

Anonymised version

Translation

C-783/19 — 1

Case C-783/19

Request for a preliminary ruling

Date lodged:

22 October 2019

Referring court:

Audiencia Provincial de Barcelona (Spain)

Date of the decision to refer:

4 October 2019

Appellant:

Comité Interprofessionnel du Vin de Champagne

Respondent:

GB

Civil Division No 15 of the Audiencia Provincial de Barcelona (Provincial Court, Barcelona, Spain).

[...] Appeal [...]

Matter: Ordinary proceedings

Originating court: Juzgado de lo Mercantil No 6 de Barcelona (Commercial Court No 6, Barcelona, Spain)

Originating proceedings: Ordinary proceedings [...]

Appellant [...]: COMITÉ INTERPROFESSIONAL DU VIN DE CHAMPAGNE
[...]

Respondent: GB

[...] [In the a]ppeal [...] before this court which was brought by COMITE INTERPROFESSIONAL DU VIN DE CHAMPAGNE against GB, in connection with ordinary proceedings, a [...] **FINAL** decision has been given, which is worded as follows:

ORDER

[...] [details of the court]

Barcelona, 4 October 2019.

Appellant: Comité Interprofessionnel du Vin de Champagne.

Respondent: GB.

Decision under appeal: Judgment.

Date: 13 July 2018.

Applicant: Comité Interprofessionnel du Vin de Champagne.

Defendant: GB.

FACTS

1. This division of the Audiencia Provincial de Barcelona (Provincial Court, Barcelona) [...] is seised of an appeal [...] brought by the Comité Interprofessionnel du Vin de Champagne against the judgment given by the

[OR 2] Juzgado Mercantil 6 de Barcelona (Commercial Court No 6, Barcelona) on 13 July 2018.

2. The proceedings and the appeal concern the determination of the scope of protection of the designation of origin Champagne against the use by GB of the business name and logo ‘*Champanillo*’ to identify, in the course of trade, business premises used for catering activities.

3. [...] [t]his court has a number of questions concerning the scope of the Community regulations on designations of origin, specifically, the protection of origin of wine products; these are questions which can be the subject of a reference for a preliminary ruling to the Court of Justice of the European Union under Article 267 of the Treaty on the Functioning of the European Union.

4. Prior to submission of the reference for a preliminary ruling, the parties were invited to make any submissions they considered appropriate [...].

LAW [...]

FIRST.- Subject matter of the proceedings.

The Comité Interprofessionnel du Vin de Champagne (CIVC) brought intellectual property proceedings against GB under the ordinary procedure. In particular, the CIVC sought the following rulings:

‘A DECLARATION that:

- 1) The use made by the defendant of the CHAMPANILLO logo on the market [...] infringes the designation of [...] origin Champagne.*
- 2) The registration and use of the domain name “champanillo.es” and the use of the CHAMPANILLO logo on the defendant’s accounts with the social networks Facebook and Twitter infringe the designation of origin Champagne.*
- 3) As a consequence of the above ruling, the domain name “champanillo.es” and the online social network accounts on which the CHAMPANILLO logo appears must be cancelled.*

[OR 3] THE DEFENDANT IS ORDERED:

- a) To abide by the above declarations.*
- b) To cease use of the CHAMPANILLO logo.*
- c) To remove from the market any instrument, sign, poster, notice, promotional or commercial document, including on the internet, on which that logo appears.*

An ORDER is made for:

- a) Cancellation of the domain name “champanillo.es” by sending the appropriate official communication to the entity Red.es.*
- b) Removal of the accounts identified by the CHAMPANILLO logo on Facebook and Twitter by sending the appropriate official communication.*

-The costs are to be borne by the defendant.’

- 2.** The defendant contested the proceedings [...] submitting it was using the term ‘Champanillo’ or ‘el Champanillo’ as the business name of a catering industry establishment (a tapas bar), without any likelihood of confusion with the products protected by the designation of origin Champagne and without any exploitation of the reputation of that designation of origin.
- 3.** After the relevant procedural steps, the court gave judgment dismissing the forms of order sought by the applicant. The judgment states that[:]

‘In this case, after conducting a balanced assessment of the conflicting signs, this court finds that any evocation of the name “Champagne” that may arise as a

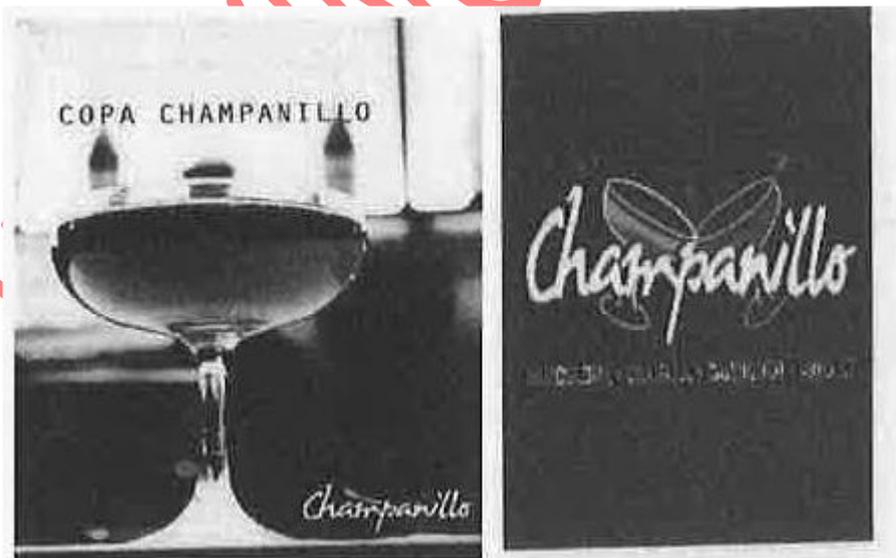
result of the defendant's use of the sign "Champanillo" [...] in the business premises that it operates and on social networks is tenuous and irrelevant [...] for the purposes of infringement of [...] Article 118m(2) of Regulation (EC) No 1234/2007.

Not all types of evocation can be the basis of an infringement and instead the infringement must be linked to the protection afforded to designations of origin. The product to which the sign "Champanillo" is applied, which is not a wine or an alcoholic beverage but rather the name of a [...]tapas [b]ar or a restaurant, where there is no evidence that "champagne" is sold, and the public at whom that product is targeted, differ to such an extent as regards the products protected by the name "Champagne", a renowned trade mark with a very good reputation in the wine and restaurant sectors, that the phonetic similarity of the signs does not lead to evocation.'

The [...] judgment at first instance refers to the case-law of the First Chamber of the Spanish Tribunal Supremo (Supreme Court, Spain), [...] judgment of 1 March 2016 (ECLI:ES:TS:2016:771), which concerned the trade mark Champín, used [OR 4] to market a non-alcoholic fizzy fruit drink consumed at children's parties. The Tribunal Supremo (Supreme Court) found that the trade mark Champín did not infringe the D.O. Champagne because the product to which the term Champín applied and those targeted by that product differed from the products covered by the name Champagne and those at whom it was targeted. Accordingly, the Tribunal Supremo (Supreme Court) held that the phonetic similarity did not lead to evocation.

4. Champagne (the applicant in the main proceedings) appealed against the judgment.
5. This court proceeds on the basis of the following facts:
 - 1) The Comité Interprofessionnel du Vin de Champagne (C.I.V.C.) is an entity recognised under French law which is responsible for safeguarding the interests of Champagne producers and for the legal protection of the designation of origin Champagne worldwide.
 - 2) As provided for in the French Law of 12 April 1941, C.I.V.C. is a semi-governmental organisation with legal personality and legal standing to bring actions [...] before the courts to protect the name Champagne.
 - 3) The designation of origin 'Champagne' is currently protected by French Decree No 2010-1441 of 22 November 2010, which is applicable in Spain pursuant to the terms of the Convention between the French Republic and the Spanish State on the protection of designations of origin, indications of provenance and names of certain products, and the protocol thereto of 27 June 1973.

- 4) The designation of origin 'Champagne' is also protected internationally through registration with the World Intellectual Property Organization (documents 3 to 8 of the application).
- 5) The designation of origin 'Champagne' enjoys global recognition and renown (documents 9 to 16).
- 6) GB uses the logo 'CHAMPANILLO' to identify tapas bars situated in Barcelona, Mollet del Vallés, Calella and Cardedeu (documents 17 to 19).
- 7) The defendant attempted on two successive occasions to register [...] the logo 'Champanillo'[...] as a trade mark at the Oficina Española de Patentes y Marcas (OEPM; Spanish Patent and Trade Mark Office) and on both occasions, following opposition by the applicant, registration was refused, by decisions dated 8 February 2011 and 14 April 2015, on the grounds that the logo was incompatible with the designation of origin 'Champagne'. [OR 5]
- 8) Mr GB also uses the term 'Champanillo' to publicise his restaurant businesses (drinks and tapas) on social networks and traditional advertising media (cards, flyers and posters). That use is also contested.
- 9) The applicant has established by means of documentary evidence that, until 2015, Mr GB sold a sparkling beverage called 'Champanillo' on his premises and that he ceased the sale of that sparkling wine when required to do so by the applicant.
- 10) Furthermore, the promotional material for his businesses uses as a graphic medium photographs of two glasses containing a sparkling beverage.



SECOND.- Legal framework in which the questions have arisen.

6. In general terms, the question at issue in the appeal relates to whether the owner of a catering industry business is entitled to use a name which could evoke a protected designation of origin for a product.
7. The legislation on the protection of designations of origin refers to products, whereas the person who uses the term evoking the designation of origin carries on a service activity.

The legislative framework within which the appeal must be resolved is defined, essentially, by Article 13 of Council Regulation [...] [(EC) No] 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs.

It is also defined by 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. Article 103 of that regulation refers specifically to the protection of designations of origin linked to wine products.

[Article 103](2)(b) [**OR 6**] of that regulation is reproduced in so far as it refers not only to products but also to products involving services:

‘2. A protected designation of origin and a protected geographical indication, as well as the wine using that protected name in conformity with the product specifications, shall be protected against:

b) any misuse, imitation or evocation, even if the true origin of the product or service is indicated or if the protected name is translated, transcribed or transliterated or accompanied by an expression such as “style”, “type”, “method”, “as produced in”, “imitation”, “flavour”, “like” or similar.’

Those provisions should be integrated with Article 1.643-1 of the French Rural Code, applicable in Spain pursuant to the Convention between the French Republic and the Spanish State on the protection of designations of origin, indications of provenance and names of certain products (Protocol of 27 June 1973).

8. On the basis of that legislative framework, and subject always to the possibility of applying other complementary provisions, this court has uncertainties relating to the scope and interpretation of that Community legislation; those uncertainties concern, in general, the following questions regarding the limits of protection of designations of origin as a system equivalent to that applicable to the protection of other intellectual property rights.

1) Does the scope of protection of [...] a designation of origin make it possible to protect that designation of origin not only as against similar products but also as

against any services which may be associated with the direct or indirect distribution of those products?

2) Does the risk of infringement by evocation, to which the articles in question of the Community regulations refer, necessitate in the first instance a nominal analysis [...] to determine the effect that this has on the average consumer, or [...], in order to examine that risk of infringement by evocation[,] is it necessary to establish first of all that the products at issue are the same or similar or are complex products whose components include a product protected by a designation of origin?

3) Must the risk of infringement by evocation be defined using objective criteria when the names are exactly the same or highly similar or must that risk be calibrated by reference to the products and services which evoke and are evoked in order to conclude that the risk of evocation is tenuous or irrelevant?

4) In cases where there is a risk of evocation or exploitation, is the protection provided for in the legislation referred to specific protection related to the special features of the products concerned or must the protection be connected to the provisions on unfair competition?

9. Those questions arise in relation to consideration of the appeal and the determination of [OR 7] the scope and interpretation of the cases of infringement of a designation of origin by exploitation of the reputation of that designation where the hypothetical infringer operates a service.
10. [...] [supplementary questions suggested by the applicant which were not taken into account]

THIRD. Relevance of the reference for a preliminary ruling.

11. Under Article 267 of the Treaty on the Functioning of the European Union and the case-law which interprets it, if a national court takes the view that a Community provision is applicable to a case and there is no interpretation of that provision and the provision could raise doubts as to its compatibility with other national provisions or with national case-law, it has the option of making a reference for a preliminary ruling even if it is not the national court of last instance. National courts have a broad discretion to submit a question to the Court of Justice if they consider that a case before them raises issues which concern the interpretation of provisions of Community law which necessitate a decision by them.
12. In the present case, those questions of interpretation arise in relation to the EU regulations cited [...] Council Regulation (EC) [...] No 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, and [...] 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 [...].

13. Having thus defined the terms of the dispute, this court considers it necessary to make a reference for a preliminary ruling as provided for in Article 267 TFEU so that the Court of Justice of the European Union can answer the following questions.

OPERATIVE PART

[OR 8] On those grounds, this court decides to refer to the Court of Justice the following questions relating to the interpretation of Article 13 of Council Regulation (EC) [...] No 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, and Article 103 of 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.

1) Does the scope of protection of [...] a designation of origin make it possible to protect that designation of origin not only as against similar products but also as against any services which may be associated with the direct or indirect distribution of those products?

2) Does the risk of infringement by evocation, to which the articles in question of the Community regulations refer, necessitate in the first instance a nominal analysis[,] to determine the effect that this has on the average consumer, or, in order to examine that risk of infringement by evocation[,] is it necessary to establish first of all that the products at issue are the same or similar or are complex products whose components include a product protected by a designation of origin?

3) Must the risk of infringement by evocation be defined using objective criteria when the names are exactly the same or highly similar or must that risk be calibrated by reference to the products and services which evoke and are evoked in order to conclude that the risk of evocation is tenuous or irrelevant?

4) In cases where there is a risk of evocation or exploitation, is the protection provided for in the legislation referred to specific protection related to the special features of the products concerned or must the protection be connected to the provisions on unfair competition?

[...] [Procedural considerations] [...] This decision is final and no appeal lies against it.

[OR 9] [...].

Barcelona, 10 October 2019.

[...]