

ECJ decides on essential function of a collective EU mark **Geographical indications/appellations of origin Certification/collective marks**
European Union - Hoogenraad & Haak, Advertising + IP Advocaten

October 23 2017

- **Tea Board opposed registrations of several EU figurative trademarks involving the word element 'darjeeling'**
- **ECJ held that the essential function of an EU collective mark is to distinguish the goods or services of the members of the association which own the mark from those of other undertakings**
- **Tea Board unable to rely on protection of GIs offered by TRIPs Agreement, as GIs and EU collective marks designating geographical origin are governed by distinct legal regimes and pursue different aims**

In *The Tea Board v the EU Intellectual Property Office (EUIPO)* (joined cases C-673/15 P to C-676/15 P) the European Court of Justice (ECJ) has held that the essential function of an EU collective mark is to distinguish the goods or services of the members of the association which own the mark from those of other undertakings, and not to distinguish those goods according to their geographical origin.

The Tea Board is a body empowered to administer the production of tea in India. It filed notices of opposition to the registrations of several EU trademarks of the following figurative sign comprising the word element 'darjeeling' for lingerie by the French company Delta Lingerie based on an earlier EU collective word mark DARJEELING and an earlier collective figurative mark containing the word 'darjeeling' (see below).



The Tea Board appealed this decision before the European Court of Justice (ECJ) relying on two grounds – the infringement of Article 8(1)(b) and Article 8(5) of Regulation 207/2009 arguing that registration of the mark containing 'darjeeling' by Delta Lingerie should be refused. The Tea Board then sought annulment of the decisions with the EU General Court. The court ruled that the essential function of EU collective marks is not different from the function of EU individual marks and that the existence of a likelihood of confusion was ruled out because the goods were neither identical nor similar. The court also stated that the board of appeal had been wrong to exclude the existence of a risk of advantage resulting from the use of the trademarks applied for without due cause, and annulled the decision to that extent. Both earlier marks covered goods in Class 30 of the Nice Agreement: 'tea'. The EUIPO Opposition Division rejected all oppositions. The Tea Board then filed notices of appeal with the EUIPO seeking annulment of those decisions. The board of appeal dismissed the appeals and upheld the opposition division's decisions.

The ECJ ruled that Article 8(1)(b) did not apply in this case. First, the ECJ held that EU collective marks – consisting of signs or indications which may serve to designate the geographical origin of goods and services – fall within the meaning of Paragraph 1 of that article. According to that paragraph, only trademarks that are capable of distinguishing the goods and services of the members of the association which own the trademark from those of other undertakings may constitute EU collective marks.

Second, while as argued by The Tea Board Article 66(2) constitutes an exception to the absolute ground for refusal under Article 7(1)(c), that circumstance does not call into question the fact that the essential function of an EU collective mark under Article 66(2) is to guarantee the collective commercial origin of the goods sold under that trademark, and not to guarantee their collective geographical origin.

Third, The Tea Board could not rely in support of its argument on Article 13(1)(c) and (d) of Regulation 1151/2012 or on Article 22 of the TRIPs Agreement, which relate to the protection of geographical indications (GIs). This is because GIs on the one hand, and EU collective marks consisting of signs or indications which may serve to designate the geographical origin of goods and services on the other, are signs which are governed by distinct legal regimes and pursue different aims.

The second complaint regarding Article 8(5) of the regulation sought to obtain an assessment of the facts by the ECJ and was therefore rejected as inadmissible.

Delta Lingerie's cross-appeals alleging infringement of Article 8(5) by the EU General Court were rejected by the ECJ because the first cross-appeal was based on a misreading of the judgments under appeal and the second cross-appeal was unfounded.

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