

Court of Justice EU, 22 December 2010, Bayerische Brauerbund v Bavaria



v
IR No 645 349



**PROTECTED GEOGRAPHICAL INDICATIONS
- TRADEMARK LAW**

Rule applicable to conflict between trademark and Protected Geographical Indication – simplified procedure

• Article 14(1) of Regulation No 2081/92 is applicable for resolving the conflict between a name validly registered as a PGI in accordance with the simplified procedure under Article 17 of that regulation and a trade mark corresponding to one of the situations referred to in Article 13 of that regulation relating to the same type of product, the application for registration of which was submitted both before the registration of that name and before the entry into force of Regulation No 692/2003.

• The date of the entry into force of the registration of that name constitutes the reference date for the purposes of Article 14(1) of Regulation No 2081/92.

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Court of Justice EU, 22 December 2010

(K. Lenaerts, D. Šváby, R. Silva de Lapuerta (Rapporteur), E. Juhász and T. von Danwitz)

JUDGMENT OF THE COURT (Third Chamber)

22 December 2010 (*)

(Reference for a preliminary ruling – Regulations (EEC) No 2081/92 and (EC) No 510/2006 – Temporal application – Article 14 – Registration in accordance with the simplified procedure – Relations between trade marks and protected geographical indications)

In Case C-120/08,

REFERENCE for a preliminary ruling under Article 234 EC from the Bundesgerichtshof (Germany), made by decision of 20 December 2007, received at the Court on 20 March 2008, in the proceedings
Bavaria NV

v

Bayerischer Brauerbund eV,
THE COURT (Third Chamber),
composed of K. Lenaerts, President of the Chamber, D. Šváby, R. Silva de Lapuerta (Rapporteur), E. Juhász and T. von Danwitz, Judges,
Advocate General: J. Mazák,
Registrar: B. Fülöp, Administrator,
having regard to the written procedure and further to the hearing on 10 June 2010,
after considering the observations submitted on behalf of:

– Bavaria NV, by G. van der Wal, advocaat, and H. Kunz-Hallstein, Rechtsanwalt,
– Bayerischer Brauerbund eV, by R. Knaak, Rechtsanwalt,
– the German Government, by J. Möller and J. Kemper, acting as Agents,
– the Greek Government, by I. Khalkias and S. Papaïannou, acting as Agents,
– the Italian Government, by G. Palmieri, acting as Agent, and F. Arena, avvocato dello Stato,
– the Netherlands Government, by C. Wissels and J. Langer, acting as Agents,
– the European Commission, by N. Rasmussen, G. von Rintelen and T. van Rijn, acting as Agents,
after hearing the [Opinion of the Advocate General at the sitting on 16 September 2010](#),
gives the following

Judgment

1 This reference for a preliminary ruling concerns the interpretation of Article 14(1) of Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ 1992 L 208, p. 1) and Article 14(1) of Council Regulation (EC) No 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ 2006 L 93, p. 12), with regard to protected geographical indications ('PGI') registered in accordance with the simplified procedure under Article 17 of Regulation No 2081/92.

2 The reference has been made in proceedings between Bavaria NV ('Bavaria') and Bayerischer Brauerbund eV ('Bayerischer Brauerbund') regarding Bavaria's right to use a trade mark containing the word 'Bavaria', in view of the PGI 'Bayerisches Bier' registered by virtue of Council Regulation (EC) No 1347/2001 of 28 June 2001 supplementing the Annex to Commission Regulation (EC) No 1107/96 on the registration of geographical indications and designations of origin under the procedure laid down in Article 17 of Regulation No 2081/92 (OJ 2001 L 182, p. 3).

Legal context

Regulation No 2081/92

3 Article 6 of Regulation No 2081/92 provides:

‘1. Within a period of six months the Commission shall verify, by means of a formal investigation, whether the registration application includes all the particulars provided for in Article 4.

The Commission shall inform the Member State concerned of its findings.

2. If, after taking account of paragraph 1, the Commission concludes that the name qualifies for protection, it shall publish in the Official Journal of the European Communities the name and address of the applicant, the name of the product, the main points of the application, the references to national provisions governing the preparation, production or manufacture of the product and, if necessary, the grounds for its conclusions.

3. If no statement of objections is notified to the Commission in accordance with Article 7, the name shall be entered in a register kept by the Commission entitled “Register of protected designations of origin and protected geographical indications”, which shall contain the names of the groups and the inspection bodies concerned.

4. The Commission shall publish in the Official Journal of the European Communities:

- the names entered in the Register,
- amendments to the Register made in accordance with Article 9 and 11.

5. If, in the light of the investigation provided for in paragraph 1, the Commission concludes that the name does not qualify for protection, it shall decide, in accordance with the procedure provided for in Article 15, not to proceed with the publication provided for in paragraph 2 of this Article.

Before publication as provided for in paragraphs 2 and 4 and registration as provided for in paragraph 3, the Commission may request the opinion of the Committee provided for in Article 15.’

4 Article 13(1) of Regulation No 2081/92 provides:

‘Registered names shall be protected against:

(a) any direct or indirect commercial use of a name registered in respect of products not covered by the registration in so far as those products are comparable to the products registered under that name or in so far as using the name exploits the reputation of the protected name;

(b) any misuse, imitation or evocation, even if the true origin of the product 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;

(c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product, 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 public as to the true origin of the product.

Where a registered name contains within it the name of an agricultural product or foodstuff which is considered generic, the use of that generic name on the appropriate

agricultural product or foodstuff shall not be considered to be contrary to (a) or (b) in the first subparagraph.’

5 Article 14 of Regulation No 2081/92 reads:

‘1. Where a designation of origin or geographical indication is registered in accordance with this Regulation, the application for registration of a trade mark corresponding to one of the situations referred to in Article 13 and relating to the same type of product shall be refused, provided that the application for registration of the trade mark was submitted after the date of the publication provided for in Article 6(2).

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

This paragraph shall also apply where the application for registration of a trade mark was lodged before the date of publication of the application for registration provided for in Article 6(2), provided that that publication occurred before the trade mark was registered.

2. With due regard for Community law, use of a trade mark corresponding to one of the situations referred to in Article 13 which was registered in good faith before the date on which application for registration of a designation of origin or geographical indication was lodged may continue notwithstanding the registration of a designation of origin or geographical indication, 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 Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks [OJ 1989 L 40, p. 1].

3. 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.’

6 Article 17 of Regulation No 2081/92 provides:

‘1. Within six months of the entry into force of the Regulation, Member States shall inform the Commission which of their legally protected names or, in those Member States where there is no protection system, which of their names established by usage they wish to register pursuant to this Regulation.

2. In accordance with the procedure laid down in Article 15, the Commission shall register the names referred to in paragraph 1 which comply with Articles 2 and 4. Article 7 shall not apply. However, generic names shall not be added.

3. Member States may maintain national protection of the names communicated in accordance with paragraph 1 until such time as a decision on registration has been taken.’

Regulation (EC) No 1107/96

7 The first and second recitals in the preamble to Commission Regulation (EC) No 1107/96 of 12 June 1996 on the registration of geographical indications and designations of origin under the procedure laid down in Article 17 of Regulation No 2081/92 (OJ 1996 L 148, p. 1) read:

‘Whereas, pursuant to Article 17 of Regulation (EEC) No 2081/92, in the six months following the entry into

force of that Regulation the Member States forwarded to the Commission the legally protected names or names established by usage they wished to register; Whereas, following examination of those names in accordance with Regulation (EEC) No 2081/92, some of them were found to be in accordance with the provisions of that Regulation and eligible to be registered and protected at Community level as geographical indications or designations of origin’.

8 Article 1 of Regulation No 1107/96 provides:

‘The names listed in the Annex shall be registered as [PGI] or protected designations of origin (PDO) pursuant to Article 17 of Regulation (EEC) No 2081/92.

Names not included in the Annex which have been forwarded pursuant to Article 17 shall continue to be protected at national level until a decision has been reached on them.’

Regulation (EC) No 2400/96

9 The first to the fourth recitals in the preamble to Commission Regulation (EC) No 2400/96 of 17 December 1996 on the entry of certain names in the ‘Register of protected designation of origin and protected geographical indications’ provided for in Regulation No 2081/92 (OJ 1996 L 327, p. 11) read:

‘Whereas, in accordance with Article 5 of Regulation (EEC) No 2081/92, Member States have forwarded to the Commission applications for the registration of certain names as geographical indications or designations of origin;

Whereas the applications have been found, in accordance with Article 6(1) of that Regulation, to comply with the Regulation, most notably in that they include all the particulars provided for in Article 4 of the Regulation;

Whereas no declaration of objection within the meaning of Article 7 of the Regulation has been forwarded to the Commission as a result of the publication in the Official Journal of the European Communities of the names in question;

Whereas, as a result, those names may be entered in the “Register of protected designations of origin and protected geographical indications” and therefore be protected throughout the Community as geographical indications or designations of origin’.

10 Article 1 of Regulation No 2400/96 reads:

‘The names in the Annex hereto are hereby entered in the “Register of protected designations of origin and protected geographical designations” as [PGI] or protected designations of origin (PDO) as provided for in Article 6(3) of Regulation (EEC) No 2081/92.’

Regulation (EC) No 692/2003

11 Article 1(13) of Council Regulation (EC) No 692/2003 of 8 April 2003 amending Regulation No 2081/92 (OJ 2003 L 99, p. 1) provides:

‘Article 14 [of Regulation No 2081/92] shall be amended as follows:

(a) Paragraph 1 shall be replaced by the following:

“1. Where a designation of origin or geographical indication is registered under this Regulation, any application for registration of a trademark that is for a product of the same type and use of which will engen-

der one of the situations indicated in Article 13 shall be refused if made after the date of submission to the Commission of the application for registration of the designation of origin or geographical indication.

Trademarks registered in breach of the first subparagraph shall be invalidated.”

...’

Regulation No 510/2006

12 Recitals 19 and 20 in the preamble to Regulation No 510/2006 read:

‘The names already registered under ... Regulation (EEC) No 2081/92 ... on the date of entry into force of this Regulation should continue to be protected under this Regulation and automatically included in the register. Provision should also be made for transitional measures applicable to registration applications received by the Commission before the entry into force of this Regulation.

In the interests of clarity and transparency, Regulation (EEC) No 2081/92 should be repealed and replaced by this Regulation.’

13 Article 4 of Regulation No 510/2006, headed ‘Product specification’, provides:

‘1. To be eligible for a protected designation of origin (PDO) or a [PGI], an agricultural product or foodstuff shall comply with a product specification.

2. The product specification shall include at least:

...’

14 Article 7 of that regulation is headed ‘Objection/decision on registration’. Article 7(6) reads:

‘The Commission shall maintain updated a register of protected designations of origin and [PGI].’

15 Article 13 of that regulation is headed ‘Protection’. Article 13(1) reads:

‘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 in so far as those products are comparable to the products registered under that name or in so far as using the name exploits the reputation of the protected name;

(b) any misuse, imitation or evocation, even if the true origin of the product 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;

(c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product, 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.

Where a registered name contains within it the name of an agricultural product or foodstuff which is considered generic, the use of that generic name on the appropriate agricultural product or foodstuff shall not be considered to be contrary to points (a) or (b) in the first subparagraph.’

16 Article 14 of Regulation No 510/2006 is headed 'Relations between trademarks, designations of origin and geographical indications'. Article 14(1) reads:

'Where a designation of origin or a geographical indication is registered under this Regulation, the application for registration of a trademark corresponding to one of the situations referred to in Article 13 and relating to the same class of product shall be refused if the application for registration of the trademark is submitted after the date of submission of the registration application to the Commission.

Trademarks registered in breach of the first subparagraph shall be invalidated.'

17 Article 17 of that regulation, headed 'Transitional provisions', states:

'1. The names that, on the date of entry into force of this Regulation, are listed in the Annex of ... Regulation No 1107/96 ... and those listed in the Annex of ... Regulation ... No 2400/96 ... shall be automatically entered in the register referred to in Article 7(6) of this Regulation. The corresponding specifications shall be deemed to be the specifications referred to in Article 4(1). Any specific transitional provisions associated with such registrations shall continue to apply.

2. In respect of pending applications, statements and requests received by the Commission before the date of entry into force of this Regulation:

(a) the procedures in Article 5 shall not apply, without prejudice to Article 13(3); and

(b) the summary of the specification drawn up in conformity with Commission Regulation (EC) No 383/2004 [of 1 March 2004 laying down detailed rules for applying Regulation No 2081/92 as regards the summary of the main points of the product specifications (OJ 2004 L 64, p. 16)] shall replace the single document referred to in Article 5(3)(c).

3. The Commission may adopt, if necessary, other transitional provisions in accordance with the procedure referred to in Article 15(2).'

18 Article 19 of Regulation No 510/2006 provides:

'Regulation (EEC) No 2081/92 is hereby repealed.

References made to the repealed Regulation shall be construed as being made to this Regulation and should be read in accordance with the correlation table in Annex III.'

The dispute in the main proceedings and the questions referred for a preliminary ruling

19 Bayerischer Brauerbund is a German association with the objective of protecting the common interests of Bavarian brewers. According to a certificate from the Amtsgericht München (Local Court, Munich), its statutes date from 7 December 1917. Bayerischer Brauerbund is the proprietor of the registered collective trade marks 'Genuine Bavarian Beer' (since 1958), 'Bayrisch Bier' and 'Bayerisches Bier' (since 1968), and 'Reinheitsgebot seit 1516 Bayrisches Bier' (since 1985).

20 Bavaria is a Netherlands commercial company producing beer which operates on the international market. Formerly called 'Firma Gebroeders Swinkels', the company began to use the word 'Bavaria' in 1925, and

it became part of its name in 1930. Bavaria was and is the proprietor of several registered trade marks and figurative elements containing the word 'Bavaria'. The registration dates include 1947, 1971, 1982, 1991, 1992 and 1995. Protection in Germany of some of those trade marks was refused in 1973, 1992 and 1993.

21 The name 'Bayerisches Bier' was covered by bilateral agreements on the protection of indications of provenance, designations of origin and other geographic names between, on the one hand, the Federal Republic of Germany and, on the other hand, the French Republic (1961), the Italian Republic (1963), the Hellenic Republic (1964), the Swiss Confederation (1967) and the Kingdom of Spain (1970).

22 On 28 September 1993 Bayerischer Brauerbund, in agreement with two other Bavarian associations, submitted to the German Government an application for registration of a PGI pursuant to Article 17(1) of Regulation No 2081/92. On 20 January 1994 the German Government informed the Commission of the application for registration of 'Bayerisches Bier' as a PGI in accordance with the simplified procedure under that provision.

23 Numerous pieces of information were exchanged between the Commission and the German authorities for the purposes of supplementing the file, which was regarded as complete on 20 May 1997. The final version of the specification was sent to the Commission by letter of 28 March 2000.

24 The Regulatory Committee on Geographical Indications and Designations of Origin discussed on a number of occasions two draft Commission regulations for registration of 'Bayerisches Bier' as a PGI. The existence of marks which also include the words 'Bayerisches Bier' or translations of them was one of the issues discussed.

25 As the majority laid down in the second paragraph of Article 15 of Regulation No 2081/92 was not reached within that committee, the latter was unable to deliver an opinion within the prescribed period. The Commission therefore converted its last draft into a proposal for a Council regulation, and the Council then adopted Regulation No 1347/2001 which registered 'Bayerisches Bier' as a PGI by including it among the names listed in the Annex to Regulation (EC) No 1107/96.

26 Following similar proceedings in other Member States, Bayerischer Brauerbund applied to the Landgericht München for an order requiring Bavaria to agree to renounce the protection of one of the trade marks cited in paragraph 20 above. The trade mark in question is the international trade mark registered under No 645 349, protected in Germany with priority from 28 April 1995.

27 The Landgericht München granted Bayerischer Brauerbund's application by a judgment which was upheld on appeal by the Oberlandesgericht München (Higher Regional Court, Munich). Bavaria appealed on a point of law to the Bundesgerichtshof (Federal Court of Justice).

28 Against that background, the Bundesgerichtshof decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

‘1. Does Article 14(1) of Regulation ... No 510/2006 apply in the case where the protected indication has been validly registered in accordance with the simplified procedure under Article 17 of Regulation ... No 2081/92 ...?’

2. (a) If the answer to Question 1 is in the affirmative, what date should be taken as the basis for determining the classification in time of the protected geographical indication for the purposes of Article 14(1) of Regulation ... No 510/2006?

(b) If the answer to Question 1 is in the negative, what provision governs the conflict between a geographical indication validly registered in accordance with the simplified procedure under Article 17 of Regulation ... No 2081/92 and a trade mark, and what determines the classification in time of the protected geographical indication?

3. May the national provisions on the protection of geographical designations be applied in the event that the indication “Bayerisches Bier” fulfils the conditions for registration under Regulation ... No 2081/92 and Regulation ... No 510/2006, but Regulation ... No 1347/2001 is invalid?’

29 By decision of the President of the Court of Justice of 8 May 2008, the present proceedings were stayed pending delivery of the judgment in Case C-343/07 Bavaria and Bavaria Italia [2009] ECR I-5491. That case was a reference for a preliminary ruling from the Corte d’appello di Torino (Appeal Court, Turin) (Italy) in a dispute which concerned, inter alia, the validity of Regulation No 1347/2001 and was also between Bavaria and Bayerischer Brauerbund.

Consideration of the questions referred

30 As a preliminary point, it should be noted that while the first and second questions assume that Regulation No 1347/2001 is valid, the third question is based on the premiss that it is invalid.

31 The third question should therefore be dealt with before the first and second questions.

The third question

32 By its third question, the referring court seeks to ascertain whether Regulation No 1347/2001 is valid and, if the answer is negative, whether the national provisions on the protection of geographical designations may be applied in the event that the PGI ‘Bayerisches Bier’ fulfils, despite the invalidity of that regulation, the conditions for registration under Regulations Nos 2081/92 and 510/2006.

33 It is clear from the order for reference that this question was raised in respect of the same factors which might affect the validity of Regulation No 1347/2001 as were raised by the [Corte d’appello di Torino in Bavaria and Bavaria Italia, which was pending before the Court of Justice at that time](#).

34 As [the answer given by the Court](#) in that case was that consideration of the question referred did not disclose any factor liable to affect the validity of

Regulation No 1347/2001, it is unnecessary to answer the third question.

The first and second questions

35 By its first and second questions, which it is appropriate to consider together, the referring court asks the Court, in essence, which provision and which reference date are applicable for resolving the conflict between a name validly registered as a PGI in accordance with the simplified procedure under Article 17 of Regulation No 2081/92 and a trade mark the application for registration of which was submitted both before the registration of that name and before the entry into force of Regulation No 692/2003.

Inapplicability ratione temporis of Article 14(1) of Regulation No 510/2006 or of Regulation No 2081/92, as amended by Regulation No 692/2003, to the main proceedings

36 Both Article 14(1) of Regulation No 2081/92, in its original version and as amended by Regulation No 692/2003, and Article 14(1) of Regulation No 510/2006 are designed to resolve a conflict between a name registered as a PGI and an application for registration of a trade mark corresponding to one of the situations referred to in Article 13 of Regulation No 2081/92 and Article 13 of Regulation No 510/2006 respectively, and relating, as the case maybe, to the same type or the same class of product.

37 The solution provided for in the case of such a conflict is refusal of the application for registration of the trade mark at issue, or, in the alternative, invalidation of the trade mark registered, where that application was submitted after the date respectively provided for in those various provisions.

38 Thus, under both Article 14(1) of Regulation No 510/2006 and the version of Article 14(1) of Regulation No 2081/92 resulting from Regulation No 692/2003, the application for registration of the trade mark must be rejected or, as the case may be, the trade mark must be declared invalid where that application was submitted after the date on which the application for registration of the name concerned as a PGI was lodged with the Commission.

39 However, the provisions cited in the preceding paragraph cannot be applied retroactively in order to govern a conflict, such as that giving rise to the dispute in the main proceedings, between a name validly registered as a PGI in accordance with the simplified procedure under Article 17 of Regulation No 2081/92 and a trade mark the application for registration of which was submitted before the entry into force of Regulation No 692/2003.

40 It is settled case-law that, as a general rule, the principle of legal certainty precludes a European Union measure from taking effect from a point in time before its publication, but it may exceptionally be otherwise where the purpose to be achieved so demands and where the legitimate expectations of those concerned are duly respected. In that regard, in order to ensure observance of the principles of legal certainty and the protection of legitimate expectations, the substantive rules of European Union law must be interpreted as ap-

plying to situations existing before their entry into force only in so far as it clearly follows from their terms, objectives or general scheme that such effect must be given to them (see Joined Cases C-74/00 P and C-75/00 P Falck and Acciaierie di Bolzano v Commission [2002] ECR I-7869, paragraph 119 and the case-law cited).

41 Whilst the principle of legal certainty precludes a regulation from being applied retroactively, irrespective of whether such application might produce favourable or unfavourable effects for the person concerned, the same principle requires that any factual situation should normally, in the absence of any express contrary provision, be examined in the light of the legal rules existing at the time when the situation obtained. However, if the new law is thus valid only for the future, it also applies, save for derogation, to the future effects of situations which came about during the period of validity of the old law (see Case C-154/05 Kersbergen-Lap and Dams-Schipper [2006] ECR I-6249, paragraph 42 and the case-law cited).

42 It must be held that the circumstances giving rise to the conflict between the name and the trade mark at issue in the main proceedings predate not only the entry into force of Regulation No 510/2006, but also the entry into force of Regulation No 692/2003 which amended Regulation No 2081/92. That conflict relates to the fact that, first, the name 'Bayerisches Bier', following an application lodged by the German Government with the Commission on 20 January 1994, was registered in accordance with the simplified procedure under Regulation No 2081/92 as a PGI by virtue of Regulation No 1347/2001 and, second, the trade mark 'Bavaria' which was the subject of international registration No 645 349 has enjoyed a right of priority and hence protection *inter alia* in Germany since 28 April 1995.

43 Since it is not apparent from the terms, objectives or general scheme of Regulations Nos 692/2003 and 510/2006, in particular the provisions examined above, that they should be given retroactive effect, a conflict such as that between the PGI and the trade mark at issue in the main proceedings must be governed by Article 14(1) of Regulation No 2081/92 in its original version.

44 In the present case it is a matter of establishing whether, when the trade mark 'Bavaria' at issue was registered in 1995, the PGI 'Bayerisches Bier' already enjoyed priority which could justify invalidation of that mark. That question must be answered in the light of the rule which governed the conflict at issue at the time when it arose.

45 It is immaterial in that regard that, according to recital 19 in the preamble to Regulation No 510/2006 and under Article 17 of that regulation, names registered as a PGI under Regulation No 2081/92 are entitled to protection under Regulation No 510/2006.

Applicability *ratione materiae* of Article 14(1) of Regulation No 2081/92 to the main proceedings

46 As a preliminary point, it should be noted that under the system established by Regulation No 2081/92

names could be registered either in accordance with the normal procedure under Article 5 *et seq.* or in accordance with the simplified procedure under Article 17. Whilst the names registered in accordance with the normal procedure were listed in the Annex to Regulation No 2400/96, the names registered in accordance with the simplified procedure were listed in the Annex to Regulation No 1107/96.

47 The conflict that gave rise to the dispute in the main proceedings is governed by Article 14(1) of Regulation No 2081/92.

48 Article 14(1) is the only provision governing conflicts between names and applications for registration of trade marks; Article 14(2) and Article 14(3) relate to different situations.

49 According to the conflict rule laid down in Article 14(1) of Regulation No 2081/92, the application for registration of the trade mark at issue is to be refused, or, if it has not been refused, the registered trade mark is to be declared invalid, if the application was submitted after the date of the publication provided for in Article 6(2) of that regulation. The application for registration is also to be refused or the trade mark declared invalid if the application was lodged before publication but publication occurred before the trade mark was registered.

50 That conflict rule therefore prescribes a ground for refusal of the application for registration of the mark at issue, or, in the alternative, for the invalidity of that mark, under which the reference date for application of the conflict rule is the date of the publication provided for in Article 6(2) of Regulation No 2081/92.

51 According to the Commission, establishing such a reference date means that Article 14(1) of Regulation No 2081/92 was not applicable to names registered in accordance with the simplified procedure, since the publication provided for in Article 6(2) of that regulation applied only to the normal registration procedure.

52 That interpretation cannot be accepted.

53 First, Article 14(1) of Regulation No 2081/92 concerns designations of origin and geographical indications registered 'in accordance with this Regulation', without a distinction being drawn on the basis of the registration procedure used.

54 Second place, it should be noted that the objective of Article 17 of Regulation No 2081/92 was to register in accordance with a simplified procedure names existing in the Member States which, whilst fulfilling the substantive conditions of that regulation, were already legally protected or established by usage.

55 In that regard, it must be held that the system introduced by Regulation No 2081/92, in particular that provided for in Article 17, was intended to afford to names registered in accordance with the simplified procedure the same level of protection as afforded to names registered in accordance with the normal procedure.

56 Furthermore, as is apparent from the second recital in the preamble to Regulation No 1107/96 and the fourth recital in the preamble to Regulation No 2400/96, registration, whether in accordance with the

simplified procedure or in accordance with the normal procedure, implied that the names at issue were in accordance with Regulation No 2081/92 and therefore warranted protection at European Union level.

57 It must therefore be held that Article 14(1) of Regulation No 2081/92 is also applicable to conflicts involving names registered as a PGI in accordance with the simplified procedure.

The reference date, under Article 14(1) of Regulation No 2081/92, in a conflict involving a name registered as a PGI in accordance with the simplified procedure

58 The reference date referred to in Article 14(1) of Regulation No 2081/92 is the date of the publication provided for in Article 6(2) of that regulation, whereas such publication did not exist under the simplified procedure. It is necessary therefore to establish the relevant reference date in the case of a conflict involving a name registered as a PGI in accordance with that procedure.

59 Since the system introduced by Regulation No 2081/92 is a uniform and exhaustive system of protection (see [Case C-478/07 Budějovický Budvar \[2009\] ECR I-7721](#), paragraphs 114 and 115), it must be regarded as forming a complete system that does not leave the Member States the power to fill a lacuna by resorting to their national law. It is thus proper to seek a solution in the light of the scheme and also the aims and objectives of the provision and of the regulation at issue (see, to that effect, Case 159/73 Hannoversche Zucker [1974] ECR 121, paragraph 4).

60 First, it should be noted in that regard that, in the case of the normal procedure, Article 14(1) of Regulation No 2081/92 provides for protection of names at European Union level in relation to a competing trade mark which begins on a date prior to the registration of the names.

61 In this context, establishing that date by reference to publication at European Union level, such as the publication provided for in Article 6(2) of that regulation, satisfies the requirements of the principle of legal certainty.

62 However, the first time the names registered in accordance with the simplified procedure were published at European Union level was when they were registered.

63 Second, under Article 17(3) of Regulation No 2081/92, the Member States could maintain national protection of the names communicated in accordance with Article 17(1) until such time as a decision on registration had been taken. Under Article 1 of Regulation No 1107/96, names forwarded pursuant to Article 17 of Regulation No 2081/92 continued to be protected at national level until a decision had been reached on them.

64 Given that national protection for the names to be registered in accordance with the simplified procedure was maintained until the date of registration, to establish the date of the entry into force of that registration as the reference date for those names for the purposes of the protection granted by Article 14(1) of Regulation

No 2081/92 is consistent with the general scheme of the system introduced by that regulation.

65 Moreover, as emerges from Regulation No 1347/2001, concerning the PGI at issue in the main proceedings, the publication of the registration also includes the date of the entry into force of that registration and therefore satisfies the requirements of legal certainty.

66 It must therefore be held that, in the case of names registered in accordance with the simplified procedure under Article 17 of Regulation No 2081/92, the entry into force of the registration satisfies both the objectives of the reference date provided for in Article 14(1) of Regulation No 2081/92 and the general scheme of that regulation.

67 That date therefore constitutes the reference date for the purposes of resolving, under Article 14(1) of Regulation No 2081/92, a conflict involving a name registered as a PGI in accordance with the simplified procedure.

68 In the light of the foregoing, the answer to the first and second questions is that Article 14(1) of Regulation No 2081/92 is applicable for resolving the conflict between a name validly registered as a PGI in accordance with the simplified procedure under Article 17 of that regulation and a trade mark corresponding to one of the situations referred to in Article 13 of that regulation relating to the same type of product, the application for registration of which was submitted both before the registration of that name and before the entry into force of Regulation No 692/2003. The date of the entry into force of the registration of that name constitutes the reference date for the purposes of Article 14(1) of Regulation No 2081/92.

Costs

69 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Third Chamber) hereby rules:

Article 14(1) of Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs is applicable for resolving the conflict between a name validly registered as a protected geographical indication in accordance with the simplified procedure under Article 17 of that regulation and a trade mark corresponding to one of the situations referred to in Article 13 of that regulation relating to the same type of product, the application for registration of which was submitted both before the registration of that name and before the entry into force of Council Regulation (EC) No 692/2003 of 8 April 2003 amending Regulation No 2081/92. The date of the entry into force of the registration of that name constitutes the reference date for the purposes of Article 14(1) of Regulation No 2081/92.

Opinion Of Advocate General Mazák

delivered on 16 September 2010 (1)

Case C-120/08

Bayerischer Brauerbund eV

v

Bavaria NV

(Reference for a preliminary ruling from the Bundesgerichtshof (Germany))

(Interpretation of Article 13(1)(b) and Article 14(1) and (2) of Council Regulation (EC) No 510/2006 and of Article 17 of Council Regulation (EEC) No 2081/92 – Conflict between a protected geographical indication, registered in accordance with the simplified procedure under Article 17 of Regulation No 2081/92 and an international mark)

I – Introduction

1. By order of 14 February 2008, received at the Court on 20 March 2008, the Bundesgerichtshof (Federal Court of Justice) (Germany) referred questions to the Court of Justice under Article 234 EC for a preliminary ruling on the interpretation of Council Regulation (EC) No 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (2) ('Regulation No 510/2006').

2. The reference was made in the course of proceedings between Bayerischer Brauerbund eV ('Bayerischer Brauerbund') and Bavaria NV ('Bavaria') concerning Bavaria's right to the continued protection and use in Germany of an international trade mark containing the word 'Bavaria', in view of the fact that the name 'Bayerisches Bier' has been registered, with effect from 5 July 2001, as a protected geographical indication ('PGI') by virtue of Council Regulation (EC) No 1347/2001 of 28 June 2001 supplementing the Annex to Commission Regulation (EC) No 1107/96 on the registration of geographical indications and designations of origin under the procedure laid down in Article 17 of Council Regulation (EEC) No 2081/92 (3) ('Regulation No 1347/2001').

3. The referring court essentially seeks guidance as to how to determine, in the event that the PGI and the trade mark conflict with one another, whether the PGI 'Bayerisches Bier' has priority in time over Bavaria's trade mark with the effect that the protection of that trade mark can be removed.

4. To that end, the referring court wishes to know which provisions of Community law govern a conflict between a trade mark and a PGI, such as 'Bayerisches Bier', which has been registered under the 'simplified' procedure provided for in Article 17 of Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (4) ('Regulation No 2081/92') and, more specifically, the point in time which is material for the classification in time of that PGI.

5. The present case is closely related to and partially overlaps with Case C-343/07 Bavaria and Bavaria Ita-

lia, in which I delivered my Opinion on 18 December 2008 (5) and the Court gave judgment on 2 July 2009.

II – Legal framework

A – Regulation No 2081/92

6. Regulation No 2081/92 seeks to establish a framework of Community rules for the protection of registered designations of origin and geographical indications relating to certain agricultural products and foodstuffs in cases where there is a link between the characteristics of the product or foodstuff and its geographical origin. That regulation provides for a system of registration at Community level of geographical indications and designations of origin which will confer protection in every Member State.

7. Regulation No 2081/92 provides both for a normal and a simplified procedure for registration of a protected designation of origin ('PDO') or a PGI.

8. The normal registration procedure for a PDO or a PGI is governed by Articles 5, 6 and 7 of Regulation No 2081/92. Article 6(2) of that regulation provides:

'If, after taking account of paragraph 1, the Commission concludes that the name qualifies for protection, it shall publish in the Official Journal of the European [Union] the name and address of the applicant, the name of the product, the main points of the application, the references to national provisions governing the preparation, production or manufacture of the product and, if necessary, the grounds for its conclusions.'

9. The simplified procedure for the registration of PGIs or PDOs, applicable to names already in existence on the date of entry into force of Regulation No 2081/92, is laid down in Article 17 of that regulation, which provides as follows:

'1. Within six months of the entry into force of the Regulation, Member States shall inform the Commission which of their legally protected names or, in those Member States where there is no protection system, which of their names established by usage they wish to register pursuant to this Regulation.

2. In accordance with the procedure laid down in Article 15, the Commission shall register the names referred to in paragraph 1 which comply with Articles 2 and 4. Article 7 shall not apply. However, generic names shall not be added.

3. Member States may maintain national protection of the names communicated in accordance with paragraph 1 until such time as a decision on registration has been taken.'

10. Article 13 of Regulation No 2081/92 delimits the scope of protection granted to registered names.

11. Article 14 of Regulation No 2081/92 governs the relationship between PDOs or PGIs, on the one hand, and trade marks, on the other. As originally enacted, it provides:

'1. Where a designation of origin or geographical indication is registered in accordance with this Regulation, the application for registration of a trade mark corresponding to one of the situations referred to in Article 13 and relating to the same type of product shall be refused, provided that the application for registration of

the trade mark was submitted after the date of the publication provided for in Article 6(2).

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

This paragraph shall also apply where the application for registration of a trade mark was lodged before the date of publication of the application for registration provided for in Article 6(2), provided that that publication occurred before the trade mark was registered.

2. With due regard for Community law, use of a trade mark corresponding to one of the situations referred to in Article 13 which was registered in good faith before the date on which application for registration of a designation of origin or geographical indication was lodged may continue notwithstanding the registration of a designation of origin or geographical indication, 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 Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ...

3. 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.'

B – Regulation No 692/2003

12. Article 14 of Regulation No 2081/92 was amended by Council Regulation (EC) No 692/2003 (6) with effect from 24 April 2003.

13. Recital 11 in the preamble to Regulation No 692/2003 states in that regard:

'Article 24(5) of the [Agreement on Trade-Related Aspects of Intellectual Property Rights] applies not only to trademarks registered or applied for but also those to which rights have been acquired through use before a specified date, notably that of protection of the name in the country of origin. Article 14(2) of Regulation ... No 2081/92 should therefore be amended: the reference date now specified should be changed to the date of protection in the country of origin or of submission of the application for registration of the geographical indication or designation of origin, depending on whether the name falls under Article 17 or ... Article 5 of that Regulation; also, in Article 14(1) thereof the reference date should become the date of application instead of the date of first publication.'

14. Article 14(1) of Regulation No 2081/92, as amended by Regulation No 692/2003, states as follows:

'Where a designation of origin or geographical indication is registered under this Regulation, any application for registration of a trademark that is for a product of the same type and use of which will engender one of the situations indicated in Article 13 shall be refused if made after the date of submission to the Commission of the application for registration of the designation of origin or geographical indication.

Trademarks registered in breach of the first subparagraph shall be invalidated.'

15. Furthermore, the simplified procedure provided for under Article 17 of Regulation No 2081/92 was abolished by Regulation No 692/2003. In that regard, recital 13 in the preamble to that regulation states:

'The simplified procedure provided for in Article 17 of Regulation ... No 2081/92 for the registration of names already protected or established by usage in Member States does not provide for any right of objection. For reasons of legal security and transparency it should be deleted. For reasons of consistency the five-year transition period provided for in Article 13(2) in the case of names registered under Article 17 should also be deleted but without prejudice to exhaustion of that period in regard to the names already registered.'

16. Point 15 of Article 1 of Regulation No 692/2003 states:

'Article 13(2) and Article 17 [of Regulation No 2081/92] shall be deleted. However, the provisions of these Articles shall continue to apply to registered names or to names for which a registration application was made by the procedure provided for in Article 17 before this Regulation entered into force.'

C – Regulation No 510/2006

17. Regulation No 2081/92, as most recently amended by Council Regulation (EC) No 806/2003 of 14 April 2003, (7) was ultimately replaced by Regulation No 510/2006, which entered into force on 31 March 2006.

18. Recital 19 in the preamble to Regulation No 510/2006 states:

'The names already registered under Council Regulation ... No 2081/92 ... on the date of entry into force of this Regulation should continue to be protected under this Regulation and automatically included in the register. Provision should also be made for transitional measures applicable to registration applications received by the Commission before the entry into force of this Regulation.'

19. Article 14 of Regulation No 510/2006, entitled 'Relations between trademarks, designations of origin and geographical indications', provides:

'1. Where a designation of origin or a geographical indication is registered under this Regulation, the application for registration of a trademark corresponding to one of the situations referred to in Article 13 and relating to the same class of product shall be refused if the application for registration of the trademark is submitted after the date of submission of the registration application to the Commission.

Trademarks registered in breach of the first subparagraph shall be invalidated.

...'

III – Facts, procedure and the questions referred

20. Bayerischer Brauerbund is a German association whose objective is to protect the common interests of Bavarian brewers. According to a certificate from the Amtsgericht München (Local Court, Munich), its statutes date from 7 December 1917. Bayerischer Brauerbund is the proprietor of the registered collective trade marks 'Genuine Bavarian Beer' (since 1958), 'Bayrisch Bier' and 'Bayerisches Bier' (since 1968), as

well as 'Reinheitsgebot seit 1516 Bayrisches Bier' (since 1985).

21. Bavaria is a Dutch commercial company producing beer which operates on the international market. Formerly called 'Firma Gebroeders Swinkels', the company began to use the word 'Bavaria' in 1925, and this became part of its name in 1930. Bavaria is the proprietor of several trade marks and figurative elements containing the word 'Bavaria'. The registration dates include 1947, 1971, 1982, 1991, 1992 and 1995. Protection of some of those trade marks was refused in Germany in 1973, 1992 and 1993.

22. The name 'Bayerisches Bier' was covered by bilateral agreements on the protection of geographical indications, appellations of origin and other geographic names between, on the one hand, the Federal Republic of Germany and, on the other, the French Republic (1961), the Italian Republic (1963), the Hellenic Republic (1964), the Swiss Confederation (1967) and the Kingdom of Spain (1970).

23. On 28 September 1993 Bayerischer Brauerbund, in agreement with the associations Münchener Brauereien eV and Verband Bayerischer Ausfuhrbrauereien eV, submitted to the German Government an application for registration of 'Bayerisches Bier' as a PGI in accordance with the 'simplified' procedure under Article 17 of Regulation No 2081/92.

24. On 20 January 1994, pursuant to Article 17(1) of Regulation No 2081/92, the German Government informed the Commission of the application for registration of 'Bayerisches Bier' as a PGI under the simplified procedure.

25. Information on numerous points was exchanged between the Commission and the German authorities for the purposes of supplementing the file and it was regarded as complete on 20 May 1997. The final version of the specification was sent to the Commission by letter of 28 March 2000.

26. Two draft regulations submitted by the Commission for registration of 'Bayerisches Bier' as a PGI were discussed on a number of occasions within the Regulatory Committee for geographical indications and appellations of origin ('the Committee'). Those discussions related inter alia to the issue of the existence of trade marks which also include the term 'Bayerisches Bier' or translations of it.

27. However, as the majority required under the second paragraph of Article 15 of Regulation No 2081/92 was not reached, the Committee was unable to deliver an opinion within the prescribed period. The Commission therefore converted its draft into a proposal for a regulation of the Council, which then adopted Regulation No 1347/2001 registering 'Bayerisches Bier' as a PGI.

28. Following similar proceedings in other Member States subsequent to that registration, Bayerischer Brauerbund brought an action before the Landgericht München (Regional Court, Munich) seeking an order requiring Bavaria to consent to the removal of one of its international trade marks, namely, international trade mark No 645 349 ('Bavaria's trade mark') which

is protected in Germany with priority from 28 April 1995.

29. The Landgericht München upheld the action. An appeal brought against that judgment by Bavaria was dismissed by the Oberlandesgericht München.

30. It falls to the Bundesgerichtshof to decide on the appeal on a point of law which Bavaria has lodged in respect of that decision and by which it seeks dismissal of the action for consent to the removal of protection for its trade mark in so far as that trade mark is registered for beer.

31. According to the referring court, the decision in the present dispute depends on the validity of Regulation No 1347/2001, which has already come under consideration in Bavaria and Bavaria Italia; (8) on whether the PGI 'Bayerisches Bier' has priority in time, for the purposes of Article 14(1) of Regulation No 510/2006, over Bavaria's trade mark; and also on whether that mark is entitled under Article 14(2) of Regulation No 510/2006 to coexist with the PGI.

32. As regards, more specifically, the issue of the priority of the PGI, the referring court observes that the condition laid down in Article 14(1) of Regulation No 510/2006 is satisfied, as the application for registration of 'Bayerisches Bier' as a PGI was received by the Commission on 20 January 1994, whereas Bavaria's trade mark has priority only from 28 April 1995. The same result flows from Article 14(1) of Regulation No 2081/92 as amended by Regulation No 692/2003.

33. Nevertheless, the referring court has doubts as to the applicability of that rule in so far as Article 14(1) of the original version of Regulation No 2081/92 referred, for the purposes of establishing priority in time, not to the date of submitting the application, but to the date of publication provided for in Article 6(2) of that regulation, which, however, has no place in the simplified procedure under Article 17. The question therefore arises as to which provision governs the classification in time of a PGI registered in accordance with the simplified procedure under Article 17 of Regulation No 2081/92 and, in particular, as to which point in time is material for that classification.

34. Against that background, the Bundesgerichtshof decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

'(1) Does Article 14(1) of Regulation (EC) No 510/2006 apply in the case where the protected indication has been validly registered in accordance with the simplified procedure under Article 17 of Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs?

(2) (a) If the answer to Question 1 is in the affirmative, what date should be taken as the basis for determining the classification in time of the protected geographical indication for the purposes of Article 14(1) of Regulation (EC) No 510/2006?

(b) If the answer to Question 1 is in the negative, what provision governs the conflict between a geographical indication validly registered in accordance with the

simplified procedure under Article 17 of Regulation (EEC) No 2081/92 and a trade mark, and what determines the classification in time of the protected geographical indication?

(3) May the national provisions on the protection of geographical designations be applied in the event that the indication “Bayerisches Bier” fulfils the conditions for registration under Regulation (EEC) No 2081/92 and Regulation (EC) No 510/2006, but Regulation (EC) No 1347/2001 is invalid?’

IV – Legal analysis

A – Preliminary remarks

35. It should be noted at the outset that, as is clear from its wording and from the order for reference, the third question has been referred in the event that Regulation No 1347/2001 – by virtue of which the name ‘Bayerisches Bier’ was registered as a PGI – is to be considered invalid as a consequence of the preliminary ruling in Bavaria and Bavaria Italia, (9) which was pending at the time when the Bundesgerichtshof made the present reference.

36. Since, in its ruling in that case, the Court has meanwhile confirmed the validity of Regulation No 1347/2001 (10) and as the referring court has not mentioned any additional factor which might affect the validity of that regulation, it is unnecessary to answer the third question.

37. The two remaining questions and their subdivisions are essentially designed to determine whether the PGI ‘Bayerisches Bier’ enjoys priority in time over Bavaria’s trade mark with the effect that, in the event of a conflict between those rights, the trade mark may be declared invalid.

38. Let me now turn to examine the two issues which arise in this connection.

39. First and foremost, it is necessary to identify the Community rule or rules under which the priority of a PGI registered in accordance with the simplified procedure under Article 17 of Regulation No 2081/92 (‘the simplified procedure’) over a trade mark falls to be assessed, that is to say, to determine whether the relevant provision in the present case is Article 14(1) of Regulation No 2081/92 or Article 14(1) of Regulation No 510/2006.

40. Secondly, it is necessary to identify the point in time which is material for the purposes of determining whether a PGI registered under the simplified procedure precludes the registration of a given trade mark.

B – Main positions of the parties

41. In the present proceedings, written observations have been submitted by Bayerischer Brauerbund, Bavaria, the Governments of Germany, Greece, Italy and the Netherlands, and by the Commission. All of those parties, with the exception of the Italian Government, were also represented at the hearing on 10 June 2010.

42. I shall not rehearse in detail here the various arguments put forward by the parties, which – even where leading to similar results – cover a wide range of legal approaches to the issues raised. I shall merely outline briefly the solutions proposed by the parties to the questions referred.

43. As regards the question of which Community rule governs the relationship between the PGI and Bavaria’s trade mark, Bavaria, the German and Dutch Governments and the Commission essentially agree that Article 14(1) of Regulation No 510/2006 is not applicable to a PGI which has been registered in accordance with the simplified procedure. According to most of those parties, the relationship between the PGI and Bavaria’s trade mark is still governed by Article 14(1) of Regulation No 2081/92 in its original version. The Commission, on the other hand, identifies the relevant provision in this context as Article 13(1) of Regulation No 510/2006, read in conjunction with Article 14(2) thereof.

44. By contrast, according to Bayerischer Brauerbund and the Governments of Italy and Greece, the classification in time of such a PGI falls to be determined by reference to Article 14(1) of Regulation No 510/2006.

45. As regards the question of which point in time is material for the classification in time of a name registered under the simplified procedure, several dates have been proposed by the parties: (i) the date on which the name concerned starts to be protected under the national law of the Member State of origin (Commission and Greek Government); (ii) the date on which the Member State concerned submits the registration application to the Commission (Bayerischer Brauerbund and Italian Government); (iii) the date on which all documents which that application should contain are communicated to the Commission (in the context of the present case, according to Bavaria, not before summer 1998); (iv) the date from which the economic operators concerned could, through the participation of the Member State in the simplified procedure, take cognisance of the application for registration (German Government); and, lastly, (v) the date of the publication of the registration (Bavaria and the Dutch Government).

C – Appraisal

1. The applicable legislation

46. It should be recalled at the outset that one of the basic principles of trade mark law and, more generally, of all intellectual property law is the principle of the primacy of the prior exclusive right, or, more generally, the ‘first-in-time=first-in-right’ principle, by virtue of which the proprietor of an earlier intellectual property right can, in the event of conflict, claim protection against a subsequent intellectual property right. (11)

47. As regards the relationship between PDOs or PGIs, on the one hand, and trade marks, on the other, that principle is reflected in the specific rules which both Regulation No 2081/92 (12) and Regulation No 510/2006 lay down in relation to the various situations of conflict referred to. Each of those rules has separate objectives and functions and they are each subject to different conditions. (13)

48. The first case is that referred to in Article 14(3) of Regulation No 2081/92 – which, in Regulation No 510/2006, appears as Article 3(4) – which is 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 and

renown, and the length of time for which it has been used, be liable to mislead the consumer as to the true identity of the product. In such a case, the pre-existing trade mark is protected in that registration of the indication or designation must be refused.

49. The second case is governed both by Article 14(2) of Regulation No 2081/92 and by Article 14(2) of Regulation No 510/2006. Those provisions concern the situation where use of a pre-existing trade mark interferes with the protection granted to a PDO or a PGI under Article 13 of those regulations. Those provisions enshrine the principle of coexistence in that, subject to certain conditions, they allow continued use of the earlier trade mark notwithstanding the registration of the conflicting name.

50. The third situation of conflict, which is the situation at issue in the present case and which is governed by Article 14(1) of Regulation No 2081/92 and by Article 14(1) of Regulation No 510/2006, is that between an earlier PDO or PGI and a later trade mark, where use of that trade mark would bring about one of the situations described in Article 13 of those regulations. Under those provisions, protection or priority is given to the earlier designation or indication, in that registration of the conflicting trade mark must be refused or, as the case may be, declared invalid. The existence of the earlier PDO or PGI – as envisaged in those provisions – is thus, in effect, tantamount to a ground for refusal of registration of the conflicting trade mark under national and Community/European Union trade mark law. (14)

51. In that regard, priority in time of a PDO or PGI vis-à-vis a given mark or, in other words, the point in the registration procedure as from which a name, in the event of conflict, may prevent a trade mark from being registered, is defined under Article 14(1) of Regulation No 2081/92, as originally enacted, by reference to the date of publication provided for in Article 6(2), that is to say, the date of publication of the application for registration and related information by the Commission. By contrast, both Article 14(1) of that regulation, as amended by Regulation No 692/2003, and Article 14(1) of Regulation No 510/2006 refer in that regard essentially to the (earlier) date of submission of the registration application to the Commission.

52. The crux of the problem with which we are now confronted in the present case is that, in referring to ‘the date of publication provided for in Article 6(2)’ of Regulation No 2081/92, Article 14(1) of that regulation as originally enacted fails – for whatever reason – to take account of the fact that, in the context of the simplified procedure, no provision is made for such publication, whereas Article 14(1) of Regulation No 2081/92, as amended by Regulation No 692/2003, and Article 14(1) of Regulation No 510/2006 appear to be compatible *ratione materiae* with the simplified procedure in view of their reliance on the date of the submission of the registration application to the Commission.

53. That cannot, however, override the fact that neither Article 14(1) of Regulation No 2081/92, as amended by Regulation No 692/2003, nor Article 14(1) of Regula-

tion No 510/2006, to which the first question refers, is applicable *ratione temporis* to the relationship between the PGI and the trade mark at issue.

54. It should be pointed out in that regard, first of all, that, as emerges from consistent case-law, the principle of legal certainty requires that, as a general rule, any factual situation should, in the absence of express provision to the contrary, be examined in the light of the legal rules existing at the time when the situation obtained. (15)

55. The situation of conflict in the case before the referring court arose in connection with the extension of the protection of Bavaria’s trade mark to Germany in 1995. It is with regard to that extension of protection that the question has to be answered as to whether the indication ‘Bayerisches Bier’ – registration of which as a PGI had at that stage been applied for under the simplified procedure but not yet concluded – already enjoyed protection or, more specifically, priority over Bavaria’s trade mark, with the effect that the legal protection of that mark in Germany was precluded and should, as a consequence, be withdrawn.

56. Obviously, at the time when those circumstances occurred, it was Regulation No 2081/92 as originally enacted which governed the registration and protection of the name ‘Bayerisches Bier’, including its relationship with trade marks. It is therefore in the light of that legislation that the situation at issue must be examined.

57. I would add that we are not dealing here with the future effects of a situation which arose under Regulation No 2081/92 as originally enacted and to which, as the Court has held in a number of cases, a new rule such as that laid down in Article 14(1) of Regulation No 510/2006 could be applied. (16)

58. Rather, the issue here is whether, at a certain point in time, a given name was to be regarded as being first in time – and, accordingly, first in right – in relation to a potentially conflicting mark, with the result that the situation at issue constitutes a situation accomplished prior to the entry into force of Regulation No 510/2006. As a consequence, that regulation can apply retroactively to that situation, or to rights acquired prior to its entry into force, only in so far as it clearly follows from its terms, its objectives or its general scheme that such effect must be given to it. (17)

59. There is nothing, however, in Regulation No 510/2006 to suggest this, it being insufficient in that regard that names already registered under Regulation No 2081/92 continue to be protected under Regulation No 510/2006, in accordance with Article 17 of that regulation and recital 19 in its preamble.

60. Lastly, it should be noted that it would be difficult indeed to argue that an issue so closely linked to the simplified procedure as that of the protection to be granted during that procedure to the name vis-à-vis a trade mark should be governed by Regulation No 510/2006, when the simplified procedure itself has already been abolished by Regulation No 692/2003.

61. It follows that Article 14(1) of Regulation No 510/2006 is not applicable in the present case, where the PGI was validly registered under the simplified

procedure, as provided for in Article 17 of Regulation No 2081/92 as originally enacted.

62. The question regarding the moment in time during the registration procedure from which such a PGI may prevent a given trade mark from being validly registered must therefore be determined by reference to Regulation No 2081/92 and, in particular, to Articles 14 and 17 thereof, account being had – in so far as the answer does not follow directly from the wording of those provisions – to the context, the purpose and general scheme of the regulation of which those provisions form part. (18)

2. The point in time from which a PGI subject to the simplified procedure may prevent the registration of a trade mark which is alleged to conflict with it

63. As has already been noted, Article 14(1) of Regulation No 2081/92, which covers circumstances such as those of the case before the referring court, in that it governs the registration of a trade mark in the light of the protection afforded to designations or indications under that regulation, identifies – in any event, as regards names registered under the normal procedure – the date of publication of the application for registration of a name as the point in time from which registration of a conflicting trade mark is not permissible. (19)

64. Since that date is not applicable in respect of names whose registration is sought under the simplified procedure, which does not entail publication of the application for registration within the meaning of Article 6(2) of Regulation No 2081/92, (20) the question to be answered is: what point in time in the simplified registration procedure can be regarded as equivalent in function to that date for the purposes of Article 14(1) of Regulation No 2081/92?

65. In that regard, it should be borne in mind, first, that both Article 14(1) and Article 14(3) of Regulation No 2081/92 are designed to act as a barrier to registration, (21) the former with regard to the registration of trade marks and the latter with regard to the registration of designations or indications, whereas Article 14(2) of Regulation No 2081/92 follows a somewhat different logic in that it provides, subject to certain conditions, in accordance with the principle of coexistence, for continued use of a pre-existing trade mark notwithstanding – and subsequent to – the registration of a PDO or PGI with which that use conflicts.

66. Secondly, as a consequence, while Article 14(2) of Regulation No 2081/92 implies the need for an analysis after registration, intended *inter alia* for the authorities and courts called upon to apply the provisions in question, the question whether the conditions laid down in Article 14(1) and Article 14(3) of that regulation have been fulfilled must be assessed, by the competent Community and national authorities called upon to apply those provisions, prior to registration of the trade mark, or the PDO or PGI, respectively. (22)

67. Thirdly, it should be noted in this context that the point in time to which Article 14(1) of Regulation No 2081/92 refers as regards the normal registration procedure – namely, publication of the registration

application – is the first point in that procedure at which the ongoing registration of a designation or indication is brought to the knowledge of all the national authorities in charge of registration of trade marks, as well as of interested third parties and economic operators, so that account can be taken of that fact in relation to the registration of trade marks which may conflict with those PDOs or PGIs.

68. In that respect, as regards names registered under the simplified procedure, it should be noted that the first point in that procedure at which all those Community authorities and economic operators can take cognisance of the registration of a name subject to that procedure is the publication of its registration under Article 17 of Regulation No 2081/92, read in conjunction with Article 15 of that regulation, in the Official Journal of the European Union.

69. In my view, therefore, in the light of the conceptual framework and spirit of Article 14(1) of Regulation No 2081/92, that date – namely, the date on which the protection granted to names registered under the simplified procedure is made public, for the first time, at a Community-wide level – is the date which is to be regarded as material for determining the primacy of such names for the purposes of Article 14(1) of that regulation.

70. That interpretation is corroborated, in the first place, by considerations relating to the way in which the application of that rule should work in practice.

71. Thus, it should be borne in mind that Article 14(1) of Regulation No 2081/92 provides primarily, as is evident from the first subparagraph of that provision, for a ground of refusal in respect of a trade mark whose registration is sought and only secondarily, as is evident from the second subparagraph of that provision, for a ground of revocation of that trade mark in the event that it has been registered in breach of that barrier to registration.

72. However, the authorities in charge of the registration of trade marks are obviously able to take account of the protection afforded to a name whose registration has been applied for under that regulation and, in particular, of the related ground for refusal, only if the name concerned has been brought to their attention prior to the registration of a trade mark which may conflict with the name.

73. In the second place, it follows also from the principle of legal certainty, to my mind, that the fact that registration of a name has been sought under the simplified procedure cannot preclude registration of a trade mark prior to the publication of the registration of that PGI or PDO.

74. According to settled case-law, the principle of legal certainty means that Community/European Union rules must enable those concerned to know precisely the extent of the obligations which those rules impose on them. (23)

75. Thus, in *Prosciutto di Parma*, which concerned a PDO registered under the simplified procedure, the Court held that, in accordance with the principle of legal certainty, a particular specification such as that the slicing and packaging of the product concerned be car-

ried out in the region of production, implied a negative obligation for third parties and, accordingly, since it was not brought to the knowledge of third parties through adequate publicity in the form of Community legislation such as the registration regulation concerned in the present case, could not be relied on against them in proceedings before a national court. (24)

76. As regards the present case, it should be noted that this concerns the procedural step or measure in the context of the registration of an indication or designation under the simplified procedure which may have the effect of precluding a trade mark from being registered.

77. Thus, the relevant event in the present case clearly implies a negative obligation for third parties applying for registration of a trade mark in so far as that trade mark may be liable to conflict with the name concerned. Moreover, it also places an obligation on the authorities competent for registration of trade marks in that they are obliged to refuse to register such trade marks.

78. Accordingly, since, in the context of the simplified procedure, only the registration of the PDO or PGI is brought to the knowledge of interested third parties or authorities concerned by adequate publicity, the preclusive effect under Article 14(1) of Regulation No 2081/92 can be defined, by dint of the principle of legal certainty, only by reference to that measure, not by reference to a prior measure such as the submission to the Commission of the application for registration.

79. More specifically, so far as the application for registration under the simplified procedure is concerned, that lack of publicity clearly cannot be offset by the – substantially unrelated – fact that, as some of the parties have correctly observed, according to settled case-law it must be possible for the national courts, in accordance with the requirement of effective judicial protection, to rule on the lawfulness of an application for registration of a designation made in the context of the simplified registration procedure. (25)

80. By the same token, it cannot to my mind be argued that – so far as economic operators, or at least some of them, are concerned – a specific publication of the application for registration under the simplified procedure was not necessary for the purposes of Article 14(1) of Regulation No 2081/92 since, as provided under Article 17(1) of that regulation, that application was in any case based on a name which already enjoyed legal protection at national level and with which economic operators must already have been familiar.

81. While it is true that application of the simplified procedure presupposes, *inter alia*, that the name which a Member State seeks to register should be legally protected in that Member State or, in Member States where there is no system of protection, validated through use, (26) it must be stressed that registration under that procedure does not amount merely to the extension to Community/European Union level of a protection which already existed before at national level. (27)

82. Thus, apart from the difference in territorial scope, the scope of protection afforded to a geographical designation or indication under national law may be

substantially different from and more restricted than – as is here indeed the case – the scope of protection afforded to PGIs or PDOs registered under Regulation No 2081/92.

83. Accordingly, the existence or, more specifically, the publication of a designation of origin under a national system of protection cannot, for the purposes of Article 14(1) of Regulation No 2081/92, be relied on to make up for the lack of publicity and legal certainty attaching to the application for registration of that name under the simplified procedure.

84. Lastly, it should be emphasised that, in accordance with settled case-law, the aim of Regulation No 2081/92 is to ensure uniform protection within the Community/European Union of the geographical designations which it covers. (28)

85. Apart from the issues of legal certainty which such an approach would obviously raise, it would in my view run counter to the uniform protection which the system established under Regulation No 2081/92 thus intends to provide if the priority in time of a designation or indication for the purposes of Article 14(1) of that regulation were to be determined in the context of the simplified procedure – as some of the parties have proposed – by reference to the time at which the name concerned started to be protected under the national law of the Member State of origin or, in the absence of a national protection system, the time from which a name had been established by usage.

86. Moreover, that approach fails to take adequate account of the difference, referred to above, (29) between designations and indications within the meaning of Regulation No 2081/92 and the nationally protected names on which they may be based.

87. In the light of all the foregoing considerations, I propose that the second question be answered to the effect that Regulation No 2081/92 is to be interpreted as meaning that the date of the publication of the registration is the material date for the classification in time, for the purposes of Article 14(1) of that regulation, of a protected geographical indication which is registered in accordance with the simplified procedure under Article 17 of that regulation.

V – Conclusion

88. I propose, therefore, that the Court answer the questions referred as follows:

1. Article 14(1) of Council Regulation (EC) No 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs is not applicable in a case where a protected indication of origin has been validly registered in accordance with the simplified procedure provided for in Article 17 of Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs.

2. Regulation No 2081/92 is to be interpreted as meaning that the date of the publication of the registration is the material date for the classification in time, for the purposes of Article 14(1) of that regulation, of a protected geographical indication which has been

registered in accordance with the simplified procedure under Article 17 of that regulation.

1 – Original language: English.

2 – OJ 2006 L 93, p. 12.

3 – OJ 2001 L 182, p. 3.

4 – OJ 1992 L 208, p. 1.

5 – [2009] ECR I-5491.

6 – Regulation of 8 April 2003 amending Regulation (EEC) No 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ 2003 L 99, p. 1).

7 – Regulation adapting to Decision 1999/468/EC the provisions relating to committees which assist the Commission in the exercise of its implementing powers laid down in Council instruments adopted in accordance with the consultation procedure (qualified majority) (OJ 2003 L 122, p. 1).

8 – Cited in footnote 5.

9 – Cited in footnote 5.

10 – Cited in footnote 5, paragraph 115.

11 – See, to that effect, Case C-245/02 Anheuser-Busch ?2004? ECR I-10989, paragraph 98.

12 – The following paragraphs apply both to the original version of Article 14 of Regulation No 2081/92 and to that provision as amended by Regulation No 692/2003.

13 – See, to that effect, as regards Article 14 of Regulation No 2081/92, Bavaria and Bavaria Italia, cited in footnote 5, paragraphs 117 to 123.

14 – See, in that regard, Article 7(1)(k) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) as amended by Council Regulation (EC) No 422/2004 of 19 February 2004 (OJ 2004 L 70, p. 1) and Article 7(1)(k) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

15 – See to that effect, for example, Case C-154/05 Kersbergen-Lap and Dams-Schipper [2006] ECR I-6249, paragraph 42, and Case 10/78 Belbouab [1978] ECR 1915, paragraph 7.

16 – See in this context, for example, Case C-334/07 P Commission v Freistaat Sachsen [2008] ECR I-9465, paragraph 43, and Case C-60/98 Butterfly Music [1999] ECR I-3939, paragraph 24.

17 – See to that effect, for example, Case C-162/00 Pokrzepowicz-Meyer [2002] ECR I-1049, paragraph 49 and the case-law cited. As to the principles stated by the Court in relation to the temporal effect of legal rules, see also my View of 10 November 2009 in Case C-357/09 PPU Kadzoev [2009] ECR I-0000, paragraphs 56 to 59.

18 – Cf. in this context, Case 292/82 Firma E. Merck [1983] ECR 3781, paragraph 12, and Case C-265/08 Federutility and Others [2010] ECR I-0000, paragraph 18.

19 – See, in particular, point 50 above.

20 – It should be noted that there is nothing in the wording of Regulation No 2081/92 which would exclude, a priori, application of Article 14(1) of that regulation to names registered under the simplified procedure; moreover, that would be inconsistent with the fact that Article 14(2) and (3) of that regulation has consistently been regarded as applicable in the context of the simplified procedure (see only, for example, Bavaria and Bavaria Italia, cited in footnote 5, paragraph 111 et seq.).

21 – Cf., as regards Article 14(3) of Regulation No 2081/92, my Opinion in Bavaria and Bavaria Italia, cited in footnote 5, points 128, 129 and 152.

22 – See, in this context, Bavaria and Bavaria Italia, cited in footnote 5, paragraphs 118 and 119.

23 – See Case C-469/00 Ravil ?2003? ECR I-5053, paragraph 93; Case C-108/01 Prosciutto di Parma ?2003? ECR I-5121, paragraph 89; and Case C-209/96 United Kingdom v Commission ?1998? ECR I-5655, paragraph 35.

24 – Prosciutto di Parma, cited in footnote 23, paragraphs 91 to 96.

25 – See to that effect, in particular, Case C-269/99 Carl Kühne and Others ?2001? ECR I-9517, paragraphs 57 and 58, and Bavaria and Bavaria Italia, cited in footnote 5, paragraph 57.

26 – Cf., for example, Case C-66/00 Bigi [2002] ECR I-5917, paragraph 28.

27 – See, to that effect, Prosciutto di Parma, cited in footnote 23, paragraphs 97 and 98.

28 – See to that effect, inter alia, Case C-478/07 Budějovický Budvar ?2009? ECR I-7721, paragraph 107, and Case C-312/98 Warsteiner Brauerei ?2000? ECR I-9187, paragraph 50.

29 – Points 80 to 82 above.
