

**Decision  
of the Fourth Board of Appeal  
of 15 June 2016**

In Case R 1105/2015-4

**Gerard Feltham**

225 Underhill Road  
London SE22 0PB  
United Kingdom

Applicant/Appellant

represented by WALKER MORRIS LLP, Kings Court 12 King Street, Leeds, West  
Yorkshire LS1 2HL, United Kingdom

v

**Instituto dos Vinhos do Douro e do Porto, IP**

Rua dos Camilos, 90  
P-5050-272 Peso da Régua  
Portugal

Opponent/Respondent

represented by PEDRO SOUSA E SILVA, Rua Mota Pinto, 42 F, 1º 1.09,  
P-4100-353 Porto, Portugal

APPEAL relating to Opposition Proceedings No B 2 338 120 (European Union trade  
mark application No 11 288 073)

THE FOURTH BOARD OF APPEAL

composed of D. Schennen (Chairman and Rapporteur), L. Marijnissen (Member) and  
E. Fink (Member)

Registrar: H. Dijkema

gives the following

## Decision

### Summary of the facts

- 1 European Union trade mark application No 11 288 073 was filed on 23.10.2012 for the figurative mark



- 2 In reply to the opposition the applicant limited the list of goods and services to 'Gin' in Class 33.
- 3 In the notice of opposition filed by Instituto dos Vinhos do Douro e do Porto it was indicated that the grounds for opposition were those laid down in Article 8(4) EUTMR. The opposition was based on the appellation of origin protected in Portugal for the sign 'PORTO / PORT' claimed to be used in trade for 'fortified wine'. As grounds for opposition, the text of Article 8(4) EUTMR was quoted. No further statements were made in or together with the notice of opposition.
- 4 The notice of opposition contained three attachments
  - a document in Portuguese 'título de registo de denominação de origem "PORTO" ' dated 18.3.1983, accompanied by a translation into English;
  - extract from the database kept by WIPO referring to the appellation of origin protected under the Lisbon Treaty No 682 'PORTO' for 'generous wine (liqueur wine)' with Portugal being the country of origin;
  - a database extract from an unidentified source headlined 'agricultural and rural development' concerning a geographical indication 'Porto' for 'wine with a protected designation of origin (PDO)' and a reference to Council Regulation No 479/2008.

- 5 On 4.9.2014, in obedience to the time limit set by the Opposition Division to complete the opposition by furnishing facts, evidence and arguments pursuant to Rule 18(1), 19(1), (2) EUTMIR, the opponent indicated and submitted:
- the contested EUTM application contained the word ‘PORT’ which was an appellation of origin for wine protected under various Portuguese decrees (as specified), included in the List of Quality Wines published in OJ EU C 187/01, registered at the Portuguese Office, and registered under No 682 pursuant to the Lisbon Agreement;
  - the opponent was the competent legal entity under Portuguese law to act in defence of this appellation of origin;
  - the opponent invoked 6 provisions of Portuguese national law (as specified);
  - Portuguese courts had granted protection against trademarks incorporating the word ‘PORTO’ or ‘PORT’ regardless of a similarity of the goods; various judgments were cited;
  - reference was made to other international treaties;
  - the text of Article 118 m (2) of Council Regulation No 491/2009 was cited, and it was claimed that the contested mark would exploit the reputation of the designation of origin, involved a misuse and evocation and was liable to mislead the consumer;
  - the appellation of origin ‘PORTO’ had world-wide fame; 62 exhibits were submitted in support of this.
- 6 By decision of 17.4.2015, the Opposition Division upheld the opposition and ordered the applicant to bear the costs.
- 7 The Opposition Division proceeded from the basis that the EU system for the protection of geographic indications of wines is directly applicable and supercedes any national protection as a geographical indication. It applied relevant provisions of Regulation No 1083/2013. It observed that that Regulation protected ‘wines’ against comparable products. It reasoned that for the contested goods ‘gin’ that was the case. It found the conflicting signs similar and took the position that in the contested sign the relevant public would associate the word ‘PORTO’ which is part of the word ‘PORTOBELLO’ with the city of ‘PORTO’ in northern Portugal. It concluded that this led to an imitation or evocation of the geographic indication ‘PORTO’ and that the contested sign could mislead consumers in relation to the protected terms when applied to wines and spirits.
- 8 On 10.6.2015, the applicant filed a notice of appeal against this decision, followed by a statement of grounds on 14.8.2015.
- 9 The applicant accused the Opposition Division of an ill-founded comparison of the conflicting signs. Actually the contested sign was a complex mark involving several verbal elements, mainly (i) PORTOBELLO ROAD, (ii) NO. 171, (iii) LONDON DRY GIN, and (iv) DISTILLED AND BOTTLED IN ENGLAND, as well as figurative elements, including (vi) a red lion, (vii) the national flag of the United Kingdom, (viii) further decorative elements. This led to a visual and aural dissimilarity. It pointed out that PORTOBELLO ROAD was a famous road in London. The public would not split off the term ‘PORTO’. It also repudiated that ‘gin’ was a product comparable to ‘wine’.

- 10 The appellant requested to annul the contested decision, to allow the EUTM application to proceed to registration, and to make an award of costs in its favour.
- 11 The opponent requested to dismiss the appeal. It agreed with the Opposition Division that the contested sign would evoke the geographical indication 'PORTO' and that wine and gin were comparable products. It moreover invoked the reputation of the earlier right and quoted the text of Article 103(2) of Regulation No 1308/2013.

### **Reasons**

- 12 The appeal is well founded. The opposition must be rejected.
- 13 The grounds for opposition were those laid down in Article 8(4) EUTMR. The opponent had to identify the earlier right or rights. He had to indicate the protected sign (here: PORTO and PORT, claimed in parallel, so to say), the territory of protection (the Member State(s) or, as the case may be, the EU), and the exact nature of the earlier right. These are identification requirements under Rule 15(2)(b)(iii) IR. Next, as a substantiation requirement under Rule 19(2) IR, the opponent had also to prove the existence, the exact scope of protection and the actual use in the course of trade of the respective rights.
- 14 The opponent failed to substantiate an earlier right. It is totally unclear whether the opponent sought to rely on a national Portuguese earlier right or a right under EU law or both.
- 15 For the proper identification of the earlier right(s) the Board is willing to take into account not only the notice of opposition, but also its attachments as integral part. Yet, the identification of the earlier right must be unambiguous, as the wording of Rule 15(2)(b) IR sets out clearly, and the earlier right(s) may not be enlarged or expanded after the filing of the opposition.
- 16 The notice of opposition is ambiguous as on the one hand the opponent invoked just one earlier right in the opposition form but attached three different annexes. However, these annexes neither specify the exact type of right invoked nor unambiguously specify the legal provisions on which the opponent relies.
- 17 Since the annexes do not solve, but rather create, ambiguity, the opposition may only proceed on the basis of the right which is checked in the opposition form, which is a geographical indication protected in Portugal. And it goes to the detriment of the opponent that at the substantiation stage he referred to a variety of national, but also international laws and treaties, thus adding further ambiguity.
- 18 The only thing which was clear was that the opponent invoked the term 'PORTO' in relation to (fortified) wine as a protected geographic indication with origin in Portugal. For this he could rely on EU legislation, for which he was not under the duty to submit the text of the relevant legislation, and it is common

ground that 'PORTO' is actually registered as a geographical indication for wine at EU level.

- 19 The text of Article 103(2) of Regulation No 1308/2013 is reproduced on page 5 of the contested decision. This text corresponds to Article 118 m (2) of Council Regulation (EC) No 491/2009, to which the opponent made loose reference to at a later stage of the proceedings, namely within the substantiation period, without, however, citing the full text.
- 20 The opposition is unfounded because the conditions for a protection under Article 103(2) of Regulation No 1308/2013 are not fulfilled. This is so for two reasons: Firstly, the contested goods 'gin' are not 'comparable' goods to wine, and secondly, the contested sign is dissimilar to the protected geographical indication and in any case no 'use', 'imitation' or 'evocation' of the protected geographical indication.
- 21 Firstly, the contested goods 'gin' do not fall under the goods for which Regulation No 1083/2013 establishes protection.
- 22 Article 103 of Regulation No 1083/2013 grants protection in respect of the use for 'comparable products not complying with the product specification', or, alternatively, if the reputation of the geographical indication is exploited.
- 23 Leaving aside for the moment that second condition, it is obvious that the notion of a 'comparable' product must be one 'comparable' to wine in the sense that the specific protection for wines is affected. 'Comparable' products are e.g. products which are types of wine or presented under names alluding to wine ('plum wine') or which look like wine and could be held by consumers to be or to contain wine. 'Gin' is a spirit which is protected under separate EU legislation, namely Regulation No 110/2008 of 15.1.2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks. 'Gin' does not look like, does not taste like and is not presented as wine, and is not even based on vine. That gin is not a 'comparable' product is also evident from the further text of that provision 'not complying with the product specification', which makes no sense, and can never be an issue, for a spirit (18.11.2015, T-659/14, 'PORT CHARLOTTE', EU:T:2015:863, § 64 to 66). And it must be emphasized that a 'comparable' product is not to be interpreted as meaning a 'similar' product in the sense of Article 8(1)(b) EUTMR.
- 24 The essential function of a geographical indication – as an IP right – is not to monopolise the name of a city or region. Any city or region serves as a place of protection of innumerable other goods. The essential function of a geographical indication is to protect the link between a product (and its characteristics) and a geographic origin. Geographical indications or appellations of origin are meant to protect the consumer's expectations that a given product has the geographic origin indicated on the product.
- 25 The second alternative for protection under Article 103 of Regulation No 1083/2013 is that there is 'any direct or indirect commercial use of the protected name' (Article 103(2)(a), header) and that 'such use exploits the reputation of the geographical indication' (Article 103(2)(a)(ii)). The Board

observes that that second condition is to be understood in the same way as Article 8(5) EUTMR, namely as a protection of a reputation or goodwill in a sign against acts of unfair exploitation of that reputation.

- 26 This provision cannot be invoked, as the opponent failed to claim a reputation of its earlier sign in the notice of opposition.
- 27 The only relevant indications in the notice of opposition were that the earlier sign is an appellation of origin and the quotation of the text of Article 8(4). Also in the three attachments nothing concerning a reputation of the geographical indication can be found.
- 28 The grounds for opposition was only Article 8(4) EUTMR. Whereas it is in principle not excluded that a national or EU right falling under that provision confers protection beyond the limits of similarity of goods and services, such must be expressly claimed. From the notice of opposition (including all its attachments) it only transpires that the opponent invokes an appellation of origin for fortified wine. The function of an appellation of origin is to protect the geographic origin of a specific given type of product (e.g., wine) and not the geographic origin of all goods and services under the sun. To the extent that the relevant provisions governing the protection of geographical indications – none of which having been indicated in the notice of opposition – also contain provisions for ‘reputed’ signs, the existence of such a reputation would have to be expressly claimed in the notice of opposition. It cannot be accepted that an owner of a geographical indication would have less elements to indicate when attacking a mark filed for dissimilar goods than the owner of a registered EUTM when relying on Article 8(1)(b) and Article 8(5) EUTMR. Whereas it can be accepted that the opponent who invokes a geographic indication protected at EU level does not have to prove the relevant EU law, it cannot be accepted that the opponent extends the grounds and legal bases for opposition to those providing specific protection along the lines of Article 8(5) EUTMR in the further course of the opposition proceedings.
- 29 Secondly, in any case, the application of Article 103(2) of Regulation No 1308/2013 is excluded for the reason that the contested sign is not a ‘use’ of the protected geographical indication.
- 30 For this to be the case, the contested sign would have to
- ~ refer to the same geographical place or region;
  - ~ be similar.
- 31 This is not the case. The contested sign refers to a road the name of which is ‘Portobello Road’. It contains a series of further elements both word and figurative. Even if one would take into account only ‘Portobello’, the syllable(s) ‘Porto’ or ‘Port’ would not be split off from it. ‘Portobello’ is a unique expression and not the combination of the words ‘Porto’ and ‘Bello’.
- 32 Any reference to an origin from ‘Port’-ugal or ‘Porto’ and any connection of the applicant’s ‘gin’ to ‘port wine’ is furthermore excluded by the numerous references to the city of London (where the Portobello Road actually is), the country

of England, and the English flag (the ‘Union Jack’). Moreover it is clearly stated that the product in issue is ‘gin’.

- 33 Article 103(2)(b) of Regulation No 1308/2013 speaks of ‘any misuse, imitation or evocation, even if the true origin of the product is indicated’. This provision is not applicable to not-comparable products, as the specific reputation protection only applies within subparagraph (a) of that provision. In any case there is no imitation or evocation. The sub-clause ‘even if the true origin of the product is indicated’ addresses situations where the defendant makes a reference to the geographic indication but at the same time adds that the product comes from somewhere else (e.g. ‘Bavarian beer – produced in Hamburg’), i.e. to situations where the confusion about the true geographic origin is only increased and where the indication of the ‘true origin’ is only used as a fig leaf. In the contested sign nothing ‘evokes’ an origin from Portugal or the region covered by the geographic indication ‘Porto’ or even the type of product ‘port wine’.
- 34 On top of this protection, the opponent cannot invoke national law as cited in the substantiation of the opposition.
- 35 There is no double protection of one and the same geographical indication for wine through national law on the one hand and through EU law on the other hand. Rather the system of EU geographical indications for wine set out by EU law (Regulation No 1308/2013, replacing earlier Regulations with essentially the same content) is governed exclusively by Article 103 of Regulation No 1083/2013 (or its predecessor, Article 118 m of Regulation) (18.11.2015, T-659/14, ‘PORT CHARLOTTE’, EU:T:2015:863, § 38). This point has even been addressed in the relevant Regulation itself: ‘Existing’ geographical indications for wines (in the sense that they were already protected prior to the entry into force of Regulation No 1308/2013) are governed by Article 107(1) of Regulation No 1308/2013, which provides that they shall be automatically protected under Regulation No 1308/2013. So either the respective geographic name is still protected but (only) under Regulation No 1308/2013, or it will have to be removed from the EU Register in accordance with Article 107(2) or (3) of that Regulation.
- 36 Although the EU wine Regulations (Regulation No 1308/2013, replacing earlier Regulations with essentially the same content) protect geographical indications for wines to some extent on the basis of national laws and decrees, it follows from the exclusive competence of the European Union that the scope of protection of any such geographical indication is exclusively determined by those Regulations and not by any elder national law or decree. This follows from the first ‘having regard’ clause of Regulation No 1308/2013, which refers to a provision in the Treaty conferring an exclusive competence to the EU. This also follows from the judgments ‘Warsteiner’ (7.11.2000, C-312/98, EU:C:2000:599), ‘Budějovický Budvar’ (8.9.2009, C-478/07, EU:C:2009:521) and ‘Chiziak’ (9.6.1998, C-129/07, EU:C:2008:15). Those judgements concerned geographical indications under Council Regulation No 2081/82, replaced by Council Regulation No 510/2006. These Regulations for the first time introduced an EU protection for geographical indications concerning certain foodstuffs. Even in this domain the Court unambiguously stated that protection granted under the Council Regulations superseded any existing national

protection. What was disputed was only whether national protection was also superseded in respect of geographical indications that were applied for EU protection, but not given protection, or for geographical indications for which EU protection would have been available, but was not requested; those issues are not relevant for the present case. The opponent, in his reply to the appeal, discussed the cited ECJ judgments. However, contrary to his theory, it is clear from those judgments that national protection is only available for geographical indications which are not protected or protectable at EU level, but these judgments are absolutely clear in emphasizing the prevalence of EU law to the extent the European legislator has exercised its competence.

- 37 In particular any such national law cannot lead to a protection of the geographical indication under conditions which are different or, and that would be the only thing which would matter, more favourable than those established in the applicable EU Regulations. The Board cannot see any convincing argument of law in the judgment of 18.11.2015, T-659/14, 'PORT CHARLOTTE', EU:T:2015:863, that would challenge that conclusion.
- 38 As concerns the third document attached to the notice of opposition, it suffices to recall (see 22.5.2015, R 1760/2014-4, 'PORTS1961 / PORT', § 22) that protection under the Lisbon Treaty does not extend to the country of origin, here Portugal.
- 39 The appeal must be upheld, as contrary to the contested decision, the opposition was unfounded from the outset.

### **Costs**

- 40 The opponent (respondent) is the losing party both in the opposition and appeal procedure and shall be ordered to bear the costs of the proceedings, pursuant to Article 85(1) EUTMR.

### **Fixing of costs**

- 41 Pursuant to Article 85(6) EUTMR in conjunction with Rule 94(7)(d)(ii) and (v) IR, the Board of Appeal fixes the amount of the fees and costs to be paid by the losing party at EUR 300 for the representations costs in the opposition proceedings and at EUR 550 for the representation costs in the appeal proceedings, and the fees to be reimbursed pursuant to Rule 94(6) IR at EUR 800 for the appeal fee, in total at EUR 1,650.



**Order**

On these grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision;**
- 2. Rejects the opposition;**
- 3. Orders the respondent to bear the costs of the opposition and appeal proceedings;**
- 4. Fixes the total amount of costs to be paid by the respondent to the appellant at 1,650 EUR.**

Signed

D. Schennen

Signed

L. Marijnissen

Signed

E. Fink

Registrar:

Signed

H.Dijkema

