

From "Cambozola" to "Toscoro"

The Difficult Distinction between "Evocation" of a Protected Geographical Indication, "Product Affinity" and Misleading Commercial Practices

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This article analyses the developments in the EU case-law on the notion of "evocation" of a geographical indication protected by the European Union in order to precisely define the elements of this particular case, distinguish it from the so-called "product affinity" and misleading conduct of juxtaposition and confusion as to the origin and identity of products, as well as analysing the boundary between "evocation" and "indirect comparative advertising" in the context of a market with increasing competition between PDO/PGI products and similar generic products.

I. Introduction

Protecting the geographical indications used to designate traditional food products in the European Union has, for a considerable time, been the subject matter of various regulations that have unified requirements for registration procedures and the protection given to geographical names against counterfeiting and unfair competition in the marketplace with regard to wine,¹ aromatised wine products,² spirits³ and other quality food products.⁴

The protection provided by these rules is particularly broad considering the structure of the provisions concerning the exclusive rights granted to registered geographical names.

Indeed, it is enough to look, by way of example, at Article 13 of EU Regulation 1151/2012 on quality schemes for agri-foodstuff products⁵ to realise that EU lawmakers intended to prevent any form of speculative association of generic products, by listing redundantly the various kinds of conduct that are forbidden and scanning their progressive articulation, extended to a final "closing provision" to any practice that might mislead the consumer as to the true origin of a product.⁶

Starting from the obvious prohibition of the use of geographical names to designate foodstuffs that are not in compliance the registered scheme, the rule actually inhibits any form of misuse, imitation or linking by means of expressions such as "type",

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1 See 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, *OJ*, L 347, 20 December 2013, pp. 671 ff, Article 93 ff. on GIs, and, more generally, on the "rationale" of their protection, see D. Gangjee, *Research Handbook on Intellectual Property and geographical indications*, Cheltenham, Edward Elgar, 2016; M. Blakeney, *The Protection of Geographical Indications: law and practice*, Cheltenham, Edward Elgar, 2014; D. Gangjee, *Relocating the Law of Geographical Indications*, Cambridge, CUP, 2012; M. Gragnani, The law of geographical indications in the EU, *Journal of Intellectual Property Law*, 2012, p. 271 ff.; D. Rangnekar; A. Kamperman Sanders; D. Giovannucci (eds.), The law and economics of geographical indications, *The Journal of World Economic Property*, 2010, pp. 77 ff.

2 See 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 and repealing Council Regulation (EEC) No 1601/91, *OJ*, L 84 of 20 March 2014, pp. 14 ff., Article 7.

3 See Regulation (EC) No 110/2008 of the European Parliament and of the Council of 15 January 2008, on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks and repealing Council Regulation (EEC) No 1576/89, in *OJ*, L 39, 13 February 2008, pp. 16 ff., Article 15 ff.

4 See 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*, L 343, 14 December 2012, pp. 1 ff., Article 13.

5 From here on, for the sake of brevity, the reflection will be developed taking the EU 1151/2012 Regulation as reference. The assessments can in any case be extended to other areas, governed by the provisions cited in the previous notes, as well.

6 See Article 13, par. 1, lett. d) Reg. 1151/2012/EU cit.

"method", "in the manner" or similar. It forbids the use of false or misleading indications as to the origin, nature or essential qualities of the product on packaging, and any other form of "evocation" even to the extent of commercial practices not directly referring to the labelling of the product.

If, on one hand, an extended passing off in this field is not particularly difficult to understand - as it concerns situations well-known in the closely related area of trademarks and can be connected in various ways to the use of the registered geographical names for products without the specific characteristics - the definition of "evocation" is, on the other hand, not so straight forward.

This has been found, especially in situations where it comes to achieving a balance between PDO-PGI products, the interest of the consumer in making informed choices on transparent elements and a need to ensure a right to competition connected to the increasing spread of generic products similar to traditional registered foodstuffs.

As will be explained later, although the Court of Justice has intervened a number of times on the matter, the issue still shows significant risks of error in distinguishing real "evocation" from simple commercial competition (unfair, maybe, according to the definition under Directive 2005/29/CE⁷), as well as the characteristics of any case and the onus of proof de-

riving from the connection to one provision or another.

Therefore, this analysis will show that there is a need for national judges (and control Authorities) to pay utmost attention to the distinctions made in EU case-law and to apply a correct interpretation based on criteria that are different case by case, depending on the values protected by the various rules in play.

II. The Definition of "Evocation" in EU Law and the European Court of Justice Case-Law

Although EU Regulations on geographical indications do refer explicitly to "evocation", they do not define the cases that might fall within this violation.⁸ Both in the area of wine and spirits as well as in other quality food products, the term is used in a complementary way with respect to passing off cases (from which, for reasons of systematic consistency, it must be distinguished) with the clear intent of ensuring the widest extension to the exclusive right given by the registration of GIs.⁹

In the absence of regulatory specifications, a theoretical reconstruction of the topic must start from the semantic meaning of the term, which is achieved, not by direct narration, but by association of ideas. So, from a theoretical standpoint, a protected geographical name can be called to the consumer's mind "by juxtaposition" with a similar generic product based on a potentially "open" series of items of labelling, presentation or advertising that can create a mental association of this kind.

In order not to fall into tautological definitions we must draw a distinction between this case and other cases of misuse: so, evocation may not coincide with the use of a protected name for products that are not included in the scheme. At the same time the concept of "suggestion" itself rules out the risk of confusion, as there may be situations where certain features of the products (such as the design of the packaging or the product name used by the similar-generic foodstuff) may trigger psychological-emotive reactions that can lead to associating the generic product with the original, without actually mistaking one for the other.

Faced with this wide variety of situations, that in the abstract may be linked to the notion of "evocation" on the basis of mere semantic content (ranging

7 See Directive 2005/29/EC of the European Parliament and of the Council of 11 May 2005 concerning unfair business-to-consumer commercial practices in the internal market ('Unfair Commercial Practices Directive'), in *OJ*, L 149, 11 June 2005, p. 22 ff.

8 On the concept of "evocation" see, *ex plurimis*, N. Coppola, Viiniverla: too much 'ado' about nothing, in *Journal of Intellectual Property Law & Practice*, 2016, Vol. 11(6), pp. 406 ff.; V. Torelli, "Balsamico" is the taste of Modena and Reggio Emilia only, *Journal of Intellectual Property Law & Practice*, 2016, p. 408 ss.; V. Paganizza, More Holes than Cheese: PDOs, Evocation and a Possible Solution, *European Food and Feed Law Review*, 2015, p. 222 ss.; A. Martinez Gutierrez, Infracción de las Denominaciones Geográficas Protegidas a través de conductas evocativas: un apunte crítico, *Rivista di Diritto Alimentare*, n. 2/2014, <<http://www.rivistadirittoalimentare.it>> (accessed on 18 July 2017); N. Coppola, Imitazione e contraffazione di denominazioni tipiche e tradizionali: la posizione recente di operatori e associazioni internazionali, *Diritto comunitario e degli scambi internazionali*, 2013, n. 1-2, p. 295 ff.; M. Gonzalez; M. Angel, Protection of geographical indications against translation, generic use, evocation and other potential enemies, *Journal of Intellectual Property Law & Practice*, 2012, p. 20 ff.

9 Evocation is thus placed alongside typical cases such as "direct or indirect commercial use of a registered name in respect of products not covered by the registration [...], any misuse, imitation [...] 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 etc."

from simply aping the product to underlining morphological and graphic items of the foodstuff label in a manner imitating PDO-PGI), the Court of Justice has found it necessary to circumscribe the legal issue in question in order to avoid any overlap with other rules with regard to both protection of geographical names and misleading practices.

In the first case in which the Court provided an interpretation of the notion of "evocation" (*Cambozola ruling*¹⁰) the judges held that "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".¹¹ At the same time, they found that "the indication of the true origin of the product on its packaging or otherwise has no bearing on the application to that product of the concepts referred to"¹² in the EU norm in question.

In the analysis, the Court also considered factors unrelated to the name of the disputed product, noting that the morphology of the cheese in question (soft, blue and with evident analogies with PDO Gorgonzola) and also the advertising material used by the firm to promote it,¹³ can be elements that the judge can use in order to establish the existence of an "evocation". Unfortunately, the judgment did not clarify if these elements were a possible rather than an essential part of the evocation assessment, or a distinct infringement of the product protection in addition to evocation.

Subsequent judgments in the matter has however dispelled doubts also from this standpoint.

In the ruling on the well-known German cheese "Parmesan",¹⁴ the Court stated that the notion 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 brought to his mind is that of the product whose designation is protected".¹⁵ The subsequent grounds, concerning the presence of "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",¹⁶ seems to be merely ancillary as compared to the main subject matter of the judgement that is the conceptual affinity between those two terms. So, the focus of the notion of evocation is "to bring to the mind of the consumer the cheese protected by the PDO 'Parmigiano Reggiano', when he is confronted by a hard cheese, grated or intended to be grated, bearing the name 'Parmesan'".¹⁷

The interpretation of the notion of "evocation", set out in this way, has not been changed substantially by later rulings in the matter either by the Court of Justice or the General Court. In *Cognac*¹⁸ and *Calvados*¹⁹ the Court indeed reaffirmed the limitation arising from the case of incorporating a significant part of PDO/PGI into the name or brand of the similar generic product. On the other hand, with regard to two trademarks held to be null or not-registrable be-

10 See the Judgment of the Court of 4 March 1999, *Consorzio per la tutela del formaggio Gorgonzola v Käseerei Champignon Hofmeister GmbH & Co. KG and Eduard Bracharz GmbH*, case C-87/97, in *Reports of Cases*, 1999 I-01301, on which see the comments by F. Capelli, *La Corte di giustizia tra "feta" e "cambozola"*, *Diritto comunitario e degli scambi internazionali*, 1999 p. 273 ff; L. Costato, *Brevi note a proposito di tre sentenze su circolazione dei prodotti, marchi e protezione del consumatore*, *Rivista di diritto agrario*, 1999, II, p.157 ff. The reference for a preliminary ruling by Handelsgericht Wien, where the Court was asked to define the extension of exclusive rights under Article 13 of Regulation 2081/92/CEE (today 1151/2012/UE) in the ambit of a judgment to stop the sale of a blue cheese called "Cambozola" in Austria, held to be evocative of the well-known Italian PDO "Gorgonzola".

11 See point 26 of the Judgement.

12 See point 29 of the Judgement.

13 See points 27-28 of the Judgement.

14 See the Judgment of the Court (Grand Chamber) of 26 February 2008, *Commission of the European Communities v Federal Republic of Germany*, case C-132/05, in *Reports of Cases*, 2008 I-00957, relating to a German hard cheese, for grating, called "Parmesan" and held to be evocative of the Italian PDO Parmigiano Reggiano. For comments on the ruling see L. Gonzalez Vaqué, *Alcance de la protección de una denominación de origen*

registrada frente a su utilización abusiva, *Revista de Derecho Comunitario Europeo*, 2008, p. 545 ff.; C. Hauer, *Using the Designation "Parmesan" for Hard Cheese (Grated Cheese) of Non-Italian Origin*, *European Food and Feed Law Review*, 2008 Vol. 3 n° 6 p.387 ff.; C. Heath, *Parmigiano Reggiano by Another Name - The ECJ's Parmesan Decision*, *International Review of Intellectual Property and Competition Law*, 2008, p. 951 ff.

15 See point 44 of the Judgement.

16 See point 46 of the Judgement.

17 See point 48 of the Judgement.

18 See the Judgement of 14 July 2011, *Bureau national interprofessionnel du Cognac v Gust. Ranin Oy*, joined cases C-4/10 and C-27/10, in *Reports of Cases*, 2011 I-06131, on which see T. Georgopoulos, *Les marques commerciales nationales à l'épreuve des indications géographiques européennes*, *Revue de droit rural*, 2012, n° 401, p.18 ff; M.A. Medina González, *Protection and geographical indications against translation, generic use, evocation and other potential enemies*, *Journal of Intellectual Property Law and Practice*, 2012, p.20 ff.

19 See the Judgement of the Court of 21 January 2016, *Viiniverla Oy v Sosiaalija terveystalun lupa- ja valvontavirasto*, case C-75/15, in *ECLI:EU:C:2016:35*, on which see commentary by N. Coppola, *Viiniverla: too much "ado" about nothing*, *Journal of Intellectual Property Law & Practice*, 2016, p. 406 ff.

ing in breach respectively of the PDO "Porto"²⁰ for a spirit and the geographical name "Toscano"²¹ for extra virgin olive oil, the General Court underlined that an analysis of the evocative capacity of a name or a trademark must be carried out by considering the possible reactions of an "average consumer of the European Union". This depends also on the "unitary" nature of the right related to geographical indications under discussion and, as a consequence, the need to ensure that they enjoy consistent protection throughout the European Union.

So, in summary, evocation must be limited to cases that have the following features:

- the generic product name or trademark in question must incorporate a significant part of the registered PDO/PGI so that it has in itself the capacity to create a mental association with the original product;
- the relevance of the part of the registered geographical name incorporated has to be assessed taking into account the possible reactions not just of any consumer, nor necessarily, a consumer in the same marketplace where the product in question is sold, but referring to an "average" consumer (*i.e.*, in accordance with the jurisprudence of the Court of Justice, a normally informed and observant person). The Court specified that this evaluation must be referred to a "European consumer" (since registered GI protection must be given to all the circumstances of purchase in the EU and/or

by referring to a consumer who may not be a "native" of the place where the PDO/PGI is produced and/or marketed); and

- the fact that there are other elements that call an authentic product to mind, either from the morphological standpoint of the product (as in the case of blue cheese or hard cheese for grating already seen above) or in the area of labelling, presentation or advertising of the similar generic product (e.g. the use of symbols, images, wordings, descriptions and other elements of communication that hint at or are inspired by the authentic product) may be taken into account by a national judge in the assessment process, but this cannot replace the founding element of the case of evocation which remains at all times based on simple incorporation of the geographical indication into the name or brand in question.

Once the terms of the question have been set out in this way, a number of systematic issues still need to be clarified in order to define the boundary between these cases and other cases that are similar and are described under the same rule. In particular, we need to define the uncertain boundary between "evocation", "unfair commercial practices" on the origin of products and mere "indirect comparative advertising".

III. The Consumer as a Criterion for Making a Distinction between Evocation and Other Misleading Practices, and Its Definition in EU Law

The case-law of the Court and the Tribunal, recalled above, highlights the need for a judge (and for a business operator who must make marketing choices) to take the possible reactions of an "average consumer of the European Union" into consideration in order to evaluate the evocative nature of the disputed denominations.

The statement, although apparently clear, may be difficult to enforce in practice. The notion of "average consumer"²² tends to be set in an abstract judicial pre-evaluation. On the other hand, the introduction of the "average consumer" criteria into the paradigm of evocation may bring the particular case back within the boundaries of an illegal act constituted by a real danger.

20 See the Judgement of the General Court of 18 November 2015, *Instituto dos Vinhos do Douro e do Porto, IP v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*, Case T-659/14, in *ECLI:EU:T:2015:863*.

21 See the Judgement of the General Court, of 2 February 2017, *Roberto Mengozzi v European Union Intellectual Property Office*, in *ECLI:EU:T:2017:54*. On the relationship between GIs and Trade Marks please see, by way of example, C. Heath, D. Marie-Vivien, *Geographical Indications and the Principle of Trade Mark Law - A Distinctly European Perspective*, *IIC*, 2015, Vol. 46, p. 819 ff.; R. Knaak, *Geographical Indications and their Relationship with Trade Mark in EU Law*, *IIC*, 2015, p. 843 ff.; B. Fontaine, *The present and the future of the interaction between Trade Marks and geographical indications in Community law*, *ERA-Forum, Scripta iuris Europaei*, 2014, p. 183 ff.; G. Evans, *The Comparative advantages of geographical indications and Community Trade Marks for the marketing of agricultural products in the European Union*, *IIC*, 2010, p. 645 ff.; N. Resinek, *Geographical Indications and Trade-marks: coexistence or "first in time, first in right" principle?*, *European Intellectual Property Review*, 2007, p. 446 ff.; D. Gangjee, *Quibbling Siblings: Conflicts between Trade Marks and GIs*, 2007, *Chicago-Kent Law Review*, p. 1253 ff.

22 With regard to the "average consumer" in the EU Law see D. Leczykiewicz, S. Weatherill (eds.), *The Images of the Consumer in the EU Law*, Oxford, 2016; H.W. Micklitz, N. Reich P. Rott, K. Tonner (eds.), *European Consumer Law*, 2014, Cambridge; S. Weatherill, *EU Consumer Law and Policy*, Cheltenham, 2013; I. Iris Benöhr, *EU Consumer Law and Human Rights*, Oxford, 2013.

So, the conduct in question may appear to be prohibited if, and to the extent that, it can be ascertained to mislead a consumer, rather than as a violation itself of the exclusive rights, granted to legitimate manufacturers of PDO/PGI products. In this regard, we need to remember that, on the basis of the EU case-law, the "average consumer" is a person normally informed, aware and prudent. So, he is reasonably able to discern the characteristics of products and understand the advertising messages, on the basis of a juridical evaluation which does not require a "statistical" verification.

In other words, as affirmed by the Court of Justice in the well-known *Sekt*²³ case concerning the possibly misleading effect of an evocative brand of a wine indication protected by German rules, "it is for the national court to assess whether an appellation, brand name or advertising statement may be misleading [...]. In this case, it is for the national court to assess in the light of the circumstances whether, bearing in mind the consumers to whom it is addressed, a brand name or its component parts are liable to be confused with all or part of the description of certain wines. In that respect, it is also apparent from the Court's case-law that the national court must take into account the presumed expectations of an average consumer who is reasonably well informed and reasonably observant and circumspect".²⁴

Furthermore, "[i]t is only where it has particular difficulty in appraising the misleading nature of the brand name that, in the absence of any Community provision on the matter, the national court must assess whether it is necessary, under the conditions laid down by its national law, to decide upon measures of enquiry such as an expert's report or a consumer research poll as guidance for its judgment and, where appropriate, adopt interim measures".²⁵

As appears evident, the Court has made an effort to unify the criteria of the legal pre-assessment basing them on "reasonableness", in order to avoid the effect of the many variables of the real world on each specific case. The statement, indeed, seems to be especially significant in the context we are dealing with here. As already pointed out, the need to ensure a "unitary" protection for registered geographical names in the EU imposes that judges and control Authorities take into account all the possible mental attitudes of EU consumers as well as the impact of language variation,²⁶ circumstances that can be overcome only with a certain degree of abstraction.

So, the fundamental question that the latest rulings of the EU Court seems to pose is what exact role the "average EU consumer" plays in a judgement on evocation, given that including this in the parameters to take into consideration may lead to the belief that the need to ascertain the materially deceptive character of the name or brand in question is under discussion.²⁷

The General Court, judging the term "Port", uses the "perception of a consumer" argument not as a stand-alone factor, but rather to underline the fact that combining the term with a feminine name (Charlotte) shifts the centre of gravity of the appellation towards this second part, thus giving the brand and overall character that is merely descriptive of a river or maritime port location and not a well-known Portuguese wine.

The approach of an "average consumer", then, appears to remain confined to the context of a judgement of the "importance" of the geographical reference incorporated in the brand name. This should not be taken to the limit of an evaluation of deceptiveness on the nature of the product, in order to avoid contradiction with the ECJ case-law already cited.

23 See the Judgment of the Court (Fifth Chamber) of 28 January 1999, *Verbraucherschutzverein eV v. Sektellerei G.C. Kessler GmbH und Co.*, Case C-303/97, in *Reports of Cases*, 1999 I-00513; in the same terms, the ruling of 16 July 1998, C-210/96, *Gut Springenheide GmbH, Rudolf Tusky*. The reasoning, indeed, draws inspiration from leanings in prior jurisprudence of the Court where the judges, in reaching a decision concerning the possibly misleading character of an appellation, a brand or an advertising wording referring to provisions of the Treaty or derived law, have always relied on a presumed expectation of the average consumer, without ordering expert studies or surveys. In the same way, according to the Court, national judges should be able to assess the various particular cases upon which the notion of consumer might impact under the same conditions. On this point see, merely simply by way of example, the rulings of the Court of Justice 7 March 1990, C-362/88, *GN-INNO-BM*; 13 December 1990, C-238/89, *Pall*; 16 January 1992, C-373/90, *X*; 18 May 1993, C-126/91, *Yves Rocher*; 2 February 1994, C-315/92, *Verband Sozialer Wettbewerb*; 29 June 1995, C-456/93, *Langguth*; 6 July 1995, C-470/93, *Mars*.

24 See point 36 of the Judgment, and the case-law cited therein.

25 See point 37 of the Judgment.

26 Cf. ruling *f.lli Graffione* cit., point 22. See also by way of example, Judgment of Court of Justice of 13 January 2000, C-220/98, *Estée Lauder Cosmetics GmbH & Co. OHG c. Lancaster Group GmbH*, and Judgment of the General Court of 14 December 2006, T-81/03, *Mast-Jägermeister AG c. UAMI*, points 95-97, and in the same terms, 19 October 2006, T-350/04- 352/04, *Bitburger*, point 64.

27 On this point I. Calboli, *Geographical Indications of Origin at the Cross roads of Local Development, Consumer Protection and Marketing strategies*, *IIC*, 2015, p. 760 ff; R. Teuber, *Consumers' and Producers' expectations towards geographical indications; empirical evidence for a German study*, *British Food Journal*, 2011, p. 900 ff.

The judgment, thus, gives also precious indications concerning the very nature of the rule in question which, while being strictly tied to the parameter of "perception", is a direct expression of "exclusive right"²⁸ (i.e. the right connected with a prevailing interest of legitimate producers of PDO/PGI in forbidding the use of the place name by non-legitimate parties) and not the public policy interest of protecting a consumer from the danger of deception for which, as we will see later, the EU regulation in question has separate provisions.

In the end, the role of the consumer in a judgement on evocation is "ancillary" or "instrumental" to demonstrating that the term in dispute is indeed apt to generate an improper psychological link between the protected geographic name and the generic appellation or brand under evaluation, but the fact that the two products in question may actually be confused during purchase has no specific relevance for the judgement in question.

IV. Evocation *versus* Competition?

The features of evocation thus described allow us to "bring a little order" also to the systematic structure

of the various rules set out to protect registered geographic names included under the EU regulations in respect of PDO/PGI mentioned previously, or in other mandatory rules of a more general kind.

In particular, we need to investigate what judicial treatment we should apply to those specific cases where it is possible to see a more or less explicit juxtaposition of products, even if this is not achieved through incorporating, even partially, the geographical name into the name of the generic product.

The most disparate cases fall under this category: from a mere inclusion of messages (as for example, similar agri-environmental links) that bring to mind the same place of origin of a PDO/PGI on the label,²⁹ to the use of colours and graphic resemblance in the presentation/packaging of products, or the most banal (but no less insidious) mixing of PDO/PGI and generic products on supermarket shelves. So, it is necessary to assess where the boundary between "evocation" in the strict sense, a mere "affinity of products" and the simple indirect comparative advertising lies, by seeking a point of equilibrium between protection of exclusive rights connected with the registration of geographical indications, the right to competition and protection of consumers.

In this regards it seems to be fundamental at the outset to recall that the various regulations that lay down rules of protection for PDO/PGI contain one or more "closure" clauses that prohibit any commercial practice that might lead a consumer into error concerning the true origin of a product and its essential features.

By way of example, Article 13 of Regulation 1151/2012/EU states that "registered names shall be protected against: [...] (c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product that is used 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".

This, as appears obvious, is a specification made in the context of geographic indications of a more general prohibition of improper commercial practices in respect of origin contained under Article 7 of Regulation 1169/2011/UE concerning information for the consumer on foodstuffs³⁰ and under Article 6 of Directive 2005/29/CE on unfair commercial practices.³¹

28 On this point see H. Ilbert; M. Petit, Are geographical indications a valid property right? global trends and challenges, *Development Policy Review*, 2009, p. 503 ff.

29 See, as an example, the Judgment of the General Court of Cagliari of 31 May 2014, No. 1363/2014, with regard to a cheese named "Pecorino" (which, of course, is a generic name that means simply "sheep-cheese"), labelled with some commercial claims related to the origin of the milk, the place of production and the characteristics (flavours, taste and so on) indirectly connected to the region of Sardinia, which is also the geographical term protected in PDO "Pecorino Sardo". The specific claim was: "the C.T. Pecorino is produced using only sheep's milk and, after three weeks of maturing, it reaches its typical sweet and intense taste, that captures the flavour of its Land of origin: Sardinia". On the concept of the generic nature of a denomination, see V. Paganizza, More Holes than Cheese...*cit.*, p. 222 ff.; J. Audier, Generic and semi-generic denominations. Determination criteria and methods to reduce their effects, *AIDV-IWLA Bulletin*, 2000, p. 29 ff.; D. Gangjee, Say Cheese: A Sharper Image of Generic Use through the Lens of Feta, *European Intellectual Property Review*, 2007, p. 172 ff.

30 See the Regulation (EU) No 1169/2011 of the European Parliament and of the Council of 25 October 2011 on the provision of food information to consumers, in *OJ*, L 304, p. 18 ff.

31 Article 6 of the Directive states that "1. A commercial practice shall be regarded as misleading if it contains false information and is therefore untruthful or in any way, including overall presentation, deceives or is likely to deceive the average consumer, even if the information is factually correct, in relation to one or more of the following elements, and in either case causes or is likely to cause him to take a transactional decision that he would not have taken otherwise: [...] (b) the main characteristics of the product, such as [...] geographical or commercial origin [...]".

The particular cases that can be attributed to these hypothetical categories may thus be the most varied in kind, but they will all have in common a fundamental legal datum: the predisposition to mislead the consumer as to the identity and/or characteristics of the product.³²

The mention of the "true origin" of the foodstuff challenged and the coherence of the provision with the general discipline on misleading practices *vis-à-vis* consumers make the assessment of the material capacity of the packaging or presentation of the product – we are dealing with to "deceive" a consumer – unavoidable. This element, as was clarified above, does not however have any relevance in a judgement on evocation.

Therefore, a Judge or a control Authority, when assessing these situations, must verify whether the particular case under examination may confuse a consumer taking into consideration all possible variables, including the ordinary distraction that might characterise the time and place of purchase (especially in supermarkets³³), and, obviously, the language variable.

V. Protected Geographical Indications and Indirect Comparative Advertising

Starting from this basis, it is now also possible to provide an answer to the final question concerning the relationship between evocation, misleading commercial practices and indirect comparative advertising.

The Court of Justice, in *Toshiba Europe*, ruled that "in order for there to be comparative advertising within the meaning of Article 2 (2a) of Directive 84/450 as amended, it is therefore sufficient for a representation to be made in any form which refers, even by implication, to a competitor or to the goods or services which he offers. It does not matter that there is a comparison between the goods and services offered by the advertiser and those of a competitor".³⁴

In this regard it is well-known that the Court of Justice in the *Champagne*³⁵ ruling interpreted Directive 97/55/EC³⁶ on comparative advertising in the sense that holding a comparison between the PDO product and a similar-generic one was acceptable in order to ensure the benefits deriving from competition also in the sector in question. Indeed, according to the Court, "comparative advertising helps to demonstrate objectively the merits of the various comparable products and to stimulate competition between suppliers of goods and of services to the consumer's advantage. In the wording of recital 5 in the preamble to Directive 97/55, comparative advertising, when it compares material, relevant, verifiable and representative features and is not misleading, may be a legitimate means of informing consumers of their advantage".³⁷

However, the need to balance the aims mentioned with the limits set by the provisions protecting PDO/PGI has also led the Court to affirm that "under the latter provision, comparative advertising is to be permitted provided that it does not take unfair advantage of the reputation of a trade mark, trade

32 See, on this point, D. Sewagudole, How likely is a "likelihood of confusion"?, *Journal of Intellectual Property Law & Practice*, 2011, p. 359 ff.

33 We are thus dealing with particular cases that are separate, in the overall panorama described, from the concept of "evocation" as reconstructed previously. In any case, the two different situations (evocation vs. misleading practices) are not intended as being "in speciality relationships", considering that they can co-exist in a single case. This comes to light clearly in *Cognac*, where the Court states that if, on one hand, the notion of evocation "covers a situation in which 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" (see point 56 of the Judgement), on the other hand it adds that "[t]o the extent that the referring court considered it useful, it would be for that court, for the purposes of ascertaining whether the situations referred to in Article 16(c) and (d) of Regulation No 110/2008 existed, to determine, by taking account of the interpretative guidance already provided by the Court, whether the use of a mark containing a geographical indication, or a term corresponding to that indication and its translation, with respect to spirit drinks which do not meet the specifications set for that

indication is such as to give rise to a false impression as to the origin of those drinks or to mislead the consumer as to their true origin" (see point 60 of the Judgement).

34 See the Judgement of the Court of Justice 25 October 2001, Case C-112/99, *Toshiba Europe GmbH c. Katun Germany GmbH*, in *Reports of Cases*, 2001 I-07945, on which see comments by F. Henning-Bodewig, The Notion of Comparative Advertising, *Landmark cases of EU consumer law: in honour of Jules Stuyck*, Cambridge, Intersentia, 2013, p. 347 ff; A. Indraccolo, Comparisons and Conclusions: Welcome Clarification from the European Court of Justice on the Interpretation of the Comparative Advertising Directive, *European Intellectual Property Review*, 2003, p. 570 ff.

35 See the Judgement of the Court (First Chamber) of 19 April 2007, Case C-381/05, *De Landtsheer Emmanuel SA v Comité Interprofessionnel du Vin de Champagne and Veuve Clicquot Ponsardin SA*, in *Reports of Cases* 2007 I-03115.

36 See Directive 97/55/EC of European Parliament and of the Council of 6 October 1997 amending Directive 84/450/EEC concerning misleading advertising so as to include comparative advertising, in *OJ*, L 290, 23 October 1997, p. 18 ff.

37 See point 62 of the Judgement.

name or other distinguishing marks of a competitor or of the designation of origin of competing products. The effectiveness of that requirement would be partly compromised if products without designation of origin were prevented from being compared to those with designation of origin. If there were such a prohibition, the risk that an advertiser might wrongly derive benefit from the designation of origin of a competing product would, a priori, be precluded, since the product whose merits were being promoted by the advertising would, necessarily, have to have the same designation of origin as that of its competitor. Conversely, Article 3a(1)(g) of the directive would apply in all cases where an advertisement promoting a product without designation of origin was aimed at taking unfair advantage from the designation of origin of a competing product. In the context of that assessment, it is particularly important to determine whether the aim of that advertising is solely to distinguish between the products of the advertiser and those of his competitor and thus to highlight differences objectively. Where all the other conditions governing whether such advertising is permissible are met, protection of designation of origin which would have the effect of prohibiting absolutely comparisons between products without designation of origin and others with designation of origin would be unwarranted and could not be justified under the provisions of Article 3a(1)(f) of the directive".³⁸

The statements of the Court allow us to clarify this particular case systematically.

The offending conduct under letters (c) and (d) Article 13 Regulation 1151/2012/EU (and similar norms contained in the regulations on the protection of IG mentioned) reveal their "speculative intent" in their hidden link to the origin and other characteristics of PDO/PGI, without making an explicit and direct comparison concerning the elements (nature, manufac-

turing process, ingredients, price, etc.) of the products in question.³⁹ So, the particular case ends up in an attempt to mislead the consumer concerning the true identity of the two products.

It cannot therefore be justified as being a form of "comparative advertising" since explicit evidence of the point of comparison between one product and the other is missing and the unclear nature of the communication ends up becoming a form of speculative marketing association, which is not permitted under the regulations on the protection of registered geographical indications.

To the contrary, where similar generic products are intended to be compared with those of a protected place name directly, they should of necessity clearly highlight the subject matter of the comparison (which should in any event have some relevance for the consumer to avoid translating, in its turn, into a form of speculative linking) and a measurable difference in an overall context that is transparent and comprehensible, aimed at allowing a purchaser to make free and informed choices, *i.e.* without psychological conditioning and suggestion that are unduly generated.⁴⁰

VI. Final Remarks

The various rulings of the Court of Justice and the General Court that have dealt with the matter of evocation of PDO/PGI products or practices of unfair comparison between generic products and products with protected denominations have laid out a legal framework that is now quite clear and which allows each particular case to be "pigeon-holed" in the matching judicial provision.

As things currently stand in the matter therefore, the main problem does not appear to be the ambiguity of the various definitions but rather the risk of a mistaken approach by anyone who must apply the rules referred to, especially in respect of the role of the consumer as a parameter for discerning whether one or another particular case subsists.

In order to guarantee consistency, predictability and effectiveness to the EU legal framework described, the orientation of the national case-law must fully respect the specific indications given by the Court of Justice.

In particular, in a marketplace that is increasingly competitive and where the "thrust" of competition

38 See points 65-70 of the Judgement.

39 See, on this point, the *Toshiba Europe* Judgement cit., statement 33.

40 In this sense, even the positioning of products on shelves would appear to matter. Since positioning similar generic products alongside those with protected denominations may make an average consumer believe the two products to be equivalent to each other, it is indispensable that the seller highlights the difference between the PDO/PGI product and the generic one clearly, underlining in a comparative form any difference in price or other characteristics there are and which they want to compare. Simple "shelf mixing", on the contrary, risks becoming an unfair commercial practice for the reasons already given.

from generic products and the ever more refined techniques of marketing and psychology of consumption move towards a progressive watering-down of limits and differences, the only way to ensure that PDO/PGI products continue to have an area of commercial autonomy (and relative margins of economic sustainability) is to ensure that there is a clear distinction made between the effects of exclusive rights (which in the case of evocation materialises in an absolute irrelevance concerning possible confusion between products, as this is nothing more than an expression of a propriety right to the use of the registered name by someone who is entitled to do so) and the dynamics of competition which, to the contrary, are to be governed on the basis of broader pub-

lic interest (including therein the favourable effects of competition in economic terms, an increase in supply of products and a general lowering of costs in the sector).

The freedom of expression and economic initiative that every business operator in the market is entitled to may be fully recognised only in this second area (through direct comparative advertising or the promotion of the real characteristics of one's products, even if it is generic in kind) so that the balance is tipped in favour of one or other of the contrasting interests of PDO/PGI producers and those who make similar-generic products, by the protection of good faith *vis-à-vis* consumers and transparency in business activity.