

JUDGMENT OF THE GENERAL COURT (Second Chamber)

24 September 2025 (*)

(EU trade mark – Invalidity proceedings – EU word mark PriSecco – Earlier PDO ‘Prosecco’ – Relative ground for invalidity – Article 8(4) and Article 53(1)(c) of Regulation (EC) No 207/2009 – Article 103(2)(b) of Regulation (EU) No 1308/2013 – Concept of ‘evocation’ of a PDO)

In Case T-406/24,

Manufaktur Jörg Geiger GmbH, established in Schlat (Germany), represented by W. Heisrath, F. Dehn and C. Kleiner, lawyers,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by D. Gája, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO, intervener before the General Court, being

Consorzio di Tutela della Denominazione di Origine Controllata ‘Prosecco’, established in Treviso (Italy), represented by M. Mostardini, G. Galimberti, R. Tardiolo, C. Andreotta and F. Fili, lawyers,

THE GENERAL COURT (Second Chamber),

composed, at the time of the deliberations, of A. Marcoulli, President, J. Schwarcz (Rapporteur) and L. Spangsberg Grønfeldt, Judges,

Registrar: V. Di Bucci,

having regard to the written part of the procedure,

having regard to the fact that no request for a hearing was submitted by the parties within three weeks after service of notification of the close of the written part of the procedure, and having decided to rule on the action without an oral part of the procedure, pursuant to Article 106(3) of the Rules of Procedure of the General Court,

gives the following

Judgment

- 1 By its action under Article 263 TFEU, the applicant, Manufaktur Jörg Geiger GmbH, seeks the annulment and, in essence, the alteration of the decision of the Fifth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 30 May 2024 (Case R 1454/2022-5) (‘the contested decision’).

Background to the dispute

- 2 On 3 September 2020, the intervener, Consorzio di Tutela della Denominazione di Origine Controllata ‘Prosecco’, filed an application for a declaration of invalidity with EUIPO in respect of the EU trade

mark which had been registered following an application filed by the applicant on 9 June 2015 for the word sign PriSecco.

- 3 The goods covered by the contested mark in respect of which a declaration of invalidity was sought were in Class 32 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and corresponded to the following description: ‘Cocktails, non-alcoholic’.
- 4 The application for a declaration of invalidity was based on the designation of origin No PDO-IT-A0516 for the name ‘Prosecco’, protected in the European Union for wine since 1 August 2009 pursuant to Article 107 of Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013 establishing a common organisation of the markets in agricultural products and repealing Council Regulations (EEC) No 922/72, (EEC) No 234/79, (EC) No 1037/2001 and (EC) No 1234/2007 (OJ 2013 L 347, p. 671) (‘the PDO Prosecco’).
- 5 The grounds relied on in support of the application for a declaration of invalidity were those referred to in Article 59(1)(a) in conjunction with Article 7(1)(g) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1), and that referred to in the combined provisions of Article 60(1)(d) and Article 8(6) of that regulation.
- 6 On 8 June 2022, the Cancellation Division declared the contested mark invalid for all the goods covered by it on the basis of the combined provisions of Article 60(1)(d) and Article 8(6) of Regulation 2017/1001.
- 7 On 4 August 2022, the applicant filed a notice of appeal with EUIPO against the Cancellation Division’s decision.
- 8 By the contested decision, the Board of Appeal dismissed the appeal. First of all, it accepted the applicant’s request that the list of goods covered by the contested mark be limited to ‘non-alcoholic cocktails whose ingredients are apple and or pear juices based on meadow fruit varieties’. It also noted that, given the date on which the application for registration of the contested mark was filed, the facts of the case were governed by the substantive provisions of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1). Next, pursuant to Article 53(1)(c) and Article 8(4) of that regulation, it found that the documents produced by the intervener showed that the PDO Prosecco had been used in the course of trade and was of more than mere local significance ‘well before’ the date of the application for registration of the contested mark. It also noted that the PDO Prosecco had been registered since 1 August 2009 and that it therefore enjoyed protection on that basis. Lastly, it found that, in the mind of the average European consumer throughout the European Union, the contested mark evoked the PDO Prosecco, within the meaning of Article 103(2)(b) of Regulation No 1308/2013, with the result that the application for a declaration of invalidity had to be upheld.

Forms of order sought

- 9 The applicant claims, in essence, that the Court should:
 - annul the contested decision;
 - alter that decision by rejecting the application for a declaration of invalidity;
 - order EUIPO to pay the costs, including those incurred before the Board of Appeal.
- 10 EUIPO contends that the Court should:
 - dismiss the action;
 - order the applicant to pay the costs incurred by EUIPO in the event that an oral hearing is convened.

- 11 The intervener contends, in essence, that the Court should:
- dismiss the action;
 - order the applicant to pay the costs incurred by the intervener in connection with the proceedings before the Court and the proceedings before EUIPO.

Law

- 12 The applicant relies, in essence, on two pleas in law. The first alleges infringement of Article 53(1)(c) in conjunction with Article 8(4) of Regulation No 207/2009 and the second alleges infringement of Article 103(2) of Regulation No 1308/2013.

The first plea in law, alleging infringement of Article 53(1)(c) in conjunction with Article 8(4) of Regulation No 207/2009

- 13 By its first plea in law, the applicant raises three complaints.
- 14 First, it observes that the Board of Appeal correctly pointed out that neither Article 53(1)(d) of Regulation No 207/2009 nor Regulation 2017/1001 were intended to apply in the present case and that, consequently, only the combined provisions of Article 53(1)(c) and Article 8(4) of Regulation No 207/2009 could constitute the legal basis for the application for a declaration of invalidity of the contested mark. The applicant states that Article 53(1)(d) of Regulation No 207/2009, which expressly refers to designations of origin, was added to that regulation by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Regulation No 207/2009 and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OJ 2015 L 341, p. 21). It infers from this that the absence of any reference to such designations in Article 53(1)(c) of Regulation No 207/2009 precluded the Board of Appeal from basing the invalidity of the contested mark on the PDO Prosecco.
- 15 EUIPO and the intervener dispute the applicant's arguments.
- 16 Given the date on which the application for registration at issue was filed, 9 June 2015, which is decisive for the purposes of identifying the applicable substantive law, the facts of the case are governed by the substantive provisions of Regulation No 207/2009, before it was amended by Regulation 2015/2424 (see, to that effect, order of 5 October 2004, *Alcon v OHIM*, C-192/03 P, EU:C:2004:587, paragraphs 39 and 40, and judgment of 21 December 2022, *Puma v EUIPO – DN Solutions (PUMA)*, T-4/22, not published, EU:T:2022:850, paragraph 14 and the case-law cited).
- 17 Therefore, as the applicant acknowledges, the Board of Appeal was right, in the present case, to find that the combined provisions of Article 53(1)(c) and Article 8(4) of Regulation No 207/2009 were applicable *ratione temporis*.
- 18 In addition, it should be pointed out that, pursuant to Article 53(1)(c) of Regulation No 207/2009, an EU trade mark is to be declared invalid, on application to EUIPO, where there is an earlier right as referred to in Article 8(4) of that regulation and the conditions set out in that paragraph are fulfilled.
- 19 Under Article 8(4) of Regulation No 207/2009, the proprietor of a sign other than a registered trade mark may oppose the registration of an EU trade mark if that sign fulfils four cumulative conditions. First, the sign must be used in the course of trade. Second, it must be of more than mere local significance. Third, the right to that sign must have been acquired in accordance with the law of the European Union or of the Member State governing that sign prior to the date of application for registration of the EU trade mark. Fourth, and lastly, the sign must confer on its proprietor the right to prohibit the use of a subsequent trade mark.

- 20 Designations of origin are used in the marketing of various goods and may therefore constitute signs used in the course of trade within the meaning of Article 8(4) of Regulation No 207/2009. They enjoy, in particular in the wine sector under Article 103 of Regulation No 1308/2013, protection enabling their proprietor, under certain conditions, to prohibit the use of a subsequent trade mark. Therefore, as EUIPO observes, designations of origin could fall within the concept of ‘earlier right’ for the purposes of Article 8(4) of Regulation No 207/2009, before that regulation was amended by Regulation 2015/2424 and an explicit reference to such designations was added in new provisions, namely Article 53(1)(d) and Article 8(4a) of Regulation No 207/2009. Moreover, it was on the basis of Article 8(4) of Regulation No 207/2009 that the Courts of the European Union accepted that names registered as designations of origin or geographical indications could be relied on as an earlier right (see, to that effect, judgments of 18 September 2015, *Federación Nacional de Cafeteros de Colombia v OHIM – Accelerate (COLOMBIANO COFFEE HOUSE)*, T-359/14, not published, EU:T:2015:651, paragraphs 23 to 25, and of 14 December 2017, *Consejo Regulador ‘Torta del Casar’ v EUIPO – Consejo Regulador ‘Queso de La Serena’ (QUESO Y TORTA DE LA SERENA)*, T-828/16, not published, EU:T:2017:918, paragraphs 18 to 20).
- 21 It should also be noted, as observed by EUIPO, that the possibility of including designations of origin in the concept of ‘earlier right’ for the purposes of Article 8(4) of Regulation No 207/2009, before that regulation was amended by Regulation 2015/2424, is confirmed by recital 11 of that regulation, according to which ‘in order to maintain strong protection of rights in designations of origin and geographical indications protected at Union and national levels, it is necessary to clarify that those rights entitle any person authorised under the relevant law to oppose a later application for the registration of an EU trade mark ...’. It follows from that recital that the adoption of the new provisions of Article 53(1)(d) and Article 8(4a) of Regulation No 207/2009 was not intended to create new rights associated with protected designations of origin at EU and national level, but to clarify the scope of existing rights with the aim of maintaining the strong protection of those designations.
- 22 Consequently, the first complaint put forward by the applicant, alleging that Article 53(1)(c) of Regulation No 207/2009 cannot constitute the legal basis of the contested decision, must be rejected as unfounded.
- 23 Second, the applicant claims that the PDO Prosecco, which was registered on 1 August 2009, does not predate the contested mark because that mark enjoys the seniority of a German word mark PriSecco, of which it is the proprietor and which was registered on 20 April 2008.
- 24 EUIPO and the intervener contend that that complaint is unfounded.
- 25 In that regard, it is sufficient to state that the registration of the contested mark was applied for on 9 June 2015, therefore after registration of the PDO Prosecco in 2009, with the result that the PDO Prosecco predates that mark.
- 26 The applicant cannot plead seniority of a national trade mark PriSecco in order to prevent the consequences of the protection of the PDO Prosecco. Although Article 8(4) of Regulation No 207/2009 requires that the earlier right must have been acquired prior to the date of application for registration of the EU trade mark, or the date of the priority claimed for that application, it does not, however, make any reference to seniority. Furthermore, according to the wording of Article 34(2) of Regulation No 207/2009, that seniority has the sole effect that, where the proprietor of the EU trade mark surrenders the earlier trade mark or allows it to lapse, he, she or it is to be deemed to continue to have the same rights as he, she or it would have had if the earlier mark had continued to be registered.
- 27 It follows from the foregoing considerations that, in the present case, the seniority of the applicant’s German trade mark PriSecco affects only the question whether the applicant may continue to enjoy the rights attached to that national mark, without that question having any impact on the present action, which concerns an application for a declaration of invalidity directed against the contested mark, the filing of which is subsequent to the date of registration of the PDO Prosecco.
- 28 Consequently, the second complaint made by the applicant under the first plea must also be rejected.
- 29 Third, the applicant submits that the Board of Appeal erred in finding that the PDO Prosecco was of more than mere local significance. It claims that the popularity of the name ‘Prosecco’ was acquired with

regard to a grape variety rather than with regard to a wine originating from a determined region in Italy. In that regard, it refers to Commission Regulation (EC) No 1166/2009 of 30 November 2009 amending and correcting Commission Regulation (EC) No 606/2009 laying down certain detailed rules for implementing Council Regulation (EC) No 479/2008 as regards the categories of grapevine products, oenological practices and the applicable restrictions (OJ 2009 L 314, p. 27), which, in its view, shows that the name 'Prosecco' originally designated a grape variety and not a wine originating from such a region. The supra-regional meaning of that name still applies to that grape variety.

30 EUIPO and the intervener contend that that complaint is also unfounded.

31 It must be stated, as did the Board of Appeal, that it is apparent from numerous items of evidence in the administrative file that the PDO Prosecco has more than mere local significance. On the contrary, the evidence shows that it protects a wine which, both before and after the date on which the contested mark was filed, was sold in large quantities worldwide. The intervener submitted to EUIPO, inter alia, brochures containing statistics according to which several hundred millions of bottles of wine protected by the PDO Prosecco are sold each year worldwide. According to other statistics in the file, two thirds of the production of that wine are exported from Italy, which is the country where the producing region is located. The evidence submitted by the intervener also includes publications in various media showing the global scale of the promotion and sales of wine protected by the PDO Prosecco.

32 The applicant's argument that the supra-regional meaning of the name 'Prosecco' is still based on the former name of the grape variety rather than on the name of the wine originating from a determined region in Italy cannot succeed. In essence, that argument concerns the way in which the significance of the name 'Prosecco' was, according to the applicant, acquired, and the applicant does not dispute the fact that that name is of more than mere local significance.

33 It follows that the third complaint put forward by the applicant under the first plea must also be rejected and that that plea in law must be dismissed in its entirety.

The second plea in law, alleging infringement of Article 103(2) of Regulation No 1308/2013

34 By its second plea in law, the applicant submits that the contested mark does not evoke the PDO Prosecco within the meaning of Article 103(2)(b) of Regulation No 1308/2013 and that the latter cannot therefore preclude registration of that mark. As a preliminary point, it disputes the principle that the Board of Appeal applied in the present case, which, according to the applicant, amounts to considering that there may be an evocation even if the goods at issue are different. It submits that the Board of Appeal thus incorrectly made the PDO Prosecco a trade mark with a reputation and that that was not the intention of the legislature in relation to protected designations. Next, it claims, referring to the average European consumer who, in its view, is very observant as regards the distinction between alcoholic beverages and non-alcoholic beverages, that the goods at issue are different and that the signs at issue are sufficiently different visually, phonetically and conceptually, which prevents any evocation of the PDO Prosecco by the contested mark. Lastly, it addresses the issue, not examined by the Board of Appeal, of any direct or indirect commercial use of the PDO Prosecco within the meaning of Article 103(2)(a) of Regulation No 1308/2013.

35 EUIPO and the intervener dispute the applicant's line of argument.

36 In the present case, the Board of Appeal found that there was a high likelihood that, for a substantial proportion of European consumers seeing the sign PriSecco in connection with the non-alcoholic cocktails at issue, the image triggered directly in his or her mind would be that of the wine protected by the PDO Prosecco. According to the Board of Appeal, the similarity between the signs at issue is of such a high degree that it is likely that the sign PriSecco will even be perceived simply as a misspelling of the sign Prosecco. The Board of Appeal therefore concluded that the contested mark evoked the PDO Prosecco within the meaning of Article 103(2)(b) of Regulation No 1308/2013 and that the application for a declaration of invalidity had to be upheld.

37 Article 103(2) of Regulation No 1308/2013 provides as follows:

‘A protected designation of origin and a protected geographical indication, as well as the wine using that protected name in conformity with the product specifications, shall be protected against:

...

- (b) any misuse, imitation or evocation, even if the true origin of the product or service is indicated or if the protected name is translated, transcribed or transliterated or accompanied by an expression such as “style”, “type”, “method”, “as produced in”, “imitation”, “flavour”, “like” or similar;

...’

38 It should be borne in mind, first of all, that the conduct which falls within the scope of Article 103(2)(b) of Regulation No 1308/2013 does not use the protected name itself, either directly or indirectly, but suggests it in such a way that it causes the consumer to establish a sufficiently close connection with that name (see, to that effect, judgment of 9 September 2021, *Comité Interprofessionnel du Vin de Champagne*, C-783/19, EU:C:2021:713, paragraph 39 and the case-law cited).

39 The Court of Justice has stated that the connection between the contested sign and the product which has a protected name must be sufficiently clear and direct, and therefore a mere association with the protected designation of origin or the geographical zone relating thereto cannot be used (see, by analogy, judgments of 21 January 2016, *Viiniverla*, C-75/15, EU:C:2016:35, paragraph 22, and of 7 June 2018, *Scotch Whisky Association*, C-44/17, EU:C:2018:415, paragraph 53).

40 In that context, it has been noted in the case-law that the concept of ‘evocation’ covers a situation in which the term used to designate a product incorporates part of a protected designation, so that when the consumer is confronted with the name of the product, the image triggered in his or her mind is that of the product whose designation is protected (see judgment of 14 September 2017, *EUIPO v Instituto dos Vinhos do Douro e do Porto*, C-56/16 P, EU:C:2017:693, paragraph 122 and the case-law cited).

41 Furthermore, there may be an evocation of a protected designation of origin where, concerning products which are similar in appearance, the protected designation of origin and the contested sign are phonetically and visually similar (see, to that effect, judgment of 9 September 2021, *Comité Interprofessionnel du Vin de Champagne*, C-783/19, EU:C:2021:713, paragraph 56 and the case-law cited).

42 In assessing the risk of evocation, account must be taken of all the relevant factors surrounding the use of the sign against which a protected designation of origin is invoked (see, by analogy, judgment of 4 October 2024, *Consortium des Charcutiers Corses*, C-579/23 P, EU:C:2024:832, paragraph 80 and the case-law cited).

43 It follows from the foregoing that, in order to establish evocation within the meaning of Article 103(2)(b) of Regulation No 1308/2013, the Board of Appeal was entitled to find, in paragraph 73 of the contested decision, that the decisive criterion was whether, when the consumer was confronted with the contested mark PriSecco, the image triggered directly in his or her mind was that of the goods covered by the PDO Prosecco.

44 In that regard, the Board of Appeal observed that, visually, the word signs at issue both consisted of eight letters and that seven of those letters were identical, moreover in the same order. It found that those signs were fairly long and that, therefore, the only different letter, the third, would probably go unnoticed. It concluded that they were visually highly similar. Following similar reasoning to that carried out for the purposes of the visual comparison, it found that the signs at issue were phonetically highly similar. In addition, it found that, at least from the point of view of a non-negligible part of the relevant public in the European Union, there was no conceptual difference between the signs at issue. The Board of Appeal thus concluded that the signs at issue were overall similar to a high degree.

45 It should be noted that the contested sign PriSecco contains, in the same order, the same letters as the name protected by the PDO Prosecco, with the exception of the third letter, which is an ‘i’ instead of an ‘o’. It follows that the PDO Prosecco is almost completely embedded in the contested sign. That

incorporation forms part of the high degree of visual and phonetic similarity between the signs at issue, correctly found by the Board of Appeal.

46 The Board of Appeal was also correct to reject the comparison of the signs at issue proposed by the applicant, according to which the component ‘secco’ could be perceived differently in the contested sign, on account of the capital letter ‘S’, and is purely descriptive as regards the Italian designation for drinks with a low sugar content, with the result that there is a clear difference between the prefixes ‘pri’ and ‘pro’. It should be noted that, according to settled case-law, a word mark is a mark consisting entirely of letters, of words or of associations of words, written in printed characters in normal font, without any specific graphic element. Consequently, the protection which results from registration of a word mark concerns the word mentioned in the application for registration and not the specific graphic or stylistic elements accompanying that mark (see, to that effect, judgment of 31 January 2018, *Weber-Stephen Products v EUIPO (iGrill)*, T-35/17, not published, EU:T:2018:46, paragraph 29 and the case-law cited). Therefore, the fact that the letter ‘s’ of the contested sign is written in upper case cannot be taken into consideration, which makes it unlikely that the element ‘secco’ will be perceived separately.

47 In addition, the Board of Appeal found that there was a notable proximity between the wines covered by the PDO Prosecco and the non-alcoholic cocktails covered by the contested mark, on account of their consumption and marketing patterns. As regards the way in which the goods at issue are consumed, it noted that those two categories of beverages were both commonly consumed in society, in particular as aperitifs or accompanying dishes served during meals. It pointed out that non-alcoholic beverages were increasingly consumed in an equivalent manner to alcoholic beverages. As regards the way in which the goods at issue were marketed and distributed, the Board of Appeal stated that they were displayed side by side in the food sections of supermarkets and in bars and cafés.

48 In that regard, even assuming that the goods at issue are not similar, as the applicant submits, it must be pointed out that it is possible to find an ‘evocation’ within the meaning of Article 103(2)(b) of Regulation No 1308/2013 even where there is no similarity between the goods concerned (judgment of 9 September 2021, *Comité Interprofessionnel du Vin de Champagne*, C-783/19, EU:C:2021:713, paragraph 61). In the circumstances of the present case, given the fact that the goods at issue are beverages, with the result that they may have a similar appearance, the partial incorporation of the PDO Prosecco in the contested mark and their high degree of visual and phonetic similarity are sufficient, in accordance with the case-law cited in paragraphs 38 to 42 above, to justify a finding of evocation.

49 Since the Board of Appeal thus correctly applied the criteria for finding an evocation, nor can the applicant claim that the contested decision is based on the fact that the PDO Prosecco is a trade mark with a reputation.

50 Regarding, lastly, the applicant’s argument alleging the incorrect application of the concept of ‘commercial use’ within the meaning of Article 103(2)(a) of Regulation No 1308/2013, it must also be rejected, since that issue was not raised before the Board of Appeal and EUIPO is under no obligation to examine it of its own motion. Addressing that issue at the stage of the present action would amount to changing the subject matter of the dispute, which is contrary to the case-law (see, to that effect, order of 29 November 2011, *Tresplain Investments v OHIM*, C-76/11 P, not published, EU:C:2011:790, paragraphs 63 and 64) and to Article 188 of the Rules of Procedure of the General Court, according to which ‘the pleadings lodged by the parties in proceedings before the General Court may not change the subject matter of the proceedings before the Board of Appeal.’

51 Accordingly, the second plea in law must be rejected as being in part inadmissible and in part unfounded.

52 Since none of the pleas in law has been upheld, the action must be dismissed in its entirety.

Costs

53 Under Article 134(1) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party’s pleadings.

- 54 In the present case, although the applicant has been unsuccessful, EUIPO has applied for the applicant to be ordered to pay the costs only in the event that a hearing is convened. Since no hearing has been organised, it is appropriate to order EUIPO to bear its own costs.
- 55 Since the intervener has claimed that the applicant should be ordered to pay the costs relating to the proceedings before the Court, the applicant must be ordered to bear its own costs and to pay those incurred by the intervener in the present action.
- 56 Finally, as regards the intervener's request that the applicant be ordered to pay the costs relating to the proceedings before EUIPO, it is sufficient to note that the present judgment dismisses the action brought against the contested decision and that, therefore, it is the operative part of that decision which continues to govern the costs at issue (see, to that effect, judgment of 28 April 2021, *Comercializadora Eloro v EUIPO – Zumex Group (JUMEX)*, T-310/20, not published, EU:T:2021:227, paragraph 45).

On those grounds,

THE GENERAL COURT (Second Chamber)

hereby:

1. **Dismisses the action;**
2. **Orders Manufaktur Jörg Geiger GmbH to bear its own costs and to pay those incurred by Consorzio di Tutela della Denominazione di Origine Controllata 'Prosecco';**
3. **Orders the European Union Intellectual Property Office (EUIPO) to bear its own costs.**

Marcoulli

Schwarcz

Spangsberg Grønfeldt

Delivered in open court in Luxembourg on 24 September 2025.

V. Di Bucci

S. Papasavvas

Registrar

President

* Language of the case: English.