

Case C-490/19**Summary of the request for a preliminary ruling under Article 98(1) of the Rules of Procedure of the Court of Justice****Date lodged:**

26 June 2019

Referring court:

Cour de cassation (France)

Date of the decision to refer:

19 June 2019

Applicant:

Syndicat interprofessionnel de défense du fromage Morbier

Defendant:

Société Fromagère du Livradois SAS

I. The dispute

- 1 The dispute is between the Syndicat interprofessionnel de défense du fromage Morbier ('the Syndicat'), which was recognised on 18 July 2007 by the Institut national des appellations d'origine (National Institute for Designations of Origin (INAO)) as the organisation responsible for the protection of 'Morbier', and Fromagère du Livradois, a company that produces and markets cheese.
- 2 'Morbier' cheese has enjoyed registered designation of origin (AOC) status since a decree was adopted on 22 December 2000 which defined a geographical reference area and the necessary conditions for entitlement to that designation of origin. That decree provided for a transitional period for undertakings situated outside that geographical area which had produced and marketed cheeses under the name 'Morbier' continuously, in order to enable them to continue to use that name without the indication 'AOC' for a five-year period from the publication of the registration of the designation of origin 'Morbier' as a protected designation of origin (PDO) by the Commission of the European Communities, in accordance with Article 5 of Council Regulation (EEC) No 2081/92 of 14 July 1992 on the

protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ 1992 L 208, p. 1).

3 The decree of 22 December 2000 describes Morbier as ‘a pressed, uncooked cheese made from cow’s milk, ... [which] has a continuous, joined, horizontal, central black mark throughout each slice ...’.

4 Pursuant to Regulation (EC) No 1241/2002, * the name ‘Morbier’ was entered in the register of PDOs. The specification submitted, in accordance with Article 4 of Regulation No 2081/92, in support of the PDO application with a view to its registration was amended slightly by Implementing Regulation (EU) No 1128/2013: **

“‘Morbier’” is a cheese made from raw cow’s milk, ... Throughout each slice the cheese has a continuous, joined, horizontal, central black mark ...’.

5 In accordance with the decree of 22 December 2000, Fromagère du Livradois, which had produced Morbier since 1979, was authorised to use the name ‘Morbier’, without the AOC indication, until 11 July 2007. After that date, it substituted for that name ‘Montboissié du Haut Livradois’.

6 Moreover, on 5 October 2001 Fromagère du Livradois filed an application in the United States for the United States trade mark ‘Morbier du Haut Livradois’, which it renewed in 2008 for a period of ten years, and on 5 November 2004 it filed an application for the French trade mark ‘Montboissier’ for goods in Class 29.

7 Accusing Fromagère du Livradois of infringing the protected designation and committing acts of unfair and parasitic competition by producing and marketing a cheese that reproduces the visual appearance of ‘Morbier’, the product protected by the PDO, in order to create confusion with that product and to benefit from the renown of the image associated with that product, without having to conform to the specification of the designation of origin, on 22 August 2013 the Syndicat brought proceedings against Fromagère du Livradois before the Tribunal de grande instance de Paris (Regional Court, Paris). The Syndicat requested that the defendant be ordered to cease any direct or indirect commercial use of the name of

* Commission Regulation (EC) No 1241/2002 of 10 July 2002 supplementing the Annex to Regulation (EC) No 2400/96 on the entry of certain names in the ‘Register of protected designations of origin and protected geographical indications’ provided for in Council Regulation (EEC) No 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (Gailtaler Speck, Morbier, Queso Palmero or Queso de la Palma, Thrapsano extra virgin olive oil, Turrón de Agramunt or Torró d’Agramunt) (OJ 2002 L 181, p. 4).

** Commission Implementing Regulation (EU) No 1128/2013 of 7 November 2013 approving minor amendments to the specification for a name entered in the register of protected designations of origin and protected geographical indications (Morbier (PDO)) (OJ 2013 L 302, p. 7).

the PDO ‘Morbier’ for products not covered by it, any misuse, imitation or evocation of the PDO ‘Morbier’, any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product by any means liable to convey a false impression as to the origin of the product, any other practice liable to mislead the consumer as to the true origin of the product and, in particular, any use of a black line separating two parts of the cheese, and to compensate it for its loss.

- 8 By judgment of 14 April 2016, that court dismissed all of the Syndicat’s claims. By the judgment under appeal, the cour d’appel de Paris (Court of Appeal, Paris) confirmed the judgment.
- 9 The court of appeal ruled out any misconduct by Fromagère du Livradois in respect of the filing, use, renewal and maintenance of the United States figurative mark ‘Morbier du Haut Livradois’ containing the word ‘Morbier’ and in respect of the use of the name ‘Morbier’ on its cheeses. It also ruled out misconduct by Fromagère du Livradois in respect of the filing of the French trade mark ‘Montboissier’ and its use.
- 10 Moreover, it took the view that the marketing of a cheese which has one or more features contained in the specification for Morbier and therefore resembles it did not constitute misconduct. After stating that the PDO legislation was not intended to protect the appearance of a product or its features as described in its specification, but its name, and therefore it did not prohibit the production of a product using the same techniques as those set out in the rules applicable to the geographical indication, and after noting that, in the absence of an exclusive right, reproducing the appearance of a product did not constitute misconduct but fell within the scope of the freedom of trade and industry, the court of appeal held that the features relied on by the Syndicat, in particular the blue horizontal line, related to a historical tradition, an ancestral technique present in other cheeses, which were implemented by Fromagère du Livradois even before it obtained the PDO and which are not dependent on the investments made by the Syndicat or its members.

The court of appeal held that, although the right to use vegetable carbon is conferred only on cheese with the PDO ‘Morbier’, in order to comply with United States legislation, Fromagère du Livradois had to replace it with grape polyphenol, and therefore the two cheeses cannot be likened as a result of that feature. Noting that Fromagère du Livradois had claimed other differences between the Montboissié and the Morbier cheeses relating, inter alia, to the use of pasteurised milk in the former and raw milk in the latter, the court concluded that the two cheeses were distinct and that the Syndicat was seeking to extend the protection of the designation ‘Morbier’ for commercial interests, which was unlawful and contrary to the principle of free competition.

- 11 The Syndicat has lodged an appeal on a point of law against that judgment.

- 12 It submits, first, that a designation of origin is protected against any practice liable to mislead the consumer as to the true origin of the product and that, in holding, however, that only the use of the name of the protected designation of origin is prohibited, the court of appeal infringed 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 (OJ 2006 L 93, p. 12) and Article 13 of 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 (OJ 2012 L 343, p. 1).
- 13 It submits, next, that by merely stating, first, that the features relied on by the Syndicat related to a historical tradition and were not dependent on the investments made by the Syndicat and its members and, second, that the ‘Montboissié’ cheese marketed since 2007 by Fromagère du Livradois was different from ‘Morbier’ cheese, without investigating, as requested, whether Fromagère du Livradois’ practices (copying the ‘cinder line’ feature of Morbier and other characteristics of the cheese, in particular) were liable to mislead the consumer as to the true origin of the product, the court of appeal’s decision had no legal basis in the light of that legislation.
- 14 The Syndicat also submits that the cour d’appel de Paris (Court of Appeal, Paris) misinterpreted those provisions in so far as it held that the renewal of the trade mark ‘Morbier du Haut Livradois’ in 2008 did not constitute misconduct, and nor did maintaining that trade mark until its cancellation in 2013, since Fromagère du Livradois submitted that, after 2007, it no longer used that trade mark, whereas a designation of origin is protected against any evocation by a competing sign, irrespective of whether or not that competing sign is used.
- 15 Finally, the Syndicat takes the view that the cour d’appel de Paris (Court of Appeal, Paris) infringed those provisions in so far as it merely noted that it had not been demonstrated that the wrongful use of the name ‘Morbier’ after 11 July 2007 was imputable to Fromagère du Livradois, without examining, as requested, whether Fromagère du Livradois had failed to take all necessary measures in order to prevent the name ‘Morbier’ being used by third parties with whom it had had business dealings, as the Syndicat, for its part, has not given any formal instructions to third-party operators, whereas a designation of origin is protected against any wrongful evocation that the defendant could have prevented and the only stipulation on the defendant company’s invoices, that its cheese had to be sold under the designation ‘Montboissié’, was inadequate in that regard.
- 16 Furthermore, a portion of the dispute concerns provisions of French national law regarding registered designations of origin, unfair competition and civil liability.

II. Legal framework

- 17 The European Union introduced protection for protected designations of origin (PDO) and protected geographical indications (PGI) for agricultural products and

foodstuffs in Regulation No 2081/92, which was replaced by Regulation No 510/2006 and then by Regulation No 1151/2012.

- 18 Article 13(1) of all three regulations sets out the types of acts which are prohibited:

‘Registered names shall be protected against:

(a) any direct or indirect commercial use of a registered name in respect of products not covered by the registration in so far as those products are comparable to the products registered under that name or in so far as using the name exploits the reputation of the protected name;

(b) any misuse, imitation or evocation, even if the true origin of the product is indicated or if the protected name is translated or accompanied by an expression such as “style”, “type”, “method”, “as produced in”, “imitation” or similar;

(c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product, on the inner or outer packaging, advertising material or documents relating to the product concerned, and the packing of the product in a container liable to convey a false impression as to its origin;

(d) any other practice liable to mislead the consumer as to the true origin of the product’.

III. Findings of the Cour de cassation (Court of Cassation)

- 19 The Syndicat submits that it is clear from the wording of Article 13(1) of each of those regulations that a PDO is not protected solely against the use of the registered word itself, but also against ‘any other practice’ besides the use or evocation of the protected name, where that practice is liable to mislead the consumer as to the true origin of the product. The courts adjudicating on the substance of the case must examine whether the practices attributable to an economic operator are liable to mislead the consumer; this may be caused by copying the presentation which is characteristic of the product, without the name of the product having to be reproduced in order for infringement to occur.
- 20 It submits that, in the present case, by stating that only the use of the name Morbier could have constituted an infringement of the PDO ‘Morbier’, the court of appeal adopted a position contrary to the wording of Article 13 of the regulations cited above and did not address the question as to whether the presentation of the ‘Montboissié’ cheese was capable of misleading the consumer into believing that he is looking at a ‘Morbier’ cheese.

- 21 It adds that the court of appeal merely found that the features invoked by the Syndicat related to a historical tradition, that they had been used since 1979 by Fromagère du Livradois and were not dependent on the investments made by the Syndicat, whereas those factors have no influence since any practice aiming to mislead the consumer into confusing ‘Montboissié’ cheese with ‘Morbier’ cheese has been prohibited since 2007. Finally, it complains that the court of appeal focused on the differences highlighted by Fromagère du Livradois, which submitted that the public for which its cheese was intended was canteens and hospitals, without specifically examining whether that company’s practices were liable to mislead the consumer as to the true origin of the product.
- 22 For its part, Fromagère du Livradois submits that the PDO protects products from a defined region and only those products are able to use the protected name. It does not prohibit other producers from producing and marketing similar products, where they do not suggest that they are covered by the designation in question and as long as that marketing is not accompanied by any practice capable of giving rise to confusion, in particular by the misuse or the evocation of the protected designation.
- 23 It also submits that a ‘practice that is liable to mislead the consumer as to the true origin of the product’, within the meaning of Article 13(d) of the regulations, must necessarily focus on the ‘origin’ of the product; this must therefore be a practice which causes the consumer to think that he is looking at a product with the PDO in question. It considers that that ‘practice’ cannot result merely from the appearance of the product per se, without any indication on its packaging referring to the protected origin.
- 24 It relies on the observations of the ministre de l’Économie, des Finances et de l’Industrie (Minister for the Economy, Finance and Industry), those of the INAO (Institut national de l’origine et de la qualité (National Institute of Origin and Quality)) and, finally, a decision of the Conseil d’État (Council of State) of 5 November 2003 on the action brought against the decree of 22 December 2000, which agree that only the use of the name ‘Morbier’ is prohibited for cheeses produced outside the protected designation area.
- 25 It submits that, by recalling, in the present case, that nothing prohibited the production of a product using the same techniques as those set out in the rules applicable to the geographical indication, the court of appeal rightly considered that only the use of a sign capable of constituting a misuse of the PDO was prohibited and that, by continuing to produce and market the cheeses it manufactured, Fromagère du Livradois was not guilty of ‘prohibited practices’. The court of appeal added that it is immaterial that those cheeses contain the ‘cinder line’ feature of Morbier or that they have the same ‘characteristics’. By a judgment of 5 November 2003, the Conseil d’État (Council of State), in an action for annulment of the décret du 22 décembre 2000 relatif à l’appellation d’origine contrôlée « Morbier » (decree of 22 December 2000 on the registered designation of origin ‘Morbier’), held that the objective of both the national and Community

rules governing the protection of designations of origin is to promote the quality of products with a registered name, in particular by requiring that the production, processing and preparation of those products is carried out in the defined area; that those rules do not preclude the free movement of other products which do not enjoy that protection.

- 26 The Court of Justice of the European Union does not appear to have given a ruling on the question raised in the present case.
- 27 However, in point 3.4 of its ‘Guidelines for examination of European Union trade marks’, Part B — Examination, Section 4 — Absolute grounds for refusal, Chapter 10 — Geographical indications, Article 7(1)(j) EUTMR, entitled ‘Other misleading indications and practices’, the European Union Intellectual Property Office (‘the Office’) states, with regard to Article 13(1)(c) and (d) of Regulation No 1151/2012, that, although it very much depends on the particularities of each case, each of which must therefore be assessed individually, a European Union trade mark may be considered misleading when, for example, it contains figurative elements that are typically associated with the geographical area in question, such as well-known historical monuments, or when it reproduces a particular shape of a product. The Office states that the above must be interpreted in a restrictive way and that it ‘refers solely to [European Union trade marks] that depict ... a singular shape of the product that is described in the specifications of the PDO/PGI’.
- 28 Furthermore, names consisting of geographical terms are not the only signs entitled to the protection provided for in Regulation No 1151/2012. Certain signs, be they word signs or not, are also protected in so far as they are corollaries to those geographical indications.
- 29 It is therefore accepted that traditional, non-geographical terms, relating to wines and spirits, such as ‘traditional method’, ‘reserve’, ‘clos’, ‘village’ or ‘château’ are reserved for certain designations. The Court has acknowledged the validity of reserving the designation ‘méthode champenoise’ for wine with the designation of origin ‘Champagne’ (judgment of 13 December 1994, *SMW Winzersekt*, C-306/93, EU:C:1994:407).
- 30 It is also accepted that certain shapes that are characteristic of the geographical origin of a product may be reserved for products bearing the protected designation of origin. Thus, Article 56 of Commission Delegated Regulation (EU) 2019/33 supplementing Regulation (EC) No 1308/2013, * and Annex VII to that regulation, to which reference is made in Article 56, reserves ‘flûte d’Alsace’ bottles for wines produced from grapes harvested on French territory bearing the

* Commission Delegated Regulation (EU) 2019/33 of 17 October 2018 supplementing Regulation (EU) No 1308/2013 of the European Parliament and of the Council as regards applications for protection of designations of origin, geographical indications and traditional terms in the wine sector, the objection procedure, restrictions of use, amendments to product specifications, cancellation of protection, and labelling and presentation (OJ 2019 L 9, p. 2).

protected designations of origin ‘Alsace’ or ‘vin d’Alsace’, ‘Alsace Grand Cru’, ‘Crépy’, ‘Château-Grillet’, ‘Côtes de Provence’ red and rosé, ‘Cassis’, ‘Jurançon’, ‘Jurançon sec’, ‘Béarn’, ‘Béarn-Bellocq’ rosé and ‘Tavel’ rosé.

That regulation provides that a specific type of bottle may be reserved for wines with a protected designation of origin provided that that bottle type has ‘been exclusively, genuinely and traditionally used for the last 25 years for a grapevine product bearing a particular protected designation of origin or geographical indication’ and that ‘its use shall evoke for consumers a grapevine product bearing a particular protected designation of origin or geographical indication’. The regulation states that ‘the use of bottles having a particular shape for certain grapevine products bearing a protected designation of origin or geographical indication is a long-established practice within the Union and such use can evoke certain characteristics or the provenance of those grapevine products in the mind of consumers’, which justifies those bottle shapes being reserved for the wines in question.

- 31 With regard to cheese products, a decree regarding the AOC ‘Beaufort’, now repealed, extended the protection of the designation of origin to the characteristic concave heel of the Beaufort cheese.
- 32 In general, decrees acknowledging designations of origin in respect of cheeses contain rules on their characteristic shapes. Thus, the decree of 22 December 2000 on the AOC ‘Morbier’ described the external appearance of that cheese and its internal composition. A slightly amended description of the appearance of that cheese is now contained in the specification for the designation of origin ‘Morbier’ in its consolidated version resulting from Regulation No 1128/2013.
- 33 Therefore, there is doubt as to the interpretation of the expression ‘any other practice’ in Article 13(1) of Regulation No 510/2006 and the same article of Regulation No 1151/2012 as being a particular form of infringement of a protected designation if it is liable to mislead the consumer as to the true origin of the product.
- 34 The question therefore arises as to whether the reproduction of physical characteristics of a product protected by a PDO may constitute a practice that is liable to mislead the consumer as to the true origin of the product, as prohibited by Article 13(1) of the regulations cited above.
- 35 That question is in fact whether the presentation of a product that is protected by a designation of origin, in particular the reproduction of the shape or the appearance which are characteristic of it, is capable of constituting an infringement of that designation, despite the fact that the name has not been reproduced.
- 36 It is therefore appropriate to consult the Court of Justice of the European Union.

IV. The question referred for a preliminary ruling

Must Article 13(1) of Council Regulation No 510/2006 of 20 March 2006 and Article 13(1) of Regulation No 1151/2012 of the European Parliament and of the Council of 21 November 2012 be interpreted as prohibiting solely the use by a third party of the registered name, or must they be interpreted as prohibiting the presentation of a product protected by a designation of origin, in particular the reproduction of the shape or the appearance which are characteristic of it, which is liable to mislead the consumer as to the true origin of the product, even if the registered name is not used?

WORKING DOCUMENT