

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE MARKS
IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

In the matter of an application for the protection of International Registration No. 251619 and in the matter of an Opposition thereto.

BAVARIA N.V.

Applicant

(Represented by MacLachlan & Donaldson)

BAYERISCHER BRAUERBUND e.V.

Opponents

(Represented by Tomkins & Co.)

The Application

1. On 23 September, 2014 (“the relevant date”), Bavaria N.V. of de Stater 1, NL-5737 RV Lieshout, the Netherlands, made an application to register this sign:



(hereinafter BAVARIA HOLLAND) as a Trade Mark in respect of the “Beers” in Class 32.

2. The application was accepted for registration and advertised accordingly in Journal No. 2271 dated 31 December, 2014.
3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Trade Marks Act, 1996 (“the Act”) was filed on 30 January, 2015 by Bayerischer Brauerbund e.V. of Oskar-von-Miller-Ring, D-80333 Munchen, Germany. The Applicant filed a counter-statement on 8 April, 2015 and evidence was, in due course, filed by the parties under Rules 20, 21, and 22 of the Trade Marks Rules, 1996 (“the Rules”).
4. The opposition became the subject of a hearing before me, acting for the Controller, on 19 February, 2019. The parties were notified on 6 March, 2019 that I had decided to uphold the opposition and to refuse the registration of the mark. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Applicant in that regard pursuant to Rule 27(2) of the Rules.

Grounds of the Opposition

5. In its Notice of Opposition, the Opponent states that it is the proprietor of the Protected Geographical Indication BAYERISCHES BIER (hereinafter “the PGI”) under Council Regulation (EEC) No. 2081/92 of 14 July, 1992 for the protection of geographical indications and designations of origin for agricultural products and foodstuffs. The protection was granted by Council Regulation (EC) No. 1347/2001 and published on page 3 of Official Journal L182 of 5 July, 2001.
6. The Opponent then raises objection to the application based on two grounds: (i) the protection afforded the PGI and its validity and effect in all Member States of the European Union and (ii) under Section 8(4)(a) of the Act, on the basis that the use of the mark is prohibited in the State by an enactment or rule of law or by any provision of Community law.

Counter-Statement

7. In its Counter Statement the Applicant admits the Opponent is the proprietor of the PGI Bayerisches Bier. Nonetheless, Council Regulation (EC) No. 1347/2001 which approved the PGI Bayerisches Bier also makes it clear that following notification of the application by the German authorities to register the PGI the Dutch and Danish authorities informed the Commission of the existence of trade marks used for beer which include that name. According to Article (3) of the Council Regulation, “*The information provided confirms the existence of the name ‘Bavaria’ as a valid trade mark*”. In view of the facts and information available, it was considered that registration of the name ‘Bayerisches Bier’ was not liable to mislead the consumer as to the true identity of the product. Consequently, the PGI and the trade mark ‘Bavaria’ are not in the situation referred to in Article 14(3) of Regulation (EEC) No. 2081/92. The Applicant claims that it is clear therefore, from Council Regulation No. 1347/2001, that the Council decided that the PGI and the trade mark BAVARIA were not confusingly similar.
8. Furthermore, the Applicant states in its Counter Statement the trade mark BAVARIA has been in use in the State since before the date of the PGI and is still in use in the State. As a consequence of that use the Applicant’s trade mark BAVARIA is distinctive of the Applicant’s goods. The Applicant denies the application offends against Section 8(4)(a) of the Trade Marks Act, 1996 and states the Applicant is fully entitled to register the trade mark.

Rule 20 Evidence

9. Evidence submitted by the Opponent under Rule 20 consists of a Statutory Declaration dated 6 July 2015 and supporting evidence, by way of seven exhibits labelled “BB1” to “BB7”, of Robert Scholz, Managing director of Bayerischer Brauerbund e.V., a German registered association of Bavarian brewers, of Oscar-von-Miller-Ring 1, D-80333 Munich, Germany.
10. In his declaration Mr Scholz states that his association was founded in 1880 for the purpose of protecting the interests of Bavarian beer brewers. His association is tasked with fostering and strengthening the protection of the geographical indication “Bayerisches Bier” by the registration of the collective marks “Bayerisches Bier” and “Bavarian Beer”, and by taking proceedings against the unauthorised use of the geographical indications “Bayerisches Bier” and “Bavarian Beer”.
11. Mr Scholz states that on 28 September, 1993 his association submitted to the German Government an application for registration of BAYERISCHES BIER as a Protected Geographical Indication (PGI) pursuant to new European Economic Community (EEC) regulations on the protection of geographical indications and designations of origin. On 20 January, 1994 the German Government informed the European Commission of that application and, following an extensive scrutiny by the Commission, the European Council adopted Council Regulation No. 1347/2001 of 28 June 2001 by which the name BAYERISCHES BIER was registered as a PGI for beers. The Regulation was published in the Official Journal of the European Communities on 5 July, 2001. He attaches at Exhibit “BB1” an extract from the DOOR database of the European Commission having Dossier No. DE/PGI/0017/0518 showing the registration details of the PGI and at Exhibit “BB2” a copy of the publication in the Official Journal of the European Communities of Regulation No. 1347/2001 showing the entry into force of the Regulation on 5 July, 2001. By this publication the PGI BAYERISCHES BIER obtained protection in all Member States of the European Union, and as the application for registration of the opposed mark was made on 23 September 2014, the PGI is an earlier right.
12. Mr Scholz states that in terms of the opposition based on Section 8(4)(a) the relevant provisions of EU Law are Article 14(1) in conjunction with Article 13 of Regulation (EU) No. 1151/2012 of the European Parliament and Council on quality schemes for agricultural products and foodstuffs, which repealed earlier EC Regulations of 1992 and 2006. He says

that as the conflict between the PGI and the trade mark arose on 23 March 2014 (the application date of the opposed mark) Regulation No. 1151/2012 of 21 November 2012 applies. He attaches at Exhibit “BB3” a copy of the Regulation.

13. He states that Article 13(1)(b) of Regulation No. 1151/2012 provided that registered names (including geographical indications) will be protected against “*any misuse, imitation or evocation, 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 ...*”. He says the opposed mark falls within this protection as it is to be protected for “beers” in Class 32, which are the exact goods for which the PGI is registered. The English translation of the PGI is “Bavarian beer” and the word Bavaria in the opposed mark is almost a direct translation of “Bayerisches Bier”. He says the opposed mark is therefore either an imitation of the PGI or an evocation of it, or both.
14. Mr Scholz states the Court of Justice of the European Union (CJEU) has interpreted the concept of evocation in its judgment in *GORGONZOLA*¹ (as copy of which he attaches at Exhibit “BB4”), where at paragraphs 25 and 26 the Court found:

“25. Evocation, as referred to in Article 13(1)(b) of Regulation No 2081/92, 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 triggered in his mind is that of the product whose designation is protected.

26. As the Advocate General states in points 37 and 38 of his Opinion, it is possible, contrary to the view taken by the defendants, 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.”

15. Mr Scholz states that the provisions of Regulation 1151/2012 are directly applicable in Ireland as EU Regulations always have direct effect. This is expressly laid out in Article 288 of the Treaty on the Functioning of the EU. He says the CJEU clarified in the judgment in *Politi*² of 14 December 1971 that this is a complete direct effect. He attached at Exhibit “BB5” a copy of the cover page of the Treaty and its Article 288. He states the CJEU, in joined Cases C-4/10 and C-27/10³, which were concerned with provisions in Regulation No. 110/2008 on the protection of geographical indications for alcoholic spirits (which are

¹ Consorzio per la Tutela del Formaggio Gorgonzola -v- Käserei Champignon Hofmeister GmbH & Co. KG and Eduard Bracharz GmbH, case C-87/97

² Politi s.a.s. v Ministry for Finance of the Italian Republic Case 43-71

³ Bureau national interprofessionnel du Cognac v Gust. Ranin Oy (decision dated 14 July, 2011)

relevant to those of Article 13 and 14 of Regulation No. 2081/92) that the national authorities are required to refuse or invalidate the registration of a trade mark which falls within the provisions of Article 16 (which are equivalent to those of Article 13 of Regulation No. 1151/2012). He provides a copy of the Court's judgment in the joined cases at Exhibit "BB6".

16. Mr Scholz then turns to the Applicant's Counter Statement. He argues the reference by the Applicant to the EC Regulation 1347/2001 and the claims the European Council found that consumers would not be liable to be confused as to the true identity of the product (covered by the PGI) as a result of the Applicant already using Bavaria as a trade mark in Denmark and the Netherlands is misleading and irrelevant in the context of this opposition. He provides his analysis of what he sees as the relevant provisions of the Regulations and concludes that there is no basis on which the Applicant can assert the Council decided the PGI and the trade mark BAVARIA were not confusingly similar. Notwithstanding that, he says confusion is not required under the provisions of Article 13 1(b) of Regulation 1151/2012 which is the rule of EU Law being relied on.

17. He states EC Regulation 1347/2001 does not address the relationship between the PGI and the sign BAVARIA HOLLAND but did find that the registration of the PGI would not contravene Article 14(3) of Regulation No. 2081/92. Therefore, the Council was considering an entirely different matter - the registration of the PGI, specifically in respect of pre-existing trade marks - which had nothing to do with the prohibitive provisions in Articles 13 and 14 of Regulation No. 1151/2012. He says the findings of the Council were confirmed by the CJEU in Bavaria NV⁴ (he attaches a copy of the judgment at Exhibit "BB7") wherein the Court says the Council was right to find in Regulation No. 1347/2001 that the name "Bayerisches Bier" was not in a situation covered by Article 14(3) of Regulation No. 2081/92, and found, at paragraphs 117-124, as follows:

"117. In that regard it must be pointed out that Article 14 of Regulation No 2081/92 specifically governs the relationship between names registered under that regulation and trade marks by setting out, in respect of the various situations referred to, rules of conflict the scope, consequences and addressee of which are different.

118. First, Article 14(3) of Regulation No 2081/92 refers to a situation of conflict between a PDO or a PGI and a pre-existing trade mark where registration of the name at issue would, in the light of the trade mark's reputation, renown and the

⁴ Bavaria NV, Bavaria Italia Srl v Bayerischer Brauerbund eV, Case C-343/07 (2 July 2009)

length of time for which it has been used, be liable to mislead the consumer as to the true identity of the product. The consequence provided for in the event of such a conflict is that registration of the name must be refused. This is therefore a rule which implies that there must be an analysis, intended inter alia for the Community institutions, prior to registration of the PDO or PGI.

119. Second, Article 14(2) of Regulation No 2081/92 refers to a situation of conflict between a registered PDO or a PGI and a pre-existing trade mark where the use of that trade mark corresponds to one of the situations referred to in Article 13 of Regulation No 2081/92 and the trade mark was registered in good faith before the date on which the application for registration of the PDO or PGI was lodged. The consequence provided for in that situation is that use may continue notwithstanding the registration of the name, where there are no grounds for invalidity or revocation of the trade mark as provided respectively by Article 3(1)(c) and (g) and Article 12(2)(b) of First Directive 89/104. This is therefore a rule which implies that there must be an analysis, intended inter alia for the authorities and courts called upon to apply the provisions in question, after registration.

120. The analysis arising out of Article 14(3) of Regulation No 2081/92 is confined to the possibility of a mistake on the part of the consumer as to the true identity of the product as a result of registration of the name at issue, and is based on an examination of the name to be registered and the pre-existing mark having regard to that mark's reputation, renown and the length of time for which it has been used.

121. By contrast, the analysis arising out of Article 14(2) of Regulation No 2081/92 involves ascertaining whether the use of the trade mark corresponds to one of the situations referred to in Article 13 of Regulation No 2081/92; whether the trade mark was registered in good faith before the date on which the application for registration of the name was lodged; and, if appropriate, whether there are grounds for invalidity or revocation of the trade mark as provided respectively by Article 3(1)(c) and (g) and Article 12(2)(b) of First Directive 89/104.

*122. That analysis thus calls for an examination of the facts and of national, Community or international law, which it is for the national court alone to carry out, if necessary making a reference for a preliminary ruling under Article 234 EC (see, to that effect, Case C-87/97 *Consorzio per la tutela del formaggio Gorgonzola* [1999] ECR I-1301, paragraphs 28, 35, 36, 42 and 43).*

123. It follows that Article 14(2) and Article 14(3) of Regulation No 2081/92 each have separate objectives and functions and are subject to different conditions. Thus, the fact that Article 1 of Regulation No 1347/2001 registered the name 'Bayerisches Bier' as a PGI and that recital 3 in the preamble to that regulation states that that PGI and the trade mark Bavaria are not in the situation referred to in Article 14(3) of Regulation No 2081/92 cannot affect the examination of the conditions which make it possible for the mark and the PGI to co-exist as set out in Article 14(2) of that regulation.

124. In particular, the fact that there is no likelihood of confusion on the part of the consumer, for the purposes of Article 14(3) of Regulation No 2081/92, between the name at issue and the pre-existing mark does not preclude the use of the mark from being covered by a situation referred to in Article 13(1) of that regulation or the possibility that the mark may be subject to one of the grounds for invalidity or

revocation as provided for by Article 3(1)(c) and (g) and Article 12(2)(b) respectively of First Directive 89/104. Furthermore, the fact that there is no likelihood of confusion does not mean that it is not necessary to ascertain that the trade mark in question was registered in good faith before the date on which the application for registration of the PDO or PGI was lodged.

18. He also disputes the claim that use of the opposed trade mark in Ireland has pre-dated the PGI and puts the Applicant on notice that full proof of such is awaited.

Rule 21 Evidence

19. Evidence submitted by the Applicant under Rule 21 consists of the following:

- i. a Statutory Declaration of Franciscus Alfonsus Maria (Frank) Swinkels, Director of Bavaria N.V., dated 12 January, 2016 and six supporting exhibits labelled “BNV 2.1” to “BNV 2.6”;
- ii. a Statutory Declaration of Petrus Johannes Joseph Maria (Peter) Swinkles, retired Chairman of the Board of Directors of Bavaria N.V., dated 12 January, 2016 and one supporting exhibit labelled “BNV 2.7”;
- iii. a Statutory Declaration of Wilhelmina Maria Petronella Antonie (Willianne) Slegers, Attorney at Law and Company Lawyer of the Applicant, dated 6 April, 2016 and one supporting exhibit labelled “BNV 3.1”;
- iv. a Statutory Declaration of Norman MacLachlan, Registered Trade Mark Attorney, dated 13 July, 2016 and three supporting exhibits labelled “NM1” to “NM3”;
- v. a Statutory Declaration of Keith Fagan, Director of Molson Coors Brewing Company (Ireland) Limited, dated 15 July, 2016 and one accompanying exhibit labelled “KF1”.

20. For his part Mr Frank Swinkels provides details of the Applicant’s history and business. He explains the Applicant is the second largest brewery in the Netherlands and produces approximately 600 million litres of beer annually. The Applicant, based in North Brabant, was founded in 1719 by Laurentius Moorees and is currently owned by the Swinkels family. He says the Applicant has been using its trade mark BAVARIA since at least 1931 and first registered it in the Netherlands in 1971 (under No. 0067230) and that that registration is now effective in the Benelux territories. He attaches at Exhibit “BNV 2.1” a copy of the registration certificate for that Benelux trade mark, on which it is stated the mark was in use in the Netherlands since 1931 and in Belgium from 1957.

21. He says the Applicant has gone on to register its trade mark BAVARIA nationally in a large number of countries and internationally under the Madrid Protocol. He attaches at Exhibit

“BNV 2.2” a copy of the official publication of the International Trade Mark No. 133171 (a combined figurative and verbal mark containing the very prominent word element BAVARIA) registered on 8 November 1947 in Germany, Austria, Belgium, Spain, France, Hungary, Italy, Liechtenstein, Luxembourg, Morocco (French Zone), the Netherlands, Portugal, Romania, Switzerland, Tangier (Zone of), Czechoslovakia (as it then was), Tunisia, Turkey and Yugoslavia (as it then was). He states this mark was in force until 8 November 1987 but was not renewed by his Company because the specific design was no longer used as it had been replaced by other designs.

22. Mr Frank Swinkels states that until the 1970’s the Applicant mainly concentrated on the Dutch market, but now sells its beer in up to 120 countries and has sales subsidiaries in France, Spain, Italy, England and Canada and it also has agents in a large number of other countries. In 1978 the Applicant exported alcohol-free malt beer to countries in the Middle East under the trade mark BAVARIA and that BAVARIA beer is now brewed locally in Russia under licence. He attaches at Exhibit “BNV 2.3” a schedule containing particulars of all the Applicant’s trade mark registrations. The schedule shows a large number of registrations in countries within the European Community, including Ireland.

23. Mr Frank Swinkels says the Applicant has been using its trade mark BAVARIA within the European Community for many years prior to June 28 2001, the date of the PGI, and has obtained numerous registrations consisting of and/or containing its trade mark BAVARIA both before and after the date of the PGI (2001) in numerous countries of the European Community. He states the registration of the PGI has not and could not have the effect of preventing the Applicant from continuing to use its trade mark BAVARIA within the European Community. He says that neither his Company’s BAVARIA trade mark nor the form of that trade mark which is the subject of the opposed application evokes or is confusingly similar to the BAYERISCHES BIER PGI and that the opposition is therefore entirely unjustified.

24. Furthermore, he states the Applicant has used the trade mark BAVARIA within Ireland since 1998 in connection with a number of the Applicant’s beers including BAVARIA CROWN LAGER BEER, BAVARIA PREMIUM PILS, BAVARIA PREMIUM LAGER BEER, BAVARIA 8.6 and BAVARIA NON-ALCOHOLIC BEER. The Applicant’s trade mark has been used throughout the whole of Ireland. It was originally distributed by O’Brien Fine Wines but subsequently through Gleeson and C&C Holdings Ltd. He says the Applicant’s

BAVARIA beer has been sold in the principle supermarkets in Ireland including Dunnes Stores, Spar and Tesco. It has also been sold in independent retailers and in at least 400 public houses scattered throughout Ireland. Sales of BAVARIA beer in Ireland in 1998 exceeded 500,000 litres with a retail value of more than €295,000. Sales gradually increased over the years reaching a peak in 2009 when more than 10,000,000 litres of BAVARIA beer were sold in Ireland amounting to sales in excess of €5,000,000. He provides a table of litres sold and sales revenue for the 19 years from 1998 to 2015 which shows total sales of nearly 99 million litres and sales valued at over €49 million. He says that advertising expenditure figures prior to 2007 are not available, but he provides a table showing advertising expenditure figures for the 9 years from 2007 to 2015, which show a total of more than €4,379,000 was spent on advertising BAVARIA beer in Ireland. He attached at Exhibit “BNV 2.4” copies of such advertisements which were placed on location in Ireland and in Irish publications.

25. He states the Applicant also sponsored the BAVARIA city racing in Dublin in the years 2011 and 2012, events which were well publicised and very successful. He attaches at Exhibit “BNV 2.5” pictures of those events at which the Applicant’s trade mark BAVARIA was prominently displayed. Also included in that exhibit are screenshots from the Applicant’s website www.bavaria.ie from 2007.
26. Mr Frank Swinkels attaches, at Exhibit “BNV 2.6” a copy of a Statutory Declaration made by Stephen Meleady in respect of proceedings before the Controller involving an application by his Company to extend its International Registration BAVARIA CROWN (no. 0884242) to Ireland, the contents of which Mr Frank Swinkels says are also applicable in these proceedings.
27. In that Statutory Declaration Mr Meleady states that his company (M J Gleeson & Company) is Ireland’s leading distributor of alcohol products to the on-trade and off-trade and represents a number of well-known brands in its beer, wine and spirits division including Bavaria. His company is also a wholesale supplier of packaged beer for the country’s leading brands, namely Heineken, Budweiser and Carlsberg. His company is now a subsidiary of C&C Group PLC which distributes Becks, Franziskaner and Spaten, three leading German beers in Ireland.

28. Mr Meleady states that the sales figures set out in Mr Swinkels' declaration when translated into retail sales values in Ireland can be multiplied by a factor of five to reflect the addition of excise duties and VAT. In the years 2012 and 2013, for example, the retail sales value of BAVARIA beer sold in Ireland exceeded €21.5 million and €19 million respectively.
29. He states the most popular beers in Ireland are those which originate from countries other than Germany, namely, Heineken from Holland, Budweiser from the USA and Carlsberg from Denmark. BAVARIA is ranked sixth most popular beer in Irish off licences. He estimates that sales of German beers represent less than 1% of total beer sales in the country.
30. He says that his company has been instrumental in many promotional activities which he believes have had a significant effect in increasing the brand awareness of BAVARIA beer in Ireland. The dominant colour associated with BAVARIA beer is blue and at least 20 prominent public houses throughout the country have been painted blue and emblazoned with the trade mark BAVARIA. He attaches at Exhibit "SM1" photographs of the famous public house, The Silver Tassie, which is located on a principle route from Dublin to the south of the country. Through this type of promotion and other marketing activities BAVARIA has become a very popular and widely recognised Dutch beer. He concludes his evidence by stating that, based on his experience, Irish drinkers are well aware that BAVARIA is the name of a Dutch beer and not a German beer.
31. Mr Frank Swinkels then turns his attention to the Opponent's PGI. He notes that almost 50 years following the first registration of his Company's BAVARIA mark in the Netherlands the Opponent initiated steps to register the "Bayerisches Bier" as a PGI pursuant to Council Regulation 2081/92 of 14 July 1992. He notes Article 14(3) of that Regulation reads:
- "A designation of origin or geographical indication shall not be registered where, in the light of a trade mark's reputation and renown and the length of time it has been used, registration is liable to mislead the consumer as to the true identity of the product."*
32. He notes the application for the PGI was made in 1994, but it was not registered until 28 June 2001 and argues that the long delay is due to the reservations on the suitability of the name BAYERISCHES BIER as a PGI in light of the long-established, earlier existing and renowned trade mark BAVARIA. He says these reservations resulted in the following "Whereas clauses" (2), (3) and (4) of the Regulation which read:
- (2) Following notification of the application by the German authorities to register the name 'Bayerisches Bier' as a protected geographical indication, the Dutch and*

Danish authorities informed the Commission of the existence of trade marks used for beer which include that name.

(3) The information provided confirms the existence of the name 'Bavaria' as a valid trade mark. In view of the facts and information available, it was, however, considered that registration of the name 'Bayerisches Bier' was not liable to mislead the consumer as to the true identity of the product. Consequently, the geographical indication 'Bayerisches Bier' and the trade mark 'Bavaria' are not in the situation referred to in Article 14(3) of Regulation (EEC) No 2081/92.

(4) The use of certain trade marks, for example, the Dutch trade mark 'Bavaria' and the Danish trade mark 'Høker Bajer' may continue notwithstanding the registration of the geographical indication 'Bayerisches Bier' as long as they fulfil the conditions provided for in Article 14(2) of Regulation (EEC) No 2081/92.

33. He interprets the above clauses to mean the registration of the PGI would have been refused if it would be liable to mislead consumers as to the true origin and/or identity of the product, but as the Council decided the registration of the PGI was not liable to so mislead consumers, the Council must have reached the conclusion that the PGI and his Company's trade mark BAVARIA could co-exist without consumer confusion.
34. Turning to the Opponent's evidence filed under Rule 20 Mr Frank Swinkels disputes the claim made by Mr Schloz that as the opposed mark was filed in 2014 the PGI is the earlier right. Mr Swinkels claims that it is quite clear from Regulation 1347/2001 that in comparing the respective dates of the PGI and his Company's trade mark BAVARIA, that it is his Company's trade mark which is the earlier right. He bases this claim on the disputed application being effectively an application to register his company's trade mark BAVARIA. He argues the addition of the name HOLLAND does not alter that essential fact, as it cannot be logically claimed that the PGI can prevent the use which is reflected in the numerous representations of the trade mark BAVARIA which his Company has used and continues to use in Ireland.
35. Mr Frank Swinkles notes the Opponent has abandoned all grounds of opposition mentioned in the Notice of Opposition save that in respect of Section 8(4)(a). He says the reality is that the use of the trade mark BAVARIA is not prohibited in the State by any enactment of rule of law or any provision in Community. He states, on the contrary, the use of the trade mark BAVARIA is in fact sanctioned by Regulation No. 1347/2001 and in subsequent Regulations.

36. He argues Mr Scholz is wrong in his claims that Articles 13(1)(b) and 14(1) of Regulation (EU) No. 1151/2012 are applicable to the present opposition. Mr Swinkels argues they do not apply, but that Article 14(2) does, and allows a trade mark which is applied for, registered or established in good faith within the territory of the Union before the date of application of the PGI may continue to be used and renewed for the product notwithstanding the registration of a designation of origin or geographical indication, provided that no grounds for its validity or revocation exist. In such cases use of both the PGI and the trade mark are permitted, and that is precisely the situation that exists in these proceedings.
37. He concludes his evidence by claiming it would be completely illogical if the PGI BAYERISCHES BIER could successfully be invoked to prevent his Company from continuing to use its BAVARIA mark in combination with another element, namely the name of the country in which BAVARIA beer is actually produced.
38. For his part Peter Swinkles states he is a member of the Swinkels family that owns and operates the Applicant. He provides details of his employment and the positions held by him from joining the business in 1972 to his retirement in March 2003. These included the role of Export Manager as well as being a Member and Chairman of the Board of Directors. Though retired he says he remains actively involved with the Applicant and continues to have access to the Applicant's records.
39. He states the purpose of his Statutory Declaration is to confirm the contents in the Declaration of Mr Frank Swinkels and to provide additional information regarding the use of the BAVARIA trade mark in Ireland prior to 1998. He says he was the Export Manager during that period and was responsible for deciding to begin exporting products to Ireland and other countries.
40. Mr Peter Swinkels says that while the records of export sales by the Applicant prior to 1998 have been destroyed in the normal course of its business, details of sales were reported in an overview of exports (showing exports of BAVARIA per country) as part of a report named "EXPORT-NOTA 1981/1985 Internationalisering" dated June 1987. He says he compiled the overview and presented it to the Board of Directors. He says he retained a copy of the overview for his personal archives, a copy of which he attaches at Exhibit "BNV 2.7". The document shows the volume of exports of BAVARIA beer to Ireland between 1983 and 1986 being over 6,000 hectolitres.

41. He says beer bearing the BAVARIA trade mark and manufactured by the Applicant was first sold in 1983 to a wholesaler called “VG” in Cork. The wholesaler was part of the Musgrave family group which was the predecessor of the SuperValu Group and is still owned by the Musgrave family.
42. In her Statutory Declaration Ms Willianne Slegers speaks about the history of actions taken against the Applicant by the Opponent on the pretext that the use and registration of the Applicant’s trade mark BAVARIA infringed the PGI. These include actions to try to prevent the extension of the protection the Applicant already enjoyed within the European Union. She attaches at Exhibit “BNV 3.1” a memo she prepared outlining the actions taken by the Opponent in EU Member States and other countries and the results of those actions.
43. Ms Slegers refers to Council Regulation No. 1347/2001 of 28 June 2001 which she says confirms the Applicant can continue to use its BAVARIA mark. She says the Opponent is well aware of the Applicant’s long standing and extensive use of the BAVARIA trade mark in Ireland and she states she is advised the Applicant has common law rights under Irish law which support and justify the continued use by the Applicant of the mark in Ireland. She states she is also advised that the trade mark BAVARIA is distinctive under Irish law as a result of that use.
44. For his part Norman MacLachlan states he called into one O’Brien’s off-licence store (of around 30 such stores in Ireland) on 8 July 2016 and purchased one of every German beer on sale there. There were eleven in total and he attaches at Exhibit “NM1” photocopies of the front and rear of each bottle, together with a receipt (attached at Exhibit “NM2”) for same. He says he also visited Aldi and Lidl, two well-known German owned supermarkets to find additional examples of German beers. He found only four of which he purchased three (the other being on sale only in a multi-pack) and attaches at Exhibit “NMK3” photocopies of them. He says none of the labels in Exhibits “NM1” or “NM3” contain any reference to the PGI or indeed Bavaria as a geographical location, though four of the labels refer to the town of Munchen (Munich).
45. Keith Fagan, a Director of Molson Coors Brewing Company (Ireland) Limited, states that in his 8-year experience in the sale and distribution of alcoholic beverages, including beers, in Ireland the most popular beers sold are those which originate from countries other than Germany namely, Denmark, the Netherlands and the USA. He says there are few German

beers on sale in Ireland and he estimates sales of them represents less than 1% of total beer sales in the country.

46. Mr Fagan states he has never seen any reference to the PGI on German beer labels in Ireland. He attaches at Exhibit “KF1” photographs of all the [13] German beers that he has been able to identify as being on sale in Ireland and none of them carry any reference to the PGI. Also, he says none make any reference to Bavaria as the name of a place in Germany.

Rule 22 Evidence

47. Evidence submitted by the Opponent under Rule 22 consists of a second, third and fourth Statutory Declaration of Robert Scholz, all dated 10 March 2017, and supporting evidence by way of twelve exhibits labelled “BB9” to “BB20”. The Declarations are in reply to the evidence of (a) Mr Frank Swinkels; (b) Mr Peter Swinkels and Ms Willianne Slegers; and (c) Mr MacLachlan and Mr Fagan, respectively.

48. Mr Scholz takes issue with a number of statements and claims made by Mr Frank Swinkels in his evidence. Many revolve around the interpretation of the relevant provisions of Regulation No. 1151/2012 and the impact of the provisions on the Applicant’s rights to use, continue to use, or register trade marks incorporating the term BAVARIA in respect of beer.

49. Mr Scholz is critical of the Applicant’s evidence regarding the many claimed trade mark registrations throughout the world. Of the list of marks that runs to 42 pages only three marks are protected in Ireland – all the rest being irrelevant to the proceedings at hand. The three marks are Irish registration No. 155136 “8.6 BAVARIA”, which was filed on 29 October 1992 before the PGI came into existence (and for which exclusive rights to the word Bavaria were disclaimed), “BAVARIA CITY RACING”, which is not registered in respect of beer and is therefore irrelevant, and European Union Trade Mark No. 003016615 “RED BAVARIA” which was filed in 2003 but before the Opponent started a systematic trade mark watch.

50. Mr Scholz claims Mr Swinkels’ interpretation of recitals 2, 3 and 4 of EC Regulation 1347/2001 is misleading as these refer to trade marks registered prior to the registration and publication of the PGI in July 2001. Further, recital 3 states that the registration of “Bayerisches Bier” is not liable to mislead the consumer as to the true identity of the product. Recital 4 merely points out that certain trade marks such as the trade mark BAVARIA which

were registered before the date of application for the PGI may continue after the registration of the PGI, as long as they fulfil the conditions under Article 14(2) of Regulation No. 2081/92. He presents legal arguments in reply to some of Mr Frank Swinkels' assertions and attaches at Exhibits "BB9" and "BB11" copies of a decision of the Controller⁵ to refuse to register the Applicant's "BAVARIA CROWN (logo)" as a trade mark and a judgment of the Tribunal de Grande Instance of Paris⁶ rejecting French trade mark application "8.6 GOLD BAVARIA (logo)", respectively. Both decisions found the Opponent's PGI was a legitimate barrier to the registration of the respective marks.

51. Mr Scholz also questions the relevance and admissibility of certain of Mr Frank Swinkels' evidence. He attaches at Exhibit "BB10" beer statistics published on the website of "The Brewers of Europe" showing market share of BAVARIA branded beer in Ireland of between 0.56% and 2.12% of the total beer sales between 2003 and 2015.

52. I would summarise Mr Scholz's second Declaration as an in-depth critique of Mr Frank Swinkels' evidence wherein he claims the Applicant has produced no evidence nor shown any valid reason as to why the Applicant's mark should be protected in Ireland. I feel it is not necessary for me to make any other comment on his Second Declaration but suffice to say I have considered his evidence in its entirety in making my decision.

53. In his third Statutory Declaration Mr Scholz states that anything Mr Peter Swinkels says regarding the use of the mark BAVARIA in Ireland since 1983 is irrelevant to this opposition as it has nothing to do with the use of that BAVARIA mark and is only concerned with the Applicant's attempt to register BAVARIA HOLLAND.

54. He then turns his attention to the Statutory Declaration of Ms Slegers regarding various legal actions taken in Europe involving the parties. In summary he says these actions are either irrelevant (the Spanish and Italian actions concern marks that predate the effective date of the PGI), find in favour of the Opponent (decision of the German Courts), resulted in the withdrawal of the opposed applications by the Applicant (France and the UK), the amendment of the goods to remove "beer" (UK), cancellation of "8.6 GOLD BAVARIA" registration (France), rejection of the BAVARIA CROWN application (Ireland) and the withdrawal of applications for BAVARIA HOLLAND following objections by National

⁵ The Controller's decision dated 21 April 2016

Offices (Bulgaria, Slovenia, Czechia, Poland and Slovakia). However, he admits the Spanish and Portuguese Offices rejected the Opponent's opposition and registered the BAVARIA HOLLAND mark. Mr Scholz attaches at Exhibits "BB12" and "BB13" copies of the decisions or notifications from National Intellectual Property Offices in respect of some of those proceedings.

55. In his fourth Statutory Declaration Mr Scholz addresses the evidence of Mr Keith Fagan and Mr Norman MacLachlan. In summary he states the declarations made by the two gentlemen and the exhibits selected by them reveal a lack of knowledge of the PGI system and of Bavaria and Bavarian beer. Their exhibits do not support what the declarants claim, i.e. that none of the labels presented refer to the PGI or make any reference to Bavaria as a geographical region where beers are produced. He said they have mixed beer labels of non-Bavarian breweries and non-PGI breweries from Bavaria with beer labels of Bavarian PGI-approved breweries. He says a distinct lack of care appears to have been taken with the preparation of the declarations as all of the Bavarian PGI breweries either refer on their labels to the PGI "Bayerisches Bier" or, in case of Munich breweries "Munchener Bier", which he says is equivalent to the PGI, or to Bavaria as the geographical origin of the beers. He attaches at Exhibit "BB14" a list of all breweries approved to use the PGI and at Exhibits "BB15" to "BB20" labels, website extracts and other materials in respect of the use and the conditions of use of the PGI.

The Hearing

56. At the Hearing the Opponent was represented by Ms Yvonne McNamara BL, instructed by Louise Carey, Trade Mark Attorney, of Tomkins & Co., and the Applicant by Mr Paul Coughlan BL, instructed by Norman MacLachlan, Trade Mark Attorney of MacLachlan and Donaldson.

57. At the outset of her submission Ms McNamara focused on the two provisions in the relevant law upon which the opposition is grounded. The main one is Regulation (EU) No. 1151/2012 of the European Parliament and Council on quality schemes for agricultural products and foodstuffs, and the subsidiary one Section 8(4)(a) of the Trade Marks Act 1996, insofar as that section allows for the refusal of an application if the use of the mark applied for is

⁶ Judgement of 9 December 2016, Reference No. 14/16395

“prohibited in the State by an enactment or rule of law or by any provision of Community law”.

58. Ms. McNamara submitted the Controller has a duty to apply the provisions of the Regulation because it has the full force of law in the State without any requirement for it to be underpinned by legislative measures transposing it into Irish law. She spoke about the supremacy of EU law as established by the European Court of Justice (ECJ) in *Costa v ENEL* Case 6/64. She argued that confirmation of the duty to apply EU law falls on all decision-making bodies in the Member States (and not just the courts) has been recently and unequivocally given by the Court of Justice of the European Union (CJEU) in *Minister for Justice v Workplace Relations Commission* (Case C-378/17) where the Court reaffirmed that duty even to the point of disapplication of national legislation by ruling at paragraphs 38 to 39:

“38. As the Court has repeatedly held, that duty to disapply national legislation that is contrary to EU law is owed not only by national courts, but also by all organs of the State — including administrative authorities — called upon, within the exercise of their respective powers, to apply EU law ...”

“39. It follows that the principle of primacy of EU law requires not only the courts but all the bodies of the Member States to give full effect to EU rules.”

59. Ms McNamara recalled the application for the PGI was made on 28 September 1993 – almost as soon as it could be after the coming into effect of the relevant EU legislation⁷. The application was submitted by the German government to the European Commission on 20 January, 1994 and it was ultimately granted, via Council Regulation 1347/2001 of 28 June 2001, which entered into force on 5 July 2001. The registration details set out the exacting characteristics as to the type of fermentation, the characteristics of the wort, alcohol content by volume, colour and hop bitter content required for each of the 13 types of beer that must be met before the BAYERISCHES BIER can be used on those types of beer.

60. Ms McNamara argued Article 14(1) of the Regulation is absolute in its application and bars registration of a mark where the use of it would contravene Article 13(1) of the Regulation. The bar to registration under Article 14(1) is unaffected by the possibility of a right to continued use of a mark under Article 14(2) (based on accrued prior rights), but which she argued does not apply in this case. Therefore, the only question for determination under the

⁷ Council Regulation 2081/92 of 14 July 1992 which entered into force on 26 July 1993

first ground of opposition is whether the use of the opposed mark would contravene Article 13(1).

61. Ms McNamara argued that registration should be precluded under Article 13(1)(a) as the direct or indirect commercial use of the mark on products which are comparable to the PGI (i.e. beer) but in respect of products not covered by the PGI (i.e. they are not Bavarian beer) is expressly forbidden. It must also be precluded under Article 13(1)(b) as the use of the mark would evoke the PGI – another mandatory ground for refusal - even in circumstances where the true origin of the product is indicated.
62. Ms McNamara argued that while the Applicant seeks to rely on its claimed earlier and continuous use of its BAVARIA mark in Ireland, what cannot be overlooked is that the Applicant has not demonstrated acquired rights to the mark in question, which she argued is of recent provenance and the earliest application to register it dates only to 2009. Accordingly, use of the opposed mark is prohibited under Article 13(1) of the Regulation, not allowed under Article 14(2) and therefore the elements of the second ground of opposition under Section 8(4)(a) of the Act are made out.
63. Mr Coughlan opened his submissions by arguing the Notice of Opposition is lacking as it does not explicitly base itself on the PGI Regulations or identify what elements of the PGI Regulations the Opponent is relying upon, and therefore the Applicant cannot adequately address unspecified grounds.
64. I will deal with this point now. Mr Coughlan is correct in that in its Notice of Opposition the Opponent did not identify the specific elements of the Regulations that it was relying upon. The Opponent simply stated its PGI is valid and is in full effect in all Member States of the EU. I do not find such a statement to be lacking or incapable of being interpreted. I am satisfied the Opponent outlined clearly and precisely from the outset that its case was based on its BAYERISCHES BIER PGI. The battle was joined on that basis and the Applicant at all times defended its application against claims that it infringes the PGI. The materials filed, and arguments made in declarations by the Applicant show that throughout these proceedings the Applicant was never in any doubt that the Opponent's case was centred on the PGI Regulations.

65. Mr Coughlan submitted that no evidence of any reputation in the PGI was put into evidence – so the opposition cannot succeed on Article 13(1)(a). He argued that under Irish trade mark law the opposition is doomed to fail as Bavarian beer does not have any reputation in Ireland and the Opponent has no knowledge of Ireland or beers in Ireland. Furthermore, the Opponent has not shown Irish consumers are up to spec with regards to Bavarian beer having particular standards or qualities. Evidence provided by the Applicant shows that sales of the Applicant’s BAVARIA branded beer in Ireland are on a par with the total combined sale of all German beers in Ireland. In light of these facts Mr Coughlan urged me not to make any assumptions, leaps of faith or to draw any inferences as regards Irish beer consumers’ knowledge of the Opponent and/or its PGI.

66. Mr Coughlan referred to any earlier decision wherein I refused to allow the Applicant’s application for *BAVARIA CROWN*⁸ to proceed to registration, but in doing so I acknowledged that: “*The Applicant is a Dutch company that has long used the mark BAVARIA for beer.*” He reminded me that I also agreed with the Applicant’s position that “... *at the date of Council Regulation No. 1347/2001 the trade mark BAVARIA was in use in Ireland and ... that use was established as far back as 1998*” and the Applicant “... *would have been (and remains) able to assert common law rights and to sue in passing off if the need arose*”.

67. He drawn my attention to the fact that in *BAVARIA CROWN* I refused that mark because it evoked the Opponent’s PGI and set out the test as regards evocation in the following terms:

“ 94. ... *The intended purpose of the PGI registration system is not to protect names per se, but to protect products. Therefore, this case is not about the protection of the words BAYERISCHES BIER, it is about protecting a certain product, that product being beer brewed in a specific geographical location (Bavaria) and brewed to exacting standards and specifications that are synonymous with that location and for which beer from that location has become renowned. Therefore, the evocation test is not as between the words BAVARIA CROWN and BAYERISCHES BIER, it is between BAVARIA CROWN and the product protected by the PGI, namely Bavarian beer.*

95. *In conducting this test, I am satisfied that the average consumer does not have to know that there are such things as Protected Geographical Indications or that there is a specific PGI in respect of BAYERISCHES BIER. Further, the consumer does not, if he encounters the words BAYERISCHES BIER on a beer product, need to understand the meaning of the term. Further still, the*

⁸ Decision date 21 April 2016

consumer does not need to know that beer from Bavaria is brewed strictly in accordance with purity laws and exacting specifications. In my opinion, the foregoing considerations are not important factors pertinent to the evocation test. The all-important factor is whether the consumer, who encounters the Applicant's mark BAVARIA CROWN on a beer product, is caused to think the beer product is from Bavaria, or that the beer is brewed using techniques and standards that put it on a par with Bavarian beer.

...

98. *In the present case, for evocation of the Opponent's PGI to occur the consumer need know only two simple things. Firstly, a no-brainer, that the product they are consuming is a beer. Secondly, that there is a geographical location called Bavaria. The consumer need not even know where Bavaria is (though I am satisfied the average Irish beer drinker would be well aware that Bavaria is in Germany). All that is sufficient is that the consumer puts beer and Bavaria together and as a result thinks the beer is from Bavaria or that it is brewed using Bavarian brewing methods. I am completely satisfied the average consumer would do just that, because the evocation of the Opponent's PGI is, in my opinion, inescapable and inevitable."*

68. Mr Coughlan argued that the circumstances in *BAVARIA CROWN* are not repeated in these proceedings, because the words *BAVARIA HOLLAND* cannot evoke in the mind of the average Irish beer consumer the geographical area of Bavaria in Germany or beer from the Bavaria region of Germany.

69. He maintained the word *HOLLAND* (which is commonly used by Irish people when referring to the Netherlands) completely negates the possibility of such evocation. It is a name known to Irish consumers and refers to a country that the consumer will know to be different to Germany. By way of analogy he compared it to the city of Paris, Texas in the United States of America (USA) that gives its name to the 1984 road movie starring the late Harry Dean Stanton. He argued the reference to Texas dominates to the point that everyone knows it refers to somewhere in Texas and not to the capital city of France.

70. He argued that in *BAVARIA CROWN* I accepted the Applicant had used its *BAVARIA* mark in respect of beer and that it had become distinctive in the State as regards the Applicant's beer. This fact necessarily reinforces the negation of evocation achieved through the name *HOLLAND*. The Applicant is perfectly entitled to rely on this fact, particularly as the Applicant's use of *BAVARIA* in the State preceded the registration of the PGI in 2001.

71. Mr Coughlan also argued the following points:

- a. The Applicant owns the brand BAVARIA in Ireland as it was the first to use it here.
- b. There is no false message as regards to origin as the Applicant is clearly stating its beer is from the Netherlands.
- c. There is no evidence the Opponent has ever made any attempt to injunct the Applicant for its use of the word BAVARIA. Not even one letter of complaint regarding the use of the brand in Ireland was ever sent.
- d. No legal action is possible as regards the Applicant's use of its brand BAVARIA and the Opponent cannot stop the Applicant from continuing to use it.
- e. The Opponent is constructing an artificial complaint as there is and never was any confusion in the marketplace.
- f. The Opponent cannot object to the Applicant using the word HOLLAND, so its objection is to the BAVARIA element, which the Applicant has every right to use and to continue to use: so, no objection under Section 8(4)(a) can succeed.
- g. Article 13(1) of the Regulation is EU law, but the application is in respect of Ireland alone, so the competent authority must come back to Irish trade mark law and what is allowed under Irish law.
- h. The Applicant has rights in its earlier registered trade mark BAVARIA and would be allowed to take an action for passing off under Section 7(2) of the Act.
- i. The concept of a European consumer does not exist, so the relevant consumer is deemed to be Irish.

Decision

72. It is clear that during its examination of the application for the registration of the Opponent's PGI the Commission was made aware of the existence and long-standing use by the Applicant of its BAVARIA trade mark in the Netherlands. That examination resulted in the Commission confirming that the Opponent's trade mark BAVARIA was valid. It specifically noted this in the second and third recitals to Council Regulation (EC) No. 1347/2001 where it is stated:

“(2) Following notification of the application by the German authorities to register the name "Bayerisches Bier" as a protected geographical indication, the Dutch and Danish authorities informed the Commission of the existence of trade marks used for beer which include that name.

(3) The information provided confirms the existence of the name "Bavaria" as a valid trade mark. In view of the facts and information available, it was, however, considered that registration of the name "Bayerisches Bier" was not liable to mislead the consumer as to the true identity of the product. Consequently, the

geographical indication "Bayerisches Bier" and the trade mark "Bavaria" are not in the situation referred to in Article 14(3) of Regulation (EEC) No 2081/92."

73. The registrability of the mark at issue must be assessed as of its date of application (29 September 2014) and, accordingly, the legislation governing the impact of the PGI on the mark is Regulation (EU) no. 1151/2012 (hereinafter the "Regulation") which entered into force on 3 January 2013. The Regulation repealed and replaced Council Regulation (EC) no. 510/2006 which in turn had repealed and replaced Council Regulation (EC) no. 2081/92, pursuant to which the PGI was initially registered. Any rights awarded under the earlier regulations were automatically deemed registered under each successive regulation.

74. Article 14(1) of the Regulation sets out the grounds for the refusal of a trade mark application based on a registered PGI and Article 14(2) allows for the continued use of trade marks that contravene Article 13(1) providing that their use and/or registration predated that of the registered PGI. In such circumstances use of both the PGI and the trade mark is allowed.

75. When the Commission registered the PGI it explicitly provided for the continued use of the Opponent's BAVARIA mark, as long as the mark fulfilled the conditions provided for in the legislation prevailing at the relevant time, specifically Article 14(2) of the Regulation, which is written in the following terms:

2. Without prejudice to Article 6(4), a trade mark the use of which contravenes Article 13(1) which has been applied for, registered, or established by use if that possibility is provided for by the legislation concerned, in good faith within the territory of the Union, before the date on which the application for protection of the designation of origin or geographical indication is submitted to the Commission, may continue to be used and renewed for that product notwithstanding the registration of a designation of origin or geographical indication, provided that no grounds for its invalidity or revocation exist under Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark or under Directive 2008/95/EC. In such cases, the use of the protected designation of origin or protected geographical indication shall be permitted as well as use of the relevant trade marks.

76. Nothing in the intervening years has altered that position and the BAVARIA mark continues to enjoy the legal protections afforded registered marks in Ireland. It is fair to say that Council Regulation (EC) No. 1347/2001 specifically mandates co-existence and acknowledges that there are earlier rights in the word BAVARIA. In that regard, Mr Coughlan argued the Opponent cannot be permitted to invoke a ground of opposition that is

expressly premised on the use of the BAVARIA HOLLAND mark being “*prohibited in the State*” purely because it contains the word BAVARIA.

77. The Applicant’s long-standing use of its BAVARIA mark has been recognised by the Commission and evidence of its use in Ireland over a number of years has been provided, but it is not the mark at issue here. The Regulation makes it clear that existing marks (and it specifically refers to the Applicant’s BAVARIA trade mark) can continue to be used. However, it is equally clear that no trade mark applications filed after the date of registration of the PGI can proceed to registration if the mark offends against any of the provisions of Article 13 of that regulation. While the Applicant’s BAVARIA simpliciter mark dates back to the late 1990’s there is no evidence to prove or even suggest the BAVARIA HOLLAND mark existed and was used as a trade mark prior to the date of registration of the PGI. Accordingly, the coexistence and co-use provisions in Article 14(2) do not apply and cannot be relied upon by the Applicant to secure registration of a mark that was not used prior to the protection of the Opponent’s PGI.

78. The question now rests on whether or not BAVARIA HOLLAND falls foul of the provisions of the 2012 Regulation, in particular Article 13, which provides as follows:

““1. *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 where those products are comparable to the products registered under that name or where using the name exploits the reputation of the protected name, including when those products are used as an ingredient;

(b) any misuse, imitation or evocation, 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, including when those products are used as an ingredient;

(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.”

79. While Article 13(1) sets out what a PGI is protected against, it must be considered in conjunction with Article 14(1) which concerns the relationship between trade marks and Protected Geographical Indications, and which provides for the mandatory refusal of any application to register a trade mark, the use of which would contravene Article 13(1). Article 14(1) provides as follows:

“1. Where a designation of origin or a geographical indication is registered under this Regulation, the registration of a trade mark the use of which would contravene Article 13(1), and which relates to a product of the same type shall be refused if the application for registration of the trade mark is submitted after the date of submission of the registration application in respect of the designation of origin or the geographical indication to the Commission.

Trade marks registered in breach of the first subparagraph shall be invalidated.

The provisions of this paragraph shall apply notwithstanding the provisions of Directive 2008/95/EC.”

80. I will consider the provisions of Article 13(1) starting with provision (d). It is unclear what actions, outside of those mentioned in (a), (b) or (c) above, constitutes “*any other practice liable to mislead the consumer*”. And as the Opponent did not identify any practice which might relate to this prohibition I must, without further ado, find the Applicant has not engaged in action that would disqualify the application under this provision.

81. Moving next to provision (a) relating to products not covered by the PGI registration but for which the Applicant seeks trade mark registration. There are no such products as the product for which registration is sought is beer, which is the product covered by the PGI.

82. Turning now to provision (c). The Applicant is a Dutch company that has long used the mark BAVARIA for beer. No evidence was advanced by the Opponent to suggest the Applicant has ever made any claims that the Applicant’s beer originated in any place other than the Netherlands, or that the nature or essential qualities of the beer are anything other than Dutch. Furthermore, the inclusion of the word HOLLAND in the mark provides ample evidence that the Applicant is not seeking to mislead consumers as regards the origin of the product bearing the mark but is seeking to assure consumers that the product is a Dutch beer. Also, in my opinion, by using the mark at issue the Applicant is not seeking to convey a false impression as regards the essential nature of the beer to be offered under the mark. Nor is there any evidence to suggest the Applicant is attempting to imitate any brewing techniques or quality standards other than those which it has long used in brewing its own already well-

known beer. Therefore, I find the conditions allowed for in (c) are not present and, in that regards, there is no consequential basis for refusing the mark.

83. Finally, looking at provision (b) and the question of whether or not BAVARIA HOLLAND misuses, imitates or evokes the product protected by the PGI. I am satisfied the Applicant is neither misusing nor imitating the product protected by the PGI. The Applicant is merely attempting to register a sign the dominant component of which it already owns rights to. The Applicant is seeking to use the mark applied for in the same legitimate way it uses its earlier BAVARIA mark, and such use does not fall into the realm of misuse that the regulation protecting PGIs seeks to avoid.

84. What remains is the issue of evocation. Both Ms McNamara and Mr Coughlan agreed that the meaning of evocation was correctly defined by the CJEU in *Consorzio per la Tutela del Formaggio Gorgonzola v. Kaserei Champignon Hofmeister GmbH & Co. KG*⁹ where at paragraph 25 the Court found the following:

“25. Evocation, as referred to in Article 13(1)(b) of Regulation No 2081/92, 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 triggered in his mind is that of the product whose designation is protected.

85. In considering the issue of evocation I need not concern myself with the criteria that must be brought into play when comparing two trade marks, in particular the visual, aural and conceptual similarities between them which are important in determining a likelihood of confusion based on similarity. This is because the courts have found that evocation can arise where there is an absence of a likelihood of confusion. In *TOSCORO*¹⁰ the CJEU found:

“... there could be evocation of a protected designation even in the absence of any likelihood of confusion between the goods concerned, since what matters is, in particular, that an association of ideas regarding the origin of the products is not created in the mind of the public, and that a trader does not take undue advantage of the reputation of the PGI.”

86. Furthermore, the Regulation does not mention similarity or confusion or the need for these factors to be considered. It appears to me the Regulation bestows upon PGIs a much broader level of protection than that afforded to a trade mark. The intended purpose of the PGI registration system is not to protect names per se, but to protect products. Therefore, this case

⁹ Case C-87/97 (4 March 1999)

¹⁰ *Roberto Mengozzi v European Union Intellectual Property Office* (Case T-510/15)

is not about the protection of the words BAYERISCHES BIER, it is about protecting a certain product, that product being beer brewed in a specific geographical location (Bavaria) and brewed to exacting standards and specifications that are synonymous with that location and for which beer from that location has become renowned. Therefore, the evocation test is not as between the words BAVARIA HOLLAND and BAYERISCHES BIER, it is between BAVARIA HOLLAND and the product protected by the PGI, namely Bavarian beer.

87. At the Hearing Mr Coughlan argued the presence of the word HOLLAND in the Applicant's mark rendered evocation impossible. Mr Coughlan argued the Applicant's mark conveys the true origin of the product and used the analogy of the film tile PARIS TEXAS which he said clearly informed the public that the film was about a place in the USA and not the capital of France. I understand his point, but while there is an actual place named Paris in Texas the Applicant has not identified a place called Bavaria in the Netherlands. I am satisfied the Applicant is not seeking to convey the false message that its beer comes from a place called Bavaria in Holland but is attempting to convey the truthful message that its beer is brewed in a brewery in the Netherlands that sells beer under the BAVARIA brand. However, "true origin" in terms of PGIs refers to the actual place of origin of the product (e.g. Ireland in the case of Irish Whiskey and Champagne in respect of Champagne) and not the brand origin. Accordingly, different Irish consumers might understand the messages differently and it is therefore possible that some Irish consumers, in looking at the Applicant's mark, might think that Bavarian beer comes from Holland (the Netherlands).

88. Another argument put forward by the Applicant was that the Opponent's PGI is not known in Ireland and does not feature on German beer sold here. Both Mr MacLachlan and Mr Fagan testified to that. However, I found certain of the combined evidence of Mr MacLachlan and Mr Fagan to be curious. One of the beers (Ayinger) included in Mr MacLachlan's list and three of the beers (Maisels Weisse, Weihenstephaner and Holzar Bier) in Mr Fagan's list clearly contain the words "BAYERISCHES BIER" as well as the EU PGI stamp on their rear labels (albeit that the words on the stamp are "Geschützte Geografische Angabe" - the German translation of the English term "Protected Geographical Indication"). Also, despite Mr Fagan's efforts to identify all the German beers available for sale in Ireland his evidence does not contain eleven of the German beers Mr MacLachlan refers to in his evidence.

89. While the evidence points to low sales of German beer (approximately 1% of total beer sales) in Ireland, I am satisfied that tens of thousands of Irish adults have consumed German beer

here. While some German beers are not Bavarian beer, and therefore are not entitled to use the PGI, clearly some are and do.

90. In any event, I am satisfied that the average consumer does not have to know that there are such things as Protected Geographical Indications or that there is a specific PGI in respect of BAYERISCHES BIER. Further, the consumer does not, if he encounters the words BAYERISCHES BIER on a beer product, need to understand the meaning of the term. Further still, the consumer does not need to know that beer from Bavaria is brewed strictly in accordance with purity laws and exacting specifications. In my opinion, the foregoing considerations are not important factors pertinent to the evocation test. The all-important factor is whether, as a result of encountering the Applicant's mark BAVARIA HOLLAND on a beer product, the consumer's mind drifts to thoughts of the product being from Bavaria, or, if the consumer is aware of the Bavarian brewing purity laws and standards, that the beer is brewed using techniques and standards that put it on a par with Bavarian beer.

91. In a number of cases before the CJEU and other European Courts the courts found:

- a. CAMBOZOLA in respect of cheese evoked GORGONZOLA;¹¹
- b. GRANA BIRAGHI in respect of cheese evoked GRANA PADANO¹²;
- c. TOSCORO in respect of olive oil evoked TOSCANO¹³ and
- d. PARMESAN in respect of hard cheese evoked PARMIGIANA REGGIANO¹⁴

92. It is abundantly clear from these examples that applications for trade marks are being refused as a result of the PGI evocation test that would never be rejected on the basis of a similarity or likelihood of confusion test between two trade marks. It appears to me the European legislators have bestowed what can be considered a superior level of protection upon PGI's over and above that accorded to trade marks. Furthermore, the CJEU has ruled the refusal of trade mark applications, on the basis that the mark evokes a PGI, can result even where there is no phonetic and/or visual similarity between the disputed mark and the PGI, or in the

¹¹ Case C-87/97

¹² Case T-291/03

¹³ Roberto Mengozzi v European Union Intellectual Property Office (Case T-510/15)

¹⁴ Case C-132/05

absence of any partial incorporation of the PGI. The CJEU confirmed this *Glen Buchenbach*¹⁵ were the Court ruled as follows:

“Article 16(b) of Regulation No 110/2008 must be interpreted as meaning that, for the purpose of establishing that there is an ‘evocation’ of a registered geographical indication, the referring court is required to determine whether, when the average European consumer who is reasonably well informed and reasonably observant and circumspect is confronted with the disputed designation, the image triggered directly in his mind is that of the product whose geographical indication is protected. In making that determination, the referring court, in the absence of (i) any phonetic and/or visual similarity between the disputed designation and the protected geographical indication and (ii) any partial incorporation of that indication in that designation, must take account of the conceptual proximity, if any, between the designation and the indication.”

92. The goods at issue are beers, the sale of which in Ireland is restricted to persons over 18 years of age. The average consumers are therefore Irish adults who are deemed to be reasonably well informed and reasonably observant and circumspect when it comes to purchasing beer. Beer consumers generally know the provenance of their preferred tipples and would recognise certain brands as being from certain countries. Beers are rarely branded with a country name, but when it does occur the consumer will notice and bring the place to mind.
93. In this case the Applicant is using the word HOLLAND to persuade consumers that the beer is from Holland. The Applicant emphasised the HOLLAND element in the disputed mark, claiming it negates any evocation of Bavaria because it is a clear statement the beer is from Holland. I disagree. The word BAVARIA is by far the dominant element of the mark and, in my opinion, renders all other elements insignificant. While BAVARIA is undoubtedly the star of the show, HOLLAND plays no more than a non-talking, walk-on part. It is significantly smaller than the BAVARIA element and is depicted in a different font and different colour. In my opinion, it may even go unnoticed.
94. I am satisfied that adult Irish consumers know Bavaria refers to a place, though, albeit highly unlikely, they may not know that it is in Germany. Even if the word HOLLAND was noticed, it would lead some consumers to think Bavaria was in Holland, or cause others to question their prior understanding that Bavaria was in Germany, or others to instantly recognise that the label is misleading because they know for a fact that Bavaria is a region in Germany. All considered, and despite the Applicant’s use of the word HOLLAND, I am satisfied the consumer will bring to mind a place called Bavaria and such calling to mind will produce the close conceptual proximity between the product (Bavarian Beer) protected by the PGI and

¹⁵ Scotch Whisky Association v Michael Klotz (Case C-44/17)

the goods (beer) for which the BAVARIA HOLLAND trade mark seeks registration, which, in light of the European Court of Justice ruling, I must take into account.

95. In light of the extremely close conceptual proximity, I am satisfied evocation of the Opponent's PGI is an inescapable and inevitable outcome. It is unavoidable when the consumer puts Bavaria and beer together, which in my opinion is exactly what the consumer will do. I am satisfied the issue at hand is analogous to use of the marks Parma Holland for ham or Scotland Holland for whisky, both of which I have no doubt would cause consumers to evoke the protected PGI's Parma Ham and Scotch Whisky.
96. The reality is that while the Applicant can continue to use and renew any of its BAVARIA trade marks that were used or registered prior to the date of the PGI, it cannot register BAVARIA marks, even these that are completely identical to the ones registered prior to the entry into force of the PGI, if such marks infringe the PGI. I interpret the Regulation as meaning: whatever you already have you can keep, but from now on you will not be given anything that would infringe the PGI.
97. I find the BAVARIA HOLLAND logo mark impinges on protections afforded the Opponent's BAYERISCHES BIER PGI as it undoubtedly evokes the product which is protected by the PGI (Bavarian beer) and, as there are no exceptions to those protections and the refusal is mandatory, I must refuse to allow the application to proceed to registration.
98. For clarity and completeness, I have refused the application on both grounds of opposition, (i) the mandatory obligation imposed on the Controller by Regulation 1151/2012 on protected geographical indications to refuse registration if the provisions of Article 14(1) of the Regulation apply - in this case the use of the mark contravenes Article 13(1)(b) of the Regulation (based on evocation); and (ii) the application offends Section 8(4)(a) of the Act which imposes a mandatory obligation on the Controller to refuse to register a mark when "*its use is prohibited in the State by any enactment or rule of law or by any provision of Community law*", which also ultimately maps back to Article 13(1)(b) of the Regulation.

Dermot Doyle
Acting for the Controller
31 July, 2019