

WHAT'S IN A NAME? CAN IT "EVOKE" MORE THAN IT SAYS?"



Scotch Whisky is protected as geographical indication, meaning only whisky produced in Scotland in accordance with specific standards and using prescribed raw materials can call itself "Scotch Whisky". However, this protection could be extended further, depending on how a German Court applies a recent decision of the Court of Justice of the European Union (CJEU).

The case arose from a German producer naming his whisky, produced outside Stuttgart, "Glen Buchenbach". The name and the label did not mention "Scotch Whisky" and marked the product as being made in Germany. Why then did the case make it to the CJEU?

The reason is that Regulation 110/2008 (Regulation) extends the protection of geographical indications. Under the Regulation the protection also covers "indirect commercial use" of the indication (Article 16(a)); "misuse, imitation or evocation" of the indication (Article 16(b)); and any other "false or misleading indication as to the provenance, origin, nature or essential qualities" on the product or its labelling, which gives a false impression as to its origin (Article 16(c)).

The CJEU concluded that "indirect commercial use" in Article 16(a) should not be given a broad interpretation and for a product to fall foul of this provision the indication needed to be used in identical or highly similar form. The CJEU concurred with the Advocate General that this provision was intended to cover use of the indication on supplementary marketing or information sources, such as advertising.

However, on the question relating to evocation, the CJEU said that Article 16(b) was intended to be of broader application. The issue for the national Court is whether when the consumer sees the name of the product, an image is triggered in his or her mind of the protected product. That assessment should be made by reference to the average European consumer who is reasonably well informed, observant and circumspect.

In the right circumstances, an evocation can occur without the geographical indication even being included on the product, as the national Court should also take account of conceptual proximity.

Therefore, the question for the German court will be whether when consumers see the word "Glen" on a bottle of whisky, this evokes "Scotch Whisky". The evocation must be of the particular protection. It will not be enough to show that "Glen" brings Scotland to mind. Including a reference to it being a German product manufactured in Germany will not assist if in their minds consumers are forming a link with "Scotch Whisky".

In respect of the final element, the CJEU confirmed that for the purposes of Article 16(c) account is not to be taken of the context in which the disputed element is used.

While the national court's decision is awaited on the facts, this Judgment is good news for geographical indications, as it confirms that their scope is not limited to the specific words being used on a product. It will also make interesting reading for retailers, particularly those that develop own brands. For a level of certainty and protection, trade mark clearance searches are advised for the names of product ranges. However, it may also be advisable to consider the impression a name may give and whether this could lead to future issues. Changing the name of an entire product range, could be costly although any evocation will likely need to be strong for a product to infringe the geographical indication.

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