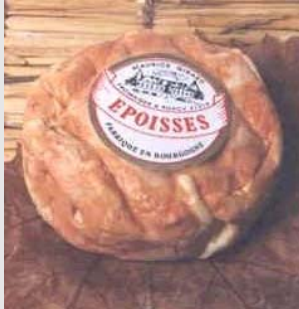


**European Court of Justice, 9 June 1998, Chiciak and Fol**

*Époisses de Bourgogne*



**TRADEMARK**

**Harmonisation European designation of origin**

- European designation of origin can not be changed by national provision or protected on a national level

(...) The uniform protection of designations of origin which was introduced by the 1992 regulation that a Member State which considers it appropriate for an alteration to be made to the designation of origin for which registration has been requested in accordance with the regulation should comply with the procedures established for that purpose.

Any alteration of an element of the product specification, such as the name of the product, that is to say the registered designation of origin, can therefore be procured only within the framework of the Community arrangements and procedures laid down by the 1992 regulation and, in particular, in compliance with the procedure laid down in Article 9 of the regulation, which refers to the Article 6 procedure. (...) The answer to the first question must therefore be that the 1992 regulation must be interpreted as meaning that, since its entry into force, a Member State may not, by adopting provisions of national law, alter a designation of origin for which it has requested registration in accordance with Article 17 and protect that designation at national level.

**Compound names**

- The provision cannot constitute a sufficient basis for interpreting the 1996 regulation as meaning that, in the absence of a footnote, each constituent part of the compound name is protected

Even though it was considered necessary in the 1996 regulation to specify in a certain number of cases, by means of footnotes, that protection of part of the name in question was not sought, the inference to be drawn from this is that the persons concerned cannot assert rights under the 1992 regulation in respect of that part of the name. Furthermore, there is nothing in the 1996 regulation to indicate the reasons for which the Member States decided not to seek protection, whether because the part had become generic, because the part in question was not protected at national level at the time when the application was made pursuant to Article

17 of the 1992 regulation or for other reasons. The eighth recital in the preamble to the 1996 regulation merely states that 'certain Member States have made it known that protection was not requested for some parts of designations and this should be taken into account'. Even if it may prove to be the case that it follows from Article 13 of the 1992 regulation that, in the absence of specific circumstances pointing to the contrary, the protection afforded by that provision covers not only the compound designation as a whole, but also each of its constituent parts, provided they are not generic or common terms, that provision cannot constitute a sufficient basis for interpreting the 1996 regulation as meaning that, in the absence of a footnote, each constituent part of the compound name is protected.

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**European Court of Justice, 9 June 1998, Chiciak and Fol**

(G. C. Rodríguez Iglesias, C. Gulmann (rapporteur), H. Ragnemalm en M. Wathelet, J. C. Moitinho de Almeida, P. J. G. Kapteyn, J. L. Murray, J.-P. Puissochet, G. Hirsch, P. Jann en L. Sevón)

**JUDGMENT OF THE COURT**

9 June 1998 (1)

(Regulation (EEC) No 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs — Exclusive competence of the Commission — Scope of the protection of names comprising several terms)

In Joined Cases C-129/97 and C-130/97,

REFERENCE to the Court under Article 177 of the EC Treaty by the Tribunal de Grande Instance, Dijon, France, for a preliminary ruling in the criminal proceedings pending before that court against

Yvon Chiciak and Fromagerie Chiciak (C-129/97),  
Jean-Pierre Fol (C-130/97),

Third parties: Syndicat de Défense de l'Époisses (C-129/97 and C-130/97),

Institut National des Appellations d'Origine Contrôlées (INAO) (C-129/97 and C-130/97),

Association Nationale d'Appellation d'Origine Laitière Française (ANAOF) (C-129/97 and C-130/97),

Laiterie de la Côte SARL and Others (C-130/97), on the interpretation 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 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),

**THE COURT,**

composed of: G.C. Rodríguez Iglesias, President, C. Gulmann (Rapporteur), H. Ragnemalm and M. Wathelet (Presidents of Chambers), J.C. Moitinho de

Almeida, P.J.G. Kapteyn, J.L. Murray, J.-P. Puissochet, G. Hirsch, P. Jann and L. Sevón, Judges, Advocate General: A. La Pergola, Registrar: L. Hewlett, Administrator, after considering the written observations submitted on behalf of:

— Syndicat de Défense de l'Époisses, by Daniel Bouchard, of the Dijon Bar,

— Mr Chiciak, Fromagerie Chiciak and Mr Fol, by Corinne Linval, of the Aube Bar,

— the French Government, by Kareen Rispal-Bellanger, Assistant Director in the Legal Affairs Directorate of the Ministry of Foreign Affairs, and Frédéric Pascal, Central Administrative Attaché in the same directorate, acting as Agents,

— the Italian Government, by Professor Umberto Lenza, Head of the Contentious Diplomatic Affairs Department of the Ministry of Foreign Affairs, acting as Agent, assisted by Ivo Braguglia, Avvocato dello Stato,

— the Commission of the European Communities, by José Luis Iglesias Buhigues, Legal Adviser, and Xavier Lewis, of its Legal Service, acting as Agents, having regard to the Report for the Hearing,

after hearing the oral observations of Syndicat de Défense de l'Époisses, represented by Daniel Bouchard; of Mr Chiciak, Fromagerie Chiciak and Mr Fol, represented by Corinne Linval; of the French Government, represented by

Christina Vasak, Assistant Secretary for Foreign Affairs in the Legal Affairs Directorate of the Ministry of Foreign Affairs, acting as Agent, and Frédéric Pascal; of the German Government, represented by Corinna Ullrich, Regierungsrätin in the Federal Ministry of Justice, acting as Agent; of the Greek Government, represented by Ioanna Galani-Maragkoudaki, Assistant Special Legal Adviser in the Special Department for Community Affairs of the Ministry of Foreign Affairs, and Ioannis Chalkias, Assistant Legal Adviser in the State Legal Council, acting as Agents; of the Italian Government, represented by Ivo M. Braguglia; and of the Commission, represented by José Luis Iglesias Buhigues and Xavier Lewis, at the hearing on 27 January 1998,

after hearing the Opinion of the Advocate General at the sitting on 12 March 1998,

gives the following

#### **Judgment**

1. By judgments of 26 February 1997, received at the Court on 1 April 1997, the Tribunal de Grande Instance (Regional Court), Dijon, referred to the Court for a preliminary ruling under Article 177 of the EC Treaty two questions on the interpretation 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, hereinafter 'the 1992 regulation'), and 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, hereinafter 'the 1996 regulation').

2. Those questions were raised in criminal proceedings brought against Mr Chiciak and Mr Fol for having marketed cheese using a protected designation of origin in breach of the applicable national rules.

3. The 1992 regulation, which entered into force on 25 July 1993, lays down the rules relating to the protection of designations of origin and geographical indications of agricultural products intended for human consumption and of foodstuffs. The seventh recital in the preamble to the regulation states that '... there is diversity in the national practices for implementing registered designations of origin and geographical indications; ... a Community approach should be envisaged; ... a framework of Community rules on protection will permit the development of geographical indications and designations of origin since, by providing a more uniform approach, such a framework will ensure fair competition between the producers of products bearing such indications and enhance the credibility of the products in the consumers' eyes'. The twelfth recital states that '... to enjoy protection in every Member State geographical indications and designations of origin must be registered at Community level ...'.

4. Article 2(2)(a) of the 1992 regulation provides:

'For the purposes of this Regulation:

(a) designation of origin: means the name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff:

— originating in that region, specific place or country, and

— the quality or characteristics of which are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors, and the production, processing and preparation of which take place in the defined geographical area.'

5. Articles 4 to 7 of that regulation lay down a registration procedure (called the 'normal' procedure).

6. Article 4(1) of the 1992 regulation provides that '[t]o be eligible to use a protected designation of origin (PDO) or a protected geographical indication (PGI) an agricultural product or foodstuff must comply with a specification'. It follows from paragraph 2 of that article that the product specification is to include, in particular, 'the name of the ... product ... including the designation of origin or the geographical indication'.

7. According to Article 5(4) of the 1992 regulation, the application for registration must be sent to the Member State in which the geographical area is located. According to Article 5(5), the Member State is to check that the application is justified and is to forward it to the Commission together with, inter alia, the product specification. According to Article 6(1), (2) and (3), within a period of six months the Commission is to verify, by means of a formal investigation, whether the registration application includes all the particulars provided for in Article 4. If the Commission concludes that the name qualifies for protection, it is to publish a notice in the Official Journal of the European Communities. If no statement of objection by a Member State or by a natu-

ral or legal person concerned is notified to it in accordance with Article 7, the Commission is to enter the name in a register entitled 'Register of protected designations of origin and protected geographical indications'.

8. According to Article 8 of the 1992 regulation, the indications 'PDO' and 'PGI' may appear only on agricultural products and foodstuffs that comply with that regulation.

9. Article 9 of the 1992 regulation provides:

'The Member State concerned may request the amendment of a specification, in particular to take account of developments in scientific and technical knowledge or to redefine the geographical area.

The Article 6 procedure shall apply *mutatis mutandis*.

The Commission may, however, decide, under the procedure laid down in Article 15, not to apply the Article 6 procedure in the case of a minor amendment.'

10. Article 13(1) of the 1992 regulation 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 insofar 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.'

11. Article 17 of the 1992 regulation, which sets out the so-called 'simplified' registration procedure and concerns the registration of names already in existence on the date on which that regulation entered into force, 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.'

12. The annex to the 1996 regulation lists the names registered as protected geographical indications (PGI) or protected designations of origin (PDO) pursuant to Article 17 of the 1992 regulation. They include 'Époisses de Bourgogne (PDO)'

13. The 1992 regulation was amended by Council Regulation (EC) No 535/97 of 17 March 1997 (OJ 1997 L 83, p. 3, hereinafter 'the 1997 regulation') which, in particular, inserted the following text into Article 5(5), after the first subparagraph:

'That Member State may, on a transitional basis only, grant on the national level a protection in the sense of the present Regulation to the name forwarded in the manner prescribed, and, where appropriate, an adjustment period, as from the date of such forwarding; these may also be granted transitionally subject to the same conditions in connection with an application for the amendment of the product specification.

Such transitional national protection shall cease on the date on which a decision on registration under this Regulation is taken.

The measures taken by Member States under the second subparagraph shall produce effects at national level only; they shall have no effect on intra-Community trade.'

14. The French Decree of 14 May 1991 concerning the designation of origin 'Époisses de Bourgogne' (JORF, p. 6593, hereinafter 'the 1991 decree') introduced that designation and defined the cheeses eligible to use it. The French Government applied for registration of that designation in accordance with the simplified procedure under Article 17 of the 1992 regulation and the Commission proceeded to register it within the framework of the 1996 regulation.

15. The 1991 decree was amended by the decree of 14 April 1995 concerning the registered designation of origin 'Époisses' (JORF, p. 6271, hereinafter 'the 1995 decree'), and the name 'Époisses de Bourgogne' was replaced by 'Époisses' throughout. The French Government stated in its observations that by letter dated 25 April 1997 it had requested the Commission to amend the product specification for the protected designation of origin 'Époisses de Bourgogne' in accordance with Article 9 of the 1992 regulation.

16. Mr Chiciak and Mr Fol are cheese makers who are being prosecuted for having 'used the name "Époisses", a protected designation of origin created by the 1995 decree, which is reserved to cheeses whose characteristics are defined in the 1991 decree concerning the designation of origin "Époisses de Bourgogne"'. The defendants did not deny that the products manufactured by them failed to comply with the requirements laid down by the 1995 decree. They submitted however that they were legally entitled to use the name 'Époisses' for their cheeses, on the ground that the 1995 decree was contrary to the 1992 regulation. They submitted that that regulation reserves to the Commission exclusive



power to grant protection to designations of origin and prohibits the Member States from legislating in that field. They pointed out that they had not infringed the 1991 decree and that the name registered in the 1996 regulation in accordance with the French authorities' request was 'Époisses de Bourgogne' and not 'Époisses'.

17. The Syndicat de Défense de l'Époisses and the Association Nationale d'Appellation d'Origine Laitière Française challenged the argument that the 1995 decree was unlawful. They claimed that the term 'Époisses' was protected on the same footing as the term 'Époisses de Bourgogne'. In that respect, they referred in particular to the 1996 regulation, the annex to which lists the products registered with protected designation of origin. It includes, inter alia: Époisses de Bourgogne, Camembert de Normandie, and Chabichou du Poitou. As regards the two latter cheeses, taken by way of example, a footnote expressly specifies that protection of the terms 'chabichou' and 'camembert' is not sought. It therefore followed, they argued, from an a contrario interpretation of the absence of any express provision in that respect, that the 'Époisses' part of the designation 'Époisses de Bourgogne' was protected as such.

18. In those circumstances, the national court decided to stay proceedings and to refer the following questions to the Court for a preliminary ruling:

'1. Does Regulation No 2081/92 of 14 July 1992 preclude, as from its entry into force, any residual power on the part of the Member States to alter a pre-existing designation of origin?

2. Do the particulars given in the form of footnotes to the annex to Regulation No 1107/96 of 12 June 1996 constitute an exhaustive list of the unprotected parts of names made up of several terms?'

19. By order of the President of the Court of 10 April 1997, these two cases were joined for the purposes of the written procedure, the oral procedure and the judgment.

#### **The first question**

20. By its first question, the national court is essentially asking whether the 1992 regulation is to be interpreted as meaning that, after its entry into force, a Member State may, by adopting provisions of national law, alter a designation of origin in respect of which it has requested registration in accordance with Article 17 and protect that designation at national level.

21. Mr Chiciak and Mr Fol, the Greek Government and the Commission submit that the 1992 regulation is exclusive in scope, which means that, since its entry into force, it precludes any power on the part of the Member States to create a new geographical name or to alter any name which has been registered in accordance with that regulation.

22. The Italian and German Governments submit that the 1992 regulation is intended to provide effective protection at Community level. That purpose is not, however, inconsistent with national legislation of a complementary nature which confers more limited protection nor does it preclude such legislation.

23. The French Government, supported by the Syndicat de Défense de l'Époisses, submits that the 1992 regulation is intended to ensure protection for designations of origin at Community level without depriving the Member States of their power as regards the operation of those designations. It submits in particular that, although the 1997 regulation now expressly provides that national protection of names may be maintained until they are registered at Community level, the national authorities necessarily had such a power as soon as the 1992 regulation entered into force. Each Member State is therefore entitled to protect certain elements of names pending conclusion of the Community registration procedure.

24. In that respect, as the Advocate General has pointed out at point 4 of his Opinion, it is sufficient to consider whether a Member State which, in accordance with Article 17 of the 1992 regulation, requested registration of a designation of origin which was protected when that regulation entered into force, has power to alter that designation without observing the procedure laid down for that purpose by the regulation.

25. According to the seventh and twelfth recitals in its preamble, the 1992 regulation is intended to ensure uniform protection within the Community of geographical names which comply with it. Furthermore, that uniform protection results from registration carried out in accordance with the rules specifically laid down by the regulation.

26. The 1992 regulation introduced the requirement for geographical names to be registered at Community level in order to enjoy protection in every Member State and defined the Community framework which was thenceforth to govern that protection, which is obtained only at the end of a compulsory notification, verification and registration procedure.

27. Within the time-limit of six months prescribed by the 1992 regulation, the French authorities requested registration of the designation of origin 'Époisses de Bourgogne', which was protected pursuant to the 1991 decree, under the 'simplified' procedure laid down in Article 17 of the aforesaid regulation, which means inter alia that the registration was effected without the objections stage prescribed by Article 7 of the 1992 regulation in the context of the 'normal' registration procedure.

28. A Member State which has used the registration procedure laid down in Article 17 may, pursuant to Article 17(3), maintain national protection of the name in question until such time as a decision on registration has been taken.

29. It is implicit in the uniform protection of designations of origin which was introduced by the 1992 regulation that a Member State which considers it appropriate for an alteration to be made to the designation of origin for which registration has been requested in accordance with the regulation should comply with the procedures established for that purpose.

30. Any alteration of an element of the product specification, such as the name of the product, that is to say the registered designation of origin, can therefore be

procured only within the framework of the Community arrangements and procedures laid down by the 1992 regulation and, in particular, in compliance with the procedure laid down in Article 9 of the regulation, which refers to the Article 6 procedure.

31. The French Government claims that, according to the scheme of the regulation, Member States must be afforded the possibility of granting provisional national protection, at least until such time as a decision has been taken on the request for registration. It maintains that its view is supported by the new provision which was inserted into Article 5 of the 1992 regulation by the 1997 regulation and which introduces the possibility for a Member State which has requested registration to grant 'on a national level, a protection in the sense of the present Regulation to the name forwarded'; that protection may also be granted 'in connection with an application for the amendment of the product specification'.

32. In that respect, it must be held, while pointing out that the new provision inserted into Article 5 of the 1992 regulation by the 1997 regulation does not apply to the registration procedure laid down in Article 17, that before the 1997 regulation entered into force there was no basis in the 1992 regulation for a power such as that relied upon by the French Government. Contrary to that government's assertion, it is clear from the 1997 regulation itself that, under the system introduced by the 1992 regulation, where Member States have the power to adopt decisions, even of a provisional nature, which derogate from the provisions of the regulation, that power is derived from express rules.

33. The answer to the first question must therefore be that the 1992 regulation must be interpreted as meaning that, since its entry into force, a Member State may not, by adopting provisions of national law, alter a designation of origin for which it has requested registration in accordance with Article 17 and protect that designation at national level.

#### **The second question**

34. In view of the context in which the second question is raised and having regard to the explanations given by the national court, that question is essentially asking whether, in the case of a 'compound' designation of origin, the fact that there is no footnote in the annex to the 1996 regulation specifying that registration is not sought for one of the parts of that designation means that each of its parts is protected.

35. In that respect, the French Government and the Commission essentially submit that, as regards compound names, the general rule resulting from Article 13 of the 1992 regulation is that, provided that a generic or common term is not involved, the protection applies not only to the name as a whole, but also to each of its terms. In their submission, if, as regards compound names, only the name as a whole were protected, the result would be that the level of protection specified in Article 13 of the 1992 regulation could not be fully ensured. When the 1996 regulation was under consideration, the principle was laid down that unprotected terms in compound names had to be expressly

specified. That specification does not prejudice whether or not the part of the name concerned is generic. In the present case, the absence of any footnote means that the protection covers not only the name as a whole, but also each of its constituent terms.

36. That argument cannot be accepted. Even though it was considered necessary in the 1996 regulation to specify in a certain number of cases, by means of footnotes, that protection of part of the name in question was not sought, the inference to be drawn from this is that the persons concerned cannot assert rights under the 1992 regulation in respect of that part of the name. Furthermore, there is nothing in the 1996 regulation to indicate the reasons for which the Member States decided not to seek protection, whether because the part had become generic, because the part in question was not protected at national level at the time when the application was made pursuant to Article 17 of the 1992 regulation or for other reasons. The eighth recital in the preamble to the 1996 regulation merely states that 'certain Member States have made it known that protection was not requested for some parts of designations and this should be taken into account'.

37. Even if it may prove to be the case that it follows from Article 13 of the 1992 regulation that, in the absence of specific circumstances pointing to the contrary, the protection afforded by that provision covers not only the compound designation as a whole, but also each of its constituent parts, provided they are not generic or common terms, that provision cannot constitute a sufficient basis for interpreting the 1996 regulation as meaning that, in the absence of a footnote, each constituent part of the compound name is protected.

38. There is nothing in the 1996 regulation — adopted by the Commission according to the committee procedure laid down in Article 15 of the 1992 regulation — to suggest that the use of the system of footnotes had such a purpose. Furthermore, under the system of protection created by the 1992 regulation questions concerning the protection to be accorded to the various constituent parts of a name, and, in particular, the question whether a generic name or a constituent part protected against the practices referred to in Article 13 of the 1992 regulation may be concerned, are matters which fall for determination by the national court on the basis of a detailed analysis of the facts presented before it by the parties concerned.

39. The answer to the second question must therefore be that, as regards a 'compound' designation of origin, the fact that there is no footnote in the annex to the 1996 regulation specifying that registration is not sought for one of the parts of that designation does not necessarily mean that each of its parts is protected.

#### **Costs**

40. The costs incurred by the French, German, Greek and Italian Governments, and by the Commission of the European Communities, which have submitted observations to the Court, are not recoverable. Since these proceedings are, for the parties to the main proceed-

ings, a step in the action pending before the national court, the decision on costs is a matter for that court.

On those grounds,

THE COURT,

in answer to the questions referred to it by the Tribunal de Grande Instance de Dijon by judgments of 26 February 1997, hereby rules:

1. 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 must be interpreted as meaning that, since its entry into force, a Member State may not, by adopting provisions of national laws, alter a designation of origin for which it has requested registration in accordance with Article 17 and protect that designation at national level.

2. As regards a 'compound' designation of origin, the fact that there is no footnote in the annex 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 specifying that registration is not sought for one of the parts of that designation does not necessarily mean that each of its constituent parts is protected.

Rodríguez Iglesias

Gulmann

Ragnemalm

Wathelet

Moitinho de Almeida

Kapteyn

Murray

Puissochet

Hirsch

Jann

Sevón

Delivered in open court in Luxembourg on 9 June 1998.

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1: Language of the case: French.