



European Union Intellectual Property Office (EUIPO)  
Avenida de Europa, 4  
E-03008 Alicante  
SPAIN

Brussels, 09/02/2018

**Subject : Observations regarding the application to register the word “Emmentaler” as a trademark**

To whom it may concern:

With the present letter, Eucolait would like to comment on the planned registration of the word “Emmentaler” as an EU trade mark, a possibility provided for in article 45 (1) of regulation 2017/1001 on the EU trade mark. We strongly believe that the application has to be refused *ex officio*. In our view, there are two absolute grounds for refusal preventing the registration of “Emmentaler”: Emmental(er) is a generic name and there are geographical indications registered under 1151/2012 containing the name Emmental(er).

**Emmental(er) is a generic name**

Article 7 (1) (d) of regulation 2017/1001 prevents the registration of trademarks “*which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.*” Emmental is a type of cheese and the name is considered as generic in the EU and globally. Several facts support this view.

Emmental is one of the cheese types for which a Codex Standard has been adopted (CODEX STAN 296-1967). The existence of a codex standard implies that the cheese can be manufactured anywhere in the world as long as the composition and other requirements laid down in the standard are complied with. By no means is production restricted to a certain geographical area. Point 7.2 of the standard states that the country of origin (which means the country of manufacture, **not the country in which the name originated**) shall be declared. While the existence of a Codex Standard and the clause regarding the declaration of origin may not constitute sufficient proof for the generic nature of the name, it does indicate Emmental is a widely produced and traded cheese variety.

Because Emmental is considered a generic name in the EU, it was also excluded from the EU-Swiss agreement on geographical indications concluded in 2009 and in force since 2012, despite pressure from the Emmentaler Switzerland Consortium to reserve the use of the term for the Swiss “AOP” only. The benefits of excluding Emmental from this agreement, which was clearly in the interest of European producers, would be made redundant if the Emmentaler Switzerland Consortium were to be granted a monopoly on the use of the name via a registration as a word mark.

Furthermore, the judgement of the European Court of Justice in case C-448/98 suggests that Emmental is a type of cheese. In this case, the Court ruled that a national (French) rule prohibiting the marketing

of a cheese without rind under the designation “Emmenthal” was incompatible with the free movement of goods, where the cheese in question had been lawfully produced and marketed under that name in another Member State. The judgement also makes reference to the judgement of the French Tribunal referring the case to the ECJ which stated that *“the variation between different national rules and, in particular, the restrictive position adopted in the French regulations as compared with those of other European countries is capable of hindering, directly or indirectly, actually or potentially, intra-Community trade, while no right to protection of **the generic name 'Emmenthal'** is recognised by Community legislation”* (paragraph 10 of the judgement). Moreover, the Court states in paragraph 32 that *“it is undisputed that such an **'Emmenthal'** cheese variant is lawfully manufactured and marketed in Member States other than the French Republic”*.

Emmental is also one of the 4 cheese types (along with Gouda, Edam and Cheddar) for which weekly EU price quotations are published, based on prices recorded in several EU Member States. On the website of the milk market observatory which is under the responsibility of the European Commission Directorate General for Agriculture, it is listed under “EU prices for dairy commodities” which is a further indication of its generic nature.

Most production of Emmental cheese takes place outside Switzerland. In France and Germany alone, it amounts to some 385 000 tonnes yearly. Austria and Finland are also large producers of Emmental, bringing the total EU production to at least 415 000 tonnes per year (some producing Member States not included due to lack of data). This compares with 17 000 tonnes of the Swiss AOP Emmentaler produced yearly, implying that Switzerland would account for about 4% of Emmental production. Emmental cheese is traded in large quantities between EU Member States (for instance Germany exported 80 000 tonnes of Emmentaler in 2016) and considerable volumes are also being exported out of the EU (almost 17 000 tonnes in 2016). Please refer to the annex for more details.

### **Existence of prior geographical indications**

According to article 7 (j) of regulation 2017/1001, trade marks shall not be registered if they are excluded from registration pursuant to, among others, EU legislation on geographical indications. The now repealed trademark regulation 207/2009 was even more explicit: its article 7(k) prevented the registration of trade marks which contain or consist of a designation of origin or a geographical indication.

Regulation 1151/2012 on quality schemes for agricultural products and foodstuffs protects designations of origin and geographical indications against any misuse, imitation or other misleading practices (art.13 (1)) and stipulates in its article 14 that any trademarks violating the protection granted to registered names shall be refused or, if already registered, invalidated. Three geographical indications containing the name “Emmental(er)” are registered under regulation 1151/2012: “Allgäuer Emmentaler” (PDO), Emmental de Savoie (PGI) and “Emmental Est-Central” (PGI).

Concerning the protection of compound designations, we refer to the legal statement of the EU Commission mentioned in the ECJ Judgement of February 26, 2008 (C-132/05 Parmesan) where it is stated in paragraphs 20 and 21:



*“The Commission claims that the system of Community protection is underpinned by the principle that the registration of a designation containing several terms confers the protection of Community law both on the constituent elements of the compound designation and on the designation as a whole. The effective protection of compound designations therefore implies that, in principle, all the constituent elements of a compound designation are protected against abuse. The Commission is of the opinion that, in order to guarantee such protection, Regulation No 2081/92 does not require registration of every element of a compound designation intended to be protected, but assumes that each element enjoys intrinsic protection. That interpretation was confirmed by the Court in Joined Cases C129/97 and C-130/97 Chiciak and Fol [1998] ECR I-3315.*

*The Commission argues that the principle of the protection of all the constituent elements of a compound designation is subject to only one exception, provided for in the second indent of Article 13(1) of Regulation No 2081/92, whereby the use of a single element of a compound designation is not regarded as an infringement of Article 13(1)(a) and (b) of the regulation if the element concerned is the name of an agricultural product or of a foodstuff which is considered to be generic. That provision would be superfluous if the various constituent elements of designations registered exclusively in the form of compound designations were to be considered as not enjoying any protection.”*

This means that even if the term Emmental(er) were not considered generic, it could still not be registered as a trademark as it would enjoy protection under the regulation on quality schemes. Because of the protection of the constituent elements of a compound designation, the registration of the sole word Emmentaler as a trade mark would clearly violate the rights granted to the three EU geographical indications containing the word Emmental(er). The word mark would benefit from the reputation of these products on the EU market. Consumers could easily confuse the trade mark with the already protected designation of origin and geographical indications.

In light of these arguments, the registration of the word Emmentaler as a trade mark should be refused. Such registration would be contrary to EU law and would cause serious damage to producers of generic Emmental cheese across the EU, while producers of the aforementioned geographical indications would be affected as well. The motivation behind this application is to circumvent the EU rules on quality schemes, as it is obvious that (Swiss) Emmentaler could not be granted protection as a designation of origin on the EU market. We kindly ask the Intellectual Property Office to take the necessary steps to refuse the application.

We remain at your disposal for any further information.

Yours sincerely,

Jukka Likitalo

Secretary General



Annexes:

Annex 1: Codex Standard for Emmental

Annex 2: Production and trade statistics of Emmental Cheese

Annex 3: EU Emmental price quotations (pages 2 and 5 of the annex)

Annex 4: ECJ Judgement C-448/98 “Emmenthal”

Annex 5: ECJ judgement C-132/05 “Parmesan”