

Commercial Chamber : Scope of protection of protected designations of origin (PDOs)

14/04/2021



Scope of protection of protected designations of origin (PDOs) (after preliminary ruling) : protection of PDOs against reproduction of the shape or appearance characterizing the product covered by the registered name.

Ruling no 366 of 14 April 2021 (17-25.822) - Cour de cassation (Court of Cassation) - Commercial Chamber -
ECLI:FR:CCASS:2021:CO00366

Partial quashing

Only the french version is authentic

Appellant(s) : Syndicat interprofessionnel de défense du fromage Morbier

Respondent(s) : Fromagère du Livradois, simplified joint-stock company

Facts and procedure

1. According to the ruling under appeal (Paris, 16 June 2017), the Syndicat interprofessionnel de défense du fromage Morbier (the Syndicat) is an entity that defends the interests and manages protective measures for Morbier, a type of cheese from the Jura region that, since the adoption of the decree of 22 December 2000, has enjoyed appellation d'origine contrôlée (AOC) (registered designation of origin) status, and as of 10 July 2002, entered the register of appellations d'origine protégée (AOP) (protected designations of origin).

2. Fromagère du Livradois, established in Puy-de-Dôme, produces and markets cheeses. Having produced since 1979 a cheese under the name "Morbier", it was authorised, within the framework of the transitional period provided for in the decree of 22 December 2000 for undertakings situated outside that geographical reference area, to use this name, without the "AOC" indication, until 11 July 2007, date after which it replaced that name with "Montboissié du Haut-Livradois."

3. On 5 October 2001, Fromagère du Livradois filed an application in the United States for the American trademark "Morbier du Haut-Livradois, which it renewed in 2008, for ten years, before cancelling the registration in 2013 and, on 5 November 2004, it filed an application for the French trademark, "Montboissier" for Class 29 products.

4. On 22 August 2013, accusing Fromagère du Livradois of infringing the protected designation "Morbier" and committing acts of unfair and parasitic competition by producing and marketing a cheese that has the visual appearance of the product protected by this AOP in order to create confusion with that product and to benefit from the renown of this designation of origin without having to comply with its specifications, the Syndicat brought proceedings against Fromagère du Livradois, requesting that it be ordered to cease any practice infringing the protected designation "Morbier", and to compensate it for the damage suffered.

5. Fromagère du Livradois counterclaimed damages for abusive proceedings.

6. In a ruling of 19 June 2019, the Cour de cassation (Court of Cassation) referred a question for a preliminary ruling concerning the interpretation of Article 13, paragraph 1 of Regulation (EC) No 510/2006 of the Council, of 20 March 2006, on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, and Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs.

7. The CJEU responded to the question referred for a preliminary ruling with a ruling on 17 December 2020, to the Syndicat interprofessionnel de défense du fromage Morbier (C-490/19).

Reviewing pleas

Considering the third, sixth, seventh, and eighth parts of the first plea, appended hereafter

8. Pursuant to Article 1014, paragraph 2 of the Civil Procedure Code, there is no need to rule by a specially reasoned decision on this plea which is clearly not of a nature to lead to quashing.

On the first and second parts of the first plea

Statement of plea

9. The Syndicat criticises the ruling for dismissing its requests, whereas :

"1°/ the decree of 22 December 2000 on the "Morbier" protected designation of origin only recognised the right for undertakings not located in the designated geographical area to "continue to use this name under current conditions" ; The Syndicat submits that the cour d'appel (Court of Appeal) noted that in October 2001, Fromagère du Livradois had filed an application in the United States, for a new trademark including the name "Morbier" and used it after the publication of the decree, and that, as a result, far from continuing to use the "Morbier" name "under current conditions", Fromagère du Livradois had sought to develop its use of the name "Morbier" starting in 2001. Therefore, the Syndicat claims that in ruling that Fromagère du Livradois did not commit any fault by filing an application for the trademark in 2001 and by operating the brand afterwards. In so ruling, the cour d'appel (Court of Appeal) infringed Article 8 of the decree of 22 December 2000 on the "Morbier" protected designation of origin, which at that time was applicable ;

2°/ the designation of origin is protected from any use by a competing symbol, whether this competing symbol is operated or not. The syndicat submits that by ruling that filing a new application for the trademark "Morbier du Haut Livradois" in 2008 and maintaining it up to the cancelling of its registration in 2013 did not constitute misconduct, once Fromagère du Livradois stated that it was no longer operating that trademark starting in 2007, the cour d'appel (Court of Appeal) infringed Article 13 of Regulation (EC) No 510/2006 of the Council of 20 March 2006, and Article 13 of the Regulation (EU) No 1152/2012 of the European Parliament and of the Council of 21 November 2012. "

Court's response

10. On the one hand, the cour d'appel (Court of Appeal) having ruled that the acts posterior to 22 August 2008 were not time-barred, so that the action for damages due to the violations committed by Fromagère du Livradois by filling an application in the United States, in October 2001, for the trademark "Morbier du Haut-Livradois" and by operating it until 2007, was time-barred, the plea is without effect.

11. On the other hand, Article 13 of Regulation (EC) No 510/2006 then Article 13 of Regulation (EU) No 1152/2012 giving protection to protected designation of origin (appellation d'origine contrôlée, AOC) only in Member States, the plea alleging an infringement of the "Morbier" protected designation of origin (appellation d'origine protégée, AOP) committed outside of the European Union territory by simple renewal of the registration of a trademark in the United States, without a risk of evocation in the mind of European consumers, is without effect.

12. Consequently, the plea is not founded.

But on the fourth and fifth parts of the first plea

Statement of plea

13. The Syndicat takes issue with the cour d'appel (Court of Appeal) for dismissing its requests, whereas :

"4°/ a designation of origin is protected against any practice that is likely to mislead the consumer as to the true origin of the product. The Syndicat submits that by ruling that only the use of the name of the protected designation of origin is

prohibited, the cour d'appel (Court of Appeal) infringed Article 13 of Regulation (EC) No 510-2006 of the Council of 20 March 2006, and Article 13 of Regulation (EU) No 1152/2012 of the European Parliament and of the Council of 21 November 2012.

5°/ a designation of origin is protected against any practice that is likely to mislead the consumer as to the true origin of the product. Consequently, it limits itself on the one hand to the characteristics stated by the Syndicat that concern a historical tradition and are not founded on investments made by the Syndicat and its members. On the other hand, the "Montboissié" cheese marketed since 2007 by Fromagère du Livradois was different from "Morbier" cheese, and it did not investigate, as it was requested to do, if the practices of Fromagère du Livradois (copy of the "line of ashes" that is a characteristic of Morbier cheese and the other characteristics of the cheese, specifically) were not likely to deceive the consumer as to the true origin of the product. In so ruling, the cour d'appel (Court of Appeal) departed from the legal basis under Article 13 of Regulation (EC) No 510/2006 of 20 March 2006 and Article 13 of Regulation (EU) No 1152/2012 of the European Parliament and of the Council of 21 November 2012."

Court's response

In view of Article 13, paragraph 1 of Regulation (EC) No 510/2006 of the Council, of 20 March 2006, on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, and Regulation (EU) No 1152/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs :

14. Under these texts, "Registered names shall be protected against :

- a) any direct or indirect commercial use of a registered name 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 in so far 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 consumer as to the true origin of the product. "

15. In response to the aforementioned question referred for a preliminary ruling, the CJEU, after holding that the AOPs are protected as they designate a product that has certain qualities or characteristics and that the AOP and the product covered are closely linked (point 37) ruled that :

"Article 13 (1), of Council Regulation (EC) No 510/2006 of the Council, of 20 March 2006, on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, and Article 13 (1) of Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs, must be interpreted as meaning that they do not prohibit solely the use by a third party of a registered name.

Articles 13 (1) (d), of Regulation No 510/2006 and Article 13 (1) (d) of Regulation No 1151/2012 must be interpreted as prohibiting the reproduction of the shape or appearance characterising a product covered by a registered name where that reproduction is liable to lead the consumer to believe that the product in question is covered by that registered name. It is necessary to assess whether such reproduction may mislead the European consumer, who is normally informed and reasonably observant and circumspect, taking into account all relevant factors in the case."

16. To dismiss the requests of the Syndicat, the ruling holds that the AOP legislation does not aim to protect the appearance of a product or its features as described in the specifications, but its name, so that it does not prohibit a

product being made using the same techniques as those set out in the standards applicable to the geographical indication, and that in absence of an exclusive right, reproducing the appearance of a product is not a misconduct, and falls within the scope of freedom of trade and free competition. The court stated that the features relied on by the Syndicat relate to a historical tradition and implemented by Fromagère du Livradois in 1979, even before the AOP "Morbier" was obtained, and that they are not built on features developed by the Syndicat or its members. Moreover the court stated that the blue horizontal line is an ancestral technique that can be found in other cheeses. It holds that the two cheeses could not be likened as a result of the use of vegetable carbon as several years ago. Fromagère du Livradois replaced it with grape polyphenol and that there are other differences, relating, inter alia, to the use of pasteurised milk in the Montboissié cheese and raw milk in the Morbier cheese, an essential feature considering that the Montboissié cheeses intended for consumption in canteens and hospital. It deduced that the Syndicat was seeking to extend the protection of the AOP "Morbier" for commercial interests, which was unlawful and contrary to the principle of free competition.

17. In so ruling, while a AOP is not solely protected against the use by a third party of the registered name, but also against the reproduction of the shape or the appearance characterising a product covered by the registered name where that reproduction is liable to lead the consumer to believe that the product in question is covered by that registered name, the cour d'appel (Court of Appeal), which did not investigate whether the blue horizontal line constituted a referential characteristic that was unique to the "Morbier" cheese and, if whether, its reproduction, combined with all of the relevant factors in the case, was not liable to mislead the consumer as to the true origin of the product being marketed under the name "Montboissié", deprived its decision of a legal basis.

On the first part of the second plea,

Statement of plea

18. The Syndicat criticises the ruling for ordering it to pay a certain sum to Fromagère du Livradois for abusive proceedings, where "a litigant cannot be ordered to pay compensation for abusive proceedings when his claims were founded. The previous plea demonstrated that the claims of the Syndicat interprofessionnel de défense du fromage Morbier were wrongly dismissed. Consequently, the quashing intervening based on the former justifies the quashing of the decision of the ruling being appealed by the present plea, by application of Article 624 of the Civil Procedure Code."

Court's response

In view of Article 624 of the Civil Procedure Code :

19. According to this text, the scope of the quashing extends to all of the provisions of the ruling being quashed that have a link of indivisibility or necessary dependence.

20. The quashing pronounced on the first plea leads to the consequential quashing on account of the operative part of the ruling related to the claim for compensation for abusive proceedings, which is connected by a link of necessary dependence.

**ON THESE GROUNDS, and without it being necessary to rule on the other pleas,
the Court :**

QUASHES AND SETS ASIDE, except where, according to the ruling, it sets aside the three sets of proceedings carried out on 5 March 2013 in Fournols, Tauves, and Allanches by the court bailiff as part of decisions in ex parte proceedings obtained based on Article 145 of the Civil Procedure Code, the ruling of 16 June 2017, between the parties, by the cour d'appel (Court of Appeal) of Paris ;

RETURNS, except on these points, the case and the parties to the status existing prior to the said ruling and refers them to the cour d'appel (Court of Appeal) of Paris, otherwise composed ;

ORDERS Fromagère du Livradois to pay the costs ;

Pursuant to Article 700 of the Civil Procedure Code, dismisses the request formulated by Fromagère du Livradois and orders it to pay the sum of 3,000 euros to the Syndicat interprofessionnel de défense du fromage Morbier ;

President : Mrs Mouillard,

Reporting Judge : Mrs Lebras, Judge Referee

Advocate-General : Mr Debacq

Lawyer(s) : SCP Gatineau, Fattaccini et Rebeyrol – SCP Piwnica et Molinié

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Translated rulings

concurrence déloyale ou illicite