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### 4C Trademark Law Session. Trademark Potpourri

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**Emily C. & John E. Hansen Intellectual Property Institute**

**TWENTY-EIGHTH ANNUAL CONFERENCE  
INTERNATIONAL INTELLECTUAL PROPERTY  
LAW & POLICY**

*Thursday, April 8, 2021 – 1:00 p.m.*

**SESSION 4: TRADEMARK LAW  
4C. Trademark Potpourri**

**Moderator:**

**Magdalena Berger**

*Curi Platz LLP, New York*

**Speakers:**

**Etienne Sanz de Acedo**

*International Trademark Association (INTA), New York*

***The Pandemic and Trademarks: Challenges and Opportunities***

**Gordon Humphreys**

*European Intellectual Property Office, Alicante*

***Getting Real: The Empirical Evidence Toolkit in EU Trademark Law***

**Melissa Pittaoulis**

*NERA Economic Consulting, Philadelphia*

***How Should Surveys Measure Continuing Commercial Impression?***

**Joel Smith**

*Herbert Smith Freehills LLP, London*

***Extended Protection Across Europe for Geographical Indications – More Disputes Likely***

**Daan Erikson**

*Husch Blackwell LLP, Chicago*

***Say, “Gruyere”: USPTO Deference to FDA and USDA***

**Panelists:**

**Irene Calboli**

*Texas A&M University School of Law, Fort Worth*

**Anderson Duff**

*Hogan Duff LLP, New York*

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MAGDALENA BERGER: Hello everyone. Welcome to the Potpourri of Trademarks, which means we're going to cover two very exciting areas of the law. We're going to cover surveys and trademark law, which is a perennial, and we finally got it on to the program. And we're going to cover geographic indications, also a perennial that we have managed to avoid for many years, but it made it into the program this year. I'm very excited about it. We were supposed to hear from Etienne Sanz de Acedo on the pandemic and trademarks, but unfortunately, technology did not work for him today. Yuan Yuan and Etienne, in case this works in the background, just show up and we'll make it happen.

I have a very esteemed panel that makes me insanely happy. I have Gordon Humphreys who doesn't need an introduction. I have Melissa Pittaoulis, who's going to tell us about surveys. We have Daan who's going to talk about geographical indications and then we're going to have Joel Smith, also talking about geographical indications.

On the panel, we have Irene Calboli and Anderson Duff, all good friends. We're going to start with Gordon, just take it away. You know what you're doing. Go for it.

GORDON HUMPHREYS: All right. Well, I'm not going to be brave enough to use a PowerPoint within what's happened in the other session, so I'll go straight into it. I'm talking about survey evidence and what's been happening in the EU. Typically, going to start looking at survey evidence. Obviously, companies like Pepsi Cola have spent a fortune trying to show acquired distinctiveness and to no avail with survey evidence. Decision takers are really good at picking holes in survey evidence, but rarely, if ever, do they [inaudible].

It's quite ironic because the General Court here in Europe has actually been [inaudible] even in things like GIs.<sup>1</sup> It's almost bizarre, but on the other hand, they don't like survey evidence for actual confusion, unlike in the U.S. It's probably for the reason that the EUIPO<sup>2</sup> gives in its guidelines, and I'm citing here that, "In everyday life, there are always people who confuse and misconstrue everything." Therefore, that's used to say that there's a risk of being overly subjective. I hope you've [inaudible] with you. More recently in the four-finger chocolate bar case, which is in that case, we've had some small relaxing of the fact that you have to prove an EU 27-wide<sup>3</sup> acquired distinctiveness for non-verbal marks, or even word marks that have no meaning in an EU language. But still, the bar is really high as Glaxo found out last September when the General Court confirmed that strength of the mark was well known in 10 member states wasn't enough for that color purple asthma inhaler.<sup>4</sup>

Actually, you know that was pretty much a disaster for them. In fact, they

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<sup>1</sup> Geographical indications.

<sup>2</sup> European Union Intellectual Property Office.

<sup>3</sup> This refers to the 27 countries of the European Union.

<sup>4</sup> Case T-187/19, Glaxo Group Ltd v. European Union Intellectual Property Office, ECLI:EU:T:2020:405 (Sept. 9, 2020).

did many things wrong. They interviewed people with different images, different representations and they hadn't taken account of the full extent of the relevant public, namely actual patients that use these inhalers, they only interviewed health professionals. You can see that there are a lot of things going wrong.

On the other hand, Oreo did a lot better with its flagship cookie, registering or showing that the shape of that cookie had a really high reputation in Spain, where survey evidence really won the day,<sup>5</sup> so it can make all the difference to what you can do. I'm going to talk about what we've been doing at the Boards of Appeal to help people use survey evidence to better effects.

First of all, we had this Convergence Project 12,<sup>6</sup> drawing together national appeal bodies. The first thing that we looked at was the period and timing of a service. I'm now moving on to when, right? Which is basically you want it to be as close as possible, the relevant period of action. When you're looking at the acquired distinctiveness, that's just before the filing date of your application and they're rather [inaudible] and enhanced distinctive, you're looking at the date of filing of the opposition. Now, actually, don't be too concerned by these dates, because it's pretty clear that reputation isn't acquired overnight. It's to show the level of reputation rather than getting too worried about the dates, but obviously, the further away your survey is in time from the relevant dates this gives, the lower its probative value.

You want to be pretty careful on the survey provider you choose. Obviously, the big survey companies are safer, but as we've seen with the *Glaxo* judgment,<sup>7</sup> they're not immune to making mistakes. You've got to be careful with your consumers, so take great care with the sampling method and the size, so you have to really be transparent about how you did it and what's the size. Obviously, the smaller the size, the more explanations you're going to need. In general terms, really, if you're looking at below 200 people, we're going to need some pretty convincing explanations for why such a small sample.

Then the method of conducting the sample. Well, you've got face to face, telephone, or online, the novelty now, we're saying online, so provided that you're transparent, and you work through the methodology and explain it to the examiners and to the Boards of Appeal. We want to see the structure and wording of the survey questionnaires and obviously, a checklist to assess the content and the standard of the survey. Just a quick thing on your samples. This is really important because you've got as that *Glaxo* case, to make sure you've got the right people that are being interviewed. You've also got to show what method you're using for the sample. Is it the random or quota sample method, which is the preferred way of doing things? We want to know about the confidence level there is in a survey, so

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<sup>5</sup> Case T-677/18, *Galletas Gullon, SA v. European Union Intellectual Property Office*, ECLI:EU:T:2020:229 (May 28, 2020).

<sup>6</sup> European Union Intellectual Property Office, CP12 — Evidence in Trade Mark Appeal Proceedings: filing, structure and presentation of evidence, and the treatment of confidential evidence (2020), [https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/EUIPN/Common\\_practice/Draft\\_CP12-Evidence\\_in\\_TM\\_appeal\\_proceedings.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/EUIPN/Common_practice/Draft_CP12-Evidence_in_TM_appeal_proceedings.pdf).

<sup>7</sup> Case T-187/19, *Glaxo*.

it should be at least 95% with a maximum of a 5% error margin. All these things have to be questions we want to know.

Don't ask leading questions, obviously, but on top of that, don't ask double-barreled ones. Ones where you're asking a number of questions at the same time, because it's just overcomplicating things. Obviously, the spontaneity carries more weight than anything. If the consumers can answer spontaneously that they recognize the brand, that's the best, but if they can't do that, it's okay, particularly for acquired distinctiveness to show images of various brands. Don't just show one brand, show a number of brands, and then ask some controlling questions on that to show it wasn't a lucky guess.

MAGDALENA BERGER: Gordon, I'm sorry, but you're out of time. If you want to have 20 more seconds, you can have 20 more seconds.

GORDON HUMPHREYS: I probably said most of it, but maybe the key also is that in Europe, no threshold percentages. The only exception to that is Germany, as Lena, you probably well know. 51% for acquired distinctiveness is like something written in stone, but for the rest of us, no percentages. Obviously, the more the merrier. Thanks.

MAGDALENA BERGER: Thank you, Gordon. In true Fordham fashion, I'm going to prioritize everyone's questions over mine. We already have a question from the audience. The question is, while the guidelines give guidance, wouldn't it be better and more cost-effective if we had an EU IP protocol telling us what kind of surveys we like, and for example, how to handle a specific type of mark? Gordon, what do you think?

GORDON HUMPHREYS: What I can say is that this CP, Convergence Project 12, drops some recommendations. What we then did was we implemented them through a presidium decision<sup>8</sup> at the Boards of Appeal in November of last year, on recommendations for assessments of survey evidence. Some of this is now implemented, but I don't think that it's the job of any IP office to tell somebody how they've got to do a survey. We can only give some guidelines or some hints and tips. Obviously, the questions have to be done by professionals, and that, at the end of the day, is the job of the professionals. I hope that if you have a look at the recommendations in the presidium decision of November last year that's on our website, you may find some useful material on that.

MAGDALENA BERGER: Thank you. Do we have any questions from our esteemed panelists? [crosstalk] Oh, sorry. No, go ahead, Melissa.

ANDERSON DUFF: No, go ahead, Melissa, please.

MAGDALENA BERGER: Always females first.

MELISSA PITTAOULIS: I understand that surveys are used to measure acquired distinctiveness in Europe. Are there other legal areas where surveys are used?

GORDON HUMPHREYS: Reputation as well, the reputation of a mark. Those are the new ones. There are some other ones that are used occasionally, but not actual confusion, like in the States. As I said that there are polls and opinion polls and surveys that are done even for recognition of geographical indications.

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<sup>8</sup> Decision 2020-8 of 6 November 2020 of the Presidium of the Boards of Appeal Concerning Market Surveys as Evidence Before the Boards of Appeal.

Occasionally they come up, but these are outliers, really, the two main ones are those.

MAGDALENA BERGER: Thank you. Anderson, it's your turn.

ANDERSON DUFF: I'm just going to ask, Gordon, is it just a matter of not hiring the right person like Melissa or someone with similar experience who's going to rigorously conduct the survey?

GORDON HUMPHREYS: I don't think so because usually, of course, the very experienced survey firms are the safest bet, there's no doubt about that. But it's not just that. You should also hire a specialized survey firm rather than just a general firm that's doing opinion polls or whatever. It's not a Gallup poll for the elections. If you have a specialist, normally that's a better guarantee, but it's not a complete guarantee as I said with that case with the popular inhaler. They did make a mistake, so, always be behind them.

MAGDALENA BERGER: Thank you, Gordon. Any other questions from the panel at this point?

I think we're going to use the time and move on to Melissa since she's just joining us, and then Étienne, you're going to go right after Melissa and, welcome. Okay, Melissa. Melissa knows how to do surveys and she even knows how to do them better, so we all listen up very carefully now. Okay, Melissa, you just have to unmute yourself, and you can go.

MELISSA PITTAOULIS: All right. Hi, everyone, my name is Melissa Pittaoulis. I'm happy to be here today to talk with you a little bit about how survey evidence might be used to measure whether two marks have the same continuing commercial impression. I'm going to set the stage by briefly discussing the doctrine of tacking.

The doctrine of tacking only arises in a limited set of circumstances. I think that's one of the things that makes this an interesting topic. The issue of tacking comes up when a trademark owner revises or modifies its trademark. The question is, can a trademark owner make such modifications without losing its date of first use, and in some cases, they might be able to. Tacking allows a party to close a new mark with a priority position of an older mark when the marks are legal equivalence. That is, the marks create the same continuing commercial impression.

Prior to 2015, courts were split on whether tacking was a question of law or a question of fact. In 2015, the U.S. Supreme Court issued its decision in a case called *Hana Financial Inc. vs. Hana Bank*.<sup>9</sup> The court decided that because the tacking inquiry operates from the perspective of an ordinary purchaser or consumer, we hold that a jury should make this determination. They decided it's a question of fact for the jury. In their opinion, they cited the jury instructions that had been provided in this case by the district court. I'll just highlight a portion of those instructions.

The district court had told the jury, the mark must create the same continuing commercial impression. The later marks should not materially differ from or alter the character of the mark attempted to be tacked. Those are the circumstances in which tacking would apply. Because the Supreme Court affirms that this is a question for the jury, many commentators have noted that survey

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<sup>9</sup> *Hana Financial, Inc. v. Hana Bank*, 574 U.S. 418 (2015).

evidence might be helpful in helping the jury figure out whether two marks can be tacked.

After all, surveys are used in a number of different trademark contexts. They're used to help evaluate whether a mark has secondary meaning, whether it's generic, whether there's a likelihood of confusion. One of the questions is, are any of the formats used in those other trademark inquiries sufficient for establishing whether two marks give the same continuing commercial impression.

I'm going to briefly go over a couple of the existing survey formats that are routinely accepted in U.S. courts. When the inquiry is about genericness, you see questions that ask whether the trademark is a brand name or a common name. I think it's fairly clear that that type of question doesn't really get at the tacking inquiry.

In a secondary meaning survey or an acquired distinctiveness survey, the survey questions often ask respondents whether they associate the trademark with one company or brand, or more than one company or brand. That's getting a little bit closer to our issue because we certainly want to know that consumers associate the marks with a single source. I still think that that doesn't get us to establishing the fact. Those two marks offer the same continuing commercial impression. That brings us to the likelihood of confusion survey formats.

There are generally two accepted formats in U.S. courts. In the Eveready format, we show one product, we show the allegedly infringing product, and we ask questions about whether the respondent thinks that that product is made or put out by the senior user. In what's called the Squirt format, there we show both the junior user and the senior user's product and ask questions about whether respondents think that those products or marks are made by the same company.

Here, I do think that the likelihood of confusion questions where they're measuring whether two marks come from the same source, that does start to get at whether the marks give the same commercial impression. I think we can imagine that there are many marks that come from the same source that don't actually look alike in such a way that they could be considered the same, or giving the same impression.

I think what that calls for is a new survey format that would be needed to measure continuing commercial impression. When we're thinking about how a survey might be used in a tacking inquiry, I think there's a few issues that you would want to consider.

One is, do you need to establish that the initial trademark or trade dress has secondary meaning? That might seem like an unnecessary step, but I can imagine that there are trade dress cases where you want to establish that the respondents associate that trade dress with a single source. Even if the initial mark has already registered, I think it bears consideration whether you need to also do an acquired distinctiveness inquiry.

You also want to consider whether you need to establish that the initial and revised trademarks come from the same source. I do think that that would be important to establish that both trademarks come from the same source. I think there, we could look to the types of questions that are used in a likelihood of confusion survey to establish that fact.

Then finally, how do you operationalize the same continuing commercial impression? I'm going to spend my last few minutes talking about that issue. One of the things that we want to think about is how we might design the research to look at continuing commercial impressions. We also want to think about the question wording that would be used, and then, what are the survey results? Is there a threshold for those results that are needed?

With the research design, there are two types of research designs that are commonly used in survey work. One is a between-subjects design. That's where we have a test in a control group. You have a sample of respondents; they're divided into two groups and each group sees a different survey stimulus. In your likelihood of confusion inquiry, this is the typical design that you see.

A within-subjects design on the other hand, shows the same stimuli. It measures those stimuli using the same set of respondents. For measuring continuing commercial impression, I think that the between-subjects design that is used in a likelihood of confusion surveys is probably not appropriate here. I think it's important that we get measurements and impressions from the same respondents about the initial mark and the later mark. I think that brings it closer to within-subjects design.

I also think that we should not assume that a control group is needed. Control groups are used when you're testing a causal proposition, so does the allegedly infringing mark cause confusion? We're not necessarily testing causal propositions when we're looking at a tacking inquiry.

Controls might be helpful for looking at benchmarks or as a comparison group. I don't think that we would want to use it in the same way that we use control in a trademark survey.

MAGDALENA BERGER: Melissa, sorry for interrupting. You have about 30 seconds.

MELISSA PITTAOULIS: Okay, that's all I need. Question wording. We have the "X" here, but we have to think about what questions to ask. The question on the left uses the exact phrasing that's asked in the legal inquiry, but I think that that actually makes a poor question for survey respondents, because the typical consumer is not going to know what continuing commercial impression means, so that's why we put the X on it.

The question on the right on the other hand uses a scale. While I don't think this question perfectly measures continuing commercial impression, I think it does get us closer to where we need to be. Then finally, once you have your survey question, you have your result, we have to think about what result establishes that continuing commercial impression. There's no threshold that exists right now and so I think that's ultimately going to be a question for the jury to decide how big is big enough, but I think counsel and their survey expert would want to be able to argue in defense that their number is big enough.

MAGDALENA BERGER: Thank you, Melissa. Yes, of course, Anderson. You've been waiting for this. Go for it.

ANDERSON DUFF: This is more of a comment. I just want to thank you, Melissa, for discrediting the Kars4Kids expert survey, because that jingle is evil and will never leave any of our minds if you live in the New York area. My question

is, to what extent do different jurisdictions change your approach to crafting a survey? How closely do you work with the attorneys to come up with the questions that are going to be on the survey with the relevant case law in the controlling jurisdiction?

MELISSA PITTAOULIS: That's a good question. The jurisdiction that the case is in is certainly something that we want to be aware of and know what the courts have said about surveys and in other cases, but for the most part, I try to design my surveys so that they're consistent regardless of the jurisdiction. I'm not tailoring the survey to a particular court, but I do think it's important that we know if there is a judge that had said something specific about controls that we make sure that they're addressing whatever concern that they had.

Was your other part of your question about working with counsel?

ANDERSON DUFF: Well, no, not so much. I'm just curious how idiosyncrasies in local jurisdiction's opinions on the relevant issue may or may not affect how you would change your survey. I assumed that you might get that information from the attorneys that hired you.

MELISSA PITTAOULIS: Yes. We would design our survey to address the research topic and then if counsel thinks that there's something relevant, I would hope that they would share that with us. It's not something that we would routinely start with in crafting.

MAGDALENA BERGER: Any other questions? I have a question. How often does it happen that the same clients ask you for several different types of surveys that ask for essentially the same result to get to a percentage that they feel comfortable with going to court?

MELISSA PITTAOULIS: Once we do a survey and have the result, then we're stuck with it. I know counsel sometimes will work with consulting experts to test their case and see if a survey result would be helpful to them, but once you have your testifying expert, if they're putting in a report, then any surveys that they've conducted are generally going to be disclosed.

MAGDALENA BERGER: In your experience, does it happen that if you pick the wrong survey format you really screw over your client? Has this happened or would you say that at the end of the day in your experience, the results of a properly worded survey will be similar?

MELISSA PITTAOULIS: The survey format definitely matters. One of the criteria that you need to use when you're deciding on a format is how well it replicates marketplace conditions. If you don't understand the context in which the product is sold, that could lead you to make the wrong decision. That's why it's really important from the beginning to understand how the products at issue are sold, how they compete, are they proximate and to take those things into account when deciding on the survey format.

MAGDALENA BERGER: Okay, great, thank you. If there are no other questions, I'm happy to roll over one minute since we've been running late all morning, afternoon, and evening for the poor people in Europe. I'm going to give the floor to Etienne who's going to address a completely different topic, hence the "potpourri" and is going to talk about trademark law and the pandemic. Etienne, it's yours, go for it.

ETIENNE SANZ DE ACEDO: Thank you very much, Lena, and first, my kudos to you for moderating a session with so many technical issues, besides the speakers, and I see that Gordon is back, which is definitely great news. I also quickly want to thank Hugh and the Institute for inviting me to this session.

Since this is the trademark potpourri, I'm going to perhaps be less legal and more looking at what has happened in 2020. How consumers have changed and the impact on brands. Very quickly, we started 2020 with major environmental catastrophes, just remember what happened in Australia. Immediately after we went into a pandemic, then a financial crisis. We've also witnessed massive race protests over the year. Of course, the Black Lives Matter movement. Now, as a result of that, we've also seen changes in the way consumers have been behaving. Global consumer surveys this year have really shown five ways in which consumer mindset and consumer behavior have changed.

[inaudible] professionals at large. The first one has been the accelerated move in e-commerce. There is no surprise there, except that for the non-frequent users, there's been an increase in usage of over 160%. That's absolutely huge. The second big change has been the increase of what we call the at-home economy. An example of that is the fact that we've seen the surge of virtual brands that exist digitally that do not exist physically. Just to give you an example, there is a new burger chain that is called Mr. Beast Burger. It was created in December 2020 by a YouTuber. It has been one of the most downloaded apps in the last six months and it already has 420 locations around the U.S. That's a change in behavior. The third one is the return to value and essentials. Consumers have become more frugal; they're spending more on grocery and household supplies. They're also more sensitive to price issues. As a result of that, we've seen a shift in brand loyalty. Somehow consumers have become a little less brand loyal on the one side.

However, amongst the consumers that were most concerned by the pandemic, 46% of them say that brands remain extremely important. Last but not least, more and more attention to corporate social responsibility to diversity, equity, and inclusion and an increasing interest in how companies are conducting their business.

Now, what does that mean from a counterfeiting perspective? I'm not going to talk about the overall numbers we've heard many times and the EU Observatory is great at presenting those numbers.

I would like to share with you some very recent numbers from the U.S. Homeland Security website. Since the COVID-19 pandemic, there've been 2066 seizures related to COVID-19 products, so test kits, masks, pharmaceuticals, vaccines. That represents around 50 million products. There've been around 80,000 domains that were COVID-19 related that have been analyzed. As a result of that, almost seven had seizures, 35 cases initiated, and 27 websites have been removed.

These are stats from the U.S. Homeland Security website from last month. Now, why am I referring to this? Well, we all know that counterfeiting poses very serious health and safety risks for consumers. We know that it's detracting value from brands and brand owners, but the other thing that we need to think about is that it's really undermining research and development at a time that is so critical.

It's also diminishing consumer trust. Again, at a time where some consumers are not sure about taking a vaccine, that is absolutely critical.

The reason why I want to bring this to everyone's attention is that, of course, it's extremely important that we talk about the legal arguments and all legal issues, but we also need to think from a business perspective, and from a consumer perspective, what does that mean? COVID-19 shows that more than ever, counterfeiting is a very serious issue for brand owners, for consumers. It's extremely important that we promote the positive contribution of brands to society. This is where we need to educate consumers more than ever.

I'm just going to point out one final comment. We're at a time where almost certainly four, and perhaps even five generations are coexisting. We always think that the younger generations, the Gen Z-ers, the Millennials, are the ones who are online most of the time. Well, that has changed as well because of Covid-19. We have our elderly people who are spending a lot of time online and are precisely the victims of counterfeits. All in all, we definitely need to educate consumers on the risk of counterfeiting.

That's something that we absolutely need to do hand-in-hand with policymakers. I think I'm going to be just on time and Lena, I'm going to give you back a few seconds, which probably is a good thing for the other speakers and for the attendees. Thank you so much.

MAGDALENA BERGER: Thank you, Etienne, you're getting a gold star. That's the badge of honor that Fordham speakers get for finishing early. Yay. Any questions in the audience, please put them in the Q&A box. Any questions on the panel raise your hand and I'm happy to hand the microphone to you.

Then I have a question, as always. Etienne, I understand that INTA is working on building consumer trust and brands, right? Have you been active in 2020 and the beginning of 2021? Does anything work? I mean, it's the same thing, right? INTA also has been working from home. It's probably for you just to be effective is just as challenging as for everyone else, but has INTA started to work on that? Has INTA a task force for vaccine safety or something like that?

ETIENNE SANZ DE ACEDO: Absolutely, Lena. We've done several from a policy perspective, the INTA Board of Directors has recently passed resolutions that are counterfeiting related. One of them is extremely interesting because it has to do somehow with parallel imports and with counterfeit procedures.<sup>10</sup> In addition to that, we've continued our policy dialogues with authorities from all around the world, particularly customs authorities.

Last but not least, our education campaign, which is called "Unreal," has shifted to being completely online. We've seen a lot of traction doing that. There is great potential in this format and being able to reach audiences that traditionally we're not able to reach. That's something that we've been doing with, I would say, rather significant success. We've also increased our presence on social media, particularly when it comes to the younger generation.

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<sup>10</sup> *Proceeds of Counterfeiting*, International Trademark Association, (Mar. 18, 2021), [https://www.inta.org/wp-content/uploads/public-files/advocacy/board-resolutions/Proceeds-of-Counterfeiting-Resolution\\_Final.pdf](https://www.inta.org/wp-content/uploads/public-files/advocacy/board-resolutions/Proceeds-of-Counterfeiting-Resolution_Final.pdf).

MAGDALENA BERGER: Talk for a second about your Unreal campaign. That's usually where you send INTA members to classrooms of teenagers, and to help them understand the problem of counterfeit goods.

ETIENNE SANZ DE ACEDO: Correct. I have to say, well, some of you might be INTA members, and some of you might have even been presenting on behalf of INTA for the Unreal campaign. It's a lot of fun for the students. I think it's a lot of fun for the presenters as well. I do remember myself attending a few of those sessions. You get great questions from the kids and we learn a lot from that, but it's something that is very successful and we're just expanding that, and we're going all around the world. I mean, the greatest advantage we have is that we have for our members a presence in 185 countries, so we definitely take advantage of that.

MAGDALENA BERGER: I can see how, and during times of Zoom school, teachers are very grateful to have someone else do something online for the students.

ETIENNE SANZ DE ACEDO: Indeed, we all know that.

MAGDALENA BERGER: Any other questions from the panel, and if not, I'm asking Joel — Oh, there's Gordon raising his hand. Gordon, go for it. You have to unmute yourself first, of course, the most spoken sentence of our times.

GORDON HUMPHREYS: Etienne, I just wondered, you were saying about, you started with all these disasters that have happened in the Black Lives Movement and Covid. I wonder, is this something that INTA's very aware of the problem that we faced certainly in Europe, of applications for trademarks that try to take advantage of these unfortunate situations, and whether that's something — I mean, you were saying with the kids, I suppose that's something that is targeted a bit at younger people sometimes for a sort of shock value? Is that something that's on your radar?

ETIENNE SANZ DE ACEDO: It is, Gordon, a great, great question, and as you know, we're a committee-driven organization, so we have several committees addressing these issues from different perspectives. Sometimes we have the legislation or regulation committee looking into that. When it comes to courts, the amicus brief committee might be looking into these kinds of things, and particularly TOPC, which is the Trademark Office Practice Committee, is on a permanent basis talking to IP offices about these issues.

No matter whether you consider that bad-faith filing, or the filing that goes against public policy, morale, etc., that's something that we're definitely looking into.

MAGDALENA BERGER: Thank you. I think Irene had a question? Did I see that right? Irene?

IRENE CALBOLI: Yes.

MAGDALENA BERGER: There you go.

IRENE CALBOLI: I am having a bit of internet issues as well. Thank you very much, Etienne, for the great presentation, and I want to ride on Gordon's questions about opportunistic filing. I counted and I did a bit of studies on the Covid application, Covid coronavirus in medical terms in the US, and we had around 700-

plus applications of which I would say, probably 90% will die for failure to function, but there is at this stage, there is a lot of abuses of that.

Clearly, I don't say INTA can create a campaign against opportunistic applications and the doctrines we have are good. May I ask you if INTA could perhaps do, or through members, just because of cluttering in the registry, make that as an issue because I know some of your committee actually work on that. I've been working on some of these committees directly, and so your members are very responsible. A lot of these filings are driven by individuals without any attorneys or self-represented.

Through my survey, over 75% of these applications are for small businesses and individuals. Again, I think it's where trademark education — you can't just trademark that line for a T-shirt without having to go through services-related. It's really important what you're doing, and how we can tie what Daren Tang was saying today about SMEs,<sup>11</sup> and more education, and more education for—

MAGDALENA BERGER: Irene, I'm sorry. We're actually running out of time, so I'm just going to let Etienne answer your question.

IRENE CALBOLI: [crosstalk]

MAGDALENA BERGER: Then there's a general discussion at the end. Etienne, if you want to answer?

ETIENNE SANZ DE ACEDO: Yes, quickly to react to what Irene was asking. That's something that we're definitely looking [inaudible] I think, the different ways to approach that. We need to collect data from our own members to understand what is the situation in the different countries. From there, we can start approaching IP offices on the one side, and the other side, building resolutions or policy papers, and that's exactly what we're doing, so please stay tuned on that.

IRENE CALBOLI: Thank you.

MAGDALENA BERGER: Thank you. Joel, it's yours.

JOEL SMITH: Hi, Lena. Thank you very much and thank you for Fordham for inviting me to speak. I'm going to try and share my screen, so let's see if that works.

Well, I wanted to look in this session at the extended protection available for geographical indications across Europe, and make a prediction that this is going to result in more disputes in this area in the future.

Just a brief reminder then, obviously the background for GIs and TRIPS.<sup>12</sup> You've got Article 22.1 which sets out what a geographical indication essentially is, I'm not going to go into that, and the extent to protection offered under Article 22.2, whether it's under sui generis rights, or unfair competition. There are multiple systems of protection available under the GI system.

You've got protected designations of origin, PDOs, protected geographical indications, PGIs, geographical indications, plus we've got traditional specialty guaranteed. All of which give you some sort of protection against misuse, or imitation of the registered name, and a guarantee of the origin essentially to the consumer. There are over 3,000 GIs registered in the EU, and they're now available

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<sup>11</sup> Small and medium-sized enterprises.

<sup>12</sup> The Agreement on Trade-Related Aspects of Intellectual Property Rights.

and accessible on a new EU database, GIview, which was launched in November at the end of last year.

Non-European product names can also be protected if the country has a bilateral regional agreement with the EU, such as South Africa, or we've got the recent EU agreement with China, which was now enforced from the 1st of March, offering some form of reciprocal protection in both the EU and in China for a number of new GIs.

I really wanted to turn to the EU sections, and in particular, this case of *Morbier* and *Livradois*,<sup>13</sup> which was before the Court of Justice at the end of December 2020, with a preliminary reference from the Cour de Cassation in France. It looked very much like these provisions, which hopefully are on screen, in terms of Article 13 of this regulation,<sup>14</sup> on the protection offered by GIs against direct and indirect commercial use, misuse, and in particular 13(1)(d), any other practice liable to mislead the consumer as to the true origin of the product.

The reference came about because of a dispute between the claimant holder of the PDO for a French cheese, Morbier, and the defendant producer of a similar cheese. Here we've got the various cheeses. The PDO had been registered pursuant to the regulation. The claimant essentially had a PDO which covered this cow's milk cheese, which is in the similar flat cylinder with a black line through it.

The defendant had previously been marketing a Morbier cheese, but had gone through a name change, and then started marketing an equivalent cheese under an alternative name, Livradois, but again with a black line through the center of the cheese. The claimant had taken proceedings in the French courts, claiming that this marketing was essentially causing confusion in the PDO in a way that it was likely to mislead the consumer.

The applications have been dismissed by the French court at first instance, and even by the cour d'appel, basically on re-competition grounds, and essentially that a producer should be allowed to use similar techniques or ingredients to create an equivalent appearance. The Cour de Cassation decided to stay the proceedings and referred the questions to the Court of Justice. The Court of Justice, [inaudible] that is Article 13, was not limited to prohibiting use of the registered name but had a wider scope.

In particular, focus as I mentioned on Article 13(1)(d), finding that this — It covered a number of different situations where the consumer could be misled. It went further to find a close linkage between the PDO and the product itself, with the reproduction of the shape, or the appearance able to mislead the consumer, as to the true origin of the product. This might be particularly where the appearance of the product is a baseline characteristic as they put it, and it was particularly distinctive of the product, so reproducing this characteristic would lead the consumer to believe that the product was actually covered by the registered name.

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<sup>13</sup> Case C-490/19, *Morbier v Société Fromagère du Livradois SAS*, ECLI:EU:C:2020:1043 (Dec. 17, 2020).

<sup>14</sup> Council Regulation (EC) No 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, art. 13, 2006 O.J. (L 93).

I think this is a significant development of EU law after a number of cases really focusing on GIs in the EU and moving away from pure use of the registered PDO name, but starting to look at shape, appearance, and key features.

I wanted to take that a little bit further, really, to look at PDOs and PGIs, because it's a rapidly developing area, not just because of case law or bilateral treaties, but now we've got the new regimes as a result of Brexit. Essentially, we've got the EU scheme continuing and those GIs which were protected in the UK under the EU scheme are now protected under a new UK system, so they've been recognized and protected.

They were protected before the 1st of January as part of the withdrawal agreement, but those GIs, which are registered under the EU scheme after the 1st of January will not apply in Great Britain, but they will apply in Northern Ireland. Instead from that date, applications for protection made from Great Britain under the EU scheme will be treated just as third-party applications on the EU scheme.

The UK, as I said, it's got its own GI scheme now which is open to producers, not just from the UK, but from other countries as well. As I said, the position in Northern Ireland is under the Northern Ireland Protocol,<sup>15</sup> and essentially as with a number of different issues, it treats Northern Ireland as a member state for various purposes, including protection of GIs, which is interesting.

As I mentioned, there are guidance regulations which the UK government has issued, the logos. I just wanted to touch on a couple of other things happening in the EU as a result of the European Commission communication at the end of 2020 looking at the EU IP action plan. Again, they mentioned they wanted to improve the strength of the GI system and streamline it, and in particular, look at the establishment of nonagricultural product GIs, which is an interesting area of development.

The commission has also been looking at GIs in the context of the European Green Deal and looking ahead at post-COVID and things they can do to promote the environment in the green economy. One of the things is GIs there, and they're looking at trying to streamline the management of GIs, particularly having digital registers and also looking at enforcement online. I think all of the—[crosstalk]

MAGDALENA BERGER: You have about 30 seconds left, sorry about that.

JOEL SMITH: All of these measures together really demonstrate that there is increasing protection for GIs across Europe. I think there's also — from the case law is looking — I think they're all going to be, as I said, more disputes building off the sui generis rights, but also possibly on the passing off unfair competition and various other IP forms of protection as well. I think we can see more successful challenges in the courts going forward.

I think I will leave it there and we can pick up any other things with the questions. Thank you.

MAGDALENA BERGER: Thank you, Joel. Any questions on the panel about Joel's talk? I see no hands. Is it upon me yet again? Gordon, thank you.

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<sup>15</sup> Protocol on Ireland/Northern Ireland [2020] O.J. (L 29/7).

GORDON HUMPHREYS: No, thank you, for the interesting talk. You say more disputes on the horizon. What do you think about the interaction between GIs and services? There's a preliminary reference concerning champagne. This is another area. Do you think that the territory that GIs cover is increasingly broadening and likely to continue to broaden? We've seen it extended to tapes. What do you think about services and these other areas? It includes the general tendency and what do you think?

JOEL SMITH: Well, I think it's an interesting area the fact that they're broadening it as I mentioned, not just, for instance, non-agricultural product, so you've got things like examples might be Waterford Crystal or Limoges porcelain, and things like that, or it might be lace or clothing.

As you go further and further away from, I suppose, food and drink, it's becoming an increasingly powerful right I think because in many ways, obviously, it can trump trademarks, there is obviously an interface with trademarks as well.

Particularly, because of the way GIs arise in that once they're recognized or registered and there isn't really the same system of examination or opposition as there would be for trademarks, they become quite a powerful right and they can also be recognized in other countries, they could be used to block other trademark applications. They don't become generic in the same way that trademarks could become.

I think it is an interesting area. I think that's one of the ways that they're going to butt up and jar against other rights and I suspect particularly trademarks.

IRENE CALBOLI: Following on that, to what extent this idea of evocation is getting a bit out of control because I'm a major supporter of geographic indication, but since there are not really limits in the current legislation against geographical indication there is not really an idea of fair use or descriptive uses in the same way.

This is really a right, that it's a bit out of control, particularly if it goes so much beyond when there is really no confusion. This idea of evocation that goes all the way to bubbly [unintelligible]. Bubbly champagne is one of the intrinsic features is the bubbly, but that silently what you do is [unintelligible].

The other question is when they're used as ingredients because now they're more and more used as ingredients and celebrated as ingredients, so there is a first saying the exhaustion of the GIs or other people can use it in recipes or cooking shows, but then now, what if that can actually tarnish the reputation, and so we go into the [unintelligible] so the slippery slope. I would love to hear your thoughts on that.

JOEL SMITH: I agree with you. I think that is a broadening area which is at risk. I think whether you're looking at, well, infringement-type questions, and evocation and how broadly you construe the GI. As I say, if you go down the case I mentioned where you're looking at shape, but then do you start getting at ingredients, and then how far does this protection extend?

I think particularly, as these — The other and I've come up across needs in practice where you've got a GI which might actually have been registered subsequent to maybe a trademark of local significance or something, and then you've got this very awkward relationship between the two where the trademark

holder didn't really have the ability to object to the GI or didn't do so, and then they're being threatened for essentially manufacturing a branded product which they've sold prior to the GI being recognized.

I think that there are a number of areas where these are going to bump up against each other and particularly in Europe where the rights of GIs are very strong, and we're here at the moment in the U.S. position. I think it is going to result in more disputes and litigation.

IRENE CALBOLI: If I can follow up very quickly.

MAGDALENA BERGER: Thank you.

IRENE CALBOLI: I know, but just give me one second. This is an area that across the world is growing tremendously beyond Europe, Asia, it's very much for GIs, for example, now, so this is really going to be a very interesting area to follow.

ANDERSON DUFF: I would just like to very quickly say that—

MAGDALENA BERGER: Thank you, Anderson.

ANDERSON DUFF: —I support the proliferation of GIs in so far as it allows things like Prosecco to enter the public consciousness in the market, and specifically for me, Japanese whiskey has really been on my radar because of geographical indicators. I look forward to Daan's presentation, which I think will talk more about the exact issue that you just raised, Irene.

MAGDALENA BERGER: Yes. I'm going to hand it over to Daan. We're almost out of time. Daan, good luck with your slide if you have any.

DAAN ERIKSON: Actually, I only have five minutes here, but my presentation touches on both surveys and GIs. I'm really tying everything together here. By the way, I'm Daan Erikson, senior associate with Husch Blackwell, based in our Chicago office, used to work at the Fordham IP Institute. We don't have a lot of time. Let's go. I'm talking about the Trademark Trial and Appeal Board case about the application for a certification mark for GRUYERE. Now that case is on appeal to this court. Let's take a look at this case, U.S. Dairy Export Council versus basically a Swiss organization and a French Association.<sup>16</sup> I will spare you my pronunciation of these names, but you can read them here and somebody that speaks French better than I can share that.

Basically, these two organizations applied to register GRUYERE just as a wordmark with the U.S. Patent Trademark Office as a certification mark for cheese. That meant no stylization or design with it. The Swiss organization already had a certification mark for the stylized and design mark you see on the screen there, but the French Association didn't have anything whatsoever. The word mark application was opposed by the U.S. Dairy Export Council and a bunch of other organizations, importers of cheese saying that GRUYERE is generic for a style of cheese in the United States.

The Trademark Trial and Appeal Board agreed. Why did they agree? There was certain evidence that they found persuasive and I know we don't normally talk at Fordham about individual Trademark Trial and Appeal Board cases but this one struck me as an interesting case study, because of the evidence that they found persuasive, and the evidence that was not included.

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<sup>16</sup> U.S. Dairy Export Council v. Interprofession du Gruyère, No. 91232442 (T.T.A.B. Aug. 5, 2020).

The evidence that was persuasive was usual dictionary definitions, other resources, reference materials like the *Oxford Companion to Cheese*, the *Cheese Lovers Companion*, records from the World Championship Cheese Contest, and extensive use by a domestic U.S. company that produced millions of pounds of cheese under the generic label GRUYERE. Some website evidence, limited success on the part of the Swiss and French associations in policing their claimed rights. The one thing that I found different is a deference to the U.S. Food and Drug Administration standards of identity.

I found this interesting because I do trademarks and copyrights but I work with a lot of food and beverage clients at a firm where we also provide regulatory guidance. A colleague of mine, who does FDA and USDA advising, and I looked at this issue, wrote a blog post on this case, and she was able to share her expertise with me about how the standards of identities work. I thought this was fascinating because you've got the one administrative agency looking at another and saying, "Okay, you're the ones that know about food, tell us what you think about this," essentially, and looking at their reference materials.

That was something that the Trademark Trial and Appeal Board heavily considered in their decision holding that GRUYERE is generic for cheese. What the parties didn't include is, nobody did a survey. That fascinated me because you always hear okay, you got to do a survey, you got to do a survey, and even McCarthy says it's de rigueur to include a survey as part of a genericness analysis. I guess we can discuss why do you think they didn't include a survey? Or why might you not include a survey about it being generic. Maybe they just felt their other evidence was strong enough. I have no connection to any of these parties, but my FDA regulatory colleague used to work for one of the dairy companies, in full disclosure.

After the TTAB decision, the USPTO issued a new Examination Guide,<sup>17</sup> which if you're unfamiliar with those, that's basically for the examining attorneys as they're looking at trademark applications to see, okay, if something comes up along these lines, what do we do with it? They've done similar ones for the *Booking.com* case or anything that comes out after the latest version of the Trademark Manual of Examining Procedure has been issued.

This particular Examination Guide is marks including geographic wording that does not indicate geographic origin of cheeses and processed meats. That's pretty specific but they're talking there about the FDA and USDA standards of identity, which is just the name of the food, basically. That's in regulations, you can take a look at. The USPTO also said the trademark examining attorney should look at this Codex database of other types of food names but because that's not a U.S.-based one, they don't look at that as highly or as strong evidence.

This quote here is the other part that I found fascinating, and call me a nerd, that's fine, but inclusion on the FDA or USDA list is "strong evidence" that the term is generic for the particular cheese or processed meat. If you don't work with any food clients, or cheese or processed meat is not of great interest to you, I can

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<sup>17</sup> U.S. Patent and Trademark Office, Examination Guide 3-20: Generic.com Terms after USPTO v. Booking.com (2020), <https://www.uspto.gov/sites/default/files/documents/TM-ExamGuide-3-20.pdf>.

see that maybe you think this discussion is a snooze fest, but hopefully not. Hopefully, you can see that if this is one administrative agency looking at another administrative agency for guidance, I think this could have potentially broader implications.

As I mentioned, the case is on appeal to the Eastern District of Virginia. Right now, there's a summary judgment motion pending that the defendants filed. The Hearing for that is scheduled for May 7.

MAGDALENA BERGER: You have one minute left.

DAAN ERIKSON: I got it, we're on top of it here. That motion is pending and one of the cases that they cited in that motion was this Federal Circuit case involving CHABLIS as a kind of wine. This kind of thing has happened outside of just the food realm. It's not just meat and cheese. But I could see this type of thinking having broader implications. That's my presentation.

MAGDALENA BERGER: Thank you, Daan. Gold star.

ANDERSON DUFF: Hello? I can't hear.

MAGDALENA BERGER: Now I have everyone back. Anderson, this is the space hat thing where when you take the slide away, we all put on space hats, and then we travel through time. Anderson, do you have a question?

ANDERSON DUFF: Well, first, Daan, I'm going to take your invitation and call you a nerd, but I'm also a nerd. In fact, I'm very worked up about this. I mean, giving deference to the FDA on this issue is absolutely ridiculous to me. To illustrate that, I mean, just in the time that you were presenting, I looked at the other sections of the CFR. For example, the section on Parmigiano and Reggiano. I don't know if I'm pronouncing that right. I know it's delicious, but that's a geographical indication.

There's no mention of a location in the description that the FDA gives in the CFR, Code of Federal Regulation. I think you're right, this opens the door. I mean, this is crazy. The Code of Federal Regulations was not drafted with geographical indications in mind. If we're going to start giving deference to the F — I'm also frustrated at the FDA in another case that's unrelated, but this is insane.

DAAN ERIKSON: Yes, I think it's interesting because we also represent a client that owns something they consider a mark, which may or may not be on one of these lists. What do you do about that? I mean, it is an issue, as you mentioned that, they don't essentially have trademarks in mind necessarily when these things are drafted. I think a lot of times, the American view, stereotypically is not, let's protect it, except if it comes to Florida oranges or Vidalia onions or something, right? It's an interesting area to me as well.

ANDERSON DUFF: What happens now? I mean, are stakeholders going to have to pay close attention to what the FDA is doing and lobby them in their — They have public comment sections at periods?

DAAN ERIKSON: Well, I will have to ask my colleague about that because it is my understanding that you can do some type of lobbying with the FDA and USDA to get these things changed but I haven't actively worked on that; haven't had the opportunity to.

MAGDALENA BERGER: Can I just quickly ask: If you make it on — What's that list, the standard of identity, what's that list for? Is this actually for

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cheese producers so they know if they want to make a Gruyère-type cheese, that's what they're supposed to be doing or what is that list?

DAAN ERIKSON: It's for food labeling. For people who are manufacturers of food or beverages, it's to be able to identify the food as, I don't know, apple sauce or processed potato food, or you know what, I don't know.

MAGDALENA BERGER: It should say Gruyère-style really, right? European me says it should be Gruyère-style because it also does not taste like Gruyère, the stuff that you buy here that's labeled here.

DAAN ERIKSON: At one point, the association —

ANDERSON DUFF: As somebody from the EU might —

MAGDALENA BERGER: Yes, Irene is eager, I can see it. Irene, go for it, you know this.

IRENE CALBOLI: No. I think the FDA in some ways is the certification agency for safety standards and to take it so, now but [unintelligible] of GIs in Italy and in the EU, in the U.S. is a certification mark and then I'm sure there are some of the vendors that have their actual trademark. Let's face it, it's in the U.S. now — it's all a dairy war, like in Australia it's a dairy war, in New Zealand it's a dairy war.

Wine, the wine treaties have resolved a lot of the problems and in the U.S., we have almost 350 cultural areas with viticultural certification and regions within region and micro-region in the U.S. as well, so it's really very much about common name for cheeses, also because it's very hard to find the generic term for the cheese. The grapes are the generic term for the wines, but you don't really have — it's milk, and so you don't really have a generic term. I'm all in favor of the style type that now the Europeans don't want either.

I think it's fair to have that, but this is really about their interest but you're taking what is in this list, is actually very interesting technically, because this is the food labeling, it's an area that GIs IP folks don't think very much about it but these both can be both also very useful to block products just because they don't have their necessary requirement from certification standpoint even if they can use the name that they can't under this list so at least that.

ANDERSON DUFF: Well, but aren't the labeling requirements or the motivations for the FDA's labeling requirements quite different from a GI's labeling requirement?

IRENE CALBOLI: Yes, completely. Again, it depends. I'm sure Daan can say that better than me but it depends on the specification of GI sets. It's the product control, the product quality, a certain process that might be certified similarly to what the FDA, but the FDA is about food requirements for safety reasons premier.

MAGDALENA BERGER: Gordon, I think you had something, right?

GORDON HUMPHREYS: Yes, I was just going to ask—

MAGDALENA BERGER: Oh-oh, oh-oh, we've frozen Gordon again. We can't hear you, I'm going to give you 20 more seconds,

ANDERSON DUFF: I really wanted to hear that.

MAGDALENA BERGER: Me too.

ANDERSON DUFF: Incidentally, the FDA's definitions [unintelligible] the wine, does mention regions.

GORDON HUMPHREYS: I don't know if you've gotten—

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MAGDALENA BERGER: There he is, there he is, Anderson.

ANDERSON DUFF: [unintelligible] We missed everything, you just came back.

GORDON HUMPHREYS: Sorry?

ANDERSON DUFF: You froze, we didn't hear anything.

MAGDALENA BERGER: Okay, try again, Gordon. We did not hear anything.

GORDON HUMPHREYS: Okay, how would you see this — How would you have seen a survey working to establish the generic nature in this case? Would they have had to survey the whole of the U.S.? How would this have worked?

DAAN ERIKSON: Well, maybe Melissa wants to speak to that one. Share your survey expertise.

MAGDALENA BERGER: Yes, please.

MELISSA PITTAOULIS: Typically, if you're doing a genericness survey you would not survey the whole of the U.S., you would be focused on prospective purchasers of that type of cheese. I'm sure that if they were doing a survey, there'd be a lot of discussions about how narrow to make that survey universe, is it any cheese or do they need to narrow it down to a particular type. I have no connection to the case so I don't have any information, but I would not be surprised if they did do a survey and there wasn't one entered because it wasn't favorable, so it just never made it in.

ANDERSON DUFF: [unintelligible] other side have entered it then though? [unintelligible] they did it in pre — yes. Daan, do you think even if there was a survey that supported the idea that it was generic, it would have been enough to overcome their deference to the FDA which again, I think is ludicrous.

DAAN ERIKSON: Yes, I don't know, I'm interested. Melissa, when you do a pilot survey and you don't have to disclose that, it's only once you do the full survey, is that how that works?

MELISSA PITTAOULIS: You could do a full survey and still not disclose it, just then your survey expert is a consulting expert, not a testifying expert.

DAAN ERIKSON: Okay, so yes, I don't know in this case. I think they're saying it's strong evidence which is yes, that's wild to me too, that they're looking at that. It means that trademark lawyers and FDA lawyers are going to have to work closer together on these things so it's good to have people that can then work together on that.

GORDON HUMPHREYS: Just strange strangely enough, the survey that I mentioned, the GIs was also proposed for cheese, that it was actually whether a word component of the cheese denomination was generic or not so, strange coincidence.

ANDERSON DUFF: That's serendipity.

DAAN ERIKSON: Tying it all together, right?

ANDERSON DUFF: That's right.

MAGDALENA BERGER: We're entering our final discussion round. We have three and a half minutes left, if there are any questions from the audience, please put your question in the Q&A box, and if not, the panel will just keep going strong. I have to say, I want to go back to Joel's cheese thing. I'm really all in favor

of GIs, but in that cheese case, there's plenty of cheeses that are round like that and that have some sort of middle thing in there that's more or less disgusting to some people.

I really love to protect stuff because I really do not like that in the U.S. I often get knock-offs that really do not taste like the ones that I really want to taste from my childhood but this seems to be going just way too far, is there something — What can we do? [crosstalk]

ANDERSON DUFF: I just think it's funny to think that you had a childhood.

IRENE CALBOLI: May I say something. A lot is about context because in Europe, we had some — To the eyes of the external people, some really crazy decisions, the *Rocinante*,<sup>18</sup> the fact that the cheese maker that has the name of the horse of Don Quixote, for Queso Manchego so the average non-Spanish person knowing that Rocinante is the name of the horse of Don Quixote. Don Quixote is La Mancha, you cannot use them, so there's nobody that knows that, so Melissa, you do that, you would have a zero-zero in your survey if you have anybody who is not Spanish.

That was a cheese maker very close to in the region, so there is a lot of unfair competition here that it might not come during the analysis of GIs and so it's those rip-off or free ride on very close by reputation, so even but then that makes a precedent for cases that might be then decided in terms of what can be granted as a GI or not. Very often when you contextualize and use them in the facts of these cases, there is quite, if not bad faith, free riding almost 100% of the time.

JOEL SMITH: Yes, I think it's also interesting is, as I mentioned in that case, is that the question is whether you're actually precluding use of traditional techniques that may be used for others, whether it's cheeses or other foods or whether you say, the fact that this black line was really quite distinctive of this particular GI.

The fact that another producer also produced a cheese looking very like it was something which they were free-riding and trying to ride on the back of the name so that's why the protection extends beyond the actual registered name to the inner product's appearance.

I think maybe on the particular facts that you can look at it but I do think it's interesting in a number of other cases where, for instance, scotch whiskey cases where they're continuously looking at the use of the word Glen or other Scottish imagery and whether that's an evocation of the geographic indication for scotch whiskey and so I think the protection is extending out and it's a question of, do we need to draw a line at some point saying, “Yes, these are not unlimited forms of protection, particularly where you're not really having to show the same level of confusion or deception as you might with trademarks.”

GORDON HUMPHREYS: I would definitely agree with that. One of the problems we have with the EUIPO is with very aggressive policies of certain GI owners. For instance, there have been a spate of cases involving the port, the owners of the port GI. Obviously, that gets into another field because it's actually really

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<sup>18</sup> Case C-614/17, Fundacion Consejo Regulador de la Denominacion de Origen Protegida Queso Manchego v. Industrial Quesera Cuquerella SL, ECLI:EU:C:2019:344 (May 2, 2019).

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Porto or Porto, it's the translation in English it's port but of course, there are a lot of place names with port which has also given rise to litigation. Some of which is sometimes successful, so it just creates a lot of problems when things are taken too far.

IRENE CALBOLI: Here's really where the absence of defenses, the absence of limitations is the problem.

MAGDALENA BERGER: Yes, I think that's exactly that's the point and I think Gordon got it right if you take it too far, things are getting dicey. That's a very nice sentence to end on for trademarks, I think that's a very nice way to put it. Thank you very much everyone for joining us on this wonderful Potpourri panel.