



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Tenth Chamber)

1 December 2021 *

(EU trade mark – Invalidity proceedings – EU figurative mark Steirisches Kürbiskernöl g. g. A
GESCHÜTZTE GEOGRAFISCHE ANGABE – Absolute ground for refusal – Trade mark
including badges, emblems or escutcheons – Emblem of one of the areas of action of the
European Union – Protected geographical indications – Article 7(1)(i) of Regulation (EC)
No 207/2009 (now Article 7(1)(i) of Regulation (EU) 2017/1001))

In Case T-700/20,

Gabriele Schmid, residing in Halbenrain (Austria), represented by A. Ginzburg, lawyer,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by D. Hanf and M. Eberl,
acting as Agents,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO, intervener before the
General Court, being

Landeskammer für Land- und Forstwirtschaft in Steiermark, established in Graz (Austria),
represented by I. Hödl, lawyer,

ACTION brought against the decision of the Fourth Board of Appeal of EUIPO of
23 September 2020 (Case R 2186/2019-4), relating to invalidity proceedings between
Landeskammer für Land- und Forstwirtschaft in Steiermark and Ms Schmid,

THE GENERAL COURT (Tenth Chamber),

composed of A. Kornezov, President, K. Kowalik-Bańczyk and D. Petrлік (Rapporteur), Judges,

Registrar: R. Ūkelyté, Administrator,

having regard to the application lodged at the Court Registry on 24 November 2020,

having regard to the response of EUIPO lodged at the Court Registry on 25 January 2021,

* Language of the case: German.

having regard to the response of the intervener lodged at the Court Registry on 1 February 2021,
further to the hearing on 8 September 2021,
gives the following

Judgment

Background to the dispute

- 1 On 8 July 2011, the applicant, Ms Gabriele Schmid, filed an application for registration of an EU trade mark with the European Union Intellectual Property Office (EUIPO) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended (replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1)).
- 2 Registration as a mark was sought for the following figurative sign:



- 3 The product in respect of which registration was sought is in Class 29 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and corresponds to the following description: 'Pumpkin seed oil, corresponding to the protected geographical indication Styrian pumpkin seed oil'.
- 4 The EU trade mark application was published in *European Union Trade Marks Bulletin* No 2011/207 of 2 November 2011. That trade mark was registered on 9 February 2012 under number 010108454.
- 5 On 1 March 2018, the intervener, Landeskammer für Land- und Forstwirtschaft in Steiermark (Regional Chamber of Agriculture and Forestry of Styria, Austria), filed an application for a declaration of invalidity in respect of that mark. The grounds relied on by the intervener in support of the application for a declaration of invalidity were those set out in Article 59(1) of Regulation 2017/1001, read in conjunction with Article 7(1)(h) to (j) of that regulation.

6 As regards the ground for invalidity set out in Article 7(1)(i) of Regulation 2017/1001, read in conjunction with Article 59(1) of that regulation, the intervener relied on the German version of the EU symbol for ‘protected geographical indications’ (‘the PGI symbol’), covered by 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), which is as follows:



- 7 By decision of 26 July 2019, the Cancellation Division declared the contested mark invalid.
- 8 On 26 September 2019, the applicant filed a notice of appeal with EUIPO, pursuant to Articles 66 to 71 of Regulation 2017/1001, against the decision of the Cancellation Division.
- 9 By decision of 23 September 2020 (‘the contested decision’), the Fourth Board of Appeal of EUIPO dismissed the appeal, finding that the contested mark had been registered in breach of the provisions of Article 7(1)(i) of Regulation 2017/1001 and that, under Article 59(1) of that regulation, the trade mark had to be declared invalid.

Forms of order sought

- 10 The applicant claims that the Court should:
- annul the contested decision;
 - order EUIPO to pay the costs.
- 11 EUIPO contends that the Court should:
- dismiss the action;
 - order the applicant to pay the costs.
- 12 The intervener contends that the Court should:
- dismiss the action;
 - should the applicant’s application be upheld, refer the case back to EUIPO;
 - order the applicant to pay the intervener’s costs relating to the procedure before EUIPO and the proceedings before the Court.

Law

- 13 Given the date on which the application for registration at issue was filed, namely 8 July 2011, which is decisive for the purposes of identifying the applicable substantive law, the facts of the case are governed by the substantive provisions of Regulation No 207/2009 (see, to that effect, order of 5 October 2004, *Alcon v OHIM*, C-192/03 P, EU:C:2004:587, paragraphs 39 and 40, and judgment of 23 April 2020, *Gugler France v Gugler and EUIPO*, C-736/18 P, not published, EU:C:2020:308, paragraph 3 and the case-law cited).
- 14 Consequently, as regards the substantive rules, the references to Article 7(1)(i) and Article 59(1)(a) of Regulation 2017/1001 made by the Board of Appeal in the contested decision and by the parties must be understood as referring to Article 7(1)(i) and Article 52(1)(a) of Regulation No 207/2009, those two provisions being identical in wording to those of Regulation 2017/1001 to which reference was made.
- 15 In paragraphs 20 to 23 of the contested decision, the Board of Appeal found that Article 7(1)(i) of Regulation No 207/2009 applied to emblems referring to only one of the areas of action of the European Union, even if the emblem relating to such an action concerned only certain Member States. In paragraphs 24 to 26 of the contested decision, on the one hand, it found that, by adopting Regulation No 1151/2012, the European Union had exercised its exclusive competence to protect protected geographical indications and that the PGI symbol was thus of particular public interest within the meaning of Article 7(1)(i) of Regulation No 207/2009. On the other hand, it noted that the sign of which the contested mark consists comprised that symbol in its entirety and that neither the right nor the obligation to use that symbol included the right to have it protected as part of a trade mark. The Board of Appeal concluded in paragraph 27 of that decision that the contested mark had been registered in breach of that provision and that, accordingly, the contested mark had to be declared invalid.
- 16 In support of her action, the applicant relies on a single plea in law, alleging infringement by the Board of Appeal of Article 52(1)(a) of Regulation No 207/2009, read in conjunction with Article 7(1)(i) of that regulation.
- 17 She claims that Article 7(1)(i) of Regulation No 207/2009 precludes registration of a trade mark only where it includes a symbol of an international intergovernmental organisation which is likely to mislead the public as to the connection between, on the one hand, the proprietor or user of that trade mark and, on the other, the authority to which that symbol relates. According to the applicant, that condition is not fulfilled in this case. In any event, the contested decision does not state reasons in that regard.
- 18 EUIPO contends that the applicant's line of argument should be rejected. First, the PGI symbol had already been defined by the relevant EU legislation on the date on which registration of the contested mark was applied for. Secondly, the applicant does not dispute the classification of the PGI symbol as an emblem of particular public interest. Thirdly, granting protection under trade mark law to an EU symbol such as the PGI symbol would be inconsistent with the system for the protection of indications of geographical origin established by the European Union and would undermine its proper functioning.
- 19 For its part, the intervener submits that the PGI symbol is of particular public interest and cannot be incorporated into an EU trade mark, since such incorporation has not been consented to by the competent authority, namely the European Commission. It also submits that that symbol

dominates the contested mark, that consumers do not perceive that symbol as a symbol similar to a label of quality issued by the European Union and that the public will perceive a connection between that trade mark and the European Union, in view of the fact that that mark was issued by EUIPO.

- 20 It must be recalled that Article 7(1)(i) of Regulation No 207/2009 prohibits the registration of trade marks which include badges, emblems or escutcheons other than those referred to in Article 7(1)(h) of that regulation (now Article 7(1)(h) of Regulation 2017/1001), that is to say, other than those of States or international intergovernmental organisations that have been duly communicated to States party to the Convention for the Protection of Industrial Property signed in Paris on 20 March 1883, as last revised at Stockholm on 14 July 1967 and amended on 28 September 1979 (*United Nations Treaties Series*, vol. 828, No 11851, p. 305; ‘the Paris Convention’).
- 21 According to the wording of Article 7(1)(i) of Regulation No 207/2009, the prohibition provided for in that provision applies where, first, the badge, emblem or escutcheon in question is of particular public interest and, secondly, the competent authority has not consented to that registration.
- 22 Furthermore, it is apparent from the case-law that those conditions are supplemented by a third condition, it being understood that all those conditions are cumulative. The third condition follows from a combined reading of Article 7(1)(i) of Regulation No 207/2009 and Article 7(1)(h) of that regulation.
- 23 According to the latter provision, the emblems of international intergovernmental organisations that have been duly communicated to the States which are parties to the Paris Convention are protected only when, taken as a whole, the trade mark which includes such an emblem suggests, in the public mind, a connection between, on the one hand, its proprietor or user and, on the other, the international intergovernmental organisation in question, a condition which stems directly from Article 6ter(1)(c) of the Paris Convention (see, to that effect, judgment of 10 July 2013, *Kreyenberg v OHIM – Commission (MEMBER OF €e euro experts)*, T-3/12, EU:T:2013:364, paragraph 38).
- 24 If the protection conferred by Article 7(1)(i) of Regulation No 207/2009 could take effect even where the latter condition is not fulfilled, the protection would be superior to that conferred by Article 7(1)(h) of that regulation on the emblems of international intergovernmental organisations that have been duly communicated to the States which are parties to the Paris Convention (judgment of 10 July 2013, *MEMBER OF €e euro experts*, T-3/12, EU:T:2013:364, paragraph 38).
- 25 However, there is nothing to indicate that the EU legislature wished to confer upon badges, emblems or escutcheons covered by Article 7(1)(i) of Regulation No 207/2009 greater protection than that for the badges, emblems or escutcheons referred to by Article 7(1)(h) of that regulation, so that the extent of the protection conferred by the former provision cannot be greater than that of the protection conferred by the latter provision (see, to that effect, judgments of 16 July 2009, *American Clothing Associates v OHIM* and *OHIM v American Clothing Associates*, C-202/08 P and C-208/08 P, EU:C:2009:477, paragraph 80, and of 10 July 2013, *MEMBER OF €e euro experts*, T-3/12, EU:T:2013:364, paragraph 39).

- 26 Therefore, the protection conferred upon the badges, emblems or escutcheons referred to in Article 7(1)(i) of Regulation No 207/2009 is intended to apply only where, taken as a whole, the trade mark including such a badge, emblem or escutcheon is likely to mislead the public as to the connection between, on the one hand, its proprietor or user and, on the other, the authority to which the badge, the emblem or escutcheon in question relates (judgment of 10 July 2013, *MEMBER OF €e euro experts*, T-3/12, EU:T:2013:364, paragraphs 40 and 77).
- 27 In that regard, it has been clarified that, in view of the broad wording of Article 7(1)(i) of Regulation No 207/2009, that provision also protects badges, emblems or escutcheons which, while not designating all the activities of the European Union, nevertheless have a special connection with one of those activities. The fact that a badge, emblem or escutcheon is connected with one of the activities of the European Union is sufficient to show that a public interest attaches to its protection (see, to that effect, judgment of 10 July 2013, *MEMBER OF €e euro experts*, T-3/12, EU:T:2013:364, paragraph 44).
- 28 It follows that the protection conferred by Article 7(1)(i) of Regulation No 207/2009 is applicable, inter alia, where the trade mark in question misleads the public as to the origin of the goods or services which it designates, leading them to believe that the goods or services originate from the authority to which the badge, emblem or escutcheon, a reproduction or imitation of which it contains, refers. Such protection must also apply where the public may believe that, because of the presence in the trade mark of such reproduction or imitation of a badge, emblem or escutcheon, the goods or services have the approval or warranty of the authority to which that badge, emblem or escutcheon refers or that they are connected in some other way with that authority (judgment of 10 July 2013, *MEMBER OF €e euro experts*, T-3/12, EU:T:2013:364, paragraphs 78 and 97; see also, by analogy, judgment of 15 January 2013, *Welte-Wenu v OHIM – Commission (EUROPEAN DRIVESHAFT SERVICES)*, T-413/11, not published, EU:T:2013:12, paragraph 61).
- 29 It is in the light of those considerations that the line of argument put forward against the contested decision must be examined.
- 30 In the present case, the Board of Appeal concluded that the appeal against the decision declaring the contested mark invalid should be dismissed on the basis of Article 7(1)(i) of Regulation No 207/2009, finding that the two conditions referred to in paragraph 21 above were fulfilled.
- 31 First, it found, in paragraph 24 of the contested decision, that the PGI symbol was of particular public interest, since it had to be affixed to products corresponding to a protected geographical indication, which the applicant does not dispute. Secondly, in paragraph 25 of that decision, it noted that the contested mark included the PGI symbol in its entirety and that the applicant had failed to demonstrate that the Commission had consented to such use of that symbol under trade mark law, nor was such consent apparent from Regulation No 1151/2012, which the applicant does not dispute either.
- 32 However, it must be stated that the Board of Appeal did not examine the third condition in view of which, according to the case-law set out in paragraphs 26 to 28 above, the ground for refusal provided for in Article 7(1)(i) of Regulation No 207/2009 may be relied on.
- 33 As the applicant observes, no passage in the contested decision concerns the question whether the public may believe that, because of the presence in the contested mark of the reproduction of the PGI symbol, the goods which that mark designates have the approval or warranty of the authority

to which that emblem refers, namely the European Union, or that they are connected in some other way with that authority. In particular, the Board of Appeal did not examine, in the contested decision, whether the way in which the PGI symbol was incorporated into the contested mark might lead the public to believe that the goods covered by that mark had the warranty of the European Union that those goods had a certain origin and properties which met the conditions set out in Regulation No 1151/2012 in order to benefit from protection under protected geographical indications.

- 34 In that regard, contrary to what EUIPO maintained at the hearing, it cannot be considered that, in the contested decision, the Board of Appeal implicitly examined whether the contested mark suggested, in the public mind, a connection between its proprietor and the European Union. By confining itself, in paragraphs 19 and 25 of that decision, to stating that that mark included the PGI symbol in its entirety and, in paragraph 26 of that decision, to stating that, even if the contested mark were not identical to the PGI symbol, that would not alter its assessment, the Board of Appeal did not in any way examine the way in which the public would perceive that symbol as a component of that mark, taken as a whole, or whether that perception might lead the public to believe that the goods covered by such a mark had the warranty of the European Union.
- 35 In so doing, the Board of Appeal erred in law by failing to rule on one of the three cumulative conditions governing the implementation of the protection provided for in Article 7(1)(i) of Regulation No 207/2009.
- 36 None of the arguments put forward by EUIPO and the intervener calls that conclusion into question.
- 37 First, EUIPO's argument that the PGI symbol had already been defined by the relevant EU legislation on the date on which registration of the contested mark was applied for only proves that that symbol originates from the European Union.
- 38 In that regard, it is common ground between the parties that the PGI symbol is of particular public interest within the meaning of Article 7(1)(i) of Regulation No 207/2009. Although that is one of the conditions for implementing the protection conferred by that provision, it is distinct and prior to the condition that the public may believe that the goods covered by a trade mark including such a symbol have the approval or warranty of the European Union or that they are connected in some other way with the European Union.
- 39 Secondly, it must be admitted that, as EUIPO argues, the grant of protection under trade mark law to an EU symbol such as the PGI symbol is, as a general rule, such as to affect adversely the system of protected geographical indications established by the European Union and to undermine its proper functioning. Indeed, such a grant is liable to confer on the proprietor of a trade mark including the PGI symbol a monopoly on the use of that symbol allowing him or her to prohibit the use of that symbol by any other person. However, under Article 12 of Regulation No 1151/2012, it must be possible for any producer to use that symbol for the purposes of labelling his or her products provided that they meet the requirements for being covered by a protected geographical indication.
- 40 Nevertheless, the application of Article 7(1)(i) of Regulation No 207/2009 requires a specific overall examination of the likelihood referred to in paragraph 38 above to be carried out with regard to the contested mark, since the other elements of that mark may have the consequence that, taken as a whole, that mark is not such as to suggest in the public mind that there is a

connection between the proprietor or user and the authority which possesses or uses the emblem forming part of the trade mark, and not to mislead the public in that respect (judgment of 10 July 2013, *MEMBER OF €e euro experts*, T-3/12, EU:T:2013:364, paragraph 107).

- 41 In that regard, EUIPO's decision-making bodies must not only examine whether the emblem concerned is included in full or in part in the trade mark into which it is incorporated. They must also assess whether, inter alia, in view of its size and position within such a mark, that emblem is perceptible as such by the public, whether it has a simple or complex configuration of colours or shapes, whether it is supplemented by other word or figurative elements which reduce or alter the perception of that emblem by the public or whether the other elements of the mark in question dominate the overall impression created by it.
- 42 Only after that examination can it be considered, in the event that the public makes a connection between, on the one hand, the proprietor or user of the trade mark concerned and, on the other, the authority which possesses or uses the emblem which forms part of that mark, or that the public is misled in that respect, that there is a risk of adversely affecting the system of protected geographical indications established by the European Union.
- 43 Thirdly, contrary to what the intervener maintains, the refusal to register a trade mark including the PGI symbol, on the basis of Article 7(1)(i) of Regulation No 207/2009, cannot result from the mere fact that the competent authority did not consent to such use. The absence of such consent is only one of the conditions required for the implementation of the protection provided for in that provision.
- 44 Fourthly, as regards the intervener's arguments that the PGI symbol dominates the contested mark, that consumers do not perceive that symbol as a symbol similar to a mark of quality issued by the European Union and that the public will perceive a connection between that trade mark and the European Union, in view of the fact that that trade mark was issued by EUIPO, it must be noted that they concern the assessment of the public's perception of that mark. However, no such examination was carried out in the contested decision. Such arguments are thus incapable of calling into question the conclusion that the Board of Appeal erred in law by not making such an assessment.
- 45 In that context, it should be added, for the sake of completeness, that, contrary to what the applicant claims, the fact, assuming it to be established, that, on the date of filing of the application for registration, the goods designated by the contested mark met the conditions set out in Regulation No 1151/2012 in order to benefit from protection under protected geographical indications, has no bearing on that examination. First, such a fact means only that, in accordance with Article 12 of Regulation No 1151/2012, the operator marketing those goods may use the geographical indication at issue, which does not, however, entitle him or her to use such an indication as a trade mark. Secondly, the goods in question may cease to meet those conditions in the future. Even in that case, the trade mark concerned would continue to include the PGI symbol and would, as the case may be, be more likely to mislead the public as to the origin or properties of the goods which it designates.
- 46 It follows from all the foregoing that the contested decision must be annulled.

Costs

- 47 Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. In the present case, EUIPO and the intervener have been unsuccessful and the applicant has applied only for EUIPO to be ordered to pay the costs in the present proceedings. Consequently, EUIPO must be ordered to bear its own costs and to pay all the costs incurred by the applicant in respect of the present proceedings. Pursuant to Article 138(3) of the Rules of Procedure, the intervener must be ordered to bear its own costs incurred in the present proceedings.

On those grounds,

THE GENERAL COURT (Tenth Chamber)

hereby:

- 1. Annuls the decision of the Fourth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 23 September 2020 (Case R 2186/2019-4);**
- 2. Orders EUIPO to bear its own costs and to pay those incurred by Ms Gabriele Schmid;**
- 3. Orders Landeskammer für Land- und Forstwirtschaft in Steiermark to bear its own costs.**

Kornezov

Kowalik-Bańczyk

Petrлік

Delivered in open court in Luxembourg on 1 December 2021.

[Signatures]