

## A toast to 'Prosecco': PRISECCO constitutes evocation of PDO

Narcis Codori and Marta Datcu  
BACIU PARTNERS  
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### EUROPEAN UNION

Legal updates: case law analysis and intelligence

- Consortium for the Protection of the Controlled Designation of Origin 'Prosecco' filed invalidity claim, arguing PRISECCO constituted “evocation” of Prosecco PDO
- PRISECCO owner sought to restrict mark to use for non-alcoholic cocktails
- Board held PRISECCO need not cover “wine” to be considered an evocation of Prosecco PDO and found strong likelihood substantial proportion of European consumers would directly associate PRISECCO with product covered by PDO

On 30 May 2024, the EUIPO Fifth Board of Appeal rendered its decision in [Case R 1454/2022-5](#) concerning the dispute between the Consortium for the Protection of the Controlled Designation of Origin 'Prosecco' (the applicant/defendant) and Manufaktur Jörg Geiger GmbH (the EU trademark owner/appellant).

### Background

The dispute relates to the conflict between Manufaktur Jörg Geiger's word mark PRISECCO and the previously registered protected designation of origin (PDO) 'Prosecco'.

On 3 September 2020, the Italian authority responsible for the protection of the PDO 'Prosecco' (Consorzio di Tutela della Denominazione di Origine Controllata 'Prosecco') filed an invalidity claim, maintaining that the word mark PRISECCO constituted an “evocation” of the PDO 'Prosecco' within the meaning of Article 103(2)(b) of the EU Wine Regulation 1308/2013. While the contested EU trademark was registered for goods in Class 32, specifically “cocktails, non-alcoholic”, the PDO 'Prosecco' is registered for wines.

In response to the request for a declaration of invalidity of the EU mark, Manufaktur Jörg Geiger applied for a partial surrender of the contested mark, but the Cancellation Division considered that the consortium had demonstrated a legitimate interest in obtaining a decision on the merits in relation to all the contested goods.

Following the Cancellation Division's decision to allow the invalidity application in its entirety, the Manufaktur Jörg Geiger filed an appeal requesting the decision to be entirely set aside and reiterated a declaration of partial surrender requesting that the goods be restricted to "Class 32: Non-alcoholic cocktails whose ingredients are apple and or pear juices based on meadow fruit varieties".

## Decision

### Aspects of procedure

#### *EU trademark owner's request versus applicant's interest*

The EU trademark owner, Manufaktur Jörg Geiger, had reiterated its request for a partial surrender of the contested mark. The Consortium for the Protection of the Controlled Designation of Origin 'Prosecco' opposed, seeking to obtain a declaration of invalidity *ex tunc*, for all the designated goods.

The Board of Appeal explained that the surrender request is a means to withdraw from an *inter partes* case. Following the admission of such a request, the object of the invalidity claim would be restricted only to the goods remaining after the surrender procedure.

In this sense, the board concluded that "any exception to the general rule of Article 57(1) EUTMR should be construed narrowly."

In the light of the above, the board permitted the surrender request, holding that the consortium had failed to prove a legitimate interest in justifying such an exception (ie, in obtaining a declaration of invalidity *ex tunc*). The board held:

“ Since the invalidity applicant has not shown a real, direct and present legitimate interest in obtaining a decision on the merits also in relation to the surrendered goods, the invalidity applicant's request to obtain a decision on the merits in relation to all the contested goods, including the surrendered goods, is rejected. ”

#### *Acquiescence*

In the light of the arguments submitted by the parties, the board clarified that Article 61 of the EU Trademark Regulation (ie, the institution of acquiescence) does not apply in cases in which the previous IP right is a PDO.

More specifically, the owner of a subsequent trademark cannot rely on such a defence (ie, acquiescence) when the request for a declaration of invalidity is based on an earlier PDO.

### Case on merits

The consortium claimed that the contested EU mark amounted to an "evocation" of the earlier PDO 'Prosecco'. According to Article 103(2)(b) of the Wine Regulation, a PDO will be protected against any "misuse, imitation or evocation".

In its analysis, the Board of Appeal highlighted that the term 'evocation', as defined by the Wine Regulation, is an objective term and, thus, it is not necessary for the invalidity applicant to prove that the owner of the contested sign operated under the intention of evoking the PDO.

The board also emphasised that the concept of 'evocation' does not require that the products designated by the conflicting rights be identical or similar.

Consequently, in this case, the EU trademark PRISECCO need not cover "wine" to be considered an evocation of the PDO 'Prosecco'. Nevertheless, the board considered that there is a significant proximity between the wines protected under the PDO and the non-alcoholic cocktails protected under the contested EU mark.

On the other hand, the board held that the contested EU mark amounts to an evocation of the 'Prosecco' PDO, even after its partial surrender.

As the board confirmed that evocation can be found even without any likelihood of confusion between the products concerned, it underlined that what matters is that no association regarding the origin of the products is created in the mind of the public, so that no undue advantage is taken of the reputation of the PDO (see 14/07/2011, C-4/10, Cognac, EU:C:2011:484, § 46).

In light of the above, the board concluded that there is a strong likelihood that a substantial proportion of European consumers would directly associate the sign PRISECCO with the product covered by the PDO.

In conclusion, the board dismissed the appeal and confirmed the Cancellation Division's finding that the contested EU trademark evokes the PDO 'Prosecco' within the meaning of Article 103(2)(b) of the Wine Regulation, notwithstanding the partial surrender of the contested mark.

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## Narcis Codori

Associate  
BACIU PARTNERS

**Marta Datcu**

Intern

*BACIU PARTNERS*

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