1151/2012 and Regulation (EU) No 251/2014 specifically addressing geographical indications, while Regulation (EU) No 1308/2013 and Regulation (EU) 2019/787 cover a broader range of issues related to the common organization of the markets in agricultural products and the regulation of spirit drinks, respectively. Overall, these regulations play an essential role in protecting the quality, reputation, and cultural heritage of European agricultural products and foodstuffs, while also ensuring fair competition and support for agricultural producers.

However, the EU regulations do not provide with definitions of such terms as misuse, imitation, and evocation of GIs. And the absence of explicit definitions for those terms presents a significant challenge. The lack of precise definitions can lead to confusion and uncertainty among

²⁸ "Regulation (EU) 2019/787 of the European Parliament and of the Council of 17 April 2019 on the definition, description, presentation and labelling of spirit drinks, the use of the names of spirit drinks in the presentation and labelling of other foodstuffs, the protection of geographical indications for spirit drinks, the use of ethyl alcohol and distillates of agricultural origin in alcoholic beverages," accessed 5 March 2023, <https://eur-lex.europa.eu/legal-content/en/ALL/?uri=CELEX%3A32019R0787>.

²⁹ Ibid.

³⁰ Ibid.

market players regarding the scope of permissible use and potential infringements, undermining legal certainty and I ni my work will try to solve this issue.

GIs are frequently protected by collective and certification marks, especially in common law nations. They are different from the sui generis GI regimes even though they are in the same trademark family. These systems are not mutually exclusive therefore they can be merged. While the laws governing these distinctive trademarks rely on specific national or regional laws, vand other experts have noted several common characteristics.³¹

Certification marks are signs or symbols that give customers the assurance that the products or services they purchase from a company meet specific standards, such as those for quality or accuracy. These marks are capable of distinguishing between products or services that have been certified by the proprietor of the mark and those that have not, and they are designed to give consumers with the assurance that certified goods and services satisfy particular criteria or qualities.³²

The owner of a certification mark issued by the EU is prohibited from engaging in commercial activities that involve the distribution of the products or services for which the mark was issued. This restriction is one of the most significant aspects of EU certification marks. This is done to ensure that the owner keeps a neutral stance and does not utilize the mark for their own profit, which is the primary goal of this measure. Instead, it is the responsibility of the owner of the mark to supervise the use of the mark by individuals who supply the certified products or services.³³

Furthermore, it is essential to be aware that certification marks granted by the EU cannot be utilized to validate the place of origin of products and services. Because of this, the mark cannot be used to designate the location where a good or service was manufactured or provided.³⁴

Collective marks are a unique kind of mark that provide information to customers about specific aspects of the product that uses the mark. Members of a collective body are the only people who are permitted to use collective marks. This is because the collective body itself decides whether or not to admit new members depending on whether or not they comply with the

³¹ Andrea Zappalaglio, "The Protection of Geographical Indications: Ambitions and Concrete Limitations", 2015, 4-5.

³² "Certification and Collective Marks," EUIPO, accessed 5 March 2023, <https://euipo.europa.eu/ohimportal/en/certification-and-collective-marks>.

³³ Ibid.

³⁴ Ibid.

regulations established by the collective body. This entity might be made up of associations of craftsmen, native artists, or other types of craftspeople.³⁵

A producer or service provider in the EU can use a collective mark to indicate the economic origin of certain goods and services. This is achieved by telling customers that the producer or provider of the service is a member of a particular association and possesses the legal authority to use the mark. EU collective marks can only be applied for by organizations of manufacturers, producers, suppliers of services, or merchants, as well as legal persons controlled by public law. Applicants must meet certain criteria. Also, it is possible to register an EU collective mark that designates the geographical origin of the goods or services it covers, however the regulations that govern use must explicitly authorize anyone whose goods and services originate in the geographical area to become a member of the association that owns the mark. If this is not the case, the mark will not be able to be registered.³⁶

In my opinion protection of GIs through certification marks are not the best option because one of the main features of GIs is being essentially attributable to the certain geographical area that makes the final product contain certain quality and characteristics which is not possible with that type of marks because they can't guarantee the location of origin of the goods. However, it is important to note that the same restriction may not apply to national certification marks within EU member states or non-EU states, as the effectiveness of certification marks for guaranteeing the geographical origin of GIs may vary depending on the specific jurisdiction and the type of certification mark used.

If we are talking about the protection through collective marks then it should be noted that, they cannot ensure an essential link between the product and the origin that is established in all sui generis means of protection, even though they provide a higher level of protection because it is possible to register geographical origin this still does not require a close link to that origin. Moreover, collective marks are private property, and the enforcement of their protection relies solely on the claims and actions of the trademark owner. This can result in limitations and potential gaps in ensuring the integrity and authenticity of geographical indications. On the other hand, the sui generis system, which is commonly used to protect GIs, involves a more comprehensive approach. It incorporates a system of official controls and regulations to safeguard the public interest and maintain the quality and characteristics associated with a specific geographical area.

³⁵ Andrea Zappalaglio, "The Protection of Geographical Indications: Ambitions and Concrete Limitations", 2015, 4-5.

³⁶ "Certification and Collective Marks," EUIPO, accessed 5 March 2023, <https://euipo.europa.eu/ohimportal/en/certification-and-collective-marks>.

Also, it is easy to see the difference between GIs protected under separate law, where there is a connection between the origin of the goods and inherent qualities of those goods, and protection through collective marks, which only serve to distinguish the products of one association from those of another association or its members, even when the geographical origin is indicated.

In the context of industrial or commercial concerns, the term "unfair competition" refers to any form of competitive behavior that runs against to accepted standards of conduct. It is up to each state to develop regulations that will ensure the free and honest operation of their markets and to prohibit specific business behaviors, particularly those that deceive consumers about the location from which various goods originate. Most countries have provisions for unfair competition.³⁷

Rather than creating individual property rights over those names, the purpose of the legal protection against unfair competition is to protect sellers and producers from the unauthorized use of geographical names by third parties. Specifically, the protection is aimed at preventing third parties from using those names in commerce. Rather than guaranteeing the product's originality, the purpose of this legal mechanism is to ensure that business is conducted in an honest and open manner.³⁸

To be able to successfully sue on the grounds of unfair competition and prevent the misuse of a geographical name, the plaintiff needs to prove that the products for which the geographical indication is regularly used have a market, an established reputation, and that the use of the geographical name by the non-authorized entity confuses the public and causes or risks causing prejudice. Additionally, the plaintiff needs to show that the use of the geographical name by the non-authorized entity results in or risks resulting in prejudice. The use of unfair competition is an effective method for the protection of geographical indications, and this method is frequently combined with other forms of protection. These defense mechanisms are not mutually exclusive, which means that they can be utilized in conjunction with a variety of different defense strategies.³⁹

In conclusion, it should be mentioned that GIs are a crucial instrument for attaining the goals of a globalized society. These goals include economic growth, the formation of policies, and the protection of individual rights. GIs indicate that a product originated from a particular geographical place, demonstrating not just the product's provenance but also the quality and reputation that are associated with the product. Protecting GIs on a global scale can be

³⁷ "Legal Systems to Protect GIs," Organization for an International Geographical Indications Network, accessed 5 March 2023, https://www.origin-gi.com/web_articles/legal-systems-to-protect-geographical-indications-en-gb-4/.

³⁸ Ibid.

³⁹ Ibid.

accomplished through a variety of means, such as the *sui generis* system, the application of collective or certification marks and laws prohibiting unfair competition. They are protected in the European Union by a *sui generis* system, which is unique to that region, and are acknowledged as intellectual property rights under the TRIPS Agreement of the World Trade Organization. GIs are protected by the European Union through a variety of quality schemes that are included into EU rules. These quality schemes include PDOs, PGIs, and GIs for aromatized wine products and spirit drinks. Additionally, there is a distinct protection plan for TSGs, which all will be discussed in the next paragraph.

Obtaining protection for geographical indications is also possible through the use of collective marks, certification marks, and laws against unfair competition, however, there are several following issues that can cause confusion. Certification markings can guarantee that certified goods and services satisfy specific requirements, it is possible that they are not the ideal choice for preserving GIs because their emphasis is on quality rather than necessarily the inherent features of items that are attributed to their geographical origin with some exceptions that can be applicable to national trademarks. Collective marks, on the other hand, have the ability to protect GIs by designating the economic origin of particular goods and services, however, they might not create a direct connection between the product and its place of origin. Rules that govern unfair competition can be utilized to safeguard GIs by prohibiting the unlawful use of geographical names by third parties and ensuring that fair trade practices are followed. But it is important to note that these protection methods are not mutually exclusive and can be used in combination to provide comprehensive protection for GIs. Moreover, unfair competition rules are typically utilized with the other means of protection. That is why I suppose the best option to protect GIs would be the *sui generis* rules in combination with other means of protection including all their benefits.

1.2 Exploring the Distinctiveness of Geographical Indications

1.2.1 Distinction and similarities between GIs and Trademarks

The interaction between geographical indications and trademarks has been the subject of considerable academic and judicial debate. The diverse possibilities and modalities that flow from these relationships have received considerable attention. In some national laws and international agreements, the presence of a GI serves as the final reason for rejecting a trademark application or

withdrawing a previously registered trademark.⁴⁰ Therefore it is very important to define all the similarities and differences between them to understand how they correlate with each other and find conflicts which arise from that which will be useful while defining the concepts of misuse, imitation and evocation because usually it is the trade mark that violates these concepts .

But first, even though the thesis explains the peculiarities of GIs it seems to be useful to briefly describe the main features of trademarks in accordance with EU legislation.

The European Union Trademark (EUTM) is a unitary right of industrial property that covers the entire European Union. It was formerly known as the Community Trademark and is governed by the European Union trademark regulation (EUTMR). The European Union Intellectual Property Office (EUIPO) registered and oversees the EUTM.⁴¹

The EUTM, like national trademarks, may include any signs including words, designs, letters, and numbers, as well as the appearance of goods or their packaging. Any natural or legal person may register the signs, which must be able to distinguish between the goods or services of one business and those of competitors.⁴²

In contrast to trademarks, GIs have distinct characteristics that set them apart. GIs as was said previously focus on indicating the geographical origin of a product and the specific qualities and reputation associated with that origin.

People looking to safeguard their intellectual property rights in the European Union can benefit greatly from the EUTM. Businesses no longer need to navigate various national trademark systems because it offers a streamlined registration process for trademarks that is valid across the EU. Additionally, the EUIPO provides a number of services, such as opposition and cancellation procedures as well as mediation and arbitration services, to assist businesses in defending and enforcing their EUTMs.⁴³

In addition to the rules already in place for collective marks, the EU Trademark Regulation in its last redaction added substantive and procedural rules for the protection of certification marks. This was a response to the lack of balance between national and EU trademark systems. The new

⁴⁰ Martin Nacevski, "The relationship between protected geographical indications and protected designations of origin and the European Union trade mark in relation to wines and spirits," (University "Ss. Cyril and Methodius" Skopje, 2017), 25-26.

⁴¹ "Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark," accessed 5 March 2023, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32017R1001>.

⁴² Martin Nacevski, "The relationship between protected geographical indications and protected designations of origin and the European Union trade mark in relation to wines and spirits," (University "Ss. Cyril and Methodius" Skopje, 2017), 25-26.

⁴³ Ibid.

rules advance the protection of trademarks in the European market, but also enhance progress in protecting indications of origin. Because as already was mentioned, indications of origin can be protected under *sui generis* regimes, unfair competition law, and through collective and certification marks. Therefore, the introduction of EU certification marks highlights the importance of indicating the place of origin of goods, while some may argue it undermines the significance of *sui generis* protection.⁴⁴

However, in my opinion and as I mentioned above the protection through collective and certification marks cannot undermine the *sui generis* system because there are some disadvantages of the trademark system which were explained.

Nevertheless, like the idea of collective and certification marks, geographic indications are a collective right that can be utilized by any business present in a particular region. However, rather than a specific geographical area, use of collective and certification marks is subject to adherence to the mark's standards. On the other hand, only the owner of a particular trademark may use it.⁴⁵

The validity of these systems also sets them apart from one another. The European Union Trade Mark Regulation (EUTMR) allows for an unlimited number of renewals during its 10-year limited validity period. However, the use of Protected Designations of Origin and Protected Geographical Indications is permitted for a period of five years and may be extended.⁴⁶

Both systems have benefits and drawbacks for applicants. It is simpler to register an EUTM than to go through the complex process necessary for the Commission, which involves a Member State. The requirements and documentation for registering a PDO or PGI are more stringent. Furthermore, if necessary, trademarks may be licensed or assigned to a third party. Geographical indications, however, offer stronger defense against trademark infringement as well as any improper use of the protected term.⁴⁷

So, while the EUTMR provides flexibility through unlimited renewals, PDOs and PGIs have stricter requirements and shorter initial validity periods but offer enhanced protection and safeguarding of geographical indications.

⁴⁴ Alessandra Cavalieri, *"The conflict between Geographical Indications and EU Trademarks in the light of the recent developments in Community Law and jurisprudence: a GIs' overprotection?"*, (University of Turin, 2019), 8.

⁴⁵ Martin Nacevski, *"The relationship between protected geographical indications and protected designations of origin and the European Union trade mark in relation to wines and spirits,"* (University "Ss. Cyril and Methodius" Skopje, 2017), 26.

⁴⁶ *Ibid.*

⁴⁷ *Ibid.*

If we are talking about similarities, it should be stated that GIs and trademarks are two types of intellectual property rights that play a vital role in the protection and promotion of goods. They are both used to identify the source of products and to differentiate them from those of competitors.⁴⁸ Trademarks are used to indicate the commercial origin of goods and services. They help to build brand identity and reputation and protect consumers from confusion or deception. In contrast, GIs are used to indicate the geographical origin of products and to protect the reputation and unique characteristics of goods that are tied to a particular region or locality.⁴⁹

Both trademarks and GIs act as guarantees of quality, with trademarks ensuring consistent quality and GIs providing more specific guarantees such as adhering to a defined area of production and traditional processes. This helps consumers make informed decisions about the products they purchase and provides a level of assurance that the goods they are buying meet certain standards of quality and authenticity.⁵⁰

In addition to their functional similarities, both trademarks and GIs can be valuable commercial brands. They can create goodwill and brand recognition, and help businesses differentiate themselves from their competitors. As a result, trademarks and GIs can be key assets in the intellectual property portfolios of businesses, contributing to their overall value and competitiveness in the marketplace.⁵¹

Also, trademarks and geographical indications both have unique qualities that set them apart from one another. The precise origin of the product is disclosed by the geographic name in geographic indications, which are descriptive. Trademarks, on the other hand, are distinctive and used to indicate the product's owner. The legal principle of collective ownership that governs GIs is another important distinction between the two. This is due to the requirement that, as opposed to trademarks that have a private character, all products bearing the GI name are owned by the same certifier of quality and high standards.⁵²

So, as can be seen, GIs and trademarks share significant similarities in the realm of intellectual property rights. They both serve as identifiers, distinguishing the source of goods and protecting consumers from confusion. Trademarks signify commercial origin, building brand identity and ensuring consistent quality. In contrast, GIs indicate geographic origin, safeguarding

⁴⁸ Report of the WTO Panel, *European Communities Protection of Trademarks and Geographical Indications*, 15 March 2005, quoted in Dev S. Gangjee: *Protecting Geographical Indications as Collective Trademarks: The Prospects and Pitfalls*, 113-114.

⁴⁹ Ibid.

⁵⁰ Ibid.

⁵¹ Ibid.

⁵² Alessandra Cavalieri, "The conflict between Geographical Indications and EU Trademarks in the light of the recent developments in Community Law and jurisprudence: a GIs' overprotection?", (University of Turin, 2019), 12.

the reputation and unique characteristics tied to specific regions. Both are valuable assets for businesses, contributing to their competitiveness and providing consumers with quality assurance.

Another important point when we are talking about correlation between GIs and TMs is that last version of EUTMR contains some specific information which is related to refusal of TM because of GIs and conflicts between these two IPRs.

When a trademark is registered using a geographical name that is significant to the relevant public or has acquired distinctiveness through secondary meaning, disputes frequently result. Due to the descriptive nature of a geographical term, this situation infringes upon the legal right of the entity entitled to use a geographical designation of origin as an indicator of the origin of goods.⁵³

A geographical term with a descriptive purpose is frequently used by product imitators to create a trademark. They may also try to present their product in a way that strongly evokes the PDO/PGI product, based on the overall impression made on consumers.⁵⁴

Since GIs and trademarks are separate and independent intellectual property rights and there is no established procedure for resolving such conflicts, finding a solution to this issue could be difficult. Two main strategies can thus be taken into consideration. The sui generis regime of protection for GIs is utilized in the first strategy, whereas trademark law is the focus of the second strategy.⁵⁵

The argument that a geographical indication reflects the cultural heritage of a region or country and, as such, somewhat supersedes the individual private property rights connected to a trademark is common under the sui generis regimes.⁵⁶

This approach might cause GIs to be overprotected relative to TMs. For instance, a subsequent PDO or PGI may invalidate an earlier trademark, or it may no longer be eligible for protection under trademark law due to the protection of an identical or similar designation as a GI.⁵⁷ However, this conflict in my opinion may be resolved through a coexistence between those two marks and if the previously registered trademark was registered lawfully.

⁵³ Nina Resinek, "Geographical Indications and Trade Marks: Coexistence or "First in Time, First in Right" Principle," *EIPR, European Intellectual Property Review*, November 2007.

⁵⁴ Alessandra Cavalieri, "The conflict between Geographical Indications and EU Trademarks in the light of the recent developments in Community Law and jurisprudence: a GIs' overprotection?", (University of Turin, 2019), 12-13.

⁵⁵ *Ibid.*

⁵⁶ B. Goebel, M. Groeschl, "Learning to love my PET: the long road to resolving conflicts between trademarks and geographical indications," quoted in D.S. Gangjee, "Research handbook on Intellectual Property and Geographical Indications," 2016, 374.

⁵⁷ Alessandra Cavalieri, "The conflict between Geographical Indications and EU Trademarks in the light of the recent developments in Community Law and jurisprudence: a GIs' overprotection?", (University of Turin, 2019), 13.

Trademark law, which is founded on the concepts of priority, exclusivity, and territoriality, takes a different approach than sui generis regimes. Priority, also known as the "first in time, first in right" principle, stipulates that the person who applied for a sign first is granted the right to exercise exclusive jurisdiction over a particular territory. The application of this principle to conflicts involving GIs and TMs, on the other hand, may not be appropriate because these entities have distinct natures, and the principle mandates that comparisons be made on the same level. This could lead to consumers being misled about the products that are marked by the compared signs, and it also has the potential to result in dilution of the brand.⁵⁸

Conflicts between GIs and TMs are likely to arise in response to the following three scenarios regardless of which approach is taken: (i) GI came before, TM came after it; (ii) TM came before, GI came after it; (iii) the coexistence of GIs and TMs.⁵⁹

And in order to understand all of the aspects of the conflict there is a need to assess it through sui generis and trademark systems discussing all three circumstances.

(i) GI came before, TM came after it:

According to this strategy, once a Protected Designation of Origin or Protected Geographic Indication has been registered, no additional trademarks may be filed for similar items that are not protected by the registration. This is because registered names are afforded protection against any direct or indirect commercial usage in respect to products that are not covered by the registration, even if those products are linked to the registered products.⁶⁰

The establishment of an exact priority date is the fundamental question that has to be addressed in order to decide which of the two signs has precedence over the other in all areas. The European Union Regulation 1151/2012 on Agricultural Products and Foodstuffs has created a standard priority date, despite the fact that in the past there have been some disagreements over the correct date that should be considered as the priority. This is the day that the application for the protection of PDO or PGI is filed to the Commission and then registered afterward. The date of uniform priority will be applied to each and every one of the items for which geographical indications have been registered.⁶¹

⁵⁸ Ibid.

⁵⁹ Ibid.

⁶⁰ Martin Nacevski, "The relationship between protected geographical indications and protected designations of origin and the European Union trade mark in relation to wines and spirits," (University "Ss. Cyril and Methodius" Skopje, 2017), 27-28.

⁶¹ Alessandra Cavalieri, "The conflict between Geographical Indications and EU Trademarks in the light of the recent developments in Community Law and jurisprudence: a GIs' overprotection?", (University of Turin, 2019), 14-15.

This priority rule is, of course, in full compliance with both the "first in time" concept and the territoriality principle. This is because the application priority is only effective in the region in which protection is being claimed.⁶²

Even though, according to the *sui generis* regime approach, the priority principle is the most effective way to resolve a disagreement between an earlier GI and a later TM, this does not provide a ground of inconsistency from the standpoint of trademark law.⁶³ So, that it can be said that this principle can be applied to both approaches, and nothing will be violated.

On the other hand, there is a possibility of some discrepancies in regard to that problem that has to be taken into consideration, and that is the necessary criteria for product similarity that establishes the level of protection afforded to each party's particular rights. The identity or a similarity of the products serves as the benchmark for evaluation under the provisions of the Trademark Law. Article 8.1 of EU Trademark Regulation 1001/2017 indicates that the possibility of customers being confused about the origin of items increases in proportion to the degree to which the goods in question are similar to one another.⁶⁴

In contrast, the extent of protection under the *sui generis* regime for GIs is broader, as it extends, in addition to identical and similar products, to the name exploiting the reputation of the protected name.⁶⁵

(ii) TM came before, GI came after it:

According to *sui generis* regime of protection even if the presence of a geographical indication that has already been registered or applied for counts as a legitimate ground for rejecting an application for an EUTM, the fact that a trademark already exists can also hinder the registration of a protected designation of origin or protected GI in certain situations. The regulations that govern PDOs and PGIs state that a name cannot be protected as a designation of origin or GI if its registration could potentially deceive consumers about the real nature of the product. This is determined by taking into consideration the reputation of the trademark in question as well as the length of time it has been used.⁶⁶

⁶² Ibid.

⁶³ Ibid.

⁶⁴ Ibid, 16.

⁶⁵ Ibid.

⁶⁶ Martin Nacevski, "The relationship between protected geographical indications and protected designations of origin and the European Union trade mark in relation to wines and spirits," (University "Ss. Cyril and Methodius" Skopje, 2017), 31-32.

It is prescribed by Article 6, paragraph 4 of the EU Regulation No 1151/2012: in order to prevent the registration of a later GI, the previous trademark must (i) already be known to the general public and have a well-established reputation, and (ii) be used for an extended length of time.⁶⁷

So, as we can see in the *sui generis* system of protection there are a strict rules applies for trademarks to prevent the registration of GIs, that seems to be a bit overprotective, however in my opinion such a protection is a need for GIs because they protect the specific quality of the product acquired only on that specific region and TM owners shouldn't have a absolute right to own the trademark if GI which is going to be registered can promote its main rationales as promoting rural developments, indicating geographical origin and preventing confusion of the consumer, protecting producers against misappropriation.

Since the laws that regulate GIs are not always explicit and give potential for ambiguity, it can be difficult to evaluate whether an application for a geographical indication should be accepted or denied. This is due to the fact that circumstances like this are uncommon, and the rules do not address them expressly. Nevertheless, notwithstanding this uncertainty, there are safeguards in place to protect trademarks. These rules are justified by the necessity to maintain the reputation of well-known marks against the prospect of a less significant region registering a name that is similar to the well-known mark. Because of this, it's possible that a significantly big number of manufacturers in the area will abuse the reputation of the trademark. For instance, if a brand makes a fancy reference to a geographical name or is not related with the location in which the product is produced, then the trademark may be vulnerable to the registration of the name of the region in which the product is produced. Because of this, it's possible that other manufacturers in the area may start using the name in order to mislead customers.⁶⁸

(iii) the coexistence of GIs and TMs:

The coexistence of a previously registered trademark and a subsequent geographical indication is a common and difficult issue. This issue is addressed in Article 14, paragraph 2 of EU Regulation No. 1151/2012, which outlines two conditions that must be satisfied for a prior trademark and a subsequent GI to coexist. First, the trademark must have been registered and used

⁶⁷ "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," EUR-LEX, accessed 5 March 2023, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32012R1151>.

⁶⁸ Martin Nacevski, "The relationship between protected geographical indications and protected designations of origin and the European Union trade mark in relation to wines and spirits," (University "Ss. Cyril and Methodius" Skopje, 2017), 33-34.

in good faith, and second, it must not be subject to a declaration of invalidity under EU trademark law.⁶⁹

There are two distinct ways to approach trademarks in relation to geographical indications. On the one hand, an application for a GI can be turned down if there is already an existing trademark for the product in question. On the other hand, it may result in a circumstance in which the GI and the trademark are both able to coexist. This would be dependent on the fact that the trademark satisfied a number of specified conditions, as well as the interpretation of the judges. And this seems to be twofold.⁷⁰ So, in simple words if the TM in question have a reputation and is registered for certain period of time that case most likely will be a ground for refusal of registration of the later GI but if trademark does not have these specific conditions which are determined on case by case basis and the trademark uses in good faith and are valid under EUTMR then in that case most likely coexistence will be in question.

This provides a compromise option that makes it possible for a prior trade mark, which is no longer exclusive, and the succeeding PDO or PGI to coexist in the marketplace.⁷¹

This is explained in the Torres case. The situation of Torres, in which the Torres trademark had been registered and used for a significant amount of time in connection with wines, is a particularly notable illustration of this phenomenon in the sector. However, after the registration of the geographical designation Torres Vedras, which was allocated for a valley close to Lisbon, its existence became in danger. The protection of this GI would have resulted in the invalidation of the Torres trademarks in accordance with the Regulation (2392/89) that was in place during that time. However, as a result of the obvious injustice, the Regulation was updated to allow for the coexistence of GIs and trademarks for comparable names. This coexistence is subject to specific requirements, which were stated earlier in this paragraph.⁷²

Another example of coexistence is shown in the cases of Bavaria NV and Bavaria Italia Srl v Bayerischer Brauerbund. The conflict centered on the usage of the geographical term "Bavaria" for beer. Bavaria NV, the former trademark owner, and Bayerischer Brauerbund, a long-standing group of Bavarian brewers who had a Protected Geographical Indication for Bavarian beer, were the parties involved. Brauerei Bavaria NV, one of the Netherlands' largest beer makers, began using

⁶⁹ Alessandra Cavalieri, "The conflict between Geographical Indications and EU Trademarks in the light of the recent developments in Community Law and jurisprudence: a GIs' overprotection?", (University of Turin, 2019), 18.

⁷⁰ Ibid.

⁷¹ M. Gagnani, "The law of geographical indications in the EU," *Journal of Intellectual Property Law & Practice* 7, 4 (2012): 279.

⁷² Martin Nacevski, "The relationship between protected geographical indications and protected designations of origin and the European Union trade mark in relation to wines and spirits," (University "Ss. Cyril and Methodius" Skopje, 2017), 34-35.

the word "Bavaria" in 1925 and incorporated it into their company name in 1930. Bavaria NV held and used various international trademarks, including the term "Bavaria," as well as other aspects, since 1947.⁷³

In 2001, the Bavarian Brewers' Association registered the PGI "Bayerisches Bier." Following that, the association filed a lawsuit against Bavaria NV in Italy, attempting to prevent the firm from using the term "Bavaria" in Italy and to invalidate the company's trademark rights to the name. When the matter reached the Turin Court of Appeal, the ECJ was asked to rule on whether the fact that the PGI was given protection after the trademarks were registered meant that the Dutch business may still use the marks. The ECJ reaffirmed the principle of coexistence in July 2009, ruling that third-party trademarks registered prior to the application for the PGI "Bayerisches Bier" could continue to exist, even if they contained the phrase "Bavaria."⁷⁴

To sum up, I would like to say that geographical indications and trademarks are great tools to protect intellectual property rights of its owners and despite the fact that they are relatively different there are some similarities which allows us to say that when the registration of TM is in case registered GI on that territory should be taken into account and vice versa. It is impossible not to notice that GIs got greater degree of protection that may seem a bit overprotective, however in my opinion there is a need for that protection because of protection of the unique product which can be manufactured only on that specific area using that specific method of production and because of that some situations arise which from time to time that put this IPRs in conflict, however nowadays the conflicts between them are solving pretty promptly by amending the existing regulations and the situations of overprotection became much lesser than it was before.

1.2.2 Understanding, distinction, and similarities of EU quality schemes (PDO, PGI, GI)

First it should be noted that EU quality schemes are protected mainly under the Regulation (EU) No 1151/2012 which is define them and set all the rules of their registration and protection. The definition of them stating specific requirements could be found in the article 5 of the Regulation and describes as follows.

Protected Designation of Origin as a kind of intellectual property right that offers the greatest degree of protection to brand names that have a close connection to their place of origin. Food, agricultural goods, and wines are the principal subjects of this sort of protection. PDO goods

⁷³ G.E. Evans, "The Simplification and Codification of European Legislation for the Protection of Geographical Indications".

⁷⁴ Ibid.

must fulfill strict requirements, such as having every step of manufacturing, processing, and preparation take place in a certain area. When making wine, the grapes must only come from the region where the wine is made.⁷⁵

The term "Protected Geographical Indication" designates a connection between a particular geographic area and a product's name in which the product's quality, reputation, or another feature is fundamentally attributed to its place of origin. Food, agricultural goods, and wines are all included in PGI products as well. Most PGI goods must go through at least one step of manufacture, processing, or preparation there. For wine, at least 85% of the grapes must be grown only in the region where the wine is produced comparing with PDO where all the grapes must comply with that requirement. Also, it worth mentioning that for foods and agricultural goods, the label is required, but for wines, it is not.⁷⁶

Although the Regulation (EU) No 1151/2012 does not deal with spirit drinks it can be presumed from the requirements set out in the Regulation (EU) No 1151/2012 for spirit drinks that the protection of them is not a PDO because the requirements are less strict and similar to that of the PDI and are named Geographical indication for spirit drinks.

This term refers to a sort of protection used to preserve the name of a spirit beverage that has a distinctive quality, reputation, or attribute that can be traced back to its place of origin. Spirit beverages that come from a certain state or area are covered by this protection. Although the raw components needed to make the drink may not always have to originate from that location, the manufacture or preparation of the drink must take place there, at least in part. Also, it is not necessary to label GI spirit beverages.⁷⁷

The PDO and PGI protection is the same which means that competitors from outside the specified region cannot use the name, even with further clarifications. Geographical indications, as opposed to trademarks, show the provenance of the goods. The benefits linked with EU GIs are more solid than those associated with trademarks in two ways: No one is permitted to use the GI moniker, even for comparing purposes and unless the earlier trademark is well known, a GI application submitted later can coexist with an earlier trademark.⁷⁸

⁷⁵ European Commission, "Quality schemes explained", accessed 5 April 2023, https://ec.europa.eu/info/food-farming-fisheries/food-safety-and-quality/certification/quality-labels/quality-schemes-explained_en/.

⁷⁶ Ibid.

⁷⁷ Ibid.

⁷⁸ Hazel V. J. Moir, "Understanding EU Trade Policy on Geographical Indications", the Journal of World Trade 51, no. 6 (2017), 1024, <http://politicsir.cass.anu.edu.au/sites/default/files/spir/Article-by-Hazel-Moir-Dec2017.pdf>.

In conclusion PDO, PGI, and GI are all types of geographical indications that protect the names of products associated with their place of origin. PDO offers the greatest protection and requires all production stages to take place in a specific area, while PGI requires at least one stage of production to occur there. GI protects the names of spirit drinks with a connection to a specific region, and production, at least partially, must take place in that region. Labels are mandatory for PDO and PGI food and agricultural products but optional for GI spirit drinks.

However, it should be noted that under the EU law there is one more quality scheme that should be considered is Traditional Specialty Guaranteed (TSG).

TSGs are not GIs themselves but a labeling system that highlights traditional characteristics and are used for products that have a traditional production, processing, or composition method or originate from traditional raw materials or ingredients that are naturally related to a specific geographic region. The names that are registered as TSGs are required to have a traditional relationship with the products for which they are registered. This designation provides protection against both unauthorized use of the product name and any attempt to falsify it.⁷⁹

TSGs include, for example, the traditional beers *Vieille Gueuze* and *Vieille Kriek*, both of which are commonly brewed in the Brussels region of Belgium. *Vieille Gueuze* is a sort of traditional beer that is generated through spontaneous fermentation, and *Vieille Kriek* is prepared by utilizing lambic beer to which cherries are added. In addition, because they are TSG products, the production process used to make them is protected from imitation and misuse, even if the items themselves are created somewhere else.⁸⁰

Every food and agricultural product that satisfies the necessary criteria for TSG registration is obligated to have the TSG warning label as it is a government mandate. This labeling system serves to protect the traditional characteristics and cultural history of a wide variety of food and agricultural goods, promoting their distinctiveness and uniqueness in the worldwide market. It is important to note that TSG is not often used; nonetheless, products such as *Gueuze*, *Kriek*, *Mozzarella*, or *Jamón Serrano*, which do not have GI protection but still qualify for TSG protection as long as they meet traditional standards, even if they do not originate from a certain geographical location.

⁷⁹ Martin Nacevski, "The relationship between protected geographical indications and protected designations of origin and the European Union trade mark in relation to wines and spirits," (University "Ss. Cyril and Methodius" Skopje, 2017), 17.

⁸⁰ European Commission, "Commission Implementing Regulation (EU) 2017/2216 of 1 December 2017 entering certain names in the register of traditional specialties guaranteed," accessed 5 April 2023, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32017R2216>.

And of course, products registered under one of the three schemes may be marked with the logo for that scheme in order to help identify those products.

The protection of TSGs, as well as PDOs and PGIs, is of the greatest importance and it is given almost equal weight. As a result, the protection of TSGs is acknowledged as an absolute ground for rejecting an application for an EU trademark under EU legislation.⁸¹

The goal of this is to ensure that the level of protection accorded to TSGs, as well as that accorded to PDOs and PGIs, remain consistent with one another. This action guarantees that TSGs will get the same level of legal protection as PDOs and PGIs, which are recognized for their specific characteristics and the cultural significance they hold. The dedication of the EU to the provision of strict protection for these items contributes to the maintenance of their distinctive qualities and the preservation of their cultural heritage. It also provides legal remedies for producers and consumers in the event that items are counterfeited, or the names of the products are misused, safeguarding the integrity and authenticity of the EU's agricultural and food production in the process.⁸²

Quality schemes serve an important part in preserving local food traditions by building a strong link between the product's quality, its location of origin, and the culture connected with it. These schemes are important because of the hazards posed by globalization and the unfettered movement of goods, which might result in the manufacturing of inexpensive and inauthentic items in many areas using inferior materials and processes. Quality schemes efficiently preserve the traditional ways and authenticity of these items by establishing particular standards and restricting manufacturing to specified places.⁸³

Furthermore, quality schemes can aid in the process of nation building. Slovenia, for example has worked hard to register its regional products under protected designations such as PDO and PGI. This initiative underlines Slovenia's dedication to defining its national character, as preserving regional products is essential for promoting and presenting the country's distinct cultural history.⁸⁴

⁸¹ "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," EUR-LEX, accessed 5 March 2023, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32012R1151>

⁸² Martin Nacevski, "The relationship between protected geographical indications and protected designations of origin and the European Union trade mark in relation to wines and spirits," (University "Ss. Cyril and Methodius" Skopje, 2017), 17.

⁸³ N.L. Berendsen, "Geographical Indications, the Internal Market: *The Questionable Justification as Industrial and Commercial Property*," Master Thesis L.L.M., International & European Law University of Groningen.

⁸⁴ Ibid.

In conclusion, the quality schemes implemented by the EU are a vital element in the process of protecting the names of products that are connected with their places of origin. These schemes offer a method for maintaining the traditional characteristics and cultural traditions of a variety of food and agricultural goods, thereby promoting their distinctiveness and uniqueness on the international market. The protection that is provided by PDOs, PGIs, and GIs guarantees that the product names will not be misused, imitated, or evoked as well as that the product's quality and originality will be preserved.

The TSG scheme is an important addition to these schemes since it places an emphasis on traditional characteristics and provides protection against falsification as well as inappropriate utilization of the product name. The dedication of the EU to the provision of thorough protection for these items contributes to the maintenance of their distinctive qualities and the preservation of their rich history. Overall, the EU quality schemes play a significant role in preserving the integrity of the EU's agricultural and food production as well as its high standards of quality, and the protection of these programs is essential to the continued success of these goods on the global market.

2. PROTECTION AGAINST VIOLATIONS OF GIs

2.1 Protection against misuse and imitation of GIs

In my opinion, before talking about the protection of GIs from specific infringements, it is important to answer the question why are GIs protected at all, what is the point of protecting them and does the EU need such strict rules for the protection of geographical indications? To answer this question, we can refer to the rationales of its protection which describe the main goal of the protection of GIs.

The rationale for geographical indications protection is based on utilizing the place of origin as a quality indicator for customers, decreasing information asymmetries, and capturing the region's resources in the labeled product. GIs inform consumers about the product's origin and reputation, allowing them to make more informed decisions. GIs also offer value by incorporating resources from the region, such as production practices, varieties, the environment, and culture. This distinction provides a premium perception among consumers, who are willing to pay extra for products that include recognized GIs.⁸⁵

There are three main justifications for protecting geographical indications. They explain the various motivations for GI protection and their intended functions. From a theoretical approach, the diversity of grounds may help us determine if GIs are designed to foster innovation or how the framework may enable innovation.⁸⁶

Promotion of rural development

Recital 4 of the EU Regulation 1151/2012 states that encouraging producers to diversify their product range through quality schemes can have positive impacts on the rural economy, particularly in less-favored, mountainous, and remote areas where agriculture plays a significant role in the economy and production costs are high. Such quality schemes can complement rural development policies, market support policies, and income support policies of the common agricultural policy, with a special focus on disadvantaged areas where the farming sector has greater economic significance. This way, quality schemes can help in fostering economic growth and development in rural regions.⁸⁷

⁸⁵ Cerchia Bramley et al, "The economics of Geographical Indications: towards a conceptual framework for Geographical Indication research in developing countries", in *WIPO, The economics of intellectual property*, 114.

⁸⁶ Drexel & A. Kamperman Sanders "The Innovation Society and Intellectual Property," quoted in A. Moerland: *Geographical Indications and Innovation: what is the connection?*: 2019, 75.

⁸⁷ "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," EUR-LEX, accessed 5 March 2023, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32012R1151>

The protection of products by an indication of origin typically involves a strong connection to the place where they are produced and significant cultural and historical ties. When a product is designated as a GI, it means that all producers must adhere to the legally defined production specifications, which include techniques, species, landscape, and cultural resources. This creates a positive impact on all aspects of the rural economy, with successful GI products preserving cultural heritage, conserving agricultural and biodiversity systems, and fostering rural development. The success of a GI product is reliant on various factors, such as its unique characteristics and the producer group's ability to establish a specialized market for the product, which may lead to increased income for producers. This impact is even greater when the GI label enables small, local producers to sell their products directly to consumers, allowing them to compete with larger corporations.⁸⁸

So, we can see that the promotion of quality schemes that reward producers for diversifying their products can have positive impacts on rural economies, by preserving cultural heritage, conserving agriculture and biodiversity, and increasing income for small, local producers especially in areas where agriculture is significant, and production costs are high, which can benefit policies related to rural development and market and income support, particularly in disadvantaged regions.

Protecting Producers against Misappropriation

GIs are economically justifiable based on information and reputation since they minimize customer search costs and prevent product quality and origin fraud. Consumers are unable to assess the quality of agricultural items prior to purchase, resulting in an information imbalance that might lead to market failure. To combat this, customers rely on previous purchases as an indicator of quality, while businesses attempt to build a reputation for creating high-quality items.⁸⁹

Companies often use signaling devices to indicate a product's origin and quality to consumers, and geographical indications serve the same purpose by conveying useful information about a product's origin and characteristics. However, when numerous producers are engaged in the production of a GI-protected product, the finished product may be rather diverse, which may undercut the purpose of eliminating customer confusion. While GI regulations primarily focus on manufacturing processes, they frequently also describe the product's composition to ensure uniformity. Despite minor differences in the final product between producers, consumers are

⁸⁸ A. Moerland, "Geographical Indications and Innovation: what is the connection?": 2019, quoted in J. Drexler & A. Kamperman Sanders: *The Innovation Society and Intellectual Property*, 75.

⁸⁹ Ibid.

always aware of the GI product's origin and regulated qualities, allowing them to make informed choices. GIs aid in product differentiation and enable consumers to make selections based on relevant product attributes.⁹⁰

Protecting producers against misappropriation

Geographical indications play a crucial role in safeguarding producers against the misuse of geographical indications, protecting their reputation and the expected quality of their products. The efforts of producers in producing origin-labelled products are significant, and they deserve certain advantages to promote and protect their investments. Some experts propose that skilled producers have a proprietary interest in the terroir. Therefore, geographical indications can also provide proprietary benefits to producers for their efforts in producing unique and authentic products.⁹¹

Therefore, the protection of geographical indications serves multiple purposes, including promoting rural development, safeguarding producers against misappropriation, and enabling informed consumer choice. By encouraging producers to expand their product range, GIs can boost the rural economy, particularly in disadvantaged areas. Additionally, by conveying useful information about a product's origin and quality, GIs help consumers make informed choices while protecting producers' reputation and investment. Ultimately, protecting geographical indications benefits producers, consumers, and the rural economy as a whole and it is the answer to question why GIs are protected, so now we can move on to the concepts of misuse and imitation.

First of all, it should be mentioned that the protection against misuse, imitation and evocation established in the four above mentioned EU Regulations and each regulation states the same information, so in accordance with Article 13.1(b) of the EU Regulation 1151/2012:

1. "Registered names shall be protected against:

*(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;"*⁹²

⁹⁰ Ibid, 76.

⁹¹ Ibid.

⁹² "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," EUR-LEX, accessed 5 March 2023, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32012R1151>.

We can see that Article 13.1(b) of EU GI regulation 1151/2012 provides important protection for registered names (and not only as will be explained latter) of geographical indications against any misuse, imitation, or evocation. This means that even if the true origin of a product or service is indicated, the use of protected names is prohibited if it is intended to mislead or deceive consumers (and even in some cases which will be included into the next chapter where there is no unfair competition).

The article goes further by explicitly stating that the use of terms such as 'style', 'type', 'method', 'as produced in', 'imitation', or similar, as well as the use of protected names as an ingredient, are also prohibited if they are intended to mislead consumers.

This provision is critical in protecting the integrity and reputation of geographical indications, which are often associated with specific qualities and characteristics that are linked to their geographical origin. By preventing any misuse, imitation or evocation and by that consumers can be assured that they are receiving genuine products that meet the high standards associated with GIs.

Article 13.1(b) is an important measure in ensuring the protection and promotion of geographical indications in the EU market and is a vital component of the wider system of intellectual property protection for agricultural products and foodstuffs.

However, this article left some abovementioned uncertainty as it does not define these concepts which in my opinion a disadvantage of EU law and I will propose the possible solution further in my work by creating possible definitions after analyzing the concepts themselves.

To start talking about misuse it should be noted that EU trademark can also be awarded protection in the European Union for products and services, including those that may be connected with a GI. This has led to concerns about the possible misuse of GIs by EUTMs, which might lead to consumer uncertainty about the true origin of the items and a dilution of the GI's value.⁹³

According to the Boards of Appeal of the European Union Intellectual Property Office (EUIPO), the idea of "misuse" in regard to the protection of geographical indications (PDO/PGI) should be understood as either an "inappropriate use" or an "unauthorized and/or illegal use." This interpretation is based on the definition of the term "use" established by the European Union's Court of Justice (CJEU). However, it is important to highlight that this interpretation is not totally apparent because the scenarios in which the use of a PDO/PGI would be considered unsuitable,

⁹³ European Union Intellectual Property Office, "EUIPO trademark Guidelines," Part B, Section 4, Chapter 10, Subsection 4.2.1, accessed 20 April 2023, <https://guidelines.euipo.europa.eu/1922895/1790180/trade-mark-guidelines/4-2-misuse--imitation-or-evocation-of-a-gi>.

unapproved, and illegal are already established in subparagraph (a) of the above-mentioned article.⁹⁴

To address these issues, the EUIPO believes that an EUTM misappropriates a GI when it falsely states the geographical origin of the products, resulting in some benefit from the GI's perceived quality. This might happen if a phrase that is same or similar to a GI is used, or if images or other marketing materials are used that establish a misleading link with the GI.⁹⁵

During the ex parte assessment process, however, establishing 'misuse' due to the use of the EUTM in trade can be difficult. This is due to the fact that the evaluation is often performed before the applicant has used the trade mark in commerce, making it difficult to verify whether the EUTM is genuinely misusing the GI. Nonetheless, the EUIPO remains committed to protecting geographical indications and ensuring that they are not misappropriated by EUTMs or other trade marks.⁹⁶

Counterfeiting, misleading marketing and labeling, cultural appropriation and exploitation are some examples of how GIs can be misused. To prevent such misuse, clear criteria for registration and protection, effective enforcement mechanisms, and awareness-raising among producers, consumers, and the public are essential. Fair and equitable trade practices that support sustainable development and cultural diversity should also be promoted.

The misuse of GIs can not only harm consumers and producers but can also damage the reputation of the regions associated with the products. For example, if a product bearing a protected GI is counterfeited or of poor quality, it can negatively affect the reputation of the region and the genuine producers who are adhering to the quality standards. This can lead to a loss of trust and credibility in the market, which can ultimately harm the economic and social development of the region. Therefore, it is crucial to prevent the misuse of GIs and promote fair trade practices that benefit all stakeholders involved and to do it in the most effective way in my opinion this concept should be clearly defined pointing out on all the features and similarities to create certainty among market players.

The next concept at hand is imitation which is according to Merriam Webster dictionary “... is resembling something else that is usually genuine and of better quality: not real”⁹⁷

⁹⁴ Manon Verbeeren and Olivier Vrins, “The protection of PDOs and PGIs against evocation: a ‘Grand Cru’ in the CJEU’s cellar?”, in *Journal of Intellectual Property Law & Practice*, Volume 16, Issue 4-5, (April-May 2021), 323.

⁹⁵ Ibid.

⁹⁶ Ibid.

⁹⁷ “Merriam-webster dictionary,” accessed 3 May 2023, <https://www.merriam-webster.com/dictionary/imitation>.

So, we can see that in the definition provided by the Merriam-Webster dictionary, the term "imitation" refers to the act of resembling something else that is typically considered to be authentic and of superior quality. The term implies a lack of authenticity, suggesting that the object of imitation is not real, but rather a copy or a simulation of the original. This definition is relevant in the context of various academic disciplines, including legal field as well, where the concept of imitation is often studied and debated.⁹⁸

And of course, the concept of imitation is also relevant in the field of law. In the legal context, imitation refers to the act of reproducing or copying the work of another person without their permission, which is known as infringement of intellectual property rights.

According to EUIPO the term "imitation" refers to the act of mimicking or reproducing certain elements of a product designated by a geographical indication (GI) which results in the product being called to mind. The term "evocation" is considered by the Office to be a corollary of the concept of imitation. Essentially, the terms "imitation" and "evocation" share a fundamental connection.⁹⁹

However, the term "imitation" also encompasses the common meaning of the term where a trademark is designed to simulate or copy something else, in this case, an earlier GI. In contrast, "evocation" is more objective in nature. It does not require the owner of the trademark to have intended to evoke the earlier GI.¹⁰⁰

In other words when we refer to "imitation" in the context of trademarks, we are typically describing a situation where a trademark is intentionally designed to simulate or copy another well-known mark, usually to benefit from the reputation, goodwill, or recognition associated with that mark. In such cases, the owner of the imitation mark intentionally creates a similarity with the earlier mark, aiming to exploit the existing market presence and consumer association of the original mark for their own gain.

On the other hand, "evocation" refers to a scenario where a trademark, although not necessary intentionally designed to imitate or copy another mark, unintentionally evokes or brings to mind an earlier well-known mark due to certain similarities in appearance, sound, or concept. In these cases, the owner of the evoking mark may not have intended to exploit the reputation or

⁹⁸ Ibid.

⁹⁹ European Union Intellectual Property Office, "EUIPO trademark Guidelines", Part B, Section 4, Chapter 10, Subsection 4.2.2, accessed 20 April 2023 <https://guidelines.euipo.europa.eu/1922895/1790180/trade-mark-guidelines/4-2-misuse--imitation-or-evocation-of-a-gi>.

¹⁰⁰ Ibid.

goodwill of the earlier mark, but consumers may still perceive a connection or association between the two.

Imitation of GIs refers to the practice of copying or mimicking the characteristics and qualities of a geographical indication that is typically genuine and of higher quality. This might entail replicating the GI's manufacturing processes, ingredients, or other distinguishing features in an attempt to mimic its popularity.

The key difference lies in the intention behind the creation of the mark. In the case of imitation, the trademark owner deliberately seeks to mimic another mark, aiming to benefit from its established reputation. In contrast, in the case of evocation, the trademark owner may have developed a mark independently, but due to its similarities to the earlier mark, it unintentionally triggers associations or recollections in the minds of consumers.

From a legal perspective, the intention behind the use of a mark can play a crucial role in determining the legal implications and potential liability. Imitation can often lead to claims of trademark infringement, as it involves a deliberate attempt to deceive consumers or unfairly capitalize on the goodwill associated with another mark. Evocation, on the other hand, may be subject to different legal standards depending on the jurisdiction and the specific circumstances involved. Courts may consider factors such as the strength of the earlier mark, the degree of similarity, and the likelihood of confusion among consumers (and other factors which will be explained further) when assessing potential infringement claims.

However, it's important to note that the imitation is not the same as the genuine product, and it may not have the same quality, taste, or other unique features that make the original GI desirable. Additionally, imitation of GIs can have negative impacts on the producers of the genuine product, as it may lead to confusion among consumers and a decrease in demand for the original product.

Imitation of GIs is a major worry for the producers of these items since it can cause consumer confusion and harm the reputation of the real product. In many countries, using a protected GI without authorization is prohibited, and people who imitate or misuse GIs might face legal consequences.

For example, if a product is called "Champagne" but does not originate in the Champagne area of France, it is an imitation of the protected GI for Champagne. This would be deemed a breach of intellectual property rights, and legal action might be taken against the person or company who created the replica goods.

To summarize, Article 13.1(b) of EU GI regulation 1151/2012 protects registered names of geographical indications from misuse, imitation, or evocation, even if the true origin of the product is indicated or the protected name is translated or accompanied by similar expressions. This article is important in protecting the reputation and quality of geographical designations and preventing consumer deceit. Misuse of GIs can hurt not just customers and producers, but also the areas linked with the products. As a result, precise criteria for registration and protection, strong enforcement mechanisms, and consumers education are required to avoid misuse and encourage fair trade practices that benefit everybody.

The notion of imitation is complicated and diverse, and depending on the circumstances, it can have both good and negative consequences. Imitation is frequently connected with infringement of intellectual property rights and there are legal systems in place to defend these rights. Imitation of GIs, in particular, is an essential concern for producers since it may cause customer misunderstanding and harm the reputation of the actual product. While imitation may be used to mimic the success of a product or concept, it is vital to understand that the imitation is not the same as the genuine thing and may lack the attributes or features that make the original appealing. Finally, a balance must be struck between fostering innovation and originality and protecting the rights of individuals who have developed unique works or goods.

2.2 Protection against evocation of Geographical Indications

2.2.1 General overview of the concept of evocation

Before explaining the concept of evocation, it is important to mention that traditionally GIs have been associated with protecting against unfair competition. Historically, GIs were primarily concerned with protecting against intentional acts of misrepresentation and deceptive practices. The Paris Convention for the Protection of Industrial Property and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) played significant roles in establishing the initial framework for GI protection. But these agreements focused on preventing unfair competition by prohibiting the use of misleading indications of origin.

However, as the understanding and importance of GIs grew in the EU, the legal concept of evocation was created. The concept of evocation recognizes that protection should extend beyond intentional acts of misrepresentation. It acknowledges that even unintentional evocation or evocation through different means can lead to confusion among consumers and harm the interests of producers associated with a particular geographical area.

The introduction of the concept of evocation aims to ensure that the protection of GIs is not limited solely to intentional acts but also encompasses situations where a product evokes, directly or indirectly, a protected GI. This broader concept acknowledges that unfair competition can arise not only through deliberate imitation or misuse but also through evoking associations with a protected GI that may mislead consumers or create confusion in the market.

It should be noted that evocation is a unique and distinctive form of protection within the EU's sui generis system for protecting geographical indications. This concept was first introduced at the EU level via Article 13.1.b) of the former Council Regulation (EEC) No 2081/92, which concentrated on the protection of geographical indications and designations of origin for agricultural and food products.¹⁰¹

This article remains unchanged in subsequent regulations and as written before provides the protection against any misuse, imitation, or evocation. And all four laws governing GI protection for foodstuffs, wines, aromatized wines and spirits have the same rules.¹⁰²

The unique aspect of the evocation concept lies in its objective nature. It focuses on the perception and association created in the minds of consumers, rather than the intent of the producer. This objective approach is intended to provide more comprehensive protection for GIs and prevent unintended violations that could still result in unfair competition.

Frankly speaking concept of evocation is used to prevent the use of certain terms on products that may evoke the name of a protected GI, even if the product is not produced in that region. Evocation occurs when a term used to describe a product not originating in a specific region brings to mind the name of a GI that is protected in that region. This can mislead consumers into believing that the product has the same characteristics or somehow connected to the protected GI, which can cause harm to the reputation of the GI and the region it represents. Therefore, the EU prohibits the use of any term or symbol that may evoke a protected GI, even if it is not used in a literal sense or used in combination with other terms.

To illustrate the concept further, let's consider the previous example of imitation involving the term "Champagne." In the case of evocation, it's not only the direct use of the term "Champagne" on another sparkling wine that can evoke the protected GI, but also the use of similar terms or even completely different names that bear resemblance. This applies even if these

¹⁰¹ Vicente Zafrilla Díaz-Marta and Anastasiia Kyrylenko, 'The ever-growing scope of Geographical Indications' evocation: from Gorgonzola to Morbier', in *Journal of Intellectual Property Law & Practice*, 2021, Vol. 16, No. 4-5, 443.

¹⁰² Ibid.

products are unrelated to Champagne or produced outside the Champagne region. Consumers may still perceive a connection or association between these products and Champagne due to the similarities, triggering the evocation of the protected GI.

The concept of evocation is seen as an important tool in protecting GIs and their reputation. This approach ensures that consumers are not misled and that the economic value of GIs is protected. The EU's system of GI protection is regarded as one of the most effective in the world, and the concept of evocation is a key element of this success.

Despite the fact that the word "evocation" is used in the legislation of the EU concerning geographical indications, it has not been defined in terms of the circumstances that can be considered a breach of the regulations. In the area of wines, spirits, and other high-quality food goods, the term "evocation" is often used in combination with instances of passing off in order to provide the fullest possible protection for registered GIs to ensure that consumers are not misled about the origin of the product. This is done with the intention of guaranteeing the largest possible scope for the exclusive rights that are provided by the registration of geographical indications.¹⁰³ However, it is essential to balance the objective nature and large scope of protection of the evocation concept with the need for legal certainty. Clarity in defining what constitutes evocation is crucial to ensure that market players understand the boundaries of permissible use.

And in my opinion in order to achieve legal certainty, it is important to establish precise definitions and criteria for what constitutes evocation. This involves determining the factors that contribute to evoking a protected GI and differentiating them from legitimate use. These factors may include visual elements, packaging, marketing techniques, or any other elements that create associations with a specific geographical origin. But to do that the comprehensive analysis of what constitutes an evocation in accordance with CJEU should be done,

2.2.2 Assessment of the scope, history of the protection and controversial issues in accordance with CJEU

The Court of Justice has determined that it is necessary to narrow down the legal issue at hand, given the wide range of situations that could be associated with the notion of "evocation" in its decisions, in order to avoid any overlap with other rules related to the protection of geographical

¹⁰³ Vito Rubino, "From "Cambozola" to "Toscoro" The Difficult Distinction between "Evocation" of a Protected Geographical Indication, "Product Affinity" and Misleading Commercial Practices", in *European Food and Feed Law Review*(2017), 12, 327 – 328.

names and misleading practices.¹⁰⁴ That is why it is necessary to conduct an analysis through the case law and to determine all the features and peculiarities of the protection against evocation which will help to propose possible definition for such a difficult concept.

*Case C-87/97 ‘Cambozola vs Gorgonzola’.*¹⁰⁵

The Cambozola case, which was heard by the CJEU on March 4, 1999, is significant as it was the first decision where the concept of evocation was discussed. The case involved an Austrian court, the Handelsgericht Wien, seeking clarification from the CJEU on whether preventing a producer from using the mark "Cambozola" for a cheese amounted to a measure with an equivalent effect to a quantitative restriction on the free movement of goods, particularly in light of the fact that the packaging indicated the true origin of the product.¹⁰⁶

The CJEU's decision in the Cambozola case provided valuable guidance on how to assess whether the use of a name constitutes evocation of a protected designation of origin or geographical indication.

*The court in its decision held that “Article 13(1)(b) of Regulation No 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs provides that registered names are protected against all evocation, even if the true origin of the product is indicated.”*¹⁰⁷

*“The concept of evocation covers a situation where the term used to designate a product incorporates part of a 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. It is possible for a protected designation to be evoked where there is no likelihood of confusion between the products concerned and even where no Community protection extends to the parts of that designation which are echoed in the term or terms at issue.”*¹⁰⁸

Even if the genuine origin of the product is indicated on the packaging, it is evident that evocation can still occur. A crucial consideration is whether the term used to denote a product

¹⁰⁴ Ibid.

¹⁰⁵ “*Consorzio per la tutela del formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH & Co. KG and Eduard Bracharz GmbH*,” Case C-87/97, [1999] ECR I-01301, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A61997CJ0087>.

¹⁰⁶ Enrico Bonadio and Patrick Goold, “The Cambridge Handbook of Investment-Driven Intellectual Property,” (CUP 2023), quoted in Andrea Zappalaglio: *EU Geographical Indications and the protection of producers and their investments*, 312.

¹⁰⁷ “*Consorzio per la tutela del formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH & Co. KG and Eduard Bracharz GmbH*,” Case C-87/97, [1999] ECR I-01301, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A61997CJ0087>.

¹⁰⁸ Ibid.

incorporates a portion of the protected designation in such a way that it evokes an image of the protected product in the consumer's mind.

Court stated that it appears reasonable to assume that if a soft blue cheese looks similar to Gorgonzola and has a name that ends in the same two syllables and contains the same number of syllables, then it will likely bring to mind the protected name. This is because the two names are phonetically and visually similar. Therefore, even if the product's packaging indicates its true origin, using a name like "Cambozola" could be considered as evoking the protected designation of origin "Gorgonzola" under Article 13(1)(b) of Regulation No 2081/92.¹⁰⁹

It is also important to mention that the CJEU stated that the determination of evocation does not rely on the likelihood of confusion that the disputed sign might create.¹¹⁰ This indicates that the defendant's position, which claimed that no evocation could be established even if the sign only produced a little link between the two items in line with EU trademark requirements, was rejected.¹¹¹

To refer to a more recent case, the Opposition Division of the European Union Intellectual Property Office provided a similar decision regarding a trademark application for "Hemp-Secco." The application, requested by an Austrian applicant, was contested by the Consorzio Prosecco based on the Protected Designation of Origin. The challenged mark, which was submitted for Classes 32 and 33, consists of a black label on an orange background with the word "Hemp-Secco" prominently displayed.¹¹²

Due to the closeness and proximity of the goods, as well as the discovered similarities between "Hemp-Secco" and "Prosecco," the EUIPO Opposition Division found that using the challenged mark would bring the Prosecco PDO to the consumer's mind. As a result, the challenged sign was deemed an evocation of the Prosecco PDO as defined by the applicable EU statute. The Consorzio's opposition was upheld by the Opposition Division.¹¹³

¹⁰⁹ Ibid.

¹¹⁰ Vicente Zafrilla Díaz-Marta and Anastasiia Kyrylenko, 'The ever-growing scope of Geographical Indications' evocation: from Gorgonzola to Morbier', in *Journal of Intellectual Property Law & Practice*, 2021, Vol. 16, No. 4-5, 444.

¹¹¹ Enrico Bonadio and Patrick Goold, "The Cambridge Handbook of Investment-Driven Intellectual Property," (*CUP 2023*), quoted in Andrea Zappalaglio: *EU Geographical Indications and the protection of producers and their investments*, 313.

¹¹² "An EUIPO decision further consolidates the concept of evocation in the context of GIs," Organization for an International Geographical Indications Network, accessed 25 April 2023, <https://www.origin-gi.com/16-07-2021-an-euipo-decision-further-consolidates-the-concept-of-evocation-in-the-context-of-gis/>.

¹¹³ Ibid.

Overall, the CJEU's decision in the Cambozola case reinforces the importance of protecting geographical indications and designations of origin for agricultural products and foodstuffs, and it highlights the need for careful consideration of the use of names that may evoke protected designations. It also underscores the complexity of balancing the protection of intellectual property rights with the free movement of goods in the context of the European Union.

*Case C-132/05, 'Parmesan case':*¹¹⁴

The next case which extended the protection is a Parmesan case which was held by the CJEU on February 26, 2008.

The Commission demanded that the German authorities stop selling items that were marketed as 'Parmesan' in Germany since these products did not match the specifications of the famous Italian cheese known as "Parmigiano Reggiano PDO." However, Germany argued that the term "Parmigiano" was just a translation of the word "Parmesan" and it was a generic name.

However court said that: *"The use of the name 'Parmesan' must be regarded as an evocation of the protected designation of origin 'Parmigiano Reggiano' in the sense of Article 13(1)(b) of Regulation No 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, which protects registered names against any misuse, imitation or evocation, even if the true origin of the product is indicated or if the protected name is translated."*¹¹⁵

*"There is phonetic and visual similarity between the names 'Parmesan' and 'Parmigiano Reggiano', and that in a situation where the products at issue are hard cheeses, grated or intended to be grated, namely, where they have a similar appearance."*¹¹⁶

So, we can see that in its decision the CJEU used the same principles as in the Cambozola pointing out on protection despite the expression of the true origin and visual similarity between the names in question.

However, the new element was added *'the conceptual proximity'* between the terms 'Parmesan' and 'Parmigiano Reggiano,' originating from different languages, should also be considered regardless of whether or not 'Parmesan' is an exact translation of the protected designation of origin 'Parmigiano Reggiano' or the term 'Parmigiano.' The proximity of the two terms and their visual and phonetic similarities are sufficient to evoke in the consumer's mind the

¹¹⁴ "Commission of the European Communities v Federal Republic of Germany," Case C-132/05, [2008] ECR I-00957, <https://eur-lex.europa.eu/legal-content/GA/TXT/?uri=CELEX:62005CJ0132>.

¹¹⁵ Ibid.

¹¹⁶ Ibid.

cheese that is protected by the 'Parmigiano Reggiano' protected designation of origin when they encounter a hard cheese, grated, or intended to be grated, labeled as 'Parmesan'.¹¹⁷

As a result, the CJEU defined recall at this early stage as the capability of a name to evoke a link with a GI product in the minds of consumers. In addition, despite the fact that it was clearly obvious that the standard of likelihood of confusion did not apply in this particular context, the Court seems to have still found it to be suggested. For instance, with parmesan, it was discovered that, despite the fact that confusion did not play a part in the situation at hand, there were yet similarities in the items that contributed to the adoption of the decision.¹¹⁸

Joined cases C-4/10 and C-27/10, Cognac cases:

This joined cases was held in 2011 where the French association of Cognac producers (Bureau national interprofessionnel du Cognac) brought a case against the registration of certain Finnish trademarks in the Cognac case. These marks included 'Konjakit [Cognacs]' and 'liqueurs containing "konjakki"'. The challenge was made before the Finnish Supreme Administrative Court.¹¹⁹

In that cases court pointed out on Parmesan and Cambozola cases referring to the definition given there.¹²⁰ However, some important innovations were adopted as well:

CJEU stated that Article 16 of Regulation No 110/2008 contains several provisions, listed as points (a) to (d), that cover different scenarios where the promotion or sale of a product involves a direct or indirect indication of a geographical origin. In such situations, there is a risk of confusing the public about the actual origin of the product or creating an association in the minds of consumers that misrepresents the origin. Additionally, this could allow the seller to exploit the reputation of the geographical indication in an unfair manner.¹²¹

Thus, in this ruling, the CJEU explained the reasoning behind the idea of evocation by using the idea of "taking unfair advantage of the reputation of the GI" as a guide. This approach is similar to the protection provided by the EU to well-known brands.¹²²

¹¹⁷ Ibid.

¹¹⁸ Enrico Bonadio and Patrick Goold, "The Cambridge Handbook of Investment-Driven Intellectual Property," (CUP 2023), quoted in Andrea Zappalaglio: *EU Geographical Indications and the protection of producers and their investments*, 313.

¹¹⁹ "Bureau National Interprofessionnel du Cognac v Gust. Ranin Oy," Joined Cases C-4/10 & C-27/10, [2011], <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A62010CJ0004>.

¹²⁰ Ibid., para. 56.

¹²¹ Ibid., para. 46.

¹²² Enrico Bonadio and Patrick Goold, "The Cambridge Handbook of Investment-Driven Intellectual Property," (CUP 2023), quoted in Andrea Zappalaglio: *EU Geographical Indications and the protection of producers and their investments*, 314.

Case C-75/15 Verlados case:

On January 26, 2016, the CJEU decided the Verlados case, where a Finnish company producing and selling apple spirits called "Verlados" was prohibited from doing so because of the French geographical indication "Calvados" for apple spirits. The company took legal action and the Finnish Market Court referred questions related to evocation to the CJEU for clarification.¹²³

The Finnish Market Court addressed two questions to the CJEU in the Verlados case. They first addressed if the perspective of a typical customer who is reasonably knowledgeable, observant, and careful should be included while judging evocation. Second, the court was asked to examine if certain facts about the status of the Verlados product should be considered.¹²⁴

The CJEU clarified that the relevant perspective to consider in assessing evocation is that of the European average consumer, rather than just the Finnish consumer.¹²⁵ This means that if the European average consumer is likely to associate two names, such as "Verlados" and "Calvados," then evocation has occurred, even if the association is not made by consumers in a particular member state. The second criterion to analyze is the phonetic and visual similarity of the names, as well as if there is proof that these similarities are not incidental.¹²⁶ This is applicable because initially the name of the Finish spirit was Verla (the same as the name of village of origin), but after the growth of export to Finland of the "Calvados" the name was changed and bearing in mind that there is no particular meaning of suffix "dos" in Finnish language the court considered that it was renamed in order to consumers have it in mind.¹²⁷

Following the rules outlined in the Cognac decision, the CJEU concluded the likelihood of confusion cannot be utilized as a test in evocation situations. Instead, the emphasis should be on avoiding consumers from associating the protected GI with the product in issue. The court stressed the need of preventing sellers from unfairly exploiting the reputation of a protected GI.¹²⁸

What is worth mentioning is that this case provided a new dimension to the term of "consumer" that must be considered while evaluating evocation. While the CJEU had previously

¹²³ "Viiniverla Oy v Sosiaali- ja terveysalan lupa- ja valvontavirasto," Case C-75/15, [2016], <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=eli%3AECLI%3AEU%3AC%3A2016%3A35>.

¹²⁴ Ibid., para. 16.

¹²⁵ Ibid., para. 48.

¹²⁶ Ibid.

¹²⁷ Ibid., para. 40.

¹²⁸ Ibid., para. 45.

established that evocation requires that the image evoked in the consumer's mind be that of the protected product, there was no classification of "consumer" provided.¹²⁹

In the present case, the CJEU highlighted that the evaluation must take into account the perspective of the average consumer who is relatively well-informed, attentive, and cautious, which includes European consumers as well as consumers in the member state where the evocative product is made.¹³⁰

It can be concluded that during this phase of the development of the concept of evocation, the CJEU established that it is intended to prevent producers from gaining an unfair advantage from the reputation of a GI and set up the clarification of the understanding of who is the consumer. The court also began to clarify the test for evocation, which includes factors such as the ability of the name to recall the GI, aural and visual similarities, proximity of the product, and alleged bad faith of the producer. This approach was influenced by the rules for the protection of well-known brands in the EU and the likelihood of confusion test in EU Trade Marks Law.¹³¹

Case C-44/17 The Scotch Whisky case:

The next step of evolving of the evocation conception is the Scotch Whisky case.¹³² The CJEU issued its decision in this case on June 7, 2018. The Scotch whiskey Association (SWA) was interested in the dispute, which sought to preserve the trade of Scottish whiskey (a protected PGI). The SWA filed a complaint in Germany to ban the distribution of a German whiskey under the name "Glen Buchenbach" on the grounds that it violated the "Scotch Whisky" PGI.¹³³

The SWA said that the word "Glen" was commonly utilized in Scotland in place of "valley" and frequently featured as a trademark element in the titles of Scottish whiskies. Thus, even if the label clearly stated that the product was of German origin, the SWA claimed that the use of the name "Glen Buchenbach" created an association with Scotland and Scotch Whisky.¹³⁴

¹²⁹ *"Consorzio per la tutela del formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH & Co. KG and Eduard Bracharz GmbH,"* Case C-87/97, [1999] ECR I-01301, para. 25, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A61997CJ0087>.

¹³⁰ *"Viiniverla Oy v Sosiaali- ja terveystieteiden tutkimuskeskus,"* Case C-75/15, [2016], para 28, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=ecli%3AECLI%3AEU%3AC%3A2016%3A35>.

¹³¹ Enrico Bonadio and Patrick Goold, "The Cambridge Handbook of Investment-Driven Intellectual Property," (CUP 2023), quoted in Andrea Zappalaglio: *EU Geographical Indications and the protection of producers and their investments*, 315.

¹³² *"Scotch Whisky Association v Michael Klotz,"* Case C-44/17, [2018], <https://eur-lex.europa.eu/legal-content/en/TXT/?uri=CELEX:62017CJ0044>.

¹³³ *Ibid.*, paras. 8-11.

¹³⁴ *Ibid.*, para. 12.

The court stated in that case that the referring court must determine whether a reasonably well-informed, observant, and circumspect European consumer associates a comparable product with the protected geographical indication, "Scotch Whisky," when confronted with the disputed designation "Glen." The referring court should examine conceptual proximity between the protected GI and the contested designation in the absence of any phonetic or visual similarity or partial inclusion of the indication in the designation in making this conclusion.¹³⁵

However, the referring court's proposed criterion for establishing "evocation" under Article 16(b) of Regulation No 110/2008, which requires the disputed element of the sign to evoke some association with the protected geographical indication or geographical area, is insufficient because it does not establish a clear and direct link between the element and the indication, is insufficient. The Advocate General who was assigned to this matter expressed confusion over whether or not the contested designation could be called an "evocation" due to the absence of significant parallels that exist between it and the protected GI as well.¹³⁶

The court goes on to say that when a reasonably well-informed and observant European consumer is confronted with a disputed designation, the court must decide whether the image directly triggered in the customer's mind is that of the protected geographical indication. If there is no phonetic or visual similarity between the disputed designation and the protected GI, and no partial incorporation of the indication into the designation, the court must consider any conceptual proximity between the disputed designation and the indication in reaching its decision.¹³⁷

Finally, on January 20th, 2022, the Scotch Whisky Association achieved a victory in the initial stage of a case that followed the judgment by the Court of Justice of the European Union regarding the "Glen Buchenbach" matter. The CJEU judgement recognized that there might be an evocation when a GI and a disputed name have a conceptual connection.¹³⁸

The Hamburg District Court determined that the term 'Glen' is firmly linked with Scotland and Scotch Whisky, and that the sole reason for using the term 'Glen' in the context of a German whisky is because of its unmistakable connection with Scotch Whisky.¹³⁹

¹³⁵ Ibid, para 52.

¹³⁶ *"Scotch Whisky Association v Michael Klotz,"* Case C-44/17, Conclusions of Advocate General Saugmandsgaard Øe, [2018], para 68.

¹³⁷ Ibid., para 56.

¹³⁸ Organization for an International Geographical Indications Network, "Recent interesting decisions for groups concerning evocation," accessed 25 April 2023, <https://www.origin-gi.com/recent-interesting-decisions-for-groups/>.

¹³⁹ Ibid.

The case *Scotch Whisky Association v. Michael Klotz* is a highly important case for the notion of evocation because it clarifies that evocation can occur even in the lack of phonetic and visual connection between the contested designation and the protected geographical indication.

It is stated that an evocation might occur as a result of conceptual proximity between a GI and the challenged name. And it is up to national courts to decide on this. This case demonstrates that evocation can occur even when the name has no phonetic or visual similarity to the GI. Furthermore, expressly disclosing the true origin of the product does not preclude the possibility of evoking a GI.¹⁴⁰

This is a very considerable enhancement for the concept of evocation. This ruling strengthens the protection given to GIs across the European Union and serves as a guideline for upcoming cases regarding evocation.

Case C-614/17 Queso Manchego case:

The Queso Manchego case was held by the CJEU on May 2, 2019 it is a significant proceeding as it stretched the concept of evocation even more.

The Queso Manchego Foundation is a body that has the responsibility of protecting and managing the PDO ‘queso manchego’. In order to carry out its duties, the Foundation initiated legal proceedings against the defendants before the Spanish court of first instance with the aim of obtaining a ruling that the labels and words used by IQC to market its cheeses, which were not covered by the PDO ‘queso manchego’, violated the protection of the PDO. The Queso Manchego Foundation argued that the use of the words ‘Quesos Rocinante’ and the figurative signs on the labels ‘Adarga de Oro’, ‘Super Rocinante’ and ‘Rocinante’ constituted an unlawful evocation of the PDO ‘queso manchego’ under Article 13(1)(b) of Regulation No 510/2006.¹⁴¹

The first court ruled that IQC's use of names and signs for their cheeses not covered by the PDO 'queso manchego' were not similar enough to infringe on the PDO. The Queso Manchego Foundation appealed this decision, but the appeal court agreed with the first court, stating that the

¹⁴⁰ Organization for an International Geographical Indications Network, “The Court of Justice of the European Union (CJEU) published a judgment in Case C-44/17, *Scotch Whisky Association v Michael Klotz*,” accessed 25 April 2023, https://www.origin-gi.com/web_articles/14-06-2018-the-court-of-justice-of-the-european-union-cjeu-publishes-a-judgment-in-case-c-44-17-scotch-whisky-association-v-michael-klotz/

¹⁴¹ “Fundación Consejo Regulador de la Denominación de Origen Protegida Queso Manchego v Industrial Quesera Cuquerella SL and Juan Ramón Cuquerella Montagud,” Case C-614/17, [2019], para. 7, <https://eur-lex.europa.eu/legal-content/GA/TXT/?uri=CELEX:62017CJ0614>.

use of La Mancha imagery on the labels of these cheeses would make consumers think of the region, but not necessarily the PDO 'queso manchego'.¹⁴²

The case was appealed to the Spanish Supreme Court by the applicant in the main proceedings. The Supreme Court provided some factual considerations in its order for reference, stating that "manchego" in the PDO refers to the people and products from La Mancha, and that the PDO covers sheep's milk cheese made in the region according to traditional requirements. The court also noted the connection of the fictional character Don Quixote to the region and the use of his name and imagery by IQC in their cheese marketing. Given the situation, the Tribunal Supremo (Supreme Court) opted to pause the proceedings and refer some inquiries to the Court of Justice for a preliminary ruling. And the CJEU had to decide whether figurative elements can be considered as the evocation of a GI.¹⁴³

The Court ruled that it should be considered not only the wording of an EU law provision, but also its context and objectives when interpreting it. Article 13(1)(b) of Regulation No 510/2006 protects registered names from any kind of evocation, even if the true origin is indicated. This includes figurative signs that can evoke protected products. The EU legislature intended to protect registered names from such evocation using a word element or a figurative sign, as seen in the use of the word "any."¹⁴⁴

According to the Advocate General's observation in point 24 of his Opinion, the key factor in determining whether an element evokes a registered name under Article 13(1)(b) of Regulation No 510/2006 is its ability to immediately bring to mind in the consumer's perception the image of the good whose name is protected. Therefore, interpretation of the Article 13(1)(b) of Regulation No 510/2006 allows for the evocation of a registered name using figurative signs.¹⁴⁵

This decision also illustrates that the protection of a registered geographical indication includes not only the geographical components of the term as a whole, but also the individual non-geographical aspects of the term. The CJEU ruled in this case that the entire PDO "queso manchego" is protected, despite being made of non-geographical phrases. In particular, "queso" simply means "cheese" and refers to the food kind, whereas "manchego" refers

¹⁴² Ibid., paras. 8-10.

¹⁴³ Ibid., 11-14.

¹⁴⁴ Ibid., 16-17.

¹⁴⁵ Ibid., 24.

to the "Manchega breed" from which the milk used to manufacture the cheese protected by the geographical indication "queso manchego" is sourced.¹⁴⁶

The CJEU's decision in favor of the GI beneficiaries has been criticized for its reasoning, which is based on the use of local imagery. The approach used by the court overlooks the fact that many traditional products are linked to specific local imagery, which contributes to the creation of a unique GI as an origin label. Additionally, the use of the 'Don Quixote' image on a cheese made in 'La Mancha' only suggests a connection to the region, not specifically to 'Queso Manchego PDO', making the association weak.¹⁴⁷

Moreover, it is worth noting that particular symbols and personalities are frequently part of a region's cultural history and should be available to anyone. They existed before the introduction of the GI product and will continue to exist even if the product is no longer manufactured.¹⁴⁸

Others consider that the CJEU was correct in ruling that figurative elements might be used to evoke a protected geographical indication. Excluding this possibility would have damaged GIs which have a strong connection to certain figurative elements. The CJEU gave national courts advice by highlighting the necessity of a "clear and direct link," but did not fully clarify the interplay between this link and the similarity test, which is a disadvantage.¹⁴⁹

It would have been more appropriate to explain that evocation would need an obvious, direct, immediate, and/or univocal relationship if the similarity between the contested signs is not particularly significant. This approach is consistent with existing case law and explains why, in cases such as Gorgonzola and Parmigiano, the CJEU did not explicitly address the link because there was a strong visual and phonetic similarity. A stronger similarity should demand less proof of a connection, whereas a weaker similarity requires a more stringent link threshold.¹⁵⁰

¹⁴⁶ Fausto Capelli and Barbara Klaus, "Protection of Geographic Indications and Designations of Origin in the Queso Manchego Case," in *European Food and Feed Law Review*, Vol. 14, No. 5 (2019), 457, <https://www.jstor.org/stable/26900841>.

¹⁴⁷ Enrico Bonadio and Patrick Goold, "The Cambridge Handbook of Investment-Driven Intellectual Property," (*CUP 2023*), quoted in Andrea Zappalaglio: *EU Geographical Indications and the protection of producers and their investments*, 317.

¹⁴⁸ Ibid.

¹⁴⁹ Vicente Zafrilla Díaz-Marta and Anastasiia Kyrylenko, 'The ever-growing scope of Geographical Indications' evocation: from Gorgonzola to Morbier', in *Journal of Intellectual Property Law & Practice*, 2021, Vol. 16, No. 4-5, p. 445.

¹⁵⁰ Ibid.

The Spanish Supreme Court's interpretation of a previous ruling led to a cheese producer being prohibited from using images and names on product labels that were associated with the PDO 'queso manchego'.¹⁵¹

The Queso Manchego case is significant as it further extended the concept of evocation, allowing figurative elements to be used to evoke a GI. While some criticize the decision for overlooking the connection between traditional products and local imagery, others argue that it is necessary to protect GIs with strong connections to certain figurative elements. However, the CJEU could have clarified the interplay between the link and similarity test, requiring a stricter link limit for weaker similarities and a less demanding one for stronger similarities. From a legal standpoint, a notable effect of this judgement appears to be the clear confirmation that the major priority in interpreting European rules on geographical indication protection is consumer protection.¹⁵² Overall, the decision highlights the importance of protecting GIs and their associated cultural history while also considering the use of symbols and imagery in a broader context.

C-490/19 The Morbier case:

The *Morbier* case was held by the CJEU on December 17, 2020.

The case involves allegations that the manufacturer of "Montboissié" cheese violated the "Morbier" cheese PDO. The accuser claimed that the two cheeses had a striking visual similarity, which constituted a violation of the PDO. The matter eventually reached the French Cour de Cassation, which referred the case to the CJEU by posing preliminary question.¹⁵³

This case was not directly related to the concept of evocation because the Court did not apply Article 13(1)(b) of Regulation 1151/2012, but rather the more general and broader Article 13(1)(d), which states that "Registered names shall be protected against any other practice liable to mislead the consumer as to the true origin of the product." Nonetheless, the case is heavily influenced by previous decisions such as Queso Manchego, Scotch Whisky, and Verlados, and thus can be viewed as a variation on the theme of evocation.¹⁵⁴

Court stated that Article 13(1) of Regulation No 510/2006 and Regulation No 1151/2012 have a broader scope than just prohibiting the use of a registered name itself. They also prohibit

¹⁵¹ Ibid.

¹⁵² Vito Rubino, "The "indirect" or "conceptual" evocation of a Protected Designation of Origin and its practical and juridical effect after EU CJ case Queso Manchego", *Revista de Derecho Comunitario Europeo*, (2019).

¹⁵³ "Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois," Case C-490/19, SAS [2019], <https://curia.europa.eu/juris/liste.jsf?num=C-490/19>.

¹⁵⁴ Enrico Bonadio and Patrick Goold, "The Cambridge Handbook of Investment-Driven Intellectual Property," (CUP 2023), quoted in Andrea Zappalaglio: *EU Geographical Indications and the protection of producers and their investments*, 317.

any other practice liable to mislead the consumer as to the true origin of the product. Therefore, they do not only prohibit the use of a registered name by a third party.¹⁵⁵

Secondly the Court ruled that these articles prohibit the reproduction of the shape or appearance of a product covered by a registered name if it may lead the consumer to believe that the product is covered by that registered name. The assessment of whether such reproduction may mislead the European consumer depends on relevant factors in the case.¹⁵⁶

The CJEU did not decide on "evocation" per se, instead focusing on Article 13(d) of Regulation 1151/2012, however the Advocate General mentioned it in the conclusion.

The Advocate General states that for an association to be considered 'evocation' under Article 13(1) of Regulations No 510/2006 and No 1151/2012, three conditions must be met.¹⁵⁷

First, the element that has been reproduced must be a distinct characteristic of the manufactured goods covered by the registered name.¹⁵⁸

Second, the element must not be intrinsically linked to a production process that must remain freely available for use by any producer.¹⁵⁹

Third, the presence of evocation must be determined on a case-by-case basis, taking into account all relevant elements, including potentially evocative elements, and whether there is an intention to unfairly benefit from the protected name.¹⁶⁰

The interpretation of Article 13(1)(b) of above-mentioned Regulations does not imply that the shape, appearance, or packaging of a common product cannot be considered as contextual factors in determining the existence of an evocation or the intention to unfairly exploit a protected name. However, Article 13(1)(b) applies only in exceptional circumstances, such as conduct in the main proceedings, and such conduct may fall under Article 13(1)(d) in appropriate cases.¹⁶¹

The current CJEU judgement may raise additional concerns regarding the exact features of a product that might be protected by a geographical designation. It is uncertain, for example, how

¹⁵⁵ *"Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois,"* Case C-490/19, SAS [2019], paras. 30-31, <https://curia.europa.eu/juris/liste.jsf?num=C-490/19>.

¹⁵⁶ *Ibid.*, para. 41.

¹⁵⁷ *"Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois,"* Case C-490/19, SAS [2019], Opinion of Advocate General M. Giovanni Pitruzzella, para. 42, <https://curia.europa.eu/juris/document/document.jsf?text=&docid=209684&pageIndex=0&doclang=EN&mode=req&dir=&occ=first&part=1&cid=6065988>.

¹⁵⁸ *Ibid.*, para. 43.

¹⁵⁹ *Ibid.*, para. 44.

¹⁶⁰ *Ibid.*, para. 45.

¹⁶¹ *Ibid.*, paras. 46-47.

many forms, colors, or distinguishing qualities a product can have. Furthermore, it is unclear whether a common manufacturing technique, such as a dark/blue line on a cheese, which was made, as observed by the Court of Appeal of Paris, from a famous and not unique production technique, can gain distinctiveness as a protected element. The CJEU judgement does not address these problems, which might possibly widen the idea of evocation to encompass aspects such as product appearance, fragrance, and taste. While this expansion may benefit GI beneficiaries and their attorneys, it is important to consider the implications of such decisions, overprotection of GIs and protection of almost every good.¹⁶²

The Court's equation of the object of protection of a GI and the elements that make up the origin link is a second questionable aspect of this decision. The Court utilized the definition of PDO to argue that the quality scheme's protection extends beyond names and, to some extent, encompasses goods. This view, however, goes beyond the language of Regulation 1151/2012, which states that GIs are names and that names are protected. The Court's conflation of the name and the product confounds the object of protection with the elements that comprise the origin link for PDO, namely the quality or characteristics that are essentially or exclusively due to a specific geographical environment with its inherent natural and human factors. While these elements form the basis for granting PDO, they don't always mean that a product feature must be protected, especially if it is the result of widely known production practices.¹⁶³

The Morbier case is significant in that it broadens the scope of registered name protection beyond the prohibition on third-party use. The ruling underlines that replicating the shape or look of a product protected by a registered name may also be forbidden if it misleads the customer regarding the genuine origin of the goods. While the case does not center on "evocation," it does build on previous evocation decisions, and the Advocate General outlines the conditions that must be met for an association to be considered evocative. However, the case raises questions about the scope of geographical designation protection, particularly in terms of product appearance, smell, and taste. Finally, the decision may have implications for GI overprotection and the protection of nearly every good.

Case C-783/19 The Champanillo case:

The Champanillo case was held by the CJEU on September 9, 2021.

¹⁶² Enrico Bonadio and Patrick Goold, "The Cambridge Handbook of Investment-Driven Intellectual Property," (CUP 2023), quoted in Andrea Zappalaglio: *EU Geographical Indications and the protection of producers and their investments*, 318.

¹⁶³ *Ibid.*

The Champagne producers' association filed a lawsuit against the proprietor of tapas bars named 'Champanillo', which is a play on the Spanish spelling of Champagne wine, spelled 'Champán'. Additionally, these bars used an image of two wine glasses filled with a red liquid to promote their establishment.¹⁶⁴ The association claimed that the use of the term "Champanillo" violated the PDO for "Champagne," and thus filed a lawsuit in a Spanish court to halt its usage. The Spanish court sought the assistance of the CJEU in interpreting EU regulations governing the protection of products covered by a PDO when the name "Champanillo" is used in commercial activities. The question was whether this constituted an evocation under Article 103(2)(b) of Regulation 1308/2013, which corresponds to Article 13(b) of Regulation 1151/2012. As expected, the CJEU answered in the affirmative.¹⁶⁵

The CJEU ruled that PDO names, as outlined in EU Regulation 1308/2013, ensure quality based on geographical origin, with the aim of helping agricultural operators secure higher incomes and prevent misuse by third parties. The court concluded that failing to provide protection to a PDO when the contested sign pertains to a service, as per the interpretation of Article 103(2)(b) of the same regulation, would contradict the extensive coverage granted to protected names. Such an interpretation would also undermine the objective of full protection, as the reputation of a product covered by a PDO is likely to be exploited even in cases involving services.¹⁶⁶

Furthermore, the Court upheld the concept of evocation established in case law. It affirmed that evocation does not require that the product or service covered by the disputed name and the product covered by the PDO be identical or similar. Instead, evocation is established when a name generates, in the mind of an average European consumer who is reasonably informed and observant, a clear and direct association between that name and the PDO. The existence of such a link can result from a variety of factors, including the partial use of the protected designation, phonetic and visual similarities between the names, conceptual similarities between the PDO and the name at issue, or similarities between the products or services covered by the name and the PDO. In this context, it is up to the Audiencia Provincial de Barcelona to consider all relevant aspects related to the use of the name in question.¹⁶⁷

¹⁶⁴ "Comité Interprofessionnel du Vin de Champagne v GB," Case C-783/19, [2021], paras. 15-18, <https://curia.europa.eu/juris/liste.jsf?language=en&td=ALL&num=C-783/19>.

¹⁶⁵ Ibid., paras. 21-24.

¹⁶⁶ Organization for an International Geographical Indications Network, "Clarification of the evocation concept with respect to contested signs used on goods and services which are not comparable to the ones of the protected name," accessed 25 April 2023, <https://www.origin-gi.com/14-09-2021-clarification-of-the-evocation-concept-with-respect-to-contested-signs-used-on-goods-and-services-which-are-not-comparable-to-the-ones-of-the-protected-name/>.

¹⁶⁷ Ibid.

And the Court of Appeal of Barcelona, on March 21, 2022, applied the CJEU's reasoning and upheld the appeal by the Comité Champagne. The court found that the sign "CHAMPANILLO" was similar to the PDO Champagne and was likely to evoke the Champagne appellation in the average Spanish consumer, thereby exploiting its reputation.¹⁶⁸

So, the protection against evocation has been extended and now the name of a service can also evoke a GI, even if that service is not similar to the protected name of the good.

It worth mentioning that the CJEU made an interesting point in its decision: even if there's no unfair competition happening, the use of an evocative term is still not allowed under the EU law. This means that the use of the word "Champanillo" by tapas bars, even if not intentionally misleading, can still be prohibited. However, the question remains whether the use of the word "Champanillo" is truly evocative of "Champagne PDO" in the minds of consumers, or if it simply refers to a place where drinks can be consumed. The CJEU's answer is not surprising, but it raises the question of how far evocation protection can go in the future¹⁶⁹

So, the evocation of GIs is an important issue for protecting their reputation and economic value. The concept of evocation is used to prevent the use of certain terms that may evoke the name of a protected GI, even if the product is not produced in that region. The EU has a sui generis system for protecting GIs and its regulations prohibit the use of any term or symbol that may evoke a protected GI, even if it is not used in a literal sense or used in combination with other terms. The concept of evocation is seen as an important tool in protecting GIs and their reputation, and it is a key element of the success of the EU's system of GI protection.

This analysis is extremely useful in order to create a definition of evocation as it highlights the development of the concept through legal cases and shows interpretation which will be used while proposing definition.

From the above we can see that the concept of evocation has experienced significant development over the course of more than two decades and it can be broadened in the future because the court did not rule the final decision on evocation and so elements described above still unclear. The CJEU has developed the concept to prevent practices that could improperly evoke the image of a GI product in the mind of the average European consumer. This is necessary to prevent

¹⁶⁸ Organization for an International Geographical Indications Network, "The Barcelona Court of Appeal confirms the depth of GIs protection following the consolidation of the evocation concept by the CJEU," accessed 25 April 2023, <https://www.origin-gi.com/11-04-2022-the-barcelona-court-of-appeal-confirms-the-depth-of-gis-protection-following-the-consolidation-of-the-evocation-concept-by-the-cjeu/>.

¹⁶⁹ Enrico Bonadio and Patrick Goold, "The Cambridge Handbook of Investment-Driven Intellectual Property," (CUP 2023), quoted in Andrea Zappalaglio: *EU Geographical Indications and the protection of producers and their investments*, 320.

behaviors that exploit and unfairly benefit from the reputation of a protected product. Because of the lack of definition of evocation in the EU legislation the CJEU in its various decisions tried to clarify that concept by adding different elements of protection and extending it to particular situations.

The concept of evocation has been established through a series of legal cases, beginning with *Cambozola*, having its extension in *Parmesan*, *Cognac* and *Verlados* cases and culminating in *Scotch Whisky*, to provide strong protection for Geographical Indications. This approach is similar to the EU's well known trademark protection system, which applies regardless of potential confusion, does not consider the similarity of products, and prevents activities that could damage or diminish the reputation of the trademark. However, test for evocation does not demand to evaluate whether protected under GI rules good owns a reputation. Because it is presumed so as the GI is already protected and if it is protected it has the reputation.

Further in the *Queso Manchego* case the scope of protection was extended, and figurative elements were added to the list of what could potentially evoke the GI and adopted the conceptual similarity to test whether the GI was evoked. However, this approach found it's criticism because technically adoption of that concept contradicts to the previous decision on evocation where the link should have been clear and direct. And I agree with the opinion of Vicente Zafrilla Díaz-Marta and Anastasiia Kyrylenko¹⁷⁰ that CJEU should have mentioned in its decision the relationship between the connection and the similarity test by adoption the requirement for link limits becomes more stringent as the similarity weakens, whereas it is less strict for stronger similarities. In my opinion it would have vanished all the criticism.

The next step of evolution is the *Morbier* case which broadened the scope of protection of GIs for the shape of products if it misleads the consumer about the true origin of the product. This case does not focus on evocation itself, but previous evocation cases were taken into account when considering this one and the Advocate General gave his opinion including the cases when the evocation could be in such a situation namely: reproduced element to be a distinct character of the protected product, the production process to remain available for use by any manufacturer and determination on a case-by-case basis.

¹⁷⁰ Vicente Zafrilla Díaz-Marta and Anastasiia Kyrylenko, 'The ever-growing scope of Geographical Indications' evocation: from *Gorgonzola* to *Morbier*', in *Journal of Intellectual Property Law & Practice*, 2021, Vol. 16, No. 4-5, 445.

However, the case raises questions about the scope of geographical designation protection, particularly in terms of product appearance, smell, and taste which in theory can be protected in future as well which will lead to great overprotection and violation of other laws.

And the last step of evolution given by CJEU can be observed in the Champanillo case in which was stated that the name of a service can also evokes a GI, even if that service is not similar to the protected name of the good. And another very important point was mentioned by CJEU regarding the prohibition of the use of a term that can be potentially evocative in cases where there no unfair competition which again led to debate. And who knows how many cases regarding the evocation is still pending and how the concept can be developed in future.

3. THE ISSUE OF LACK OF DEFINITIONS OF THE MISUSE, IMITATION, AND EVOCATION

3.1 The importance of defining misuse, imitation, and evocation.

As can be seen from the previous chapters there is no legal definition for misuse, imitation and evocation of GIs in the EU law and moreover for the misuse and imitation there are very little explanations of what is it at all, the only legal explanation is given by the EUIPO, and it does not answer the question *per se*.

Regarding the concept of evocation there plenty of the decisions of the CJEU which explain, develop, and extend the protection against evocation of the GIs. However, there was no united definition of this concept given by the court, moreover the development of the evocation raised some disagreements throughout the scholars and even some contradiction with the previous decisions of the court which in my opinion can lead to further disputes and misunderstandings. In my opinion this concept as well as misuse and imitation should get their definitions and clear scope of what is protected under these definitions.

Defining the concepts of misuse, imitation, and evocation of GIs is crucial for proper protection of the unique identities and reputations of geographical indications. Unscrupulous parties can utilize misuse, imitation, and evocation to deceive consumers and profit from the reputation and goodwill connected with a protected GI. As a result, clear and thorough definitions of these terms are required to properly protect GI producers' rights and prevent unlawful use of their intellectual property and remove the problem of uncertainty.

The significance of defining GI misuse, imitation, and evocation extends beyond legal and commercial gains. It also contributes to the preservation of the cultural and social heritage of the geographical areas linked with GIs. GIs are frequently strongly established in local traditions, and the items they represent reflect the communities' unique environment, history, and wisdom.¹⁷¹ As a result, unlawful and unfair use of GIs harms not just the economic interests of producers and consumers, but also the cultural and social identities of the related regions.

It often happens because the lack of clear definitions regarding the terms of misuse, imitation, and evocation within the realm of GI protection has given rise to a significant issue of legal uncertainty. Market players, including producers and businesses, face challenges in understanding what actions or uses might be considered violations of GIs. This lack of clarity

¹⁷¹ Martin Nacevski, "The relationship between protected geographical indications and protected designations of origin and the European Union trade mark in relation to wines and spirits," (University "Ss. Cyril and Methodius" Skopje, 2017), 17.

hampers their ability to navigate the boundaries of GI protection, potentially leading to inadvertent violations and subsequent legal repercussions.

The current situation, where the European Court of Justice has provided a broad interpretation of evocation, contributes to the prevailing uncertainty. The wide explanation offered by the CJEU leaves room for differing interpretations, leaving market players unsure about the exact parameters of what is considered permissible and what constitutes infringement.

By establishing specific definitions for terms such as misuse, imitation, and evocation within the context of GI protection, legal certainty can be enhanced. Clear and precise definitions would provide a solid foundation for market players to understand the actions that are prohibited and those that are permitted under GI regulations. This would enable them to make informed decisions and take necessary precautions to ensure compliance, ultimately reducing the risk of unintentional violations.

Moreover, the establishment of clear definitions would foster fair competition within the market. When buyers buy a product that has a GI, they anticipate that the product will meet certain criteria about its characteristics, reputation, and place of origin. Consumers' faith and confidence may be put in danger if GIs were improperly used, imitated, or evoked in the market, which could lead to confusion, deceit, and unfair competition. Allowing market players to have a better understanding of the boundaries of GI protection would create an environment that encourages innovation and healthy competition. Businesses would have the confidence to develop new products and services without the fear of unknowingly infringing upon GIs because they would know what is protected and how not to infringe it, while consumers would be able to make informed choices based on accurate information about the origin and qualities of products.

To summarize, the lack of clear definitions poses a significant challenge in ensuring legal certainty for market players. Establishing precise definitions for terms related to misuse, imitation, and evocation would provide the much-needed guidance and clarity, enabling fair competition, encouraging innovation, and preventing unintentional violations within the context of GI protection. Therefore, it is necessary to provide definitions of these concepts that are both clear and comprehensive in order to effectively protect the interests of GI producers, consumers, and the associated regions.

3.2 Possible options for definitions

As already mentioned and explained in the previous subchapter defining the concepts of misuse, imitation and evocation is a crucial point and in this the last part of my work I will try to provide possible definitions for them and to explain why I chose this particular wording.

The first will be the definition of misuse and imitation. As it was pointed out previously there are very few explanations on the misuse and imitation and there were no judgements of the ECJ on the concept of misuse or imitation insofar, therefore I will try to define them in accordance with the EUIPO trademark guidelines¹⁷² and by the general meaning of these concepts which is adopted worldwide.

According to the EUIPO misuse of the GIs occurs when the EU trademark is going to be registered for the products that could be linked with the GI which can possibly lead to uncertainty about the genuine source of the goods and a reduction of the GI's value.¹⁷³

In other words, misuse happens when trademark wrongly states the geographical location of the products and gaining some profits from the reputation of the GI which in general corresponds to the general notion of misuse as improper use of something.

So, we can see that when we are talking about the protection of GIs against misuse, we can assume that the protection should be granted to the specific geographical origin of the product, its quality and the protection shall ensure consumers certainty about such products.

Based on that I propose such a definition of the misuse of GIs:

“Misuse: Any use of a GI or any other sign that does not correspond to the product's origin, reputation, or quality as defined by the GI's registration and regulations. It includes any use that may mislead consumers about the product's origin or characteristics.”

In my opinion this is a comprehensive definition that can effectively protect GI as in provides protecting the origin, reputation, and quality of GIs by ensuring that any use of a GI must comply with the origin, reputation, and quality standards defined by the GI's registration and regulations. Also, it prevents the misleading of consumers which is important because consumers often rely on the origin and quality of products when buying something which is named as GI. And moreover, this definition is quite flexible and adaptable to many situations and products. It

¹⁷² European Union Intellectual Property Office, “EUIPO trademark Guidelines”, Part B, Section 4, Chapter 10, Subsections 4.2.1 – 4.2.2, accessed 20 April 2023, <https://guidelines.euipo.europa.eu/1922895/1790180/trade-mark-guidelines/4-2-misuse--imitation-or-evocation-of-a-gi>.

¹⁷³ Ibid.

may be modified to meet the unique needs and difficulties of various locations and markets and does not restrict the protection of GIs to certain goods or sectors.

In addition, further components may be added to this definition to clarify and enhance the protection of GIs. This includes:

1. Any use of a GI or any other sign that could lead to misunderstanding or association with a good that does not originate from the area where the GI is associated.
2. Any use of a GI or any other sign that could lead to unfair competition or undermine the legal rights and interests of the GI's owners or users.
3. Any use of a GI of any other sign that is likely to mislead consumers as to the nature, properties, or suitability of a product.

By including these additional criteria, the definition of misuse becomes more comprehensive and precise in identifying and preventing any misuses of GIs and ensuring awareness of what is protected.

The next possible notion will concern the concept of imitation. As it was already mentioned according to Mariam Webster's dictionary, imitation is the resemblance of something that is typically genuine and of higher quality to something else that is not real.¹⁷⁴

The term "imitation" means a lack of authenticity, giving the impression that the thing being imitated is the real thing, but in fact it is a copy or simulation of what came before it.

The European Union Intellectual Property Office defines "imitation" as the act of replicating specific characteristics of a product that has a geographical indication, which results in the product being suggestive of the original and so constitutes an infringement of intellectual property rights the term "imitation" is used in its more general sense, referring to the process by which a trademark is created in such a way that it resembles a previous GI.¹⁷⁵

Based on that I propose such a definition of the imitation of GIs:

“Imitation: Any intentional use of a name, term, symbol, design, or any other characteristic that is similar or likely to create confusion with a registered GI, regardless of whether the product is identical or similar.”

¹⁷⁴ “Merriam-webster dictionary,” accessed 3 May 2023, <https://www.merriam-webster.com/dictionary/imitation>.

¹⁷⁵ European Union Intellectual Property Office, “EUIPO trademark Guidelines”, Part B, Section 4, Chapter 10, Subsection 4.2.2, accessed 20 April 2023, <https://guidelines.euipo.europa.eu/1922895/1790180/trade-mark-guidelines/4-2-misuse--imitation-or-evocation-of-a-gi>.

In my opinion it is a clear and effective definition that can help to provide additional protection for GIs as it protects the distinctiveness and identity of GIs which are often closely tied to the cultural, social, and environmental traditions of the associated regions. Also, it prevents confusion among consumers and market players which helps to cope with the problem of uncertainty and promotes fair competition as it protects intentional use of a name, term, symbol, design, or any other characteristic which guards the legitimate rights and interests of the holders of the GI and ensures that the use of GIs is based on value and quality rather than confusion or deception.

If we are talking about the concept of evocation from the one hand it can be considered that it is easy to define it and that there is no need to do it as there are a lot of cases of CJEU which explain this concept and add new peculiarities to it. However, from the other hand just because of this it becomes complicated. The dispersion of the notion over a large number of cases can cause uncertainty and complicate an adoption of the decisions and moreover some cases seem to contradict each other which in my opinion needs a further explanation by the court.

To define this concept the previous analysis of the cases as well as the opinions of the scholars on subject will be used and based on that the definition will be provided.

According to the *Gorgonzola* case the concept refers to a situation in which the name of a product contains a portion of a protected designation. This causes the consumer to link the product with that protected designation when the customer comes across the product's name even though there is no likelihood of confusion between the products in place and even if just a part of it is protected by the Community.¹⁷⁶

In the *Parmesan* case, a new aspect was introduced: "conceptual proximity" between terms. This indicates that if two phrases are both visually and phonetically similar, as well as conceptually close, they might evoke a certain picture or notion in the consumer's mind.¹⁷⁷

The CJEU expressed the logic for the concept of evocation in the *Cognac* joint cases by adopting the concept of "taking unfair advantage of the GI's reputation" as a reference.

¹⁷⁶ Case C-87/97, *"Consorzio per la tutela del formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH & Co. KG and Eduard Bracharz GmbH,"* [1999] ECR I-01301, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A61997CJ0087>.

¹⁷⁷ Case C-132/05, *"Commission of the European Communities v Federal Republic of Germany,"* [2008] ECR I-00957, <https://eur-lex.europa.eu/legal-content/GA/TXT/?uri=CELEX:62005CJ0132>.

The Verlados case highlighted the importance of stopping sellers from taking advantage of the reputation of a protected geographical indication. It also introduced a new aspect to the concept of "consumer" that must be taken into account when assessing evocation.

The CJEU emphasized that the examination must take into consideration the ordinary consumer's viewpoint, who is reasonably well-informed, attentive, and cautious, which includes European customers as well as consumers in the member state where the evocative product is manufactured.¹⁷⁸

The case *Scotch Whisky Association v. Michael Klotz* demonstrates that evocation may occur even when there is no phonetic or visual link between the disputed appellation and the protected GI.

The *Queso Manchego* case permitted figurative elements to be used to evoke a GI. The CJEU gave national courts direction by highlighting the need of a "clear and direct link," but did not clearly explain how this link should be examined in regard to the similarity test. This is a disadvantage since a more acceptable method would have been to emphasize that evocation demands a clear, immediate, direct, or undisputed link when the similarity between the signs being compared is weak. This approach is consistent with existing case law and explains why the CJEU did not directly address the relationship in cases like *Gorgonzola* and *Parmigiano*, where there was a significant visual and phonetic similarity. When similarities are high, less evidence of a connection is required, nevertheless, when the similarity is poor, a stricter link criterion should be used.¹⁷⁹

The *Morbier* case is significant because it expands the range of registered name protection beyond just preventing third-party use. The decision emphasizes that copying the form or look of a registered name-protected product may also be forbidden if it misleads customers about the genuine origin of the items.

The last time evocation was expanded in *Champanillo*, the name of a service may now also evoke a GI, even though the service is not related to the protected name of the item.

¹⁷⁸ Case C-75/15, *"Viiniverla Oy v Sosiaali- ja terveystieteiden tutkimuskeskus"* [2016], para.28, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=ecli:C:2016:3A35>.

¹⁷⁹ Vicente Zafrilla Díaz-Marta and Anastasiia Kyrylenko, 'The ever-growing scope of Geographical Indications' evocation: from *Gorgonzola* to *Morbier*', in *Journal of Intellectual Property Law & Practice*, 2021, Vol. 16, No. 4-5, p. 445.

CJEU made an interesting observation in its ruling by stating that even if there is no unfair competition, the use of an evocative term is still not permitted under EU law.¹⁸⁰

Based on that we I can propose a possible definition, I consider that it should be quite simple and the points explaining and bordering it should be added. The definition itself could be the following:

“Evocation refers to the use of a product name or appearance or figurative element that contains a portion of a protected geographical indication including its translation or use of its essential elements which causes consumers to associate the product with the protected designation, even if there is no likelihood of confusion between the products.”

And the following points should be added to explain all the aspects of the concept.

1. The conceptual proximity and unfair advantage of the GI's reputation should be taken into account which means that if two phrases are visually, phonetically, and conceptually similar, they may evoke a certain picture or notion in the consumer's mind, contributing to the likelihood of evocation.

2. When examining whether a product name or appearance evokes a GI, the ordinary consumer's viewpoint must be considered. The consumer is reasonably well-informed, attentive, and cautious, including European customers and consumers in the member state where the evocative product is manufactured.

3. The "clear and direct link" between the evocative product and the protected GI should be emphasized and mentioned that when similarities are high, less evidence of a connection is required but, when the similarity is poor, a stricter link criterion should be used.

4. Copying the shape or look of a registered name-protected product should also be forbidden if it misleads customers about the genuine origin of the items but only in cases where the production method is not well known.

5. The name of a service may evoke a GI, even if the service is not related to the protected name and the use of an evocative term is not permitted under EU law, even if there is no unfair competition.

In my opinion this is a severe definition as it covers various aspects of evocation, uses clear and concise language that is easy to understand, is grounded on the case law of the CJEU, helps to

¹⁸⁰ Enrico Bonadio and Patrick Goold, “The Cambridge Handbook of Investment-Driven Intellectual Property,” (CUP 2023), quoted in Andrea Zappalaglio: *EU Geographical Indications and the protection of producers and their investments*, 320.

provide clarity on the scope of protection of the GIs which in my opinion the greatest advantage because for now the understanding of this concept very difficult due to its dispersal. Also, this definition is adaptable to changing circumstances and developments in the legal landscape.

In conclusion, the definitions of misuse, imitation, and evocation of GIs are important because they provide clear and comprehensive guidelines for the protection of GIs against unauthorized use and infringement of intellectual property rights. These definitions can serve to avoid customer confusion, provide with market players certainty, protect the origin, reputation, and quality of GI-associated items, and encourage fair competition.

A clear definition of misuse may prevent misuse of a GI or other sign that doesn't match the product's origin, reputation, or quality as stated by the GI's registration and rules. This protects GIs and prevents customers from being deceived.

Similarly, defining of imitation can protect the legal rights and interests of GI owners or users and guarantee that GIs are used for value and quality, not confusion or deceit. This definition promotes fair competition and protects the distinctiveness and identity of GIs by forbidding the purposeful use of a name, word, symbol, design, or other characteristic that is comparable or likely to cause confusion with a registered GI.

Finally, if evocation is defined it can help to prevent unlawful use of GIs that could damage their reputation and worth. And the main advantage of all the definitions is providing of certainty to market players which helps them to understand what is protected and how to avoid unintentional violation or violation due to ignorance.

CONCLUSIONS

The research conducted in this thesis has successfully achieved its aim and fulfilled the objectives outlined in the introduction. The conclusions drawn from the research, along with the following recommendations, demonstrate the importance of the protection of geographical indications against misuse, imitation and evocation and further development of these concepts in a global society.

GIs play a vital role in economic growth, policy formation, and the protection of individual rights. They not only identify a product's origin but also indicate its quality and reputation. To globally protect GIs, a combination of techniques such as the *sui generis* system, collective or certification marks, and unfair competition legislation can be employed. While each method of protection has its limitations, their combination offers the best option for maximizing the advantages of GIs. The *sui generis* system, particularly unique to the European Union, provides robust protection within the region. Alongside the *sui generis* system, certification marks, collective marks, and unfair competition laws contribute to safeguarding GIs and encouraging fair trading practices.

The EU's quality schemes, including PDOs, PGIs, and TSGs, play a significant role in preserving the traditional characteristics and cultural traditions of agricultural and food products. These schemes ensure that product names are not misused, copied, or associated with counterfeit goods, thereby maintaining their quality and authenticity.

On the other hand, the protection of GIs and their comparison with trademarks is crucial for understanding how to safeguard the intellectual property rights and provide maximum benefits for consumers. While there are differences between GIs and trademarks, there are also similarities that warrant their consideration in tandem. GIs enjoy a higher level of protection due to the unique nature of products and production methods associated with specific geographical areas. Conflicts between GIs and trademarks can arise but are generally resolved in a timely manner.

However, in order to protect consumers, producers, and the regions associated with GIs, measures against misuse and imitation are necessary. Clear registration standards, strong enforcement procedures, and consumer awareness are essential for promoting fair trade practices and minimizing harm caused by misuse. Differentiating between genuine products and imitations is crucial for maintaining consumer trust and the reputation of original goods. And in order to achieve it the problem of legal uncertainty should be resolved.

The concept of evocation, as applied in the EU's *sui generis* system, aims to prohibit the use of phrases or symbols that may evoke a protected GI, even if the product itself is not manufactured in that location. While the notion is still evolving, the European Union's Court of Justice has broadened its application. And in my opinion further development and clarification of the concept is necessary to enhance GI protection in the EU. However, achieving a balance between the objective nature and broad scope of protection for the concept of evocation while ensuring legal certainty is of utmost importance. The existing situation, wherein the CJEU has offered an expansive interpretation of evocation contributes to the prevailing uncertainty. The wide-ranging interpretation provided by the ECJ allows for varying understandings, leaving market participants uncertain about the precise boundaries of permissible actions and potential infringements.

In my view, in order to attain legal certainty, it is crucial to establish precise definitions and criteria that clearly outline what constitutes evocation, as well as misuse and imitation. This entails identifying the factors that contribute to evoking a protected GI and distinguishing them from legitimate uses. These factors may encompass visual elements, packaging, marketing techniques, or any other elements that create associations with a specific geographical origin.

Overall, the absence of precise and comprehensive definitions for the misuse, imitation, and evocation of GIs presents a significant challenge in ensuring legal certainty for market participants. And it is vital to establish clear definitions for these terms in order to provide guidance, clarity, and effective protection of geographical indication interests. The proposed definitions in this thesis serve as a valuable framework for implementing precise and comprehensive definitions, thereby protecting the interests of GI producers, consumers, and associated regions.

RECOMMENDATIONS

Based on the provided information and proposed definitions, I recommend that the authorities adopt the definitions of misuse, imitation, and evocation as outlined below:

1. Misuse:

"Misuse: Any use of a Geographical Indication (GI) or any other sign that does not correspond to the product's origin, reputation, or quality as defined by the GI's registration and regulations. It includes any use that may mislead consumers about the product's origin or characteristics."

Additional Components:

To further enhance the understanding the following components can be added to the definition:

1) Any use of a GI or any other sign that could lead to misunderstanding or association with a product that does not originate from the area associated with the GI.

2) Any use of a GI or any other sign that could result in unfair competition or undermine the legal rights and interests of the GI's owners or users.

3) Any use of a GI or any other sign that is likely to mislead consumers about the nature, properties, or suitability of a product.

2. Imitation:

"Imitation: Any intentional use of a name, term, symbol, design, or any other characteristic that is similar or likely to create confusion with a registered GI, regardless of whether the product is identical or similar."

3. Evocation:

"Evocation refers to the use of a product name, appearance, or figurative element that contains a portion of a protected geographical indication, including its translation or use of its essential elements, which causes consumers to associate the product with the protected designation, even if there is no likelihood of confusion between the products."

To further enhance understanding and application, the following points should be added:

1) The conceptual proximity and unfair advantage of the GI's reputation should be considered. Which means that if two phrases are visually, phonetically, and conceptually similar,

they may evoke a certain picture or notion in the consumer's mind, contributing to the likelihood of evocation.

2) When examining whether a product name or appearance evokes a GI, the ordinary consumer's viewpoint must be considered. The consumer is reasonably well-informed, attentive, and cautious, including European customers and consumers in the member state where the evocative product is manufactured.

3) The "clear and direct link" between the evocative product and the protected GI should be emphasized. It should be mentioned that when similarities are high, less evidence of a connection is required. However, when the similarity is poor, a stricter link criterion should be used.

4) Copying the shape or look of a registered name-protected product should also be forbidden if it misleads customers about the genuine origin of the items, but only in cases where the production method is not well known.

5) The name of a service may evoke a GI, even if the service is not related to the protected name and the use of an evocative term is not permitted under EU law, even if there is no unfair competition.

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ABSTRACT

This master thesis investigates the protection of geographical indications (GIs) against misuse, imitation, and evocation in the context of intellectual property law. GIs are collective signs that denote the distinctive attributes of a product associated with a specific region. The thesis explores the importance of GIs in the field and identifies a gap in the research regarding the lack of legal definitions for the concepts of misuse, imitation, and evocation in the European Union (EU) legal system.

The research question aims to determine whether specific definitions of these concepts are necessary and how their inclusion would impact the resolution of disputes related to GIs. The thesis analyzes relevant EU legal acts, court decisions, and scholarly literature to explore the scope of protection against these violations.

The findings highlight the need for defining misuse, imitation, and evocation in legal acts or regulations. Clear definitions would simplify the judicial process, harmonize legislation, resolve the problem of uncertainty and enable courts to make faster and clearer decisions.

The practical significance of the thesis lies in its potential to assist legislators in improving regulations and aid courts and institutions in interpreting and applying protection against misuse, imitation, and evocation of GIs. The findings contribute to the field by providing insights into the scope of protection and proposing possible definitions. Ultimately, the thesis aims to enhance the legal framework surrounding GIs and promote effective regulation and protection in a globalized society.

Key: geographical indications, misuse, imitation, evocation, violations, Court of Justice of the European Union, definitions, importance of defining, effective regulation, trademark, fair use

SUMMARY

This master's thesis explores the topic of protection against misuse, imitation, and evocation of geographical indications (GIs) and addresses the lack of clear definitions in the European Union (EU) legal system. The thesis aims to identify the major problems associated with these issues, analyze the scope of protection for GIs, and propose possible definitions to enhance the regulation of these concepts.

The thesis examines the different ways in which GIs are protected worldwide, including the *sui generis* system, collective or certification marks, and unfair competition laws. A comparative analysis of other legal systems is conducted to identify best practices that can be implemented in the EU legal system. Furthermore, the study reviews the EU regulations and case law related to the protection of GIs, with a particular focus on the concept of evocation as a unique EU concept for the protection of GIs.

The research problem revolves around the absence of legal definitions for misuse, imitation, and evocation in the EU legal system and its impact on the resolution of disputes. The thesis argues for the need to establish clear definitions either in a separate legal act or in existing regulations, which would simplify the judicial process and ensure certainty among market players.

The findings of the research contribute to the scientific novelty of the thesis by addressing the emerging need for defining these concepts in the field of GIs protection.

In the last chapter, the thesis fully achieves the aim and objectives of the research by highlighting the rationale of preventing misuse, imitation, and evocation of GIs, and offers precise definitions that can provide strong protection of GIs and ensure understanding of these terms for all market players.

The research provides valuable insights into the protection of GIs and offers recommendations for enhancing the legal framework surrounding misuse, imitation, and evocation. By addressing the gaps in the EU legal system and proposing clear definitions, this thesis contributes to the development of effective and comprehensive protection for geographical indications.