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## **Evoking the British law on extended passing off to restore balance to European geographical indications protection**

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### **Abstract**

The scope of protection for geographical indications in the EU has expanded too far, particularly in evocation cases. Scholars and stakeholders have raised alarm about the need for measures that would ensure balance in the geographical indications system. This article uses empirical data to report how the expanded scope of protection has restricted the commercial practices of third parties and illustrate the practical implications of the principled concerns raised in the intellectual property literature. In addressing these concerns, this article demonstrates that commentators have overlooked a potential source of inspiration that could offer a more principled approach to the protection of quality products: the British law of extended passing off and, more generally, unfair competition by misrepresentation. By rebalancing geographical indications protection to reflect consumer perception, this article argues that a high level of protection for quality products can be achieved without straying into unjustified and unfair levels of protection.

**Keywords:** Geographical Indications; Extended Passing Off; Evocation; Unfair Competition

## 1. Introduction

Geographical indications (GIs) are the intellectual property (IP) right that protects the names of goods exclusively or essentially linked to a given place based on specific qualitative, reputational, or other characteristics.<sup>1</sup> The European Union (EU) is known for being the region that invests the most on this IP right, promoting it as a tool to protect the producers of high-quality place-specific products (such as Champagne wine and Kalamata olives), fostering sustainability in the area of food production, preserving traditional livelihoods and gastronomic heritage, and sustaining the rural economy.<sup>2</sup> The EU GI system traditionally protects agricultural products, wines, spirits, and it has been recently extended to include non-agricultural subject matter, which may encompass products like Donegal tweed or Murano glass. EU rules still constitute the core of GI protection in the UK, which has essentially retained the pre-Brexit regime; however, it has not extended it to protect non-agricultural products.

Overall, the EU GI system has proven successful, providing protection to 3,680 names today, generating a sales value of approximately EUR 1.1 billion.<sup>3</sup> In spite of this, the evolution of the system over the past twenty-five years has proven problematic. In particular, EU case law has gradually expanded the scope of GI protection to a degree that has raised alarm from scholars and stakeholders alike, who have voiced concerns about the need to safeguard undistorted competition, freedom of expression, and other fundamental rights.<sup>4</sup> Particular concern is raised by the concept of 'evocation' which, as it will be

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<sup>1</sup> For the international definition of 'Geographical Indication', see Art. 22(1) TRIPS.

<sup>2</sup> For an updated view on the functions and current status of EU GIs, see the contributions in Zappalaglio and Bonadio 2025.

<sup>3</sup> For the EU register see, European Commission, 'eAmbrosia: Union register of Geographical Indications' <<https://ec.europa.eu/agriculture/eambrosia/geographical-indications-register/>>; similarly, the UK register lists 4,242 as it includes the products protected in the country through bilateral agreements. See, Department for Environment, Food and Rural Affairs, 'Protected geographical food and drink names' <<https://www.gov.uk/protected-food-drink-names?register%5B%5D=foods-designated-origin-and-geographical-indication&register%5B%5D=spirit-drinks&register%5B%5D=wines&register%5B%5D=aromatised-wines&status%5B%5D=registered>>. For economic data on EU GIs, valid as of 2017, see European Commission 2020, p.16.

<sup>4</sup> Kur 2023; Zappalaglio in Bonadio and Goold 2023.

shown in detail below, has been defined by the Court of Justice of the European Union (CJEU) as an ‘image triggering’ operation that allows the GI users to act for infringement when the defendant uses not just a name, but also a visual characteristic – such as the black ash stripe in the middle of a slice of cheese – or even certain imagery that could remind a consumer of the GI product. This is the case even in the absence of likelihood of confusion or deception and without the need for the claimant to provide evidence of the well-known status of the good.

The expanding scope of protection has led to increasing calls for measures that would ensure balance in the EU GI system, such as exceptions and limitations to protection, and clarification of the interpretation of the law.<sup>5</sup> This article makes an original contribution to the debate by demonstrating that commentators have overlooked a potential source of inspiration that could offer a more principled approach to the protection of quality products: the British law of extended passing off and, more generally, unfair competition by misrepresentation.<sup>6</sup>

More specifically, the article begins with an explanation of how the protection of GIs has expanded in recent years through the case-by-case analysis of the CJEU, especially in the context of infringement by evocation, which has become increasingly abstract. The concerns about this broad scope of protection are exacerbated by the recent expansion of GI protection to craft and industrial products, whereby the potential overlaps with design and copyright law raise questions about whether this scope of protection can be justified. While scholars have raised these concerns on principle, Section 3 uses empirical data to report for the first time how the expanded scope of protection has reshaped the examination of, and opposition to, EU trade mark applications. Here, it will be demonstrated how GI protection has indeed been weaponised against honest traders, illustrating the practical implications of the principled concerns raised by other scholars. Section 4 proceeds to examine the principles and logics of protection of collective goodwill in the extended passing off cases. Section 5 demonstrates how these principles and logics could be a tool to rebalance GI protection in the EU. Applying this approach, Section 6 illustrates how the EU GI regulations could be rebalanced to reflect actual consequences in the minds of consumers, demonstrating that a high level of protection for quality products can be achieved without straying into an unjustified and unfair level of protection.

In conclusion, this article, making use of a mixed methodology that combines comparative doctrinal analysis and empirical research makes a unique contribution to the existing literature. Specifically, it demonstrates how the logic of British extended passing off, and, more generally, unfair competition by misrepresentation, can constitute a useful paradigm to lead to a more balanced reinterpretation of GI

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<sup>5</sup> Kur et al. 2023; Zafrilla Díaz-Marta and Kyrlyenko 2021.

<sup>6</sup> For a critical overview of the British unfair competition system, see Gangjee 2024; Davis 2010.

protection, and specifically of the concept of 'evocation'. Hence, this analysis provides a significant and actionable solution to the problems discussed in the leading scholarship in this field, hoping to serve as a starting point for a renewed discussion on the enforcement of this IP right without requiring a – highly unlikely – reform of the text of the relevant provisions of EU Law.

## **2. The protection of GIs in the EU: rules, case law, and concerns**

### **2.1. The grounds for infringement**

Today, the EU rules on the scope of GI protection are set out in two identical provisions: Article 26 of Regulation 2024/1143 for agricultural products, wines, and spirits, and Article 40 of Regulation 2023/2411 for non-agricultural products.<sup>7</sup> Whilst these latest regulations have never applied in the UK, the previous EU regulations on GI protection for agricultural products, wines, and spirits were transposed and continue to apply as UK law, with identical provisions on the scope of GI protection.<sup>8</sup> Article 26 of Regulation 2024/1143 provides a suitable example of the legal text:

1. Geographical indications ... shall be protected against:

(a) any direct or indirect commercial use of the geographical indication in respect of products not covered by the registration, where those products are comparable to the products registered under that name or where use of that geographical indication for any product or any service exploits, weakens, dilutes, or is detrimental to the reputation of, the protected name, including when those products are used as an ingredient;

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<sup>7</sup> Regulation (EU) 2024/1143 of the European Parliament and of the Council of 11 April 2024 on geographical indications for wine, spirit drinks and agricultural products, as well as traditional specialities guaranteed and optional quality terms for agricultural products [2024] OJ L; Regulation (EU) 2023/2411 of the European Parliament and of the Council of 18 October 2023 on the protection of geographical indications for craft and industrial products [2023] OJ L.

<sup>8</sup> Retained 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 [2013] OJ L347/671; Retained 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 [2012] OJ L343/1; Retained Regulation (EU) 2019/787 of the European Parliament and of the Council of 17 April 2019 on the definition, description, presentation and labelling of spirit drinks, the use of the names of spirit drinks in the presentation and labelling of other foodstuffs, the protection of geographical indications for spirit drinks, the use of ethyl alcohol and distillates of agricultural origin in alcoholic beverages, and repealing Regulation (EC) No 110/2008 [2019] OJ L130/1.

(b) any misuse, imitation or evocation, even if the true origin of the products or services 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, including when those products are used as an ingredient;

(c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product that is used on the inner or outer packaging, on advertising material, in documents or information provided on online interfaces 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.

The provisions set out five grounds – or 'situations' in European Union Intellectual Property Office (EUIPO) terminology – for the protection of GIs. Since the introduction of unitary EU GI protection in 1992, these have been grouped into four paragraphs and this structure has never been substantively modified. This approach to protection is unique amongst IP laws. The provision groups together various approaches – if not every conceivable method – previously employed for safeguarding signs, particularly trade marks and indications of source. These approaches were combined into a single provision to provide GIs with the highest level of protection possible; however, this consolidation has come at the cost of systemic rigour, leading to uncertainty in the interpretation of the rules and potential overlaps among the individual situations. The case law on each of these situations is discussed in turn.

Paragraph (a) is based on the rules on the protection of trade marks.<sup>9</sup> In general, they can be divided into two parts. First, it protects the registered GI against 'any direct or indirect commercial use' on products not covered by the registration, where they are comparable to the registered goods. Protection against 'direct use' is not particularly surprising; only entitled persons can use the protected GI name on the market.<sup>10</sup> The reference to 'comparable goods' recalls the 'likelihood of confusion test' from the confusing similarity head of infringement under trade mark law.<sup>11</sup>

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<sup>9</sup> Trade Marks Act 1994 (UK), Sec. 10; Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark [2017] OJ L154/1 (EU Trade Mark Regulation), Art. 9.

<sup>10</sup> This is a standard provision also in trade mark law, where the proprietor of the mark is the only one who can use it in the course of trade: Trade Marks Act 1994 (UK), Sec. 9; EU Trade Mark Regulation, Art. 9(2).

<sup>11</sup> Trade Marks Act 1994 (UK), Sec. 10(2); EU Trade Mark Regulation, Art. 9(2)(b).

Paragraph (a) also protects against ‘any direct or indirect commercial use’ liable to exploit, weaken, dilute, or be detrimental to the reputation of the protected name. In this case, the approach is modelled on the protection of trade marks with a reputation. The test requires neither similarity of goods nor likelihood of confusion. Rather, it is necessary to prove that the defendant uses a similar or identical sign that takes unfair advantage of, blurs or tarnishes a trade mark that enjoys reputation.<sup>12</sup> However, there is a key difference between the GI and trade mark approaches: the latter requires the claimant to provide evidence of a reputation, whereas the former does not. GIs are considered inherently well-known merely on the basis of registration.<sup>13</sup> This legal fiction does not reflect reality. In fact, while certain GIs such as ‘Champagne’ or ‘Parmigiano Reggiano’ are world-famous, empirical evidence demonstrates that the majority of GI products are barely known outside their country – or even their region – of production.<sup>14</sup> This evidence is not entirely surprising and does not undermine the importance of GIs. Rather, it emphasises an important point: GIs are based on *origin*. Thus, reputation plays a role as a requirement for the validity of a GI application only insofar as it contributes to proving the link between a product and a given place. Furthermore, reputation is not a necessary element, as GIs can be established solely based on the evidence of a natural/qualitative link.<sup>15</sup> Therefore, treating GIs as inherently well-known to justify an exorbitant level of protection is both empirically and theoretically dubious. Moreover, a relevant share of registered GIs is underused or barely used at all.<sup>16</sup> This is a point to which we will return in the discussion of passing off.

Finally, it is worth mentioning that the concept of ‘indirect use’ in paragraph (a) was discussed by the CJEU in *Scotch Whisky*, where it held that the distinction between ‘indirect’ and ‘direct’ use merely refers to the physical manner in which the use of a GI appears on the market. That is, ‘direct use’ implies that the GI is affixed directly to the product or its packaging, while ‘indirect use’ requires the GI to feature in supplementary marketing or information sources, such as an advertisement for the product or documents relating to it.<sup>17</sup> However, the concept remains largely unclear.<sup>18</sup>

Paragraph (b) extends protection to ‘any misuse, imitation or evocation’ of the registered name, even in circumstances where the true origin of the products or services is indicated, for instance when it is

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<sup>12</sup> Trade Marks Act 1994 (UK), Sec. 10(3); EU Trade Marks Regulation, Art. 9(2)(c).

<sup>13</sup> This is explicitly stated in the examination guidelines, see EUIPO 2025, para. 3.1.1.

<sup>14</sup> For instance, in Italy, of 332 GIs registered for agricultural products, 15 account for 90% of production. For details, see the studies quoted in Jantyk and Török 2020, pp. 1095-1096.

<sup>15</sup> See Zappalaglio 2021, Ch. 2.

<sup>16</sup> Zappalaglio et al in Vandecandelaere et al 2025.

<sup>17</sup> ECJ, June 7, 2018, Case C-44/17, *Scotch Whisky Association v. Klotz*, 2018 Bus LR 1466 - *Scotch Whisky*, para. 32.

<sup>18</sup> For details and examples, see EUIPO 2025, Sec. 4.1.

accompanied by expressions such as 'style', 'type', 'method' and so on. This provision gives GIs a form of 'absolute protection', whereby GIs are protected *as such*, even in cases where the defendant's conduct causes no confusion or deception on the market. Here, unlike point (a), the GI is protected against the mere association with any other product's name. This approach derives from Article 3 of the *Lisbon Agreement*, which protects appellation against any form of 'usurpation or imitation'.<sup>19</sup> However, the EU GI law has gone further than the *Lisbon Agreement* by adding another concept: 'evocation'. This important and controversial expansion of GI protection will be analysed in the next section.

Paragraph (c) introduces the unfair competition approach, by which GIs are protected against 'any ... false or misleading indication as to the provenance, origin, nature or essential qualities of the product'. This reflects a longstanding approach to the protection of indications of source, recognised at the international level since the first version of the *Paris Convention* in 1883, followed by the *Madrid Agreement* in 1891.<sup>20</sup> These rules were reiterated in Article 22(2) of the *TRIPS Agreement*, where they appear as the minimum standard of protection that every WTO member state must implement at the national level.

As Tim Dornis puts it, the function of unfair competition law is to regulate market participants' use of the information infrastructure which constitutes the backbone of the marketplace.<sup>21</sup> In other words, the goal of the system is to ensure that consumers receive correct and reliable information by preserving truth-telling on the market. Thus, while absolute protection requires a registration system to grant protection to specific names *per se*, the unfair competition approach is characterised by the *ex post* assessment of the conduct of the defendant.<sup>22</sup> If the latter has been manipulated the information on the market, for instance, misrepresenting the qualities or origin of goods and/or deceiving consumers, this amounts to tortious behaviour.

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<sup>19</sup> Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (as amended 28 September 1979) (adopted 14 July 1967, entered into force 31 October 1973) 923 UNTS 205 (*Lisbon Agreement*). Subsequently, a similar level of protection was included for wines and spirits only in the TRIPS, art. 23(1).

<sup>20</sup> See, Paris Convention for the Protection of Industrial Property (adopted 14 July 1967, entered into force 26 April 1970) 828 UNTS 305 (*Paris Convention*), Arts. 10, 10*bis* and 10*ter*; Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods (adopted 31 October 1958, entered into force 1 June 1963) 828 UNTS 163 (*Madrid Agreement*), which does not specifically focus on the substance of unfair conduct, but stipulates that all goods bearing false or deceptive indications of source must be seized on importation. For an analysis of the provisions of the *Paris Convention*, see Ricketson 2015, pp. 670-686.

<sup>21</sup> Dornis 2017, p. 493.

<sup>22</sup> The best assessment of the specificities of an approach based on Indications of Source and Unfair Competition Law, compared with that of *sui generis* GIs can be found in Gangjee 2012, Ch. 2.

The unfair competition approach has some disadvantages when compared to the standards of protection set forth at paragraphs (a) and (b). In particular, while the *sui generis* GI system aim to define, certify and protect the substantive ‘origin’ of a product, the paradigm of unfair competition is exclusively related to the protection of the communicative strength of the indication itself.<sup>23</sup> For instance, the Champagne PDO was established by the registration of a detailed specification and is meant to convey information about the nature of the product, its method of production, the link to its place of manufacturing, etc., whereas affixing the French flag on packaging delivers the message that the product is related to France but it does not convey any additional substantive information concerning the connection between the product and that country. While acknowledging these limitations, we argue that the more flexible and practical nature of an unfair competition approach can be employed to correct some of the excesses of the absolute – or ‘abstract’ – approach to *sui generis* GI protection and ensure that it maintains a connection to market realities.

Paragraph (d) encompasses ‘any other practice liable to mislead the consumer as to the true origin of the product’. This is a broad final rule aimed at encompassing any circumstance not falling within the scope of the previous situations, especially, ‘misuse, imitation or evocation’.<sup>24</sup> Although usually considered residual, the provision was – to some extent – revived in 2020 by the CJEU decision in *Morbier*. This case is reviewed in the following subsection, together with the key decisions on the concept of ‘evocation’.

## 2.2 The concept of evocation

The concept of evocation in EU GI law has attracted considerable attention and provoked serious debate. This broad, largely judge-made concept has no equivalents in other areas of EU or global IP law. It was theorised by the French Parliament in 1990.<sup>25</sup> While French lawmakers considered whether to link the concept of ‘evocation’ to that of ‘likelihood of confusion’,<sup>26</sup> this idea was rejected in favour of a system to protect the reputation of registered geographical names from any misappropriation or weakening, even when used in relation to different kinds of products and in the absence of the likelihood of confusion.<sup>27</sup>

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<sup>23</sup> Gangjee in Dreyfuss and Ginsburg 2014, p. 128.

<sup>24</sup> There is very little judicial guidance about the functioning of this provision, although some detail has been provided in EUIPO 2025, Sec. 4.3.

<sup>25</sup> Xinzhe Song and Ying Zhou 2024, p. 52.

<sup>26</sup> *ibid*, 52-57.

<sup>27</sup> See, Code Rural et de la pêche maritime, Art L643-1 ‘Le nom qui constitue l’appellation d’origine ou toute autre mention l’évoquant ne peuvent être employés pour aucun produit similaire... . Ils ne peuvent être employés pour aucun établissement et aucun autre produit ou service, lorsque cette utilisation est susceptible de détourner ou d’affaiblir la notoriété de l’appellation’ (‘The name which constitutes the Appellation of Origin or any other use evoking it may not be used for any similar product... . They may not be used for any

Evocation was introduced in EU GI law by the first EU *sui generis* GI Regulation.<sup>28</sup> Initially, the regulations did not provide a definition of evocation, but more than 30 years later, the Preamble of the recent Regulation 2024/1143 has provided a statutory definition of the concept:

[E]vocation of a geographical indication may arise ... where a link with the product designated by the registered geographical indication, including with reference to a term, sign, or other labelling or packaging device, is present in the mind of the average European consumer who is reasonably well-informed, observant and circumspect.<sup>29</sup>

This definition reflects CJEU case law, starting with *Cambozola* that in 1999 conceptualised evocation as an ‘image triggering’ operation that can occur even if the true origin of the good is indicated,<sup>30</sup> and regardless of the intention of the defendant.<sup>31</sup> Later, it was further clarified as the establishment of a ‘conceptual proximity’ between the GI product and another non-GI good or service.<sup>32</sup> However, the definition alone does not clarify when, or how, such a link is meant to emerge. Instead, this concept has been developed by decisions of the CJEU.<sup>33</sup> The test for evocation has continually expanded over the last 25 years, with notable acceleration recently.<sup>34</sup>

In early decisions, such as *Cambozola* and *Parmesan*, the CJEU ruled out the need for the claimant to prove likelihood of confusion, but nevertheless conducted an assessment based on the phonetic and visual similarities between the signs.<sup>35</sup> Likewise, the *Cognac* and *Verlados* decisions referred to the tests of aural, visual, phonetic, and conceptual similarity. In these decisions, the CJEU added that the rationale

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undertaking or any other product or service, when this use is likely to divert or weaken the reputation of the designation.’).

<sup>28</sup> Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs [1992] OJ L208/1.

<sup>29</sup> Regulation 2024/1143, Recital 35.

<sup>30</sup> ECJ, March 4, 1999, Case C-87/97, *Consorzio per la tutela del formaggio Gorgonzola v. Kaserei Champignon Hofmeister GmbH*, 1999 ECR I-1301 - *Cambozola*, paras. 25, 29.

<sup>31</sup> This was specified by the Advocate General in his Opinion on *Cambozola*, see Opinion of Mr Advocate General Jacobs delivered on 17 December 1998, *Consorzio per la tutela del formaggio Gorgonzola v. Kaserei Champignon Hofmeister GmbH* [1999] ECR I-1301, para. 33.

<sup>32</sup> ECJ, February 26, 2008, Case C-132/05, *Commission of the European Communities v. Germany*, 2008 ECR I-957 - *Parmesan*, para. 47.

<sup>33</sup> For a complete review, see Zappalaglio in Bonadio and Goold 2023, pp. 311-321.

<sup>34</sup> A good technical reference on the functioning of ‘evocation’ is provided by EUIPO 2025, Sec. 4.2.2.

<sup>35</sup> *Cambozola*, para. 26; *Parmesan*, paras. 45-48.

behind evocation was to prevent a trader from taking 'undue advantage' of the reputation of the registered name.<sup>36</sup>

In 2017, the CJEU clarified the limits of evocation by identifying two possible exclusions: lack of association and legitimate interest. The first was discussed in *Port Charlotte*. In this decision, the Court held that the whisky brand 'Port Charlotte' did not evoke the famous Portuguese 'Port' wine as the average consumer would have interpreted the noun 'Port' in the name of the whisky as referring to a 'harbour named after a person called "Charlotte"'.<sup>37</sup> The second was addressed in *Champagner Sorbet*, in which the Court concluded that the name 'Champagner Sorbet' for a sorbet would have evoked 'Champagne' PDO only if the foodstuff did not have, as one of its essential characteristics, a taste attributable primarily to the presence of the GI ingredient. This test has the peculiar result that the judge needs to actually taste the product to determine whether the GI product is used in sufficient quantities to confer an essential characteristic. However, when the case returned to the national courts, the Munich Court of Appeal accepted the evidence of a single witness that the 'Champagner Sorbet' did not, in fact, essentially taste like Champagne and therefore constituted exploitation of the reputation of the PDO.<sup>38</sup> The recent reform of the EU GI system has endorsed this test, but added clarifications about its practical functioning.<sup>39</sup>

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<sup>36</sup> ECJ, July 14, 2011, Joined Cases C-4/10&C-27/10, *Bureau National Interprofessionnel du Cognac v. Gust. Ranin Oy*, 2011 ETMR 53 - Cognac, para 46; ECJ, January 21, 2016, Case C-75/15, *Viiniverla Oy v. Sosiaali-ja terveystalain lupa-ja valvontavirasto*, 2016 EU:C:2016:35 - Verladlos, para. 45.

<sup>37</sup> ECJ, September 1, 2017, Case C-56/16P, *EUIPO v Instituto dos Vinhos do Douro e do Porto IP*, 2017 ETMR 41 - Port Charlotte, paras. 55 and 124.

Similarly, in a recent decision of the Italian Supreme Court concerning Modena Balsamic Vinegar ('Aceto Balsamico di Modena') it was held that the terms 'aceto' and 'balsamico', or their combination, do not evoke the Aceto Balsamico Tradizionale di Modena PDO – or the Aceto Balsamico di Modena PGI – unless accompanied by words or images that would trigger an association with the origin product in the mind of the average consumer. See, Italian Supreme Court, April 17, 2024, Case No. 10350/2024, paras. 20-21.

<sup>38</sup> ECJ, December 20, 2017, Case C-393/16, *Comité Interprofessionnel du Vin de Champagne v. Aldi Süd Dienstleistungs-GmbH*, 2017 EU:C:2017:991 - Champagner Sorbet. One of the key arguments in favour of the Defendant was that, since the product contained actual Champagne, the consumer was not misled. However, even this principle has been partially rejected in the recent *Nero Champagne* decision, where the General Court of the EU refused registration to the trade mark NERO CHAMPAGNE, even for use on wine complying with the Champagne PDO specification, because the mark would still take unfair advantage of the reputation of the GI product.

<sup>39</sup> In particular, Regulation 2024/1143 art. 27 specifies that the processed products must not contain any other product comparable to the ingredient designated by the geographical indication. Moreover, the provision introduces some specific limitations, stating that the producers of prepacked food who want to use a

Overall, until 2017, the concept of evocation looked very favourable to GI users, but remained fairly balanced. However, the CJEU subsequently extended the scope of GI protection beyond their definition as ‘names’ and stretched the boundaries of what can be considered relevant ‘image triggering’. In *Queso Manchego*, a company in the Spanish region of ‘La Mancha’ produced and marketed cheese in packaging with illustrations associated with the famous literary character ‘Don Quixote de La Mancha’. The association representing Queso Manchego PDO producers sued the company, arguing that the labelling constituted an evocation of the registered name. The CJEU held that this could be considered evocation since ‘figurative signs may trigger directly in the consumer’s mind the image of products whose name is registered on account of their “conceptual proximity” to such a name’.<sup>40</sup> Hence, the ‘image triggering’ operation was extended beyond names to encompass any figurative sign that could recall the imagery related to a specific geographical location.

In 2020, the scope of protection was extended to functional characteristics of products in *Morbier*.<sup>41</sup> The CJEU declined to focus on ‘evocation’ in this case, but rather addressed the residual protection against ‘any other practice’ in paragraph (d), but is relevant to the expansionary trend in the CJEU case law. In this case, the association of producers of the French cheese ‘Morbier’ sued the producer of a cheese featuring a horizontal dark ash stripe in the middle of the cheese, similar to that which characterises ‘Morbier’ cheese. The French Tribunal and the Court of Appeal of Paris ruled in favour of the defendant, but the CJEU held that:

[the rules at hand] 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 [average European consumer] to believe that the product in question is covered by that registered name.<sup>42</sup>

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geographical indication in the name of their product must give a prior written notification to the producer group. Finally, the Champagner Sorbet test is explicitly excluded from application in the domain of spirits.

<sup>40</sup> ECJ, May 2, 2019, Case C-614/17, Fundación Consejo Regulador de la Denominación de Origen Protegida Queso Manchego v Industrial Quesera Cuquerella SL, 2019 Bus LR 1718 - Queso Manchego, para. 22.

<sup>41</sup> ECJ, December 17, 2020, Case C-490/19, Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois SAS, 2021 Bus LR 565 – Morbier.

<sup>42</sup> *Morbier*, para. 41. The issue of considering infringement for any reference to a specific place included in a product’s name, even when the product is actually produced there, is another adverse consequence of ‘evocation’. The Court of Appeal of La Coruña, Spain, found that the reference ‘De las Rías Gallegas’ (‘From the Galician Rias’) on a packet of mussels sourced from that region infringed the Mejillon de Galicia PDO (‘Mussels of Galicia’), even though the defendant had not made direct or indirect use of the name protected by the GI. However, the Court also held that the concept of ‘evocation’ should not be employed to create new exclusive rights that do not align with the actual function of GI as an IP right. See, Cour of Appeal of La Coruña, January 2022, Sentencia 00041/2024, para. 18.

This expands the scope of protection to the shape or appearance of the GI product, even if the name itself (or a similar name) is not used. Finally, the CJEU confirmed that evocation also applies to services in the *Champanillo* case, in which the name of a Spanish bar ‘Champanillo’ was found to evoke the PDO ‘Champagne’.<sup>43</sup> This over-expansion of the scope of GI protection has led to reactions from several distinguished scholars.

### 2.3 Scholarly reactions to the development of EU GI Protection

Criticisms of the EU approach to GI protection regarding the internal market and international trade are not new. Several scholars have expressed doubts about the narrative employed by the EU Commission to support the scope and level of protection granted to this IP right.<sup>44</sup> Weatherall compared GIs to abstract ‘Platonic’ ideals.<sup>45</sup> Indeed, cases such as *Queso Manchego* show how the ‘absolute’ protection combined with the Platonic concept of the GI to produce ‘abstract’ protection. This approach privileges the abstract meaning of the GI over consumer perception, which meant that an extremely loose connection between the GI and a non-protected figurative element – not even a name – was enough to find infringement, regardless of the lack of actual damage caused by the defendant’s conduct.

When discussion about the impending reform of the EU GI system heated up in 2022, several scholars in Europe began voicing their concerns about the level of protection and, most importantly, to its adverse effects on the market. In an Opinion published in December 2022, Annette Kur argued that the scope of GI protection has broadened so far and is composed by such vague concepts (especially ‘indirect use’ and ‘evocation’) that could impair fundamental rights, such as the right to impart information and to freely conduct a legitimate business.<sup>46</sup> Moreover, Kur argued that while the discussions in this area had always focused on increasing the already high level of protection of GIs, such intensive protection was not counterbalanced by appropriate exceptions, such as the ‘due cause’ and ‘functionality’ exceptions that appear in trade mark law.<sup>47</sup> Instead, decisions such as *Queso Manchego* and *Morbier* seem to flatly contradict such principles. These observations led Kur to conclude that this anomaly could be resolved:

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<sup>43</sup> ECJ, September 9, 2021, Case C-783/19, *Comité Interprofessionnel du Vin de Champagne v. GB*, 2021 EU:C:2021:713 - *Champanillo*.

<sup>44</sup> Davison et al. 2019; Hughes in Calboli and Ng-Loy 2017; Handler in Gangjee 2016.

<sup>45</sup> Weatherall in Calboli and Ginsburg 2020.

<sup>46</sup> Kur 2023.

<sup>47</sup> The case law illustrates that the scope of trade mark protection has not extended that far. For instance, the EU General Court, followed by the High Court of England and Wales, rejected the opposition filed by the producers of ‘Halloumi’ cheese against the applications for the marks ‘Grilloumi’ and ‘Grilloumaki’, concluding that there was no likelihood of confusion, either direct or indirect, see, EU General Court, October 11, 2023, Case T-415/22, *Republic of Cyprus v EUIPO*, 2023 ECLI:EU:T:2023:615; England and Wales High Court,

... by reinstating the principle that the GI system is *solely geared towards protection of names* signalling origin, and does not embrace the product or its appearance. Exceptions to that rule should be permitted (only) where consumers are manifestly misled, unless the elements targeted by infringement claims are functional in the sense that they yield a substantial contribution to the quality or usability of the product concerned.<sup>48</sup>

As explained in later sections about the British law on extended passing off, we agree that the scope of protection for GIs should focus on names and would be greatly improved by more consistently adopting the principles of unfair competition by misrepresentation.

A short time later, some of the most well-known experts in the field of EU GIs published another Opinion, putting forward observations more specifically aimed at improving the draft of the then-ongoing EU reform.<sup>49</sup> In particular, they argued that, (a) GI protection should not apply to functional features of the products; (b) dilution should only be found in cases where a change in the economic behaviour of consumers is proved; (c) also the field of GIs should include open-ended defence of 'due cause'; (d) rights conferred should be duly limited, for instance through defences such as referential use, use in comparative advertisement, and others compatible with honest business practices.

Unfortunately, none of these suggestions has been accepted by the EU legislator, and the problems remain unsolved. Therefore, this article seeks to push forward the debate and proposes that the approach to EU GI protection should be more influenced by unfair competition laws, specifically unfair competition by misrepresentation. It will develop this argument by taking the British law on extended passing off as a model.

In the following section, we demonstrate that the relevant rules that incorporate principles of unfair competition have essentially disappeared from use in practice and need to be revitalised to ensure a more balanced and predictable system. We show this based on previously unpublished empirical data from trade mark practice, which vindicates the principled concerns raised by other scholars about the current state of affairs in EU GI law.

### **3. The overriding role of evocation in the EU trade mark practice**

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September 9, 2024, Foundation for the Protection of the Traditional Cheese of Cyprus Named Halloumi v. Fontana Food AB, EWHC 2311 (2024).

<sup>48</sup> Kur 2023, p. 91. Emphasis added.

<sup>49</sup> Kur et al. 2023.

Evocation has taken a prominent role in CJEU decisions concerning GIs. The judicial expansion of the concept has raised concerns from experts in this area, as discussed earlier. However, the question remains whether evocation has become an issue in practice, whose expansion would impinge upon the activities of third parties. To address this gap in knowledge and advance the scholarly discussion of evocation, our study used trade mark applications as a proxy for the impact of GI protection on third parties. We hypothesised that the more ‘absolute’ forms of protection, especially evocation, would dominate the grounds for restricting the commercial practices of third parties, whereas the grounds based on consumer perception would be relegated to a residual – or perhaps non-existent – role. We measured the effect on third parties through trade mark practice, namely the relative grounds for refusal raised in opposition to EU trade mark applications, as well as the absolute grounds for refusal raised as objections during the examination of EU trade mark applications. All sources, data and figures in this study are current as of 1 August 2025.

### **3.1 The role of evocation in oppositions under to Article 8(6) EUTMR**

An EU trade mark application may be opposed on the grounds that the mark would conflict with an earlier GI under Article 8(6) EUTMR. This article must be read in parallel with the relevant rules on GI infringement. Therefore, the analysis of the opposition decisions under Article 8(6) can provide a picture of how GI producers enforce the protection of the registered name, in the context of preventing the registration of allegedly conflicting marks.

For this aspect of the study, all trade mark oppositions based on Article 8(6) EUTMR were collected using the EUIPO ‘eSearch Case Law’ database.<sup>50</sup> The search was restricted to the period of the entry into force of the latest version of the EUTMR, 1 October 2017 to 1 August 2025. This was because Article 8(6) was not present in the previous versions of the Regulation. The search yielded a total of 89 relevant oppositions, consisting of 21 agricultural GIs, 59 wine GIs, and 9 spirit GIs. To avoid duplicate results, the figures in Table 1 only counted the decision of the highest body that considered the opposition (for example, if a decision of the Opposition Division was appealed, only the decision of the Board of Appeal has been taken into account).<sup>51</sup> Of these results, 24 oppositions were appealed to the EUIPO Board of Appeal, of which two were then appealed to the General Court.

The decisions were catalogued by the situation(s) invoked by the opponent, according to the five grounds for protection of GIs: (1) direct or indirect use of the GI for comparable products, (2) exploitation, weakening, dilution or other detriment to the GI, (3) misuse, imitation or evocation, (4) false or misleading indication, and (5) any other practice liable to mislead the consumer as to the true origin of the product.

<sup>50</sup> EUIPO, ‘eSearch Plus Case Law’ database<<https://euipo.europa.eu/eSearchCLW/>>.

<sup>51</sup> For specific information on EUIPO’s procedures, see EUIPO 2025, Part 7.

Since the study is merely concerned with the relative frequency with which GI producers invoke the different grounds for infringement to restrict the activity of other traders, the study did not involve substantive analysis of the reasoning in each decision. The results of this analysis are summarised in Table 1. The total for each type of GI exceeds 100% because multiple grounds may be raised in a single decision, but were counted separately.

**Table 1. Overall use of infringement situations in oppositions under Article 8(6) EUTMR and percentage (%) representation (2017–2025)**

GI Product	Direct or indirect use for comparable products (Regulation 2024/1143, art 26(1)(a), first clause)	Exploitation, weakening, dilution or other detriment to the GI (Regulation 2024/1143, art 26(1)(a), second clause)	Misuse, imitation or evocation (Regulation 2024/1143, art 26(1)(b))	False or misleading indication (Regulation 2024/1143, art 26(1)(c))	Any other practice liable to mislead the consumer as to the true origin of the product (Regulation 2024/1143, art 26(1)(d))
Agricultural	5 (23.8%)	9 (42.8%)	18 (85.7%)	5 (23.8%)	4 (19.0%)
Wine	6 (10.1%)	36 (61.0%)	42 (71.1%)	5 (8.4%)	4 (6.7%)
Spirits	1 (11.1%)	7 (77.7%)	5 (55.5%)	1 (11.1%)	1 (11.1%)

Table 1 shows that approaches such as ‘exploitation, weakening, dilution or other detriment to the GI’ and ‘evocation’ are clearly predominant, with the latter being the most used opposition ground (85.7% for agricultural GIs and 71.1% for wine GIs), with the exception of spirits, for which ‘exploitation, weakening, dilution or other detriment’ dominates (77%). By comparison, the grounds rooted in the logic of unfair competition, particularly the use of ‘false or misleading indications’, has a minimal role in opposition proceedings, with the exception of agricultural products, where the percentage is higher (23.8%) compared to wine GIs (8.4%); in the case of spirits GIs, the 11.1%, represents only one case. These findings confirm the clear predominance of ‘absolute’ approaches in EU trade mark practice compared to relative, unfair competition-based ones.

Finally, it is important to note that the empirical research found that out of the 89 analysed oppositions, 58 were rejected (65.1%). These figures indicate that EUIPO examiners conduct a rigorous assessment, countering the opportunistic use of infringement claims and their overly broad interpretation

in favour of GI users. However, they also reveal that these grounds are aggressively employed against honest traders, even when the user does not have a solid case. This serves as a barometer of the current situation regarding GI infringement and provides insight into broader practices that do not reach the EUIPO Boards of Appeal or an EU court.

### 3.2 The role of evocation in objections under Article 7(1)(j) EUTMR

Earlier GIs may also be an impediment to the registration of a trade mark under the absolute grounds for refusal in Article 7(1)(j) EUTMR, following which EUIPO examiners can raise objections to the registration. As with the relative grounds for refusal, this must be read in parallel with the relevant rules on GI infringement.<sup>52</sup> The methodology mirrored the approach to oppositions, using the EUIPO ‘eSearch Case Law’ database to identify applications where the examiner raised objections under Article 7(1)(j) EUTMR (whether alone or in conjunction with other absolute grounds). However, to overcome ambiguity about the reasons for some decisions, the analysis was supplemented by details in the ‘Notice of Grounds for Refusal’ (Document L110) retrieved from EUIPO ‘eSearchPlus’ database.<sup>53</sup>

The search focused on the 10-year period from 1 January 2016 to 1 August 2025 and yielded a total of 381 results, 69 of which were excluded due to (a) lack of sufficient documentation to determine the reasons, or (b) the decisions, despite considering the conflict with a previous GIs, focused on other grounds, such as descriptiveness or lack of distinctive character of the applied mark. This left 312 relevant results. To avoid duplication, the study only counted the decision of the highest body; in this dataset, only 5 cases were brought before the EUIPO Board of Appeal and none of them reached the General Court. Some objections related to trade marks applied for multiple classes that could interfere with more than one kind of GI, such as both wine and spirits. In these instances, the relevant marks have been counted separately towards all the kinds of GIs with which they conflict. Similar to the analysis of the oppositions presented earlier, this assessment identified the grounds on which the objections of the EUIPO examiners were based, divided into 5 categories. The findings are set out in Table 2.

**Table 2. Overall use of infringement situations in objections under Art 7(1)(j) EUTMR and percentage (%) representation (2016 – 2025)**

GI Product	Direct or indirect use for comparable products	Exploitation, weakening, dilution or other detriment to the	Misuse, imitation or evocation (Regulation 2024/1143, art	False or misleading indication (Regulation	Any other practice liable to mislead the consumer as to

<sup>52</sup> EUIPO 2025, Ch. 10.

<sup>53</sup> EUIPO, ‘eSearch Plus Database’ <<https://euipo.europa.eu/eSearch/#basic>>.

	(Regulation 2024/1143, art 26(1)(a), first clause)	GI (Regulation 2024/1143, art 26(1)(a), second clause)	26(1)(b))	2024/1143, art 26(1)(c))	the true origin of the product (Regulation 2024/1143, art 26(1)(d))
Agricultural	39 (33.6%)	0	81 (69.8%)	27 (23.2%)	0
Wine	70 (45.4%)	0	77 (50%)	50 (32.4%)	0
Spirits	30 (44.1%)	0	32 (47%)	23 (33.8%)	0
Crafts	0	0	1 (50%)	1 (50%)	0

### 3.3 The cumulative impact of evocation

A comparison between the two tables reveals interesting trends that highlight the different approaches adopted by the stakeholders who submit oppositions under Article 8(4) EUTMR in comparison to the EUIPO examiners that raise objections under Article 7(1)(j). We discuss each of the situations in turn.

‘Direct or indirect use for comparable products’ (first clause of Article 26(1)(a) Regulation 2024/1143) appears more frequently in objections than in oppositions. For instance, in the case of wine GIs, it is present in 45.4% of objections, but only in 10.1% of oppositions. This is because the EUIPO examiners often point out that the trade mark application consists of a name protected by a GI, but pertains to products that do not comply with the GI specification.<sup>54</sup>

‘Exploitation, weakening, dilution or other detriment to the GI’ (second clause of Article 26(1)(a) Regulation 2024/1143) is often employed in oppositions, with 61% for wine GIs and 77.7% spirits GIs, but it never appears in objections (0%). This can be explained by observing that the ‘exploitation, weakening, dilution or other detriment’ to the reputation of a GI is likely something that the users of a GI are more willing to raise, whereas EUIPO examiners tend to apply more objective concepts which emerge directly from the text of the relevant documents, such as applications and specifications.

<sup>54</sup> For instance, in the cases ‘Allevatori bufalini campani abc caseificio del 78’ (case n R148/2021-5, 4 March 2021) and ‘Domaine de la Romanée-Conti’ (case n R1553/2020-2, 25 February 2021), the EUIPO objected that the goods covered by the applicant’s mark did not fully comply with the specification of the GI product to which the sign referred. They attempted to overcome the objection by limiting the goods and services claimed to only those products that complied with the GI specification but were unsuccessful. However, before the Board of Appeal, the applicants were successful in both cases as they demonstrated that they had amended the wording of the trademark application to limit it only to products that complied with the specification.

‘Misuse, imitation or evocation’ (Article 26(1)(b) Regulation 2024/1143) is a very prominent ground in both tables. Although it is higher in the case of oppositions, both scenarios display very high figures. For instance, in the case of agricultural GIs, it is employed in 85.7% of oppositions, and in 69.8% of objections. This confirms that ‘evocation’ has become the key situation in the EU.

‘False or misleading indication’ (Article 26(1)(c) Regulation 2024/1143) is a minor ground in both scenarios, although it is used in almost the same proportion for agricultural GIs, with 23.8% oppositions and 23.2% objections. However, in the cases of wine and spirits, the difference between the two scenarios is evident: 8.4% against 32.4% in the former and 11.1% against 33.8% in the latter. The higher figure in the case of objections can be explained by the fact that the decisions of the EUIPO often combine evocation and misleading use.<sup>55</sup>

‘Any other practice liable to mislead the consumer as to the true origin of the product’ (Article 26(1)(d) Regulation 2024/1143), the residual ground, is never mentioned in objections, probably because it concerns features of the GI products that do not directly concern their names, such as their appearance. Its use by opponents is also very limited, amounting to 19% for agricultural GIs, 6.7% for wine GIs, and 11.1% for spirits GIs.

Finally, the analysis of objections also identified two cases concerning craft products, specifically one involving Bohemia crystals and another Solingen cutlery. In the first, the EUIPO held that the mark ‘Exclusive Bohemia’ evoked various protected names related to the production of Bohemian glass and crystal.<sup>56</sup> In the second, it was concluded that the word mark ‘Solingen Brillant’ would be perceived by consumers as indicating the quality and geographical origin of the goods in question, thus being misleading.<sup>57</sup>

In conclusion, the broadening of the ‘absolute’ forms of protection through cumulative CJEU case law is not only a matter of scholarly concern. Our empirical analysis shows that the commercial activities of third parties are being affected by allegations of conflicts with existing GIs, especially on the grounds of evocation. The scale of this impact goes beyond those with strong basis in the case law. Earlier, we noted that the majority of oppositions are rejected, which means that the representatives of GI producers are often making allegations of a conflict, when the trade mark actually poses no such concern. To the extent that this data can serve as a proxy for broader legal strategy, we argue that this may reflect trends that

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<sup>55</sup> See for instance, ‘Larà, l’arancia siciliana’ (case n 018247531, 5 November 2020); ‘LANGHEMYFOOD’ (case n 018307304, 22 April 2022). Other decisions, instead, place more emphasis on misleading use alone. As an example, see ‘Fresco Marche’ (case n 018197533, 22 September 2020).

<sup>56</sup> ‘Exclusive Bohemia’ (case n 017895663, 16 August 2018).

<sup>57</sup> ‘Solingen Brillant’ (case n 017240441, 10 July 2018).

cannot be quantified, such as the use of cease-and-desist letters and other private settlements to restrict the commercial activities of traders based on allegations of GI infringement that are never made public. If the pattern from our empirical analysis is mirrored in infringement allegations, this suggests that 'absolute' protections have an overriding role, while the unfair competition approaches that take account of consumer perception and honest competitive practices have fallen by the wayside. We argue that the British law on extended passing off, as one manifestation of unfair competition by misrepresentation, offers a potential corrective to this problem.

#### **4. The development of extended passing off**

Passing off has been described as a 'protean' tort, in the sense that it is versatile and adaptable to new types of subject matter.<sup>58</sup> One instance of this adaptability was the development of passing off in the extended form of the action, which built upon the case law about misrepresentations as to quality of the goods, such as *Spalding v Gamage*,<sup>59</sup> to recognise that goodwill can be shared amongst a class of traders who produce goods with a particular characteristic or quality. However, extended passing off is not a separate cause of action; rather, it is a convenient label to indicate a specific factual situation in which a seller has misrepresented the nature or provenance of their goods.<sup>60</sup>

Cases about passing off are assessed by reference to the 'classic trinity' of elements: goodwill, misrepresentation, and damage.<sup>61</sup> The element of misrepresentation is often seen as the heart of the tort, which asks whether the defendant's actions have deceived or are likely to deceive the public.<sup>62</sup> Indeed, in one of the leading authorities on passing off, Lord Diplock formulated the elements of passing off as follows:

(1) a misrepresentation (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a *quia timet* action) will probably do so.<sup>63</sup>

<sup>58</sup> Lauriat 2016, p. 59. See also, Carty 2012.

<sup>59</sup> *AG Spalding v. AW Gamage Ltd*, 32 RPC 273 (1915). See discussion in Wadlow 2021, pp. 435-436.

<sup>60</sup> *Diageo North America Inc v. Intercontinental Brands (ICB) Ltd*, RPC 2 (2011), p. 120; Wadlow 2021, p. 488.

<sup>61</sup> *Reckitt and Colman Products Ltd v. Borden Inc*, RPC 341 (1990), p. 406; applied in extended passing off cases such as *Consorzio del Prosciutto di Parma v Marks&Spencer* RPC 351 (1991), p. 369.

<sup>62</sup> Carty in Bellido 2017, pp 181 and 186, citing *Reddaway v. Banham*, AC 199 (1896), p. 207.

<sup>63</sup> *Erven Warnink BV v. J Townend & Sons (Hull) Ltd*, FSR 397 (1979) – *Advocaat*, p. 405.

In some ways, the emergence of unitary GI protection has diminished the relevance of extended passing off. In the most recent extended passing off case to come before the British courts, namely *Fage UK v Chobani*, the Court of Appeal recognised that the EU GI Regulations ‘established a uniform and exhaustive system... which precludes the application of a parallel system of protection under the individual laws of Member States’.<sup>64</sup> Therefore, only national measures that do not fall within the scope of the GI Regulations can continue to apply. In that case, however, since ‘Greek yoghurt’ was not eligible for GI protection because that particular name is not used in the defined geographical area (as people in Greece instead use a term which means ‘strained yoghurt’),<sup>65</sup> it fell outside the scope of the GI Regulations, and the national protections under the law of extended passing off could continue to apply. Nevertheless, this would not be true for many of the names that historically received protection under extended passing off (such as Champagne wine, Scotch whisky, or Parma ham). Although extended passing off now has a diminished role, which explains the rarity of cases that raise this issue and minimal scholarly attention to the topic,<sup>66</sup> the reasoning in these cases provides some insights into how GI law could be brought back to reality.

#### 4.1 Goodwill

An action for passing off requires the plaintiff to demonstrate goodwill attached to the goods or services which they supply in the mind of the purchasing public by association with the identifying get-up. In extended passing off cases, the goodwill is generated by the public understanding that a name denotes a ‘distinct and recognisable’ product, rather than the mark of a single trader who produces it.<sup>67</sup> In the first extended passing off case, *Bollinger v Costa Brava*, Danckwerts J held that the goodwill associated with the name ‘Champagne’ could be shared:

... it ought not to matter that the persons truly entitled to describe their goods by the name and description are a class producing goods in a certain locality, and not merely one individual. The

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<sup>64</sup> 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; ECJ, September 8, 2009, Case C-478/07, *Budejovicky Budvar NP v. Rudolf Ammersin GmbH*, 2009 E.C.R. I-7721.

<sup>65</sup> *Fage UK v. Chobani*, ETMR 26 (2014), pp. 489-496.

<sup>66</sup> It seems that the last case to seriously consider extended passing off was EU General Court, September 30, 2015, Case T-136/14, *Tilda Riceland Private Ltd v. OHIM*, EU:T:2015:734, concerning an application to register the word BASmALI, although the case has limited relevance post-Brexit. Extended passing off was also raised in relation to Bitcoin, but in this case, the argument was ‘incoherent’ and ‘nonsensical’ and therefore did not warrant any consideration in this article: *Crypto Open Patent Alliance v. Wright*, EWHC 3315 (2024), paras. 40-42 and 100.

<sup>67</sup> *Advocaat*, p. 402.

description is part of their goodwill and a right of property. I do not believe that the law of passing off, which arose to prevent unfair trading, is so limited in scope.<sup>68</sup>

Therefore, twelve sparkling wine producers from the Champagne district of France were able to obtain an injunction to restrain wine made from grapes grown in Spain from being imported into England & Wales under the name of 'Spanish Champagne'. Goodwill can have many elements. The *Spanish Champagne* decision was soon harnessed by producers of the Scottish textile product 'Harris Tweed'.<sup>69</sup> The Outer House of the Court of Session in Scotland was asked to consider whether the use of the name could have a broader meaning to include some production in mainland Scotland, or whether it should be limited to the cloth produced entirely in the Outer Hebrides by a process of handweaving carried out by the Islanders. In making his findings, Lord Hunter noted that much of the goodwill associated with the name 'Harris Tweed' arose out of sympathy for the plight of the Islanders, who had been in a state of great poverty and distress as a result of lack of employment, the decline of fishing, and the failure of the potato crop during the second quarter of the nineteenth century. Therefore, as 'Harris Tweed' was introduced to the wider market, the purchase of this cloth was seen as a philanthropic act to support the human element behind this cottage industry.<sup>70</sup> Lord Hunter described:

Th[e] geographical significance and content and the idea of Harris Tweed as the product of an island industry has always in my opinion been of central importance in a manner not dissimilar to the name Champagne, but with the added element of public benevolence towards the inhabitants of the locality or region of manufacture and production.<sup>71</sup>

However, extended passing off is not restricted to names with some geographical connotation, as confirmed when the House of Lords recognised that the name 'advocaat' was understood by the public in England to denote a distinct and recognisable species of beverage, specifically an egg and spirit drink.<sup>72</sup> Nor is extended passing off limited to classes of products that consumers perceive as being of superior quality or 'premium' products. In deciding whether extended passing off could protect the name 'vodka' (as against an alcoholic drink called Vodkat), Patten LJ in the Court of Appeal affirmed that there was no

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<sup>68</sup> *J. Bollinger v. Costa Brava Wine Co Ltd*, Ch. 262, 284 (1960) - *Spanish Champagne*.

<sup>69</sup> *Argyllshire Weavers Ltd v. A. Macaulay (Tweeds) Ltd*, SLT 21 (1965).

<sup>70</sup> See also discussion in Dawson 2000, pp. 603-604.

<sup>71</sup> *Argyllshire Weavers*, 36. Extended passing off was also addressed by the Scottish court in the case, *Lang Bros Ltd v. Goldwell Ltd*, SLT 309 (1982).

<sup>72</sup> *Advocaat*, p. 408.

requirement for any 'cachet' associated with the product and that shared goodwill may be established 'simply because consumers come to like and value it for its inherent qualities rather than its status'.<sup>73</sup>

There can be challenges with determining whether shared goodwill exists. As highlighted in *Chocosuisse v Cadbury*, it is not fatal for different traders to use slightly different recipes; the central query is whether the name (in that case, Swiss chocolate) indicates a particular group of products with a discrete reputation to a significant section of the public.<sup>74</sup> The question of whether a descriptive product name had become sufficiently distinctive of a defined category of goods was a key issue in *Fage UK v Chobani*. The case concerned the meaning of 'Greek yoghurt' in the minds of British consumers. Yoghurt made in Greece has always had a characteristically thick and creamy texture, and for yoghurt made from cow's milk, this texture was traditionally achieved by straining using cloth bags, but also by more modern industrial methods. The Court of Appeal found that consumers did not have a common understanding the method of production, but there was a valuable reputation of goodwill associated with the phrase 'Greek yoghurt' in the UK as denoting a product made in Greece and having particular qualities of thickness, creaminess, taste and satisfaction. The evidence showed that a substantial proportion of the relevant public not only believe that Greek yoghurt comes from Greece, but also believe it to be special.<sup>75</sup> Importantly, there was a labelling convention amongst traders in the UK that thicker yoghurt that had *not* been produced in Greece be called 'Greek-style yoghurt'.

As seen in *Fage UK v Chobani*, there is a paradox at the heart of extended passing off cases.<sup>76</sup> The public understanding of the characteristics that make a product special might have no correspondence to any objective definition. This point was made in *Bollinger v Costa Brava*, which acknowledged that educated consumers and wine experts would know the true geographical origin of Champagne wine from a particular region of France, and therefore would not be deceived into thinking 'Spanish Champagne' was the genuine article. Yet Danckwerts J noted that for a substantial portion of the public, the obviously self-contradictory label of 'Spanish Champagne' could still amount to a misrepresentation because there was:

a considerable body of evidence that persons whose life or education has not taught them much about the nature and production of wine, but who from time to time want to purchase

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<sup>73</sup> Diageo North America Inc v. Intercontinental Brands (ICB) Ltd, ETMR 57 (2010), p. 1038. For a focus on this decision and its importance, as well as on the concept of extended passing off as a whole, see Arnold 2013, pp. 74-75.

<sup>74</sup> Chocosuisse Union des Fabricants Suisses de Chocolat v. Cadbury Ltd, RPC 826 (1999), p. 832.

<sup>75</sup> Fage UK v. Chobani, ETMR 26 (2014), p. 486.

<sup>76</sup> Wadlow 2021, p. 492.

champagne, as the wine with the great reputation, are likely to be misled by the description “Spanish Champagne”.<sup>77</sup>

By contrast, on the facts of *Fage UK v Chobani*, the widespread practice in the British yoghurt trade had educated consumers so that using the name ‘Greek-style yoghurt’ would not amount to a misrepresentation. It is here that the factual assessment in passing off cases, as opposed to the speculative assessment in GI cases, can be so crucial.

In this context, we must be clear. Some GIs are registered on the basis of their reputation,<sup>78</sup> while others rely on different criteria, such as the ‘natural link’ between the place and the qualities of the product. We are not arguing that products without a demonstrable reputation should be precluded from registration as GIs. However, this leads to the issue that all the elements of a successful passing off action are interlinked with the requirement for goodwill, whereas many registered GIs have no reputation in the minds of consumers upon which a passing off action could be made out. To that end, we emphasise two points. First, passing off is concerned with protecting goodwill, not mere reputation.<sup>79</sup> Second, passing off is a form of unfair competition by misrepresentation: the element of misrepresentation is the ‘essence’ of the tort.<sup>80</sup>

## 4.2 Misrepresentation

An actionable misrepresentation requires a false representation that is calculated to deceive the public. This does not require intent, although fraudulent intention may have evidentiary value in a passing off action.<sup>81</sup> It may be an express misrepresentation, or an implied misrepresentation through use of a mark, name, or get-up that, in the circumstances of the case, represents the defendant’s goods to be those of the plaintiff, or the plaintiff’s goods of a particular class or quality.<sup>82</sup> The nature of the misrepresentation is somewhat different in extended passing off cases. In the *British Sherry* case, Cross J remarked:

As I read the *Spanish Champagne* case, what differentiates an ordinary case of passing off from the special type of passing off illustrated by that case is that in the latter type of case the plaintiff is not saying that the defendant is leading people to think that his goods are the goods of the

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<sup>77</sup> *Spanish Champagne*, p. 291.

<sup>78</sup> For GIs, this is not synonymous with ‘notoriety’ but rather a technical concept that indicates a way to prove a connection between a product and its place of origin, as distinct from or complementary to the ‘tangible’ natural/qualitative link.

<sup>79</sup> *Starbucks (HK) Ltd v British Sky Broadcasting Group plc*, FSR 29 (2015), p. 921.

<sup>80</sup> *Wadlow* 2021, p. 261.

<sup>81</sup> *Carty in Bellido* 2017, p. 186, citing *Cutler* 1904, pp. 5 and 9.

<sup>82</sup> *AG Spalding v. AW Gamage Ltd*, 32 RPC 273 (1915), p. 284.

plaintiff; he is merely saying that the defendant is selling his goods under a false trade description and that he is being, or is likely to be, injured thereby. That, of course, necessarily involves the deception of anyone who does not already know that the description is false but it is quite a different sort of deception from that usually relied on in passing off actions, and that, no doubt, is why the pleader in the *Spanish Champagne* case gave that particular type of passing off the label “unlawful competition.”<sup>83</sup>

In this case, the plaintiffs were producers of sherry from the Jerez district of Spain. On the facts, they had not acquiesced in the use of the word ‘sherry’ simpliciter and were entitled to an injunction restraining the unqualified use of the word in connection with wines. However, they had delayed too long and therefore acquiesced to other traders using descriptions for their wines like ‘British Sherry’, ‘English Sherry’, ‘Cyprus Sherry’ and ‘Australian Sherry’.

The case law is clear that evocation is not enough to establish a misrepresentation; it is not sufficient to create a link in the minds of the public.<sup>84</sup> The misrepresentation must mislead a substantial number of people into assuming there is a connection, otherwise passing off will not be established. There must be a material misrepresentation, which is assessed based on the use of the name – extended passing off cases only ever concern names – taking account of the surrounding circumstances. For example, Marks & Spencer imported whole Parma hams from Italy, then sliced and packaged the ham in the UK and sold it as ‘Genuine Parma Ham’.<sup>85</sup> The representative body for Parma ham producers brought a claim on the grounds that Italian national law required the ham to be sliced by the producers in Italy or carved in front of the customer at the point of sale so that they could see the Parma crown mark of authenticity, which was described as ‘the official seal of approval’. As explained by Morritt J, with whom the Court of Appeal agreed:

I am unable to see how it can be a misrepresentation to sell as Parma ham a slice of ham carved from what the Consortium accepts is a Parma ham merely because the purchaser is not present. The truth of the matter is that the crown on the ham is a mark of authenticity. To apply it to a ham

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<sup>83</sup> *Vine Products Ltd v. Mackenzie & Company Ltd*, RPC 1 (1969) – British Sherry, p. 29. See also, *Diageo North America v. Intercontinental Brands (ICB) Ltd*, ETMR 17 (2010), p. 322, in which Arnold J (as he then was) described the action as ‘suppliers of products of a particular description have sought to restrain rival traders from using that description, or a confusingly similar term, in relation to goods which do not correspond to that description’.

<sup>84</sup> *Moroccan Oil Israel Ltd v. Aldi Stores Ltd*, ETMR 55 (2014), p. 1101.

<sup>85</sup> *Consorzio del Prosciutto di Parma v Marks&Spencer* [1991] RPC 351 (*Parma Ham*).

which is not produced in accordance with Italian law may well amount to passing off. But to take it off a ham which was so produced by the operation of carving, in my judgment, cannot do so.<sup>86</sup>

Thus, in the *Parma Ham* case, there was no evidence that the public would be deceived, so there was no misrepresentation (or if there was any, it was immaterial).<sup>87</sup>

### 4.3 Damage

The final element for a successful passing off action is damage, which typically takes the form of a loss of trade and customers or loss of future opportunities.<sup>88</sup> While the courts have considered loss of trade or business,<sup>89</sup> in many extended passing off cases, the courts have also defined damage in terms of the erosion of the distinctiveness of the name and loss of goodwill.<sup>90</sup> For instance, Sir Thomas Bingham MR in *Taittinger v Allbev* stated:

Any product which is not Champagne but is allowed to describe itself as such must inevitably, in my view, erode the singularity and exclusiveness of the description 'Champagne' and so cause the first plaintiffs damage of an insidious but serious kind.<sup>91</sup>

However, as Christopher Wadlow cautions, this form of damage cannot be separated from the requirement for a misrepresentation and is not sufficient in its own right to establish an action for passing off.<sup>92</sup> To the extent that the case law appears to refer to dilution as a head of damage, it is used in the narrow sense of the loss of distinctive character, and cannot be established in the absence of consumer confusion.

## 5. Passing off as a tool to inspire a rebalancing of GI protection

With respect to names that suggest a specific source for the product, extended passing off and, in general, unfair competition by misrepresentation stresses the protection of the sign that indicates the source as an element that conveys a specific message that will be up to the subjectivity of consumers to

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<sup>86</sup> *Ibid.*, 371.

<sup>87</sup> Wadlow 2021, pp. 269-270.

<sup>88</sup> *LRC v. Lila Edets*, RPC 560 (1973); *Mirage Studios v. Counter-Feat Clothing*, FSR 145 (1991).

<sup>89</sup> *H.P. Bulmer Ltd v. J. Bollinger SA*, RPC 79 (1978), p. 95.

<sup>90</sup> *British Sherry*, p. 23; *Diageo North America Inc*, p. 403.

<sup>91</sup> *Taittinger SA v. Allbev Ltd*, FSR 641 (1993), p. 678.

<sup>92</sup> Wadlow 2021, p. 254.

decode. In other words, the sign appears as a piece of information, the meaning of which must be protected to ensure the proper functioning of the marketplace. By contrast, the EU model of *sui generis* GI protection claims to adopt an objective approach to the identification, definition, and protection of the IP right.<sup>93</sup> This is related to another crucial substantive difference. Passing off provides *ex post* protection against conduct that has altered the proper flux of information in the market by engaging in conduct capable of misleading consumers. In contrast, *sui generis* GI protection has always been interpreted as the mere recognition of a matter of fact: the product exists, it features a specific link to a geographical area as well as a given community of producers, and it has a unique history that determines its identity.<sup>94</sup> Hence, in the European tradition, the GI is considered essentially as a pre-existing situation that translates into intellectual property.

This way of conceptualising the concept of *sui generis* GI protection helps to understand the tendency of this IP right to over-expand. If the identity of a product is at stake, any image-triggering operation or any conceptual association, even an extremely loose one, must be stopped. Cases such as *Queso Manchego*, *Morbier* and *Champanillo*, by providing protection against the adoption of related imagery, functional features, and colloquial terms respectively, give the impression that GI protection does not just protect products, but even the mere ‘idea’ of them.

An approach to protection that is so abstract that it does not weigh the actual conduct of the defendant and, even more so, its *consequences*, has no equals in IP law.<sup>95</sup> For instance, even the much-debated test adopted by the CJEU in the famous *L’Oréal v Bellure* case concerning the protection of trade marks with a reputation against free riding looks considerably more specific and narrower than the concept of ‘evocation’.<sup>96</sup> Evocation has now been defined as arising ‘where a link with the product designated by the registered geographical indication ... is present in the mind of the average European consumer<sup>97</sup>’. By contrast, *L’Oréal* defines ‘free riding’ as covering:

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<sup>93</sup> Gangjee in Dreyfuss and Ginsburg 2014, p. 128.

<sup>94</sup> For a presentation of the traditional views on the rationale and *raison d’être* of this rule, see Louis Lorvellec, ‘You’ve Got to Fight for Your Right to Party: A Response to Professor Jim Chen’ (1996) 5 Minn J Global Trade 65.

<sup>95</sup> Even if the EUIPO states that the finding of evocation is ‘never automatic’, the most recent leading decisions provide a clear picture of how simple and abstract such finding has become in the practice. See EUIPO 2025, Sec. 4.2.2.

<sup>96</sup> ECJ, June 18, 2009, Case C-487/07, *L’Oréal SA v. Bellure NV*, ECR I-5185 - *L’Oréal*.

<sup>97</sup> Regulation 2024/1143, Recital 35.

cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.<sup>98</sup>

Indeed, the concepts of ‘transfer of image’ and ‘image triggering’ can be considered strongly related, and it is highly likely that the former inspired the CJEU case law on the latter. However, the trade mark approach, despite the criticisms once raised,<sup>99</sup> still turned out to be more focused on the conduct of the defendant, requiring the use of identical or similar signs and a *clear* exploitation of the communicative strength of the well-known brand. The test in *L’Oréal* also prescribes a global assessment that must consider factors such as the strength of the mark’s reputation and the degree of proximity of the goods or services concerned.<sup>100</sup>

In fact, in the hypothetical situation that the CJEU had applied something analogous to the *L’Oréal* test to the latest GI infringement cases, it is highly likely that none of them would have been an infringement. In *Queso Manchego*, the defendant was not using the protected name at all, and the association between the Don Quixote imagery and the Queso Manchego PDO is loose and disputable at best. In *Morbier*, the black ash stripe is a descriptive and functional feature that is completely unprotectable.<sup>101</sup> In *Champanillo*, the signs are too different: the defendant’s mark included two crossed champagne cups filled with red liquid, and the level of proximity of the goods and services is too limited.

We argue that it is necessary to bring GI protection into the proper ambit of IP law by significantly curtailing its overly broad and abstract approach to protection. In this context, the law on passing off may serve as an appropriate model by virtue of its focus on the conduct of the defendant and the likely consequences in the minds of consumers. This represents something that may be informally called the ‘Then what?’ factor, thus ensuring an assessment that hews closer to commercial realities and honest business practices. Taking the example of *Queso Manchego*, for instance, with the statement: ‘the Defendant adopted an imagery that recalls La Mancha region, which, in turn, refers to the name of the GI product’. This approach begs the question: ‘Then what?’ Was this conduct misleading? Has this led to an actionable form of damage or adverse consequences? Since the answer is ‘no’, the business practices of

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<sup>98</sup> *L’Oréal*, para. 41.

<sup>99</sup> The forceful critique developed by Jacob LJ is particularly famous, see *L’Oréal SA v. Bellure NV*, RPC 23 (2010), paras 14, 15, 49. See also, Gangjee and Burrell 2010. However, as recently noted in passing by Arnold LJ, many academics who criticised *L’Oréal* have since moderated their views: *Thatchers Cider v. Aldi*, EWCA Civ 5 (2025), para. 149.

<sup>100</sup> *L’Oréal*, para. 41.

<sup>101</sup> See discussion in Zafrilla Díaz-Marta and Kyrylenko 2021.

the defendant are perfectly lawful and legitimate. The same outcome can be reached in cases such as *Morbier* and *Champanillo*, where no misleading practices can be found. Indeed, we find hints of this approach already in the *Port Charlotte* decision, where it was recognised that consumers would not be deceived, so there was no infringement.

Some other cases would be considered borderline. However, this would not be due to a mere association between the defendant's conduct and the name of the GI, but rather the whole circumstances of the case. For instance, in *Verlados*, a Finnish producer marketed a kind of cider under the name 'Verlados'. French producers of Calvados, also a cider brandy, filed a complaint arguing that the Finnish name constituted an evocation of their product. Hypothetically, if this case had to be decided by a British court on the basis of extended passing off, some elements could weigh in favour of the claimants, such as: the similar sound of the words, the visual similarities between the products, the fact that the goods belong to the same kind and that they might be sold in the same areas of supermarkets, and, above all, persuasive evidence that the association between the two products is not coincidental but rather the result of the intentional choice of the defendant.<sup>102</sup> The close proximity of the types of goods also supports a finding of damage, in the sense of the loss of distinctive character.

Another example could be *Scotch Whisky*.<sup>103</sup> Here, a German brewery produced whisky under the name 'Glen Buchenbach'. The Scotch Whisky Association sued, claiming that the name amounted to evocation, as the word 'glen' triggered in the mind of consumers the idea of Scotch whisky, since the word 'glen' is a Scottish word for valley and is used by many Scotch whisky producers. By analogy to *Vodkat*, this could amount to passing off if accompanied by other circumstances that may deceive consumers, such as the shape of the bottle and appearance of the label to imitate the style of Scotch whisky bottles, particularly those producers featuring 'Glen' in their name. Additionally, while the name seemed to be adopted without intention to deceive, based instead on a play on words between the place of origin of the drink (Berglen) and the name of a local river (Buchenbach),<sup>104</sup> the claimant may provide evidence of actual deception.

The previous sections have assessed how and to what extent the current protection of GIs under EU law could greatly benefit from rediscovering an unfair competition approach, particularly unfair competition by misrepresentation. To this end, the British tort of extended passing off has been used as a model. The next section puts forward some recommendations, illustrating how these key principles could

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<sup>102</sup> *Verlados*, paras. 33-40.

<sup>103</sup> *Scotch Whisky*.

<sup>104</sup> *Ibid*, para. 58.

be applied in EU practice, leading to a clearer and more balanced interpretation and application of the relevant provisions.

## **6. Using the principles of passing off to improve GI protection**

### **6.1 Anchoring protection to the name**

All existing definitions of GIs define them as ‘names’.<sup>105</sup> However, the broadening of the scope of the concept of ‘evocation’, as well as the resort to rules such as Article 26(d) Regulation 2024/1143, have *de facto* expanded the scope of protection to potentially encompass all elements related to the products, such as special physical features (*Morbier*) or even the imagery related to the areas where it is produced (*Queso Manchego*). This approach exceeds the traditional boundaries of GI law with damaging consequences for free competition, particularly for small producers and new market entrants, and increases uncertainty in the marketplace.<sup>106</sup>

While the legislative reforms advocated by other scholars were not taken up during the recent overhauls of the GI laws in the EU, we propose changes that can be made through administrative and judicial intervention. A key development that would reflect the case law on extended passing off would be to limit the protection to the name of the GI product. While the British cases take account of the whole circumstance of the case, there cannot be a misrepresentation in the absence of the name of the protected product (or a similar name, as in *Vodkat*). This approach would exclude cases that seek to protect functional characteristics (*Morbier*) or imagery (*Queso Manchego*). While recognising the importance of protecting the identity of quality products from parasitic exploitation,<sup>107</sup> the principles from passing off emphasise that competition is ‘not only lawful but the mainspring of the economy’.<sup>108</sup> A line must be drawn to prevent the over-expansion of GI protection. The element of ‘misrepresentation’ provides an appropriate threshold.

### **6.2 Narrowing the scope of protection**

The grounds for infringement in Article 26 Regulation 2024/1143 and Article 40 Regulation 2023/2411 should be clarified and reinterpreted narrowly, for at least two reasons. First, enhancing the overall predictability and clarity of the system. This is particularly important in light of the commencement of

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<sup>105</sup> See, for instance, the EU definition at Regulation 2024/1143, art. 46 and, for an international standard, that provided in the TRIPS, art. 22(1).

<sup>106</sup> See, Kur 2023.

<sup>107</sup> This was the main argument of the practitioners and producer associations, that supported *Morbier*. See, for instance, Francazi 2023.

<sup>108</sup> Jacob LJ in his discussion on the nature of unfair competition in *L’Oréal SA v. Bellure NV*, EWCA Civ 968 (2007), paras. 135-142.

Regulation 2023/2411 on 1 December 2025. This new set of rules will open the door for the registration of hundreds of new GIs for crafts and industrial products. Therefore, it is crucial to balance the expansion of the EU GI system with a more reasonable approach to protection. Second, to revive the 'unfair competition' situation, according to which GIs must be protected against 'any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product'. As shown by the empirical data in Section 3 above, this is almost never used. Therefore, it is important to revive it, thus returning the other situations to more acceptable boundaries.

In reinterpreting these provisions, we argue that the principles of passing off provide helpful guidance. The approach from the British case law may be supported by national practices concerning unfair competition by misrepresentation, as well as the broader principles from unfair competition by misappropriation.

Beginning with paragraph (a) of Articles 26 Regulation 2024/1143 and 40 Regulation 2023/2411, which protects registered GIs against any direct or indirect commercial use of the geographical indication where use of that geographical indication exploits, weakens, dilutes, or is detrimental to the reputation of the protected name. We propose that this situation be clarified and narrowed down in at least two cumulative ways. First, the law of passing off does not exclude dilution and tarnishment, but these heads of damage cannot be established in the absence of misrepresentation. GI decisions should show a clear risk of consumer deception, of which dilution or tarnishment could be a mere consequence.<sup>109</sup> This would not be foreign to GI case law; for instance, in *Champagner Sorbet*, the German Federal Court (*Bundesgerichtshof*) considered the unfair exploitation of the reputation of a GI in relation to the presence of misrepresentation by holding:

in order to examine whether there has been an exploitation of the reputation of the protected designation of origin "Champagne" ... the Court of Appeal will have to make up for the missing findings on the taste-determining property of the ingredient champagne. If this characteristic is lacking, there is likely to be a *misleading effect*...<sup>110</sup>

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<sup>109</sup> For a discussion on dilution in the realm of passing off, see *Spanish Champagne and Vodkat*. For a focus on Tarnishment, see *Annabel's (Berkeley Square) Ltd v. G. Schock (t/a Annabel's Escort Agency)*, FSR 261 (1972).

<sup>110</sup> 'Für die Prüfung, ob eine Ausnutzung des Ansehens der geschützten Ursprungsbezeichnung "Champagner" ... vorliegt, wird das Berufungsgericht die fehlenden Feststellungen zur geschmacksbestimmenden Eigenschaft der Zutat Champagner nachzuholen haben. Sofern es an dieser Eigenschaft fehlen sollte, dürfte zugleich eine Irreführung ... gegeben sein'. German Federal Supreme Court, July 19, 2018, Case no. I ZR 268/14 – *Champagner Sorbet*, para. III.2. Emphasis added.

Second, the findings of exploitation, dilution and detriment to the reputation of GI should be subject to a scrutiny on par with that already in place for trade marks. For instance, when claiming that the use of a GI has weakened or diluted its reputation, as per *Intel v CPM*, the GI users should at least provide evidence 'of a change in the economic behaviour of the average consumer ... or a serious likelihood that such a change will occur in the future'.<sup>111</sup> In addition, this test could be further refined by adopting not only the key principles of passing off and trade mark law, but also by referencing the key tests currently applied in continental European unfair competition law.

Indeed, even when referencing the broader domain of unfair competition by misappropriation, commonly known by the French term *parasitisme*, there is a noticeable trend to narrow and define the cases in which this tort can be recognised, as well as to clarify the evidence required to support such a claim. For instance, the French Supreme Court (*Cour de Cassation*) has recently reworked this concept. In twin decisions, it identified two cumulative elements required for parasitism: (a) an identified and individualised economic value held by the claimant, and (b) the wrongful apprehension of this value by the defendant.<sup>112</sup> In a previous decision, the Court had already specified that it is up to the claimant to demonstrate that, through the efforts made, the investments made, and through the risks taken, they are the origin of the identified economic value that is claimed. Anything that is not the result of specific efforts would not constitute an individualised economic value likely to be protected under parasitism.<sup>113</sup> In the decisions, the Court recalled this point and added that 'the mere fact of taking up, by deriving it, a concept implemented by a competitor does not constitute, in itself, an act of parasitism'.<sup>114</sup>

Instead, the test introduced by the Italian Supreme Court (*Corte di Cassazione*) in a leading decision stipulates that three elements are necessary to configure parasitism: (a) the systematic nature of the imitation, which must not concern a single product or advertising campaign, but a set of heterogeneous initiatives carried out in a coordinated manner; (b) temporal continuity, that is that the imitative acts must continue over time, configuring a 'constant walk in the footsteps of others' and (c) there must be a causal link between the imitation and the damage suffered by the plaintiff company, both in terms of loss of customers and erosion of the distinctive value of its offer.<sup>115</sup>

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<sup>111</sup> ECJ, *Intel Corporation Inc v. CPM United Kingdom Ltd*, November 27, 2008, Case C-252/07, ECR 1988 I-08823, para. 81.

<sup>112</sup> French Supreme Court, June 26, 2024, Case no. 22-17.647 and 22-21.497 – *Décathlon*, p. 18; French Supreme Court, June 26, 2024, Case no. 23-13.535 - *Maisons du Monde*, p. 6. For a comment, see Ballot-Léna and Decocq 2024.

<sup>113</sup> French Supreme Court, February 10, 2021, Case no. 18-21.238.

<sup>114</sup> See, *Décathlon*, p. 19 and *Maisons du Monde*, p. 7 ('le seul fait de reprendre, en le déclinant, un concept mis en oeuvre par un concurrent ne constitue pas, en soi, un acte de parasitisme').

<sup>115</sup> Italian Supreme Court, October 29, 2015, Case no. 22118.

Turning to paragraph (b), although the concept of evocation can be defined as an ‘image triggering operation’, its functioning must be better clarified, such as by emphasising the importance of misrepresentation or deception. Even if the broader standard of misappropriation or parasitism was adopted, ‘evocation’ could not be as broad as it is today: the leading French and Italian cases show that the defendant’s conduct must damage the claimant’s goodwill, not just constitute a generic association with a non-unique, banal or freely appropriable element, as occurred in cases such as *Queso Manchego* or *Morbier*.

## **7. Conclusion**

There has been a chorus of scholars raising alarm about the expanding scope of protection and calling for measures that would ensure balance in the geographical indications system in the EU. While this article is singing the same tune, we have added texture to the debate by reporting empirical evidence of the practical consequences of the broad interpretation of the grounds for infringement of a GI. Particularly, we have shown that the ‘absolute’ situations, particularly evocation, have come to dominate in allegations of conflict between a trade mark and a GI, while the grounds for infringement based in unfair competition have diminished relevance. Then, we have demonstrated that using the principles of unfair competition by misrepresentation, as embodied in the British law on extended passing off, we argue that the interpretation of the grounds of infringement should be recalibrated to focus on the names of GI products and to anchor the analysis of harm to misrepresentation or deception.

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