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Press and Information

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Judgment of the Court of First Instance in Case T-291/03

Conorzio per la tutela del formaggio Grana Padano v OHIM

‘GRANA’ IS PROTECTED AT COMMUNITY LEVEL AND IS NOT A GENERIC NAME

The Court of First Instance annuls the decision of the Board of Appeal of OHIM and holds that the name ‘GRANA’ is not generic and that the designation of origin ‘GRANA PADANO’ precludes registration of the mark GRANA BIRAGHI

In 1999, upon application by Biraghi Spa, an Italian cheese producer, the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) registered the word mark GRANA BIRAGHI as a Community trade mark for various kinds of cheese. The same year, the Consorzio per la tutela del formaggio Grana Padano filed an application for and obtained a declaration from OHIM’s Cancellation Division that that mark was invalid, on account of the registration of the earlier national and international marks GRANA and GRANA PADANO and infringement of the designation of origin ‘grana padano’. Subsequently, pursuant to an appeal by Biraghi, the First Board of Appeal of OHIM found that the word ‘grana’ was generic and described an essential quality of the goods and that, therefore, the existence of the protected designation of origin (PDO) ‘grana padano’ did not preclude registration of the Community trade mark GRANA BIRAGHI. The Consorzio per la tutela del formaggio Grana Padano then asked the Court of First Instance of the European Communities to annul that decision.

The Court points out first that **the Regulation on the Community trade mark¹ does not affect the provisions of the Regulation on the protection of geographical indications and designations of origin for agricultural products and foodstuffs²**. According to the latter regulation, an application for registration of a mark which refers to a name registered in respect of products not covered by the registration itself or which misuses, imitates or evokes a protected name must be refused by OHIM. Where the mark has already been registered, OHIM must declare that registration to be invalid.

¹ Council Regulation (EC) No 40/94 of 20 December 1993 (OJ 1993 L 11, p. 1).

² Council Regulation (EEC) No 2081/92 of 14 July 1992 (OJ 1992 L 208, p. 1).

The Board of Appeal of OHIM has to determine whether the word which it is being asked to register actually constitutes a generic name or possibly establish the protection to be granted to the various components of a name. That determination must be carried out on the basis of a **detailed analysis of all the factors which could establish the generic nature**. According to the indications already provided by the case-law of the Court of Justice, the requisite detailed analysis must be carried out by means of **legal, economic, technical, historical, cultural and social evidence**, on the basis of the **relevant national and Community legislation** and its historical development, and must be based on the **perception which the average consumer has** of the name (possibly ascertained through surveys), as well as on data relating to **marketing**, both in the Member State of origin of the goods and in other Member States.

Next, the Court of First Instance finds that the Board of Appeal failed to apply the criteria identified by the Community case-law on PDOs and did not take into consideration any of the factors which make it possible to carry out the analysis of the possibly generic character of a name or of one of its components. Accordingly, it neither called for opinion polls of consumers nor for the opinion of experts qualified in the subject area and moreover it did not request information, although it could have done so under the Regulation on the Community trade mark. By contrast, the extracts from dictionaries and the internet research – on which the Board of Appeal's decision is based – are not capable of establishing the generic nature of a name.

The Court of First Instance adds that changes in the Italian legal context and the administrative practice of systematically seizing cheeses bearing only the indication 'grana' indicate that the name is not generic.

On the basis of all those factors, the Court of First Instance holds that the Board of Appeal of OHIM erred in finding that the name 'grana' was generic and that the existence of the PDO 'grana padano' did not preclude the registration of the mark GRANA BIRAGHI.

The name GRANA BIRAGHI accordingly may not be registered as a trade mark.

REMINDER: An appeal, limited to points of law only, may be brought before the Court of Justice of the European Communities against a decision of the Court of First Instance, within two months of its notification.

Unofficial document for media use, not binding on the Court of First Instance.

Languages available: DA DE EN FR GR IT

The full text of the judgment may be found on the Court's internet site

<http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=EN&Submit=rechercher&numaff=T-291/03>

It can usually be consulted after midday (CET) on the day judgment is delivered.

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