

Case T-291/03

Consorzio per la tutela del formaggio Grana Padano

v

**Office for Harmonization in the Internal Market
(Trade Marks and Designs) (OHIM)**

(Community trade mark — Invalidity proceedings — Community word mark GRANA BIRAGHI — Protection of the designation of origin 'grana padano' — Lack of generic nature — Article 142 of Regulation (EC) No 40/94 — Regulation (EEC) No 2081/92)

Judgment of the Court of First Instance (Fourth Chamber), 12 September 2007 II - 3086

Summary of the Judgment

- 1. Community trade mark — Appeals procedure — Appeals before the Community judicature — Procedural role of the Office
(Rules of Procedure of the Court of First Instance, Art. 133(2))*

2. *Community trade mark — Surrender, revocation and invalidity — Absolute grounds of invalidity — Mark registered in violation of the rules relating to the protection of geographical indications and designations of origin*
(Council Regulations Nos 2081/92, Arts 13 and 14, and 40/94, Art. 142)
3. *Community trade mark — Surrender, revocation and invalidity — Absolute grounds of invalidity — Mark registered in violation of the rules relating to the protection of geographical indications and designations of origin*
(Council Regulations Nos 2081/92, Arts 13 and 14, and 40/94, Art. 142)
4. *Agriculture — Uniform legislation — Protection of geographical indications and designations of origin for agricultural products and foodstuffs — Regulation No 2081/92*
(Council Regulation No 2081/92, Arts 3 and 13(1), second para.)
5. *Community trade mark — Surrender, revocation and invalidity — Absolute grounds of invalidity — Mark registered in violation of the rules relating to the protection of geographical indications and designations of origin*
(Council Regulations Nos 2081/92, Arts 13 and 14, and 40/94, Art. 142)

1. In Community trade mark proceedings brought against a decision of a Board of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs), the Office, although it cannot alter the terms of the dispute, may claim that the form of order sought by whichever one of the parties it may choose should be allowed and may put forward arguments in support of the pleas in law advanced by that party. However, it cannot independently seek an order for annulment or put forward

(see para. 22)
2. It follows from Article 142 of Regulation No 40/94 on the Community trade mark

and Article 14 of Regulation No 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs that the Office for Harmonization in the Internal Market (Trade Marks and Designs) is bound to apply Regulation No 40/94 in such a way as not to affect the protection granted to designations of origin by Regulation No 2081/92.

Consequently, the Office must refuse to register any mark which is covered by one of the situations described in Article 13 of Regulation No 2081/92 and, if the mark has already been registered, must declare that registration to be invalid.

(see paras 53-56)

3. Where a protected designation of origin is made up of several elements, one of which constitutes the generic indication of an agricultural product or foodstuff, the use of that generic name in a registered mark is to be considered as complying with Article 13(1)(a) or (b) of Regulation No 2081/92 on the protection of geographical indications and designations of origin for agricultural

products and foodstuffs and an application for annulment of such a mark based on the protected designation of origin is to be rejected.

In that regard, under the system of Community registration established by Regulation No 2081/92, questions concerning the protection to be accorded to the various constituent parts of a name, in particular the question whether a generic name or a constituent part protected against the practices referred to in Article 13 of that regulation may be concerned, are subject to an assessment carried out on the basis of a detailed analysis of the facts at issue.

In proceedings for annulment of the registration of a Community trade mark brought on the basis of a protected designation of origin, the Office is competent to carry out that type of analysis and, potentially, to refuse to grant protection to the generic part of a protected designation of origin. Since this is not a question of declaring a protected designation of origin to be invalid in itself, the fact that the second subparagraph of Article 13(1) of Regulation No 2081/92 precludes the protection of generic names in a protected

designation of origin authorises the Office to ascertain whether the term in question actually constitutes the generic name of an agricultural product or foodstuff.

of Regulation No 2081/92 gives of the term 'name that has become generic' is also applicable to names which have always been generic.

(see paras 63, 64)

(see paras 58-60)

4. Article 3 of Regulation No 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, after laying down that names that have become generic may not be registered, provides that to establish whether or not a name has become generic, account is to be taken of all factors, in particular the existing situation in the Member State from which the name originates and in areas of consumption, the existing situation in other Member States and the relevant national or Community laws.
5. In proceedings for annulment of the registration of a Community trade mark brought on the basis of a protected designation of origin, the Office for Harmonization in the Internal Market (Trade Marks and Designs) may not conclude that a name contained in that protected designation of origin is generic and that the registration of a mark containing it does not constitute an infringement of the protected designation of origin for the purpose of the first subparagraph of Article 13(1) of Regulation No 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, without having carried out a detailed analysis of all the factors which could establish the generic character of the name.

The same criteria must be applied for the purpose of implementing the second subparagraph of Article 13(1) of Regulation No 2081/92. The definition which the second subparagraph of Article 3(1)

In that regard, the legal, economic, technical, historical, cultural and social evidence which makes it possible to carry out the necessary detailed analysis is, *inter alia*, the relevant national and Community legislation, including its

historical development, the perception which the average consumer has of the allegedly generic name, including the fact that the reputation of the name remains linked to the traditional matured cheese produced in a rural area as a result of the fact that it is not commonly used in other areas of the Member State or of the European Union, the fact that a product has been legally marketed under the name in question in certain Member States, the fact that a product has been legally produced under the name in question in the country where the name originated even though the traditional methods for the production thereof have not been complied with, the fact that such processes have endured over time, the quantity of goods which bear the name in question and are produced using non-traditional methods as against the quantity of goods produced using traditional methods, the market share held by goods bearing the name in question which were produced using non-traditional methods as against the market share held by goods produced using traditional methods, the fact that the goods produced using non-traditional methods are presented in such a way as to refer to the places of production of goods produced using traditional methods, the protection of the name in question under international agreements and the number of Member States which may rely on the allegedly generic nature of the name in question.

Furthermore, the possibility is not excluded of taking account, in an examination of the generic nature of a name, of a survey of consumers organised in order to understand their perception of the name in question or of an opinion of the committee set up by Decision 93/53 setting up a scientific committee for designations of origin, geographical indications and certificates of specific character, which has since been replaced by the scientific group of experts for designations of origin, geographical indications and traditional specialities guaranteed, set up by Decision 2007/71. That committee, made up of highly qualified experts in the fields of law and agriculture, has the task of examining, *inter alia*, the generic nature of names.

Lastly, it is possible to take into consideration other factors, *inter alia*, the definition of a name as generic in the Codex alimentarius and international conventions on the use and protection of the allegedly generic name.

(see paras 65-67, 88, 89)