

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

In the matter of an application for the protection of International Registration No. 0884242 and in the matter of an Opposition thereto.

BAVARIA N.V.

Applicant

(Represented by MacLachlan & Donaldson)

BAYERISCHER BRAUERBUND e.V.

Opponents

(Represented by Tomkins & Co.)

The Application

1. On 1 March, 2006 (“the relevant date”), Bavaria N.V. of De stater 1, NL-5737 RV Lieshout, The Netherlands, made application for an International Registration designating Ireland (No. 0884242) under the Madrid Protocol to register this sign:



(hereinafter BAVARIA CROWN) as a Trade Mark in respect of the following goods in Class 32:

“Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.”

2. The application was accepted for registration and advertised accordingly in Journal No. 2200 dated 11 April, 2012.
3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Trade Marks Act, 1996 (“the Act”) was filed on 9 July, 2012 by Bayerischer Brauerbund e.V. of Oskar-von-Miller-Ring, D-80333 Munchen, Germany. The Applicant filed a counter-statement on 10 October, 2012 and evidence was, in due course, filed by the parties under Rules 20, 21, 22 and 23 of the Trade Marks Rules, 1996 (“the Rules”).

4. The opposition became the subject of a hearing before me, acting for the Controller, on 15 December, 2015. The parties were notified on 12 January, 2016 that I had decided to uphold the opposition and to refuse the registration of the mark. This notification was issued on foot of me inadvertently putting an imprecise memo on the file. That error was corrected and the parties were informed on 23 February, 2016 that my decision was to uphold the opposition in respect of beer alone and to allow the application to proceed to registration in respect of all other goods, namely, “*mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages*”. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Applicant in that regard pursuant to Rule 27(2) of the Rules.

Grounds of the Opposition

5. In its Notice of Opposition the Opponent states that it is the proprietor of the Protected Geographical Indication “BAYERISCHES BIER” (hereinafter the “PGI”) under Council Regulation (EEC) No. 2081/92 of 14 July, 1992 for the protection of geographical indications and designations of origin for agricultural products and foodstuffs. The protection was granted by Council Regulation (EC) No. 1347/2001 and published on page 3 of Official Journal L182 of 5 July, 2001. The Opponent then raises objection to the present application under Sections 8 and 10 of the Act, which I shall summarise as follows:

- i. Section 8(1)(c) – *the mark consists exclusively of a sign that designates certain characteristics of the goods;*
- ii. Section 8(1)(d) – *the mark consists exclusively of a sign which has become customary in the trade;*
- iii. Section 8(3)(b) – *the mark is of such a nature as to deceive the public;*
- iv. Sections 8(4)(a) – *use of the mark is prohibited in the State by an enactment or rule of law or by any provision of Community law;*
- v. Section 10(4)(a) – *use of the mark is liable to be prevented by virtue of any rule of law protecting an unregistered trade mark or other sign used in the course of trade.*

Counter-Statement

6. In its Counter Statement the Applicant admits the Opponent is the proprietor of the PGI Bayerisches Bier, but does not admit the validity of the PGI. The Applicant also emphatically denies each and every of the allegations made against the application.

Rule 20 Evidence

7. Evidence submitted by the Opponent under Rule 20 consists of a undated Statutory Declaration and supporting evidence, by way of eight exhibits labelled “BB1” to “BB8” (each witnessed and dated 17 January 2013), of Robert Scholz, Managing director of Bayerischer Brauerbund e.V., a German registered association of Bavarian brewers, of Oscar-von-Miller-Ring 1, D-80333 Munich, Germany.

8. In his declaration Mr. Scholz states that his association was founded in 1880 for the purpose of protecting the interests of Bavarian beer brewers. His association is tasked with fostering and strengthening the protection of the geographical indication “Bayerisches Bier” by the registration of the collective marks “Bayerisches Bier” and “Bavarian Beer”, and by proceeding against the unauthorised use of the geographical indications “Bayerisches Bier” and “Bavarian Beer”. He provides details of trade mark registrations for “Genuine Bavarian Beer”, “Bayerisches Bier” and “Bayrisch Bier” (International Collective Marks 214051, 351823 and 351824 respectively), these denominations dating back to 1958. He says the name “Bayerisches Bier” has also long been protected through bilateral agreements between the Federal Republic of Germany and other countries dating back to 1960.

9. Mr. Scholz states that on 28 September, 1993 his association submitted to the German Government an application for registration of BAYERISCHES BIER as a Protected Geographical Indication (PGI) pursuant to new European Economic Community (EEC) regulations on the protection of geographical indications and designations of origin. On 20 January, 1994 the German Government informed the European Commission of that application and, following an extensive scrutiny by the Commission, the European Council adopted Council Regulation No. 1347/2001 of 28 June 2001 by which the name BAYERISCHES BIER was registered as a PGI for beers. The Regulation was published in the Official Journal of the European Communities on 5 July, 2001. He attaches at Exhibit “BB1” an extract from the DOOR database of the European Commission having Dossier No. DE/PGI/0017/0518 showing the registration details of the PGI and at Exhibit “BB2” a copy of the publication in the Official Journal of the European Communities of Regulation No. 1347/2001 showing the entry into force of the Regulation on 5 July, 2001. By this publication the PGI BAYERISCHES BIER obtained protection in all Member States of the European Community.

10. He notes the Applicant does not admit the validity of the PGI BAYERISCHES BIER, and states that the validity of the PGI was raised in proceedings before the Corte D'Appello di Torino (Appeal Court of Turin) between the Opponent and the Applicant's Italian subsidiary. In that case the Court referred to the European Court of Justice (ECJ) the question of whether Council Regulation (EC) No. 1347/2001 was invalid. In its judgment¹ the ECJ held at paragraph 115 that "*Consequently, it must be held that consideration of the first question asked by the referring Court has not disclosed any factor liable to affect the validity of Regulation No. 1347/2001*". Therefore the issue of validity of the PGI is *res judicata*. He attaches at Exhibit "BB3" a copy of the ECJ judgment in that particular case.
11. Mr. Scholz states that the Opponent abandons all grounds of opposition cited in the Notice of Opposition save that concerned with Section 8(4)(1) of the Act, which provides that "*A trade mark shall not be registered if or to the extent that its use is prohibited in the State by any enactment or rule of law or by any provision of Community law*". He identifies the relevant provisions of Community law as Article 14(1) in conjunction with Article 13 of Council Regulation No. 2081/92 (as amended by Regulation No. 692/2003 dated 8 April, 2003). He then explains why these provisions, and not the later Council Regulation of March 2006 which repealed Council Regulation No. 2081/92, applies to this opposition (he attaches at Exhibit "BB6" copies of both Regulations). The basis for this lies in the judgment of the ECJ dated 22 December 2010 in Case-120/08², a copy of which he attaches at Exhibit "BB4", wherein the Court found that the principle of legal certainty in Community law 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 the situation obtained.
12. Mr. Scholz states that the provisions of Regulation 2081/92 are directly applicable in Ireland as EU Regulations always have direct effect. This is expressly laid out in Article 288 of the Treaty on the Functioning of the EU. He attaches at Exhibit "BB7" the cover page of this Treaty and its Article 288. He goes on to provide extensive analysis and opinion on the provisions of the relevant Regulations, how these should be applied to the case at hand and how they have been applied in other cases. He attached at Exhibit "BB5" a copy of the ECJ judgment in case C-87/97 (GORGONZOLA) and draws attention to the Court's findings on what is meant by evocation. He states the ECJ, in joined Cases C-4/10 and C-27/10³, which were concerned with

¹ Case C-343/07 of 2 July, 2009

² Bavaria NV v. Bayerischer Brauerbund eV

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

provisions in Regulation No. 110/2008 on the protection of geographical indications for alcoholic spirits (which are relevant to those of Article 13 and 14 of Regulation No. 2081/92) that the national authorities are required to refuse or invalidate the registration of a trade mark which falls within the provisions of Article 16 (which are equivalent to those of Article 13 of regulation No. 2081/92). He provides a copy of the Court's judgment in those joined cases at Exhibit "BB8".

Rule 21 Evidence

13. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration of Franciscus Alfonsus Maria (Frank) Swinkels, Director of Bavaria N.V., dated 20 January, 2014 and five supporting exhibits labelled "BNV1" to "BNV5", and a Statutory Declaration of Stephen Meleady, Director of M&J Gleeson and Company, dated 23 March, 2014 and one accompanying exhibit labelled "SM1".
14. Mr. Swinkels notes that the Opponent tasks itself with the protection of the PGI "Bayerisches Bier" and claims to do so by registering the PGI and the words "Bavarian Beer" as collective trade marks. He notes the grounds mentioned in the Notice of Opposition are based on the existence of the PGI which was registered in 2001, but not on any of the Opponents trade mark registrations detailed in Mr. Scholz's declaration. In any event, he states that International Collective Trade Mark Nos. 351823 and 351824 are no longer in force and that the bilateral agreements to which Mr. Scholz refers are no longer valid following Council Regulation No. 1347/2001. Furthermore he states that there never existed a bilateral agreement between Ireland and Germany governing the use of the name BAVARIA.
15. Mr. Swinkels states that he is aware of the ECJ decision regarding the validity of the PGI, but he does not accept that the PGI could reasonably be invoked to prevent the extension to Ireland of the International Registration applied for.
16. Mr. Swinkles notes the Opponent has abandoned all grounds of opposition mentioned in the Notice of Opposition save that in respect of Section 8(4)(a), but says there is no enactment of rule of law or any provision in Community law which could prevent the registration of the mark at issue.
17. Mr. Swinkels then goes on to provide details of the Applicant's history and business. He explains that the Applicant is the second largest brewery in the Netherlands and produces

approximately 600 million litres of beer annually. The Applicant, based in North Brabant, was founded in 1719 by Laurentius Moorees and is currently owned by the Swinkels family. He says the Applicant has been using its trade mark BAVARIA since at least 1931 and registered its first trade mark in the Netherlands in 1971 (No. 0067230) and that that registration is now effective in the Benelux territories. He attaches at Exhibit “BNV1” a copy of the registration certificate for that Benelux trade mark, on which it states the mark was in use in the Netherlands since 1931 and in Belgium from 1957. He says the Applicant has gone on to register numerous trade marks in the Benelux and other territories consisting of or containing prominently its trade mark BAVARIA.

18. As evidence of his company’s long-standing use of the trade mark BAVARIA he attaches at Exhibit “BNV2” a copy of an extract from the official publication of the International Trade Mark No. 133171 (a combined figurative and verbal mark containing the very prominent word element BAVARIA) registered on 8 November 1947 and which remained in force until 8 November 1987.

19. Mr. Swinkels states that until the 1970’s the Applicant mainly concentrated on the Dutch market, but now sells its beer in up to 120 countries and has sales subsidiaries in France, Spain, Italy, England and Canada and it also has agents in a large number of other countries. In 1978 the Applicant exported alcohol-free malt beer to countries in the Middle East under the trade mark BAVARIA and that BAVARIA beer is now brewed locally in Russia under licence. He says that in addition to the Applicant’s numerous registrations in the Benelux territories, the Applicant has registered its trade mark BAVARIA nationally in a large number of countries throughout the world and internationally under the Madrid Protocol. He attaches at Exhibit “BNV3” a schedule containing particulars of all the Applicant’s trade mark registrations. The schedule shows a large number of registrations in countries within the European Community, including Ireland.

20. He takes issue with Mr. Scholz’s assertion that the mark at issue, if protected in the State, will “*evoke in the minds of the average Irish consumer the geographical area of Bavaria in Germany*”. Mr. Swinkels states the Applicant has been using for at least 15 consecutive years and continues to use its trade mark BAVARIA in Ireland and, consequently, the average Irish consumer recognises BAVARIA as the Applicant’s trade mark.

21. Furthermore, Mr. Swinkels says the Applicant has been using its trade mark BAVARIA within the European Community for many years prior to the date of the PGI and has obtained numerous registrations consisting of and/or containing its trade mark BAVARIA both before and after the date of the PGI (2001) in numerous countries of the European Community. He states the registration of the PGI has not and could not have the effect of preventing the Applicant from continuing to use its trade mark BAVARIA within the European Community.
22. Mr. Swinkels says that the PGI BAYERISCHES BIER and the opposed trade mark are not confusingly similar and that the opposition is therefore entirely unjustified. In addition, he states the Applicant has used the trade mark BAVARIA within Ireland since 1998 in connection with a number of the Applicant's beers including BAVARIA CROWN, BAVARIA PREMIUM PILS, BAVARIA PREMIUM LAGER BEER, BAVARIA 8.6 and BAVARIA NON-ALCOHOLIC BEER. The Applicant's trade mark has been used throughout the whole of Ireland. It was originally distributed by O'Brien Fine Wines but subsequently through Gleeson and C&C Holdings Ltd.
23. He says the Applicant's BAVARIA beer has been sold in the principle supermarkets in Ireland including Dunnes Stores, Spar and Tesco. It has also been sold in independent retailers and in at least 400 public houses scattered throughout Ireland. Sales of BAVARIA beer in Ireland in 1998 exceeded 500,000 litres with a retail value of more than €295,000. Sales gradually increased over the years reaching a peak in 2009 when more than 10,000,000 litres of BAVARIA beer were sold in Ireland amounting to sales in excess of €5,000,000. He provides a table of litres sold and sales revenue for the 16 years from 1998 to 2013 which shows total sales of over 89 million litres and sales valued at over €43 million. He says that advertising expenditure figures prior to 2007 are not available, but he provides a table showing advertising expenditure figures for the 6 years from 2007 to 2012, which show a total of more than €2,260,000 was spent on advertising BAVARIA beer in Ireland. He attached at Exhibit "BNV4" copies of such advertisements which were placed on location in Ireland and in Irish publications.
24. He states the Applicant also sponsored the BAVARIA city racing in Dublin in the years 2011 and 2012, events which were well publicised and very successful. He attaches at Exhibit "BNV5" pictures of those events at which the Applicant's trade mark BAVARIA was prominently displayed. Also included in that exhibit are screenshots from the Applicant's website www.bavaria.ie from 2007.

25. Mr. Swinkels states that in referring to material contained in Exhibits “BB4” to “BB8” Mr. Scholz expressed opinions which are unsupported by evidence and which he says are contradicted by incontrovertible facts relating to the use by the Applicant in the Community of its trade mark BAVARIA in numerous forms. By virtue of that use, which commenced much earlier than the date of registration of the PGI, the word BAVARIA functions as a trade mark and not as the name of a former country in Germany. He points to the European Regulation 1347/2001 (Exhibit “BB2” of Mr. Scholz’s evidence) in which the European Council confirms that the name BAVARIA is a valid trade mark and does not mislead the consumer. This he says is evidence that the Council is of the opinion that the PGI and the trade mark BAVARIA can coexist.
26. He concludes his evidence by claiming it would be completely illogical if the PGI BAYERISCHES BIER could successfully be invoked to prevent the Applicant from extending its BAVARIA CROWN mark to Ireland, bearing in mind the extent to which the Applicant has been using its trade mark BAVARIA in the European Community and in Ireland. The PGI and the mark are not confusingly similar and it is inconceivable that beer drinkers or other interested consumers in Ireland would see any connection between the mark at issue and the PGI.
27. For his part Stephen Meleady states that his company (M J Gleeson & Company) is Ireland’s leading distributor of alcohol products to the on trade and off trade, and represents a number of well-known brands in its beer, wine and spirits division including Bavaria. His company is also a wholesale supplier of packaged beer for the country’s leading brands, namely Heineken, Budweiser and Carlsberg. His company is now a subsidiary of C&C group PLC which distributes Becks, Franziskaner and Spaten, three leading German beers in Ireland.
28. Mr. Meleady states that the sales figures set out in Mr. Swinkels’ declaration when translated into retail sales values in Ireland can be multiplied by a factor of five to reflect the addition of excise duties and VAT. In the years 2012 and 2013, for example, the retail sales value of BAVARIA beer sold in Ireland exceeded €21.5 million and €19 million respectively.
29. He states the most popular beers in Ireland are those which originate from countries other than German, namely, Heineken from Holland, Budweiser from the USA and Carlsberg from Denmark. BAVARIA is ranked sixth most popular beer in Irish off licences. He estimates that sales of German beers represent less than 1% of total beer sales in the country.

30. He says that his company has been instrumental in many promotional activities which he believes have had a significant effect in increasing the brand awareness of BAVARIA beer in Ireland. The dominant colour associated with BAVARIA beer is blue and at least 20 prominent public houses throughout the country have been painted blue and emblazoned with the trade mark BAVARIA. He attaches at Exhibit “SM1” photographs of the famous public house, The Silver Tassie, which is located on a principle route from Dublin to the south of the country. Through this type of promotion and other marketing activities BAVARIA has become a very popular and widely recognised Dutch beer. He concludes his evidence by stating that, based on his experience, Irish drinkers are well aware that BAVARIA is the name of a Dutch beer and not a German beer.

Rule 22 Evidence

31. Evidence submitted by the Opponent under Rule 22 consisted of a second Statutory Declaration of Robert Scholz dated 17 July, 2014 and supporting evidence, by way of eleven exhibits labelled “BB9” to “BB19”.

32. Mr. Scholz responds to the evidence filed by the Applicant under Rule 21 and confirms the opposition is based solely on the PGI “Bayerisches Bier”. He then provides explanations for his references to a number of trade marks and bilateral agreements made in his earlier evidence under Rule 20. He attaches at Exhibits “BB9” and “BB10” material relating to those trade marks.

33. He reiterates his contention that Articles 13 and 14(1) of Council Regulation No. 2081/92 constitutes an “*enactment or rule of law or ...any provision of Community law*” as set out in Section 8(4) of the Trade Marks Act 1996. He states that similar provisions provided the basis upon which the Intellectual Property Office of the Czech Republic excluded the Applicant’s International Registration No. 1051133 BAVARIA HOLLAND from protection in December 2013. He attaches at Exhibit “BB11” a true copy of the decision in that case together with a certified English translation. He attaches at Exhibit “BB12” a true copy of a printout dated 12 June 2014 from the World Intellectual Property Organisation (WIPO) ROMARIN database containing information on the current status of International Registration No. 1051133 BAVARIA HOLLAND, which shows the mark has been provisionally refused protection in a large number of the designated countries together with a copy of the notification from the

Intellectual Property Office of the Czech Republic to WIPO of the final refusal of that mark, with certified English translation.

34. Mr. Scholz is critical of the Applicant's evidence regarding the many claimed trade mark registrations throughout the world. Of the list of marks that runs to 29 pages only two marks are registered in Ireland – all the rest being irrelevant to the proceedings at hand. The two Irish marks are “8.6 BAVARIA” (for which exclusive rights to the word Bavaria were disclaimed) and “BAVARIA CITY RACING”. The former was filed on 29 October 1992, which was before the PGI came into existence and which therefore could not be opposed at the time. The latter is irrelevant as it is registered only for services in Class 41, which hold no interest for the Opponent.
35. Mr. Scholz then provides material to support how assiduously the Opponent defends the integrity of the PGI, including at Exhibit “BB13” a copy of relevant papers from opposition proceedings in the United Kingdom.
36. He takes issue with the claim made in Mr. Swinkels' declaration that “... *the word BAVARIA functions as a trade mark and not as the name of a former country in Germany*”. If that was the case then he asks why the Applicant opposed the protection in Croatia of the Opponent's International Collective Mark No. 1166669 BAVARIAN BEER registered in WIPO for “beers” in Class 32. At Exhibit “BB14” he attaches a copy of an extract from the Romarin database of WIPO showing the Croatian Intellectual Property Office's refusal of that protection on the grounds of similarity between the marks and the goods, and the resultant likelihood of confusion. Given that the refused mark was not a trade mark it must be assumed that the Applicant (the Opponent in Croatia) was of the opinion that its earlier marks functioned as geographical indications to indicate goods from Bavaria, Germany rather than as commercial trade marks, otherwise it would not have been concerned by the registration of a collective mark indicating beers from Bavaria.
37. Mr. Scholz claims Mr. Swinkels' interpretation of recitals 3 and 4 of EC Regulation 1347/2001 is misleading as these refer to trade marks registered prior to the registration and publication of the PGI in July 2001. Further, recital 3 states that the registration of “Bayerisches Bier” is not liable to mislead the consumer as to the true identity of the product. Recital 4 merely points out that certain trade marks such as the trade mark BAVARIA which were registered before the date of application for the PGI may continue after the registration of the PGI, as long as they

fulfil the conditions under Article 14(2) of Regulation No. 2081/92. He says the German Supreme Court has since cancelled the International Registration “BAVARIA HOLLAND BEER” in Germany as the conditions laid out under Article 14(2) were not met.

38. He provides materials at Exhibits “BB15” and “BB16” relating to the withdrawal by the Applicant of two Community Trade Mark applications containing the word “BAVARIA” following the filing of oppositions by the Opponent. At Exhibit “BB17” he attaches a copy of the provisional refusal by the French National Institute for Intellectual Property in respect of International Trade Mark No. 1051133 BAVARIA HOLLAND on the grounds that it was legally prohibited in France based on the provisions of Articles 13 and 14 of Regulation No. 510/2006 due to the earlier protected PGI. He also provided information on what happened to the same mark in the Slovenian, Czech Republic, Spanish and Portuguese Offices.
39. He states that, to the best of the Opponent’s knowledge, no relevant BAVARIA trade marks have been filed in the EU or in its Member States after the date of registration of the PGI in 2001 that have not been opposed by his Association.
40. He turns to Mr. Meleady’s declaration and states that document confirms that the opposed mark was not advertised or promoted until 2007. He claims the statement made by Mr. Swinkels in his declaration that advertising figures prior to 2007 are not available is, at a minimum, disingenuous as it appears that no advertising actually took place prior to 2007.
41. Mr. Scholz then comments on the most popular brands of beer on the Irish market and shows how two of them (Heineken and Carlsberg) are specifically linked to the locations from which they originate. In the case of Budweiser he notes the long-running dispute between brewers in Budweis and the United States of America and claims the issues at stake in that dispute are similar to those obtaining in the present case. He attaches at Exhibit “BB18” information from the European Commission DOOR database regarding the PGI “Budejovické pivo”.
42. He casts doubt on Mr. Meleady’s contention that Gleasons engaged in promotional activities “*over the past 14 years*”, as no evidence of any such promotion taking place prior to 2007 has been produced. As regards the Mr. Meleady’s reference to the dominant blue colour associated with BAVARIA beer Mr. Scholz states it is important to note that blue is the colour of the flag of Bavaria, while the Dutch national colours are red, white and blue. He attaches at Exhibit “BB19” two printouts from Wikipedia showing the flag of Bavaria. He says that many Bavarian

breweries use the variant flag of Bavaria (bicolour of white over blue) for their beer labels and use by the Applicant of the dominant blue colour combined with white elements for BAVARIA beers is a clear case of riding on the coat-tails of the reputation of Bavarian beer and his Association's PGI "Bayerisches Bier".

43. He concludes his evidence by stating there is no evidence to support Mr. Meleady's claim that "*Irish beer drinkers are well aware that BAVARIA is the name of a Dutch beer and not a German beer*". He states that Irish beer drinkers would be highly likely to assume that it is a German beer.

Rule 23 Evidence

44. The Applicant claimed the Opponent went beyond what is permissible in the filing of evidence under Rule 22, which was not confined to matters strictly in reply to the Applicant's Rule 21 evidence. The Applicant sought leave to file further evidence under Rule 23 to address the claimed new material introduced by the Opponent in the Statutory Declaration of Robert Scholz. The Controller agreed that certain elements of the Rule 22 evidence went beyond what was permissible and granted the Applicant's request so long as the evidence to be filed by the Applicant under Rule 23 was limited to the following specific matters identified by the Controller as meriting a response:

- i. Paragraph 6 regarding the claimed "successful opposition" against UK application No. 2412237 and the contents of Exhibit "BB13".
- ii. Paragraph 18 regarding the Opponent's stated successful oppositions to all applications by the Applicant to register BAVARIA in respect of beer in the EU since the Opponent's PGI BAYERISCHES BIER was registered in 2001.
- iii. Paragraphs 14 and 15, which mention the withdrawal by the Applicant of CTM 004845681 and CTM 008189896 respectively, neither of which were mentioned by the Applicant in its Rule 21 evidence.

45. Evidence submitted by the Applicant under Rule 23 consists of a Statutory Declaration of Petrus Johannes Joseph Maria (Peter) Swinkels, retired Chairman of the Board of Directors of Bavaria N.V., dated 8 December, 2014 and two supporting exhibits labelled "BNV6" and "BNV7".

Some of the evidence went beyond the permitted scope, included Exhibit “BNV6”, for which leave to file further evidence was granted and, consequently, has been ignored.

46. Mr. Peter Swinkels states that UK application No. 2412237 was not successfully opposed. Because of the considerable time delay in opposition proceedings and the fact the Applicant already owned other marks containing BAVARIA in the UK the Applicant took the commercial decision to cease using the mark applied for and withdraw the application. Therefore, this was not a case of a successful opposition.
47. He also explains that the Applicant decided, for practical and cost effective reasons, to withdraw CTM 004845681 and CTM 008189896.
48. He denies the Opponent has successfully opposed all applications by the Applicant to register BAVARIA in respect of beer in the EU since the Opponents PGI was registered in 2001. He attaches at Exhibit “BNV7” a table showing 20 marks (18 of which are in respect of beer in Class 32) containing the word “Bavaria” which the Applicant applied for and successfully registered in various Member States of the European Union after the date of protection of the PGI “Bayerisches Bier”. Several of these registrations resulted from favourable decisions in opposition proceedings brought by the Opponent.
49. He says this illustrates that the Applicant – in spite of the numerous oppositions filed by the Opponent – is still successful in registering trade marks in the EU which contain the word “BAVARIA”. The fact that the Opponent files many oppositions against these applications is not grounds for upholding the opposition in these proceedings; it only proves the Opponent has an aggressive and expensive strategy.

The Hearing

50. At the Hearing the Opponent was represented by Ms. Yvonne McNamara BL, instructed by Louise Carey, Trade Mark Attorney, of Tomkins & Co. and the Applicant by Mr. Paul Coughlan BL, instructed by Norman MacLachlan, Trade Mark Attorney of MacLachlan and Donaldson.
51. At the outset of her submission Ms. McNamara provided details of the Opponent and the history of the PGI. The application for the PGI was made on 28 September 1993 – almost as soon as it

could be after the coming into effect of the relevant EU legislation⁴. The application was submitted by the German government to the European Commission on 20 January, 1994. Following the relevant inter-government process as between these two bodies, registration was achieved via Council Regulation 1347/2001 of 28 June 2001, which entered into force on 5 July 2001. The registration details set out the exacting characteristics as to the type of fermentation, the characteristics of the wort, alcohol content by volume, colour and hop bitter content required for each of the 13 types of beer that must be met before the BAYERISCHES BIER can be used on those types of beer.

52. Ms. McNamara then turned her attention to the Applicant and its indication that it has been using the word “Bavaria” in its trade marks since 1931 and that it first registered that word as a mark in the Netherlands in 1971. She observed the Applicant indicated that its export trade started in the 1970’s and exhibits a list of registrations of trade marks consisting of or containing the word “Bavaria” in various countries. However, all but 3 of the listed marks date from the 1990’s or later. Furthermore, she contended the only registration of the opposed mark is the home registration in Benelux in 2006, which is the mark that forms the basis of the international registration that is now being opposed.

Grounds of Opposition

53. She then confirmed the grounds upon which the opposition was founded. First and foremost was the BAYERISCHES BIER geographical indication, and the protection afforded it under EU law. Next was Section 8(4)(a) of the Act, the relevant provisions of which states “*A trade mark shall not be registered if, or to the extent that: (a) its use is prohibited in the State by an enactment or rule of law or by any provision of Community law...*”. Also, in the alternative to the two aforementioned grounds, that the Controller should use his discretion and refuse to register the mark.

54. In his opening remarks Mr. Coughlan addressed the Opponent’s tripartite attack on the Applicant’s mark. He accused the Opponent of ambushing the Applicant at the Hearing and attempting to expand its grounds of opposition way beyond what was laid out in the Notice of Opposition. He pointed out that there are no provisions under the 1996 Act that permit the Controller to use his discretion to refuse an application for registration. Ms. McNamara acknowledged that to be the case and conceded the point.

⁴ Council Regulation 2081/92 of 14 July 1992 which entered into force on 26 July 1993

55. As regards the other two grounds mentioned by Ms. McNamara Mr. Coughlan argued the Opponent cannot bring a case under anything other than Section 8(4)(a) as that is the only ground mentioned in the Notice of Opposition which was not formally abandoned by Mr. Scholz in his evidence. Mr. Coughlan argued that the Applicant is now, for the first time, having to deal with an objection raised specifically in respect of the Opponent's PGI, a ground which was not expressly raised in the Notice of Opposition.
56. Furthermore, he argued that the provisions of Section 8(4)(a) are applicable only where "use" of the mark is prohibited by EU law – not "registration". As such, this ground of opposition is far narrower than the Opponent had indicated and the Opponent is attempting to expand this ground to cover another ground. The Office applies clear principles which must be followed and they forbid the grounds of an opposition being extended. He argued the Opponent has failed to identify any law that expressly prohibits the "use" of the mark at issue and therefore the requirements to succeed under Section 8(4)(a) of the Act have not been met.
57. Mr. Coughlan raises interesting lines of argument regarding whether the Opponent's PGI comes within the scope of the opposition as outlined in the Notice of Opposition, whether the PGI falls within the bounds of Section 8(4)(a), and the different legal test as between the prohibition on the use of the mark at issue as distinct from a prohibition on the registration of the mark. I shall address those now before returning to the registrability of the mark.
58. Firstly, as regards the scope of the opposition, it is the case that the sole ground which needs to be decided is that in respect of Section 8(4)(a). It is also the case that I cannot allow any broadening of the grounds beyond that single ground. But is the Opponent seeking to expand its grounds as claimed by Mr. Coughlan? I think not. Mr. Coughlan argued that Section 8(4)(a) expressly relates to a law that prohibits the "use" of the mark and the 1992 Regulations are not such a law, as Article 14 of the said regulations is concerned with a prohibition on the "registration" of marks, not their use.
59. He said that use of the mark in Ireland is long-standing and the sale of BAVARIA beer in the State has not been stopped. Nor, he claimed, can it be stopped. The trade mark may be blocked but trade using the mark cannot be blocked. The Opponent had, since 2001, the right to attempt to stop the use of the mark but did not use it. While the Applicant accepts that, in light of the

Opponent's rights under EU regulations, BAVARIA cannot be the sole right of the Applicant, Nonetheless the Applicant is entitled to continue to use its BAVARIA mark.

60. Ms. McNamara countered that Mr. Coughlan's suggestion that the Opponent has somehow acquiesced in dealing with the Applicant's use of BAVARIA-type marks is wrong, as she claimed the evidence shows the parties have been at one another's throats for a long time in many jurisdictions. As regards the BAVARIA CROWN mark at the centre of these proceedings, the Opponent has lodged objections to its registration at the earlier possible opportunity. Therefore, the claim of acquiescence is a non-starter.
61. The plain meaning of Section 8(4)(a) is that it prevents the registration of a mark because there is a law that prevents the "use" of the mark. It does not contain an explicit prohibition that provides for the refusal of an application on the basis of a law that prohibits the "registration" of a mark. Mr. Coughlan argued that the 1992 Regulations do not prohibit the use of the mark and therefore it is not a provision of Community law that comes within the scope of Section 8(4)(a). I do not agree with Mr. Coughlan that the use and registration of the mark can be separated in a manner that would allow a mark to be registered because its "use" is not explicitly prohibited while at the same time a law exists which prevents the registration of the mark.
62. If Mr. Coughlan's argument was upheld it could lead to a situation in which a mark that is not worthy of registration because of a law prohibiting its registration (in this case the 1992 Regulations) could be allowed to be registered because the same law did not expressly prohibit its use (taking the plain meaning of Section 8(4)(a)) and because the law prohibiting registration was not explicitly cited in a ground of opposition other than one referencing Section 8(4)(a). This could lead to the absurd situation that, because the registered mark was in breach of the provisions of Article 13 of the 1992 Regulations, it would without any exception be liable to be declared invalid by virtue of the provisions Article 14 which states:

"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."

63. I also reject Mr. Coughlan’s assertions that the Applicant was ambushed at the Hearing and had to face an expanded ground of opposition at the Hearing. The basis for his claim is that the Opponent is attempting to separate its sole remaining ground of opposition (Section 8(4)(a)) into two separate grounds – one being the provisions of Section 8(4)(a) itself, the other being a provision of EU law that is not relevant to Section 8(4)(a). In opposition proceedings it is incumbent upon an opponent to set out precisely and clearly what its case is so that an applicant is in no doubt as to grounds of opposition. This is normally done by formulating the Notice of Opposition in terms of the provisions of the Act that set out the basis for the refusal of an application; but there is no requirement for an opponent to do it in such a manner. Oftentimes, and particularly when an opponent does not have the wherewithal to engage a legal representative, the grounds of opposition are formulated in everyday language, without specific reference to a particular section of the Act. When this is done in a manner that specifies the grounds of opposition with clarity and precision it is perfectly acceptable and does not render the grounds of opposition invalid, nor does it inconvenience or hinder the applicant in any way.
64. It appears to me, when formulating its Notice of Opposition, the Opponent looked at the Act and identified a reference to “Community law” in Section 8(4)(a) and deemed it the most appropriate provision of the Act under which to base its opposition. It is the case that the Opponent may have identified Section 10(4)(a), concerning laws protecting signs used in the course of trade other than trade marks, as suitable and used it as well as, or instead of, Section 8(4)(a). But, in my opinion, this is of no significance. In the instant case I am satisfied the Opponent outlined clearly and precisely from the outset that its case was based on its BAYERISCHES BIER PGI. The battle was joined on that basis and at no time throughout these lengthy proceedings was the Applicant in any doubt as to what the Opponent’s case was centred on. I am completely satisfied that the Opponent has not attempted to expand its grounds of opposition. The opposition was always based on the Opponent’s PGI and the question of whether or not it fits neatly within the bounds of Section 8(4)(a) is neither here nor there.

Matters of Law

65. Ms. McNamara addressed some preliminary matters of law and began by noting that the matter at hand comprises an application for protection in Ireland through the mechanism of the Madrid Protocol. Under the provisions of the Trade Marks (Madrid Protocol) Regulations, 2001, and in particular Articles 3 and 5, trade mark applications under the Madrid system are effectively made subject to the same principles of examination as an application for an Irish trade mark

registration. Holders of an international trade mark granted protection in the State have the same rights and remedies as are conferred on the proprietor of an Irish registered trade mark.

66. She then noted the significance of EU legislation (EU Regulations) providing for the protection of geographical indications relied upon by the Opponent, which the Controller is obliged to follow. EU Regulations have the full force of law in the State, without the necessity of any domestic implementing executive or legislative measure transposing the legislation into Irish law. They differ from EU Directives, which are binding on Member States as to the results to be achieved but leave it up to the Member State as to how that result is to be implemented in domestic law. EU Regulations immediately and automatically have the force of law. While oftentimes it is thought convenient to implement legislation to adopt or enforce measures provided for by EU Regulations, this is not necessary and EU Regulations comprise the valid law of Ireland without any intervening measure. In these regard Ms. McNamara directed me to Article 288 of the Treaty of the Functioning of the European Union, which, inter alia, states “...*A regulation shall have general applications. It shall be binding in its entirety and directly applicable to all Member States...*”.

67. Ms. McNamara spoke about the supremacy of EU law as established by the European Court of Justice (ECJ) in *Costa v ENEL* Case 6/64 and definitively interpreted in *Marleasing SA v La Comercial Internacionala de Alimentacion SA*, Case C-106/89 to require Member States to interpret national legislation in accordance with EU legislation (in that case an EU Directive) is one which has been unhesitatingly acknowledged by the Irish Courts. Fennelly J putting it thus in his judgment in *Collette O’Connell v The EPA*⁵:

*“...Irish law implementing directives should be construed in the light of the obligations imposed on the State by the provisions of the directives and with a view to giving effect to Community law. However, it is a matter for the national court to decide how that result is to be achieved. When applying national law, whether adopted before or after the directive, the national court called upon to interpret that law must do so, as far as possible, in the light of the wording and the purpose of the directive so as to achieve the result which it has in view. (See, for example *Dorsch Consult (Case C-54/96 [1997] ECR I-4961)*...”*

68. In *Marleasing* the ECJ emphasised the duty of emanations of the State, such as the Controller, in such a case and said:

- a. *“The Member States’ obligation arising from a directive to achieve the result envisaged by the directive and their duty under Article 5 of the Treaty to take*

⁵ [2003] IR 530 at paragraph 555

all appropriate measures, whether general or particular, to ensure the fulfilment of that obligation, is binding on all the authorities of Member States including, for matters within their jurisdiction, the courts.”

69. Ms McNamara then turned to the specific EU Regulations governing PGIs. The first, and the one relevant to this opposition, is Council Regulation (EEC) No 2081/92 of 14 July 1992 (hereinafter the “1992 Regulations”). While these Regulations were amended on five occasions and were ultimately repealed twice (by the 2006 and 2012 PGI Regulations) it is the 1992 Regulations, as amended, that apply to these proceedings.
70. Mr. Coughlan did not dispute the contention that the 1992 Regulations apply to these proceedings. He agreed that EU Regulations have effect in Ireland. He agreed also that EU Regulation 1347/2001, which entered into force on 5 July 2001 and through which the PGI BAYERISCHES BIER was registered and protected, is valid. Furthermore he was happy to rely on the relevant provisions of EU Regulation No. 2081/92, in particular Articles 13 and 14, and those of Council Regulation (EC) No. 1347/2001, specifically recitals 2, 3 and 4 thereof, which he argued all support the registration of the mark at issue.

Similarity and Confusion

71. Before considering the appropriate interpretation of the relevant regulations and its effect I will address the issue of similarity and confusion which was referred to by both parties. In trade mark law, and in particular opposition proceedings, the issues of similarity and confusion are pertinent to a comparison of the marks of the respective parties and the goods covered by the marks, with appropriate protections being afforded to the earlier mark. Such a consideration falls within what are known as relative grounds of opposition. What is somewhat unusual about the instant case is that it involves recourse to an absolute ground for the purpose of asserting a supposedly conflicting right belonging to a third party. In its evidence the Opponent even refers to its PGI as an “earlier right”. However, this is a grossly inaccurate representation of the PGI and it fails to have regard to the circumstances in which the PGI was granted.
72. It is clear that the Commission was made aware during its examination of the application for the registration of the Opponent’s PGI of the existence and long-standing use by the Applicant of its BAVARIA trade mark in the Netherlands. That examination resulted in the Commission confirming that the Opponent’s trade mark BAVARIA was valid. It specifically noted this in the second and third recitals to Council Regulation (EC) No. 1347/2001 where it is stated:

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

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

73. Article 14(3) of Council Regulation (EEC) No. 2081/92 provides:

“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.”

74. Thus, it is plain from the above that the trade mark BAVARIA is the earlier right. Nonetheless, irrespective of the earlier right, the Commission was satisfied that registration of BAYERISCHES BIER was not going to result in consumers being misled. That being the case I must consider Mr. Coughlan's argument that the absence of a likelihood of confusion is an important starting point when examining the Opponent's claim that the BAVARIA CROWN mark, and in particular the word BAVARIA therein, gives rise to “evocation” for the purposes of the 1992 Regulation.

75. It is important to point out that in examining the application for registration of the PGI the Commission was not conducting the same type of comparison between two trade marks that the Controller typically carries out in trade mark opposition proceedings. The Controller compares two marks, but the Commission compares an existing trade mark that may have a reputation and renown (and in this regard the Commission identified the Applicant's BAVARIA mark as one such mark) with the product for which the PGI seeks registration – namely (and I use the English translation for simplicity) “Bavarian beer” or “beer from Bavaria”. It appears to me the Commission found that the valid BAVARIA trade mark did not signify Bavarian beer and therefore the registration and use of the PGI BAYERISCHES BIER which means “Bavarian beer” would not confuse consumers as to the true identity of the product to be protected under the PGI – that being Bavarian beer.

76. When the Commission registered the PGI it explicitly provided for the continued use of the Opponent's BAVARIA mark, as long as the mark fulfilled the conditions provided for in Article 14(2) of the 1992 Regulation. Nothing in the intervening years has altered that position and the BAVARIA mark continues to enjoy the legal protections afforded registered marks in Ireland. It is fair to say that Council Regulation (EC) No. 1347/2001 specifically mandates co-existence and acknowledges that there are earlier rights in the word BAVARIA. In that regard, Mr. Coughlan argued the Opponent cannot be permitted to invoke a ground of opposition that is expressly premised on the use of the BAVARIA CROWN mark being "*prohibited in the State*" purely because it contains the word BAVARIA.

77. Furthermore, Mr. Coughlan contended that the use of the words "*for example*" in the fourth recital to Council Regulation (EC) No. 1347/2001⁶ make it abundantly clear that the recital's reference to "*...the Dutch trade mark 'Bavaria' and the Danish trade mark 'Høker Bajer'...*" is not exhaustive. In that regard the Applicant's Irish Registered Trade Mark "8.6 BARAVIA Device", which is registered in Class 32 for "*Beers*" since October 1992, remains on the register and there are no grounds of invalidity or revocation that can be invoked against it. He argued that the 1992 Regulation makes it clear that allowances must also be made for a trade mark established by use, if that possibility is provided for in the legislation concerned, where in Article 14(2) it states:

"With due regard to Community law, a trademark the use of which engenders one of the situations indicated in Article 13 and which has been applied for, registered, or established by use, if that possibility is provided for by the legislation concerned, in good faith within the territory of the Community, before either the date of protection in the country of origin or the date of submission to the Commission of the application for registration of the designation of origin or geographical indication may continue to be used notwithstanding the registration of a designation of origin or geographical indication, provided that no grounds for its invalidity or revocation exist as specified by Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks and/or Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark."

78. Here the "*legislation concerned*" is the Trade Marks Act 1996 and Section 7(2) expressly acknowledges that there is such a thing as an unregistered trade mark. Furthermore it expressly leaves the law of passing off intact. It states:

"No proceedings shall lie to prevent or recover damages for the infringement of an unregistered trade mark as such; but nothing in this Act shall affect the law relating to passing off."

⁶ "The use of certain trade marks, for example, the Dutch trade mark "Bavaria" and the Danish trade mark "Høker Bajer" may continue notwithstanding the registration of the geographical indication "Bayerisches Bier" as long as they fulfil the conditions provided for in Article 14(2) of Regulation (EEC) No 2081/92"

79. Mr. Coughlan argued that at the date of Council Regulation No. 1347/2001 the trade mark BAVARIA was in use in Ireland and claims the evidence shows that use was established as far back as 1998. He argued the Applicant would have been (and remains) able to assert common law rights and to sue in passing off if the need arose. Mr. Coughlan is correct in this. However, such action could only ever be taken against a third party, not the Opponent. The use by the Opponent of its PGI is expressly enshrined in Community law by way of a binding EU Regulation and no common law action based on the tort of passing off would supersede that regulation.
80. The Applicant's long standing use of its BAVARIA mark has been recognised by the Commission and evidence of its use in Ireland over a number of years has been provided. However, while the Applicant's BAVARIA simpliciter mark dates back to the late 1990's there is no evidence to prove or even suggest the BAVARIA CROWN mark existed and was used as a trade mark prior to the date of registration of the PGI.
81. Council Regulation No. 1347/2001 makes it clear that the existing marks (and it specifically refers to the Applicant's Dutch mark BAVARIA) can continue to be used. However, it is equally clear that no trade mark applications filed after the date of registration of the PGI can proceed to registration if the mark offends against any of the provisions of Article 13 of that regulation.
82. In this case the provisions of Council Regulation No. 1347/2001 are perceived as somewhat unfair by both parties. On the one hand, the Applicant, who has registered trade mark rights in the word BAVARIA in Ireland, feels it would be unfair to prevent it from registering a mark in the State which contains and is dominated by that word. While the mark contains other elements, none of which can reasonably be considered to relate in any way to the BAYERISCHES BIER PGI, on the basis that the composite mark is contrary to the EU Regulations under which the PGI was registered. On the other, the Opponent can point to the fact that the only meaning of the word Bavaria is the well-known state in Germany and the unfairness on the part of a Dutch brewer adopting as its mark that geographical location which, for centuries, has been renowned for its brewing purity, quality and methodologies that intrinsically arise out of the heritage, law and tradition of Bavaria and which justified the registration of the BAYERISCHES BIER PGI.

83. However, I am not concerned with the respective parties views of fairness, as I must simply interpret the law as is and reach a conclusion based on it. The question rests on whether or not the mark at issue falls foul of the provisions of the 1992 Regulations, in particular Article 13, which provides as follows:

“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.”

84. Looking first at provision (d). It is unclear what actions, outside of those mentioned in (a), (b) or (c) above, constitutes “*any other practice liable to mislead the public*”. And as the Opponent did not identify any practice which might relate to this prohibition I must, without further ado, find the Applicant has not engaged in action that would disqualify the application under this provision.

85. Moving next to provision (a) relating to products not covered by the PGI registration but for which the Applicant seeks trade mark registration. These products which have the potential to fall within this category are “*mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages*”. In my opinion, it is not likely that anyone would, on encountering the Applicant’s mark on, say for example, aerated water or fruit juice, associate the product with the Opponent’s PGI or the product that the PGI protects. The consumer may think that the water or juice is from Bavaria but that does not mean there is an exploitation of the PGI. Therefore I find that the goods listed do not offend against Article 13(a).

86. Turning now to provision (c). The Applicant is a Dutch company that has long used the mark BAVARIA for beer. No evidence was advanced by the Opponent to suggest the Applicant has

ever made any claims that its (the Applicant's) beer originated in any place other than the Netherlands, or that the nature or essential qualities of the beer are anything other than Dutch. Therefore, I find the conditions allowed for in (c) are not present and, in that regards, there is no consequential basis for refusing the mark.

87. Finally, looking at provision (b) and the question of whether or not BAVARIA CROWN misuses, imitates or evokes the product protected by the PGI. I am satisfied the Applicant is neither misusing nor imitating the product protected by the PGI. The Applicant is merely attempting to register a sign the dominant component of which it already owns rights to. The Applicant is seeking to use the mark applied for in the same legitimate way it uses its earlier BAVARIA mark, and such use does not fall into the realm of misuse that the regulation protecting PGIs seeks to avoid. Nor is there any evidence to suggest the Applicant is attempting to imitate any brewing techniques or quality standards other than those which it has long used in brewing its own already well-known beer.

88. As regards what is meant by evocation Mr. Coughlan directed me to the ECJ decision in *Consorzio per la Tutela del Formaggio Gorgonzola v. Kaserei Champignon Hofmeister GmbH & Co. KG*⁷ where the Court provided the following guidance, at paragraph 25, on the meaning of "evocation" in Article 13(1)(b):

"'Evocation', as referred to in Article 13(1)(b) of Regulation No 2081/92, covers a situation where the term used to designate a product incorporates part of a protected designation, so that when the consumer is confronted with the name of the product, the image triggered in his mind is that of the product whose designation is protected."

89. He argued that it is impossible to see how the words BAVARIA or BAVARIA CROWN could, when used in respect of beer in Ireland, evoke in the mind of the average consumer the words "Bayerisches Bier". There is no evidence or suggestion that the general Irish population is bilingual as between English and German. In a similar vein, from the perspective of the average Irish consumer who is not bilingual in this way, there is no obvious visual or aural link between the words BAVARIA or BAVARIA CROWN and the words "Bayerisches Bier".

⁷ Case C-87/97 (4 March 1999)

90. For her part Ms McNamara argued that common translations of a PGI name were protected in the manner outlined in Article 13 of the 1992 Regulations. In this regard she directed me to ECJ Case-13/05⁸ wherein Advocate General Mazák opined, at paragraph 42, the following:

“Since the translations of PDOs are, as a general rule, not registered, this raises the question whether a translation of a PDO is protected to the same extent as the registered PDO itself. It appears from the wording (‘even if ... the protected name is translated’) of Article 13(1)(b) that translations of registered PDOs are in principle protected to the same extent as the PDO in the original language. Moreover, this approach is in my view supported by the Court’s decision in Bigi, where the Court assumed that the protection afforded by Article 13(1)(b) of the Basic Regulation equally applied to translations of PDOs.”

91. However, the Court in its decision in that case did not echo the Advocate General’s opinion and it did not come to any conclusions as to the question of whether or not the protections afforded a PDO (as it was in that case) equally apply to common translations of the PDO. However the Court did point out at paragraph 45 that “...it is possible for a PDO to be evoked where there is no likelihood of confusion between the products concerned and even where no Community protection extends to the parts of that designation which are echoed in the term or terms at issue (*Consorzio per la tutela del formaggio Gorgonzola*, paragraph 26)”. As regards the similarity of the names in that case the Court held, at paragraphs 46-50 as follows:

*“46. In the present case, there is phonetic and visual similarity between the names ‘Parmesan’ and ‘Parmigiano Reggiano’, and that in a situation where the products at issue are hard cheeses, grated or intended to be grated, namely, where they have a similar appearance (see, to that effect, *Consorzio per la tutela del formaggio Gorgonzola*, paragraph 27).*

47. In addition, regardless whether the name ‘Parmesan’ is or is not an exact translation of the PDO ‘Parmigiano Reggiano’ or of the term ‘Parmigiano’, the conceptual proximity between those two terms emanating from different languages, which was revealed in discussions before the Court, must also be taken into account.

48. That proximity and the phonetic and visual similarities referred to in paragraph 46 above are such as to bring to the mind of the consumer the cheese protected by the PDO ‘Parmigiano Reggiano’, when he is confronted by a hard cheese, grated or intended to be grated, bearing the name ‘Parmesan’.

49. In those circumstances, the use of the name ‘Parmesan’ must be regarded, in the sense of Article 13(1)(b) of Regulation No 2081/92, as an evocation of the PDO ‘Parmigiano Reggiano’.

⁸ Commission of the European Communities v Federal Republic of Germany

50. The question whether the name 'Parmesan' is a translation of the PDO 'Parmigiano Reggiano' is therefore of no relevance for the assessment of the present action."

92. It is clear the Court gave weight to the verbal, visual and conceptual similarities between the terms at issue, and did so in isolation from considering whether or not Parmesan was a translation of Parmigiano Reggiano. It found that one would evoke the other by virtue of the similarity as to the products (hard cheeses, grated or intended to be grated) and the conceptual proximity between the terms, irrespective of the different languages from which they originate.
93. This suggests it is appropriate that I conduct a verbal, visual and conceptual comparison as between BAVARIA CROWN and the term BAYERISCHES BIER, but need not rely on the English translation of the term. Having done so I would tend to agree with Mr. Coughlan that BAVARIA CROWN, when encountered by the average Irish consumer, would not cause the consumer to bring to mind or wonder whether the mark is confusingly similar to or associated with the words BAYERISCHES BIER.
94. However, in my opinion, that is not the proper test. The 1992 Regulations do not mention similarity or confusion or the need for these factors to be taken into account. It appears to me the Regulations bestow upon PGIs a much broader level of protection than that afforded to trade marks. The intended purpose of the PGI registration system is not to protect names per se, but to protect products. Therefore, this case is not about the protection of the words BAYERISCHES BIER, it is about protecting a certain product, that product being beer brewed in a specific geographical location (Bavaria) and brewed to exacting standards and specifications that are synonymous with that location and for which beer from that location has become renowned. Therefore, the evocation test is not as between the words BAVARIA CROWN and BAYERISCHES BIER, it is between BAVARIA CROWN and the product protected by the PGI, namely Bavarian beer.
95. In conducting this test, I am satisfied that the average consumer does not have to know that there are such things as Protected Geographical Indications or that there is a specific PGI in respect of BAYERISCHES BIER. Further, the consumer does not, if he encounters the words BAYERISCHES BIER on a beer product, need to understand the meaning of the term. Further still, the consumer does not need to know that beer from Bavaria is brewed strictly in accordance with purity laws and exactly specifications. In my opinion, the foregoing considerations are not important factors pertinent to the evocation test. The all-important factor

is whether the consumer, who encounters the Applicant's mark BAVARIA CROWN on a beer product, is caused to think the beer product is from Bavaria, or that the beer is brewed using techniques and standards that put it on a par with Bavarian beer.

96. I have already adjudicated on the question of misuse and imitation, which can be decided by reference to the actions and intentions of the Applicant, such behaviours being totally within its control. However, the issue of evocation is outside the Applicant's control and relates to what goes on in the minds of consumers when they encounter beer bearing the BAVARIA CROWN mark. However, the Applicant can try and influence consumers' thought processes through advertising. One particular advertisement for BAVARIA CROWN submitted in evidence by the Applicant demonstrates the Applicant is attempting to do precisely that. I reproduce it in full here.



97. The advertisement clearly attempts to target and alter the consumers' instincts that Bavaria beer is from Bavaria in Germany. That "Joep" (a synonym for the average consumer of beer) was "GOBSMACKED when he discovered how reasonably-priced Bavaria beer was" is a clear indication that Joep would expect to pay a premium price for a Bavarian beer because of the quality that one comes to expect from such a product. The admission that it "sounds German, but it is Dutch" signifies that anyone looking at the bottle would instinctively believe the beer to be of German origin. The need to educate consumers as regards the real origin of the product is

telling. Also, and even more telling, is the use of the adage “*appearances can be deceptive*”, which is an unequivocal admission by the Applicant that BAVARIA CROWN can deceive and that it might appear to be something (a Bavarian beer) that it is not.

98. The Applicant’s attempts to disassociate BAVARIA CROWN beer from German beer and to influence consumer perception so that the consumer does not evoke Bavarian beer has undermined its case. Notwithstanding this, in my opinion, it is very difficult to stop a person evoking an image in his mind when the evocation is based on something that appears so obvious. In the present case, for evocation of the Opponent’s PGI to occur the consumer need know only two simple things. Firstly, a no-brainer, that the product they are consuming is a beer. Secondly, that there is a geographical location called Bavaria. The consumer need not even know where Bavaria is (though I am satisfied the average Irish beer drinker would be well aware that Bavaria is in Germany). All that is sufficient is that the consumer puts beer and Bavaria together and as a result thinks the beer is from Bavaria or that it is brewed using Bavarian brewing methods. I am completely satisfied the average consumer would do just that, because the evocation of the Opponent’s PGI is, in my opinion, inescapable and inevitable.

99. Therefore, I find the BAVARIA CROWN device mark impinges on protections afforded PGI’s under Article 13 of the 1992 Regulations, as it undoubtedly evokes the product which is protected by the BAYERISCHES BIER PGI (Bavarian beer) and, as there are no exceptions to those protections and the refusal is mandatory, I must refuse to allow the application to proceed to registration.

100. I find the mark BAVARIA CROWN is prohibited from registration in respect of beer because it evokes the Opponent’s BAYERISCHES PGI and I therefore refuse to allow the application to proceed to registration in respect of beer.

101. I find also that there is no prohibition on the registration of the mark BAVARIA CROWN in respect of “*mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages*” and the mark can proceed to registration in respect of those goods.

Dermot Doyle

Acting for the Controller

21 April, 2016