

# THE “MACEDONIAN” SAGA

## What does the future hold for the “Macedonian” products of Greece and North Macedonia after the Prespa Agreement?

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### ABSTRACT

*Rights about the commercial use of the name “Macedonia” have been the object of an ongoing dispute between Greece and North Macedonia for almost three decades. The issue was partially settled on 12 June 2018, when both countries agreed upon the terms of the Prespa Agreement. However, despite representing a long-awaited improvement, core aspects of the commercial use of the name “Macedonia” as trade mark and geographical indication are yet to be discussed. Even though the Agreement states that North Macedonia is required to change the name of all the official government and government related institutions, there is still uncertainty about how private companies may explore the name and its association with their products. In such cases, the Agreement relies on future negotiations between the two countries, an issue further clouded by North Macedonia’s plea to join the European Union. Specifically in the case of commercial names, trade marks, brand names and all relevant matters, it also provides for establishing an international group of experts, with representatives from both countries and transnational organizations. As the negotiations unfold, the future is still unclear.*

### 1. INTRODUCTION

Heather Ann Forrest stated that “it is entirely possible that one State might choose to be identified in the same or similar way as another.”<sup>1</sup> This is what triggered the major conflict between Greece and the country constitutionally referred to as the “The Republic of Macedonia” (nowadays The Republic of North Macedonia). The naming dispute was reignited after the breakup of Yugoslavia and the former Socialist Republic of Macedonia’s newly gained independence in 1991. Since then, it has been an ongoing issue in bilateral and international relations until it was settled with the Prespa Agreement between the two countries in 2019. The Agreement was reached between the former Greek Prime Minister Alexis Tsipras and his Macedonian counterpart Zoran Zaev, on 12 June 2018. On 12 February 2019, and after the Agreement was ratified by both sides, it entered into full force.<sup>2</sup>

During the 28 years of this ongoing dispute, various issues have arisen concerning the use of the name “Macedonia”. The ratification of the Agreement as well as the upcoming entry of The Republic of North Macedonia into the European Union (EU) brought forward serious concerns regarding the use and the registration of the name “Macedonia” as a geographical indication (GI) and as a trade mark (TM) for several products and companies from both countries. The greatest concern for the entrepreneurs and producers of the two countries has been the confusion caused by the use of the same name “Macedonia” as an indication of their goods and services.<sup>3</sup> Article 1(3) of the Prespa Agreement states that as far as TMs and brand names are concerned, the two sides agree to support and encourage their business communities in institutionalizing a structured and in good faith dialogue, in the context of which [they] will seek to reach mutually acceptable solutions on the issues deriving from commercial names, TMs, brand names, and all relevant matters at a bilateral and international level. For the implementation of the above-mentioned provisions, the Prespa Agreement further states that an international group of experts with representatives from both States will be established, in the context of the EU with the appropriate contribution of the United Nations (UN) and the International Organization for Standardization (ISO). The team of experts shall be established in 2019 and conclude its work within three years.<sup>4</sup>

The purpose of this article is to analyse the legal issues which arise as a result of products from both countries using the name “Macedonia”. The analysis is based on the TM and GI legislation as it has been formulated at international, EU and national levels. Relevant articles are used for the overall assessment of the topic. A brief historical background is provided administered for reasons of clarity and precision of the topic.

### 2. HISTORICAL BACKGROUND

The dispute first arose in 1991 between North Macedonia, then known as the Republic of Macedonia and the Greek region of Macedonia. Both parties claimed their ancestry from the ancient Greek kingdom of Macedon and Alexander the Great, who expanded the kingdom to Asia. However, what is left of the kingdom is the ancient Greek region of Macedonia, nowadays called Macedonia. Greece opposed the use of the name “Macedonia” due to historical, territorial and irredentist concerns. As millions of Greeks identify as Macedonians, unrelated to Slavs, Greece further objected to the use of the term “Macedonian” for the neighbouring country’s ethnic group and language. Greece also



reacted strongly to the appropriation of symbols and figures that are historically considered part of Greek culture such as the Vergina Sun and Alexander the Great. They also objected to the country promoting the concept of a United Macedonia, which involved territorial claims on Greece, Bulgaria, Albania, and Serbia. In 1995, the two countries established bilateral relations and committed themselves to starting negotiations on the naming issue under the auspices of the UN. Until a solution was found, the provisional reference "the former Yugoslav Republic of Macedonia" (FYROM) was used by multiple international organisations and states.<sup>5</sup> Heather Ann Forrest states that the UN Security Council avoided making use of the country's chosen name ("Republic of Macedonia") when considering its membership application, instead recommending admission of the "State whose application is contained in document S/25147" and then recommended the use of the provisional name.<sup>6</sup>

Contrary to this situation, by January 2017, 137 countries had recognised The Republic of Macedonia under its constitutional name. On the other hand, attempts by the Republic to persuade international organizations to drop the provisional reference have been met with limited success. After 28 years of negotiations, proposals for the name, provisional measures and strategic policies ("Interim Accord", "Antiquisation" policy etc.), a solution was finally found. On 12 February 2019, the Prespa Agreement entered into force. According to Article 1(a) of the Prespa Agreement, the official name of the Second Party shall be "The Republic of North Macedonia" and the short name shall be "North Macedonia".<sup>7</sup>

### 3. "THE MACEDONIAN PRODUCTS"

The ratification of the Prespa Agreement and the establishment of the name "North Macedonia" for the neighbouring country brought to light various concerns about the future of the Greek Macedonian products. Even though the Agreement states that North Macedonia is required to change the name of all official government and government related institutions, this is not the case regarding the use of the name "Macedonia" for private companies. When it comes to the use of the name as a TM and as a GI the Agreement states that such issues will be settled through negotiations between the two parties (inter partes).<sup>8</sup>

For years, the undertakings of both countries have registered or used TMs with the term "Macedonia" to distinguish their products and services from others. According to the Chamber of Commerce and Trade of Thessaloniki, the name "Macedonia" features in the brands of 182 Greek companies of all sectors and 39 companies of the food and agriculture sector. Additionally, over 4000 Greek businesses use the term "Macedonia" to identify and describe their products.<sup>9</sup> Regarding the food products, some of the most famous and well known under the name "Macedonia" are the Macedonian (Florina) peppers, the Macedonian Halva and other food products such as tahini (sesame paste), jams, spoon sweets, stewed fruits, etc. Similarly, there are a great number of companies such as "MEVGAL, the Macedonian Milk Industry", "HALVATZIS Makedoniki", "MAKAL" Macedonian asparagus, etc.<sup>10</sup> In recent publications in the Greek press, the former Deputy Minister of Development and Economy,

<sup>1</sup> Heather Ann Forrest, "Protection of Geographic Names In International Law and Domain Name System Policy", Wolters Kluwer Law & Business, 2013, p. 180.

<sup>2</sup> "Macedonia naming dispute", [https://en.wikipedia.org/wiki/Macedonia\\_naming\\_dispute](https://en.wikipedia.org/wiki/Macedonia_naming_dispute) [accessed 21 October 2019].

<sup>3</sup> "Firms with Macedonia-related names need to clinch rights", e-kathimerini, <http://www.ekathimerini.com/237308/article/ekathimerini/business/firms-with-macedonia-related-names-need-to-clinch-rights> [accessed 21 October 2019].

<sup>4</sup> "Macedonia - Greece Agreement", Virtual Macedonia, <https://vmacedonia.com/politics/macedonia-greece-agreement.html> [accessed 21 October 2019].

<sup>5</sup> "Macedonia naming dispute", Wikipedia, [https://en.wikipedia.org/wiki/Macedonia\\_naming\\_dispute](https://en.wikipedia.org/wiki/Macedonia_naming_dispute) [accessed 21 October 2019], also "The Issue of the Name of North Macedonia", Hellenic Republic, Ministry of foreign affairs, <https://www.mfa.gr/en/the-question-of-the-name-of-the-republic-of-north/> [accessed 14 November 2019].

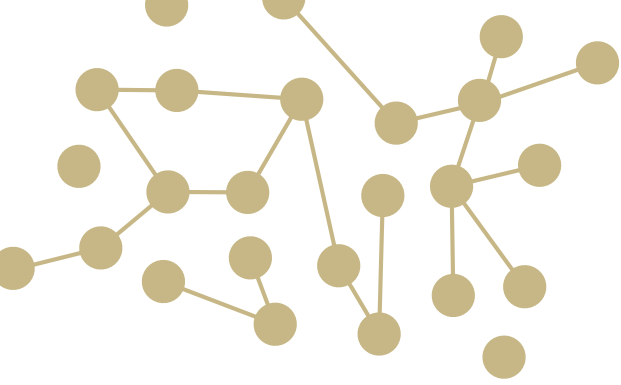
<sup>6</sup> Heather Ann Forrest, "Protection of Geographic Names In International Law and Domain Name System Policy", Wolters Kluwer Law & Business, 2013, p. 186.

<sup>7</sup> "Macedonia naming dispute", [https://en.wikipedia.org/wiki/Macedonia\\_naming\\_dispute](https://en.wikipedia.org/wiki/Macedonia_naming_dispute) [accessed 21 October 2019].

<sup>8</sup> "The Agreement explained simplified", Virtual Macedonia, <https://vmacedonia.com/politics/opinions/prespaagreement-explained-simplifiedpart1.html> [accessed 21 October 2019].

<sup>9</sup> "What is the future of the Macedonian products and trade marks" (Greek article), in.gr <https://www.in.gr/2019/01/29/politics/diplomatia/ti-tha-ginei-ta-makedonika-proionta-kai-ta-emporika-simata/> [accessed 21 October 2019].

<sup>10</sup> "The threat for the Greek Macedonian products" (Greek article), newsbeast.gr, <https://www.newsbeast.gr/weekend/arthro/3731843/i-apili-gia-ta-ellinika-proionta-tis-makedonias> [accessed 21 October 2019].



Mr Stergios Pitsiorlas, has stated that there are 64 National TM registrations, ten EUTM registrations but none at an international level under WIPO. On the other hand, at the national TM Registration Office of The Republic of North Macedonia, approximately 75 National TMs are registered or pending for registration with the name “Macedonia”, two international TM registrations and none within the EU.<sup>11</sup>

Recently, Chinese authorities have rejected a Greek company’s request for the use of the term “Macedonian” on its products, on the grounds that it cannot be used without the permission of North Macedonia.<sup>12</sup> Under these circumstances, the fear of the Greek Macedonian producers that they will no longer be able to use the name “Macedonia” for their products after the ratification of the Agreement, is not without due cause. Furthermore, of foremost concern is the existence and use of unregistered TMs from Greek Macedonian businesses and the need to secure them under the current legislation within the markets. The likelihood of confusion of the products and services between the companies and enterprises of the two countries is the biggest fear. The size and the reputation of the enterprises as well as their activity within the markets in an EU and international level will play a decisive role in the confusion.

As far as it concerns PGIs (Protected Geographical Indications) and PDOs (Protected Designations of Origin), Greece has granted protection within the EU for the GI “Macedonia” for wines and for spirits such as “Tsipouro” (Grape marc spirit or grape marc) and “Ouzo” (Distilled anis).<sup>13</sup> Furthermore, one of the most famous and reputed PDOs is “Crocus Kozanis”, a red saffron produced in Kozani, a Greek Macedonian district. On the other hand, The Republic of North Macedonia has registered 5 PGIs in the International Lisbon System. The most well-known is the “Macedonian Ajvar”, a paprika salad made with red peppers and garlic.<sup>14</sup> North Macedonia has also paid great attention to the protection and promotion of wines at a national, EU and international level. At this point it is worth mentioning that wine is one of North Macedonia’s main agricultural exports – after tobacco, fresh fruits and vegetables – and is the main source of income for 15.000 rural households.<sup>15</sup> According to 2018 statistics, the top countries receiving the wine exports across northern Macedonia are, by value, Serbia (29%), Germany (21%), Croatia (17%), Bosnia and Herzegovina (7%) and Slovenia (5%).<sup>16</sup>

Although the EU has always been reluctant to protect the products (especially wines) of North Macedonia due to existing protection for Greek Macedonian wines in the EU, the latest incident raised concerns regarding the GI

protection of the Greek Macedonian wines not only within the EU but also internationally. In particular, the association Wines of Macedonia (WoM) participated in the international wine trade fair Prowein in Düsseldorf with wines featured only as “Macedonian” and not using the indication “North”. The association stated that they have been selling wines from Macedonia for decades and they hope that they will still be able to do this in 10 or 20 years’ time. This caused a reaction from the Greek Macedonian wine producer Stelios Boutaris, one of the best-known winemakers in Greece, who said that

*“what Greek Macedonia producers want is for the wines from North Macedonia to be called just that, and for Greek wines to be called Macedonian wines, which is how they’ve been “patented” in the EU for 20 years now.”<sup>17</sup>*

#### 4. GI PROTECTION FOR THE NAME “MACEDONIA”

As previously stated, both countries have registered the term “Macedonia” as GIs for their products, especially for wines. Particularly in the past, when the constitutional name of the Republic of North Macedonia was “The Republic of Macedonia”, many local wine producers have been using and protecting the term “Macedonia” for their wines as national GIs.

*“On the 21 of May 2013 the first GI in North Macedonia was registered, leading the way to the protection of the promising wines of the Vardar River Valley. According to previous publications of the Food and Agriculture Organization of the United Nations (FAO), the Association “Wines of Macedonia” and the Macedonian Ministry of Agriculture, Fisheries and Water Economy were instrumental to reach this important breakthrough in Macedonia’s wine sector.”<sup>18</sup>*

Similarly, wine production all over the Greek Macedonian region (Drama, Thessaloniki, Kozani, Naousa, Halkidiki , etc.) has flourished since the nineties.<sup>19</sup> A great number of Macedonian wines throughout the region have been protected under the PGI Macedonia and other district PGIs such as PGI Kozani and PGI Halkidiki, etc. The PGI Macedonia zone in northern Greece, established in 1989, comprises the following 13 districts: Grevena, Drama, Imathia, Thessaloniki, Kavala, Kastoria, Kilkis, Kozani, Pella, Pieria, Serres, Florina, Halkidiki. Thus, the wines of PGI Macedonia are produced by 20 wineries within the zone and by two more outside it.<sup>20</sup>

Under the EU, national, and international legislation regarding the protection of GIs, homonymous GIs are those that are spelled or pronounced alike, but which identify products originating in different places, usually in different countries. According to legislation, GIs could be either wholly or partly homonymous.<sup>21</sup> The definition strongly reflects the current situation where the term “Macedonia” is spelled and pronounced similarly but refers to different places. As simple as it might seem, the existence of the homonymous “Macedonia” GIs in the same

markets from the two neighbouring countries could be quite a complex issue for the two parties to solve. According to Article 100 of the EU Regulation No 1308/2013<sup>22</sup>

*“[A] name for which an application is submitted and which is wholly or partially homonymous with a name already registered under this Regulation shall be registered with due regard to local and traditional usage and any risk of confusion. A homonymous name which misleads the consumer into believing that products come from another territory shall not be registered even if the name is accurate as far as the actual territory, region or place of origin of those products is concerned.*

*A registered homonymous name may be used only if there is a sufficient distinction in practice between the homonym registered subsequently and the name already in the register, having regard to the need to treat the producers concerned in an equitable manner and the need to avoid misleading the consumer.”*

Similarly, in national legislation, Article 234 of the Law of Industrial Property of The Republic of North Macedonia, states that

*“if the names of two or more places of origin of products are identical or almost identical, in writing, the protection of such names with geographical indication or appellation of origin shall be approved to all persons that meet the requirements under this Law and if these names are used in accordance with good business practices as well as on the principle of equality of the producers at the market and truthful informing of the customer, except if it might mislead the public regarding the geographical origin.”<sup>23</sup>*

As both the EU Regulation regarding the protection of GIs for wines and the national legislation of North Macedonia are for the most part coherent with each other, mutual solutions between the two countries could be found regarding the GI protection for wines. This could be possible if efficient distinctions are drawn between the homonymous GIs in a way that confusion by consumers would be avoided. In that spirit, the use of the indication “North” in the name brought forward by the Prespa Agreement, is the term that the Greek side wishes to be included from now on in all of the PGIs and PDOs registrations, for products deriving from North Macedonia, including wine.<sup>24</sup> With the upcoming entry of North Macedonia in the EU, the problem becomes even more intense since the producers from North Macedonia seem unwilling to change the use of “Macedonia” under which their products are known, protected, and promoted globally.

Once the Republic of North Macedonia enters the EU, all of the above-mentioned national GIs will be registered and protected under the EU Regulations. This has been the case in the Budějovický Budvar case (C-478/07) where the Court of Justice of the European Union (CJEU) ruled that the aim of Regulation No 510/2006 is not to establish, alongside national rules which may continue to exist, an additional system of protection for qualified GIs, but to provide a uniform and exhaustive system of protection for such indications.<sup>25</sup> In light of this, questions arise regarding the future of these GIs since they could possibly be rejected under the rules of homonymous GIs.

<sup>11</sup> “What does the Prespa Agreement hold for the Macedonian products” (Greek Article), in.gr. <https://www.in.gr/2018/06/22/economy/oikonomikes-eidiseis/ti-tha-gi-nei-ta-makedonika-emporika-simata-meta-ti-symfonia/> [accessed 21 October 2019].

<sup>12</sup> “Chinese authorities reject Greek company’s request to use ‘Macedonian’ on its products”, greek city times, <https://greekcitytimes.com/2019/03/20/chinese-authorities-reject-greek-companys-request-to-use-macedonian-on-its-products/> [accessed 21 October 2019].

<sup>13</sup> E-Ambrosia, <http://ec.europa.eu/agriculture/spirits/index.cfm?event=searchIndication> [accessed 21 October 2019].

<sup>14</sup> Lisbon Express, <https://www.wipo.int/ipdl/en/search/lisbon/search-struct.jsp> [accessed 21 October 2019].

<sup>15</sup> “Na zdravje! Macedonia’s first wine Geographical Indication Association is registered”, fao.org, <http://www.fao.org/support-to-investment/news/detail/en/c/180002/> [accessed 21 October 2019].

<sup>16</sup> “Study of Wine in North Macedonia”, Greek Embassy in North Macedonia, TCCI.gr, <https://www.ebeth.gr/pages/details/>

[grafeio-oeu-skopion-kladiki-meleti-sxetika-me-tin-agera-oinou-sti-dimokratia-tis-boreias-makedonias,34000](http://grafeio-oeu-skopion-kladiki-meleti-sxetika-me-tin-agera-oinou-sti-dimokratia-tis-boreias-makedonias,34000) [accessed 21 October 2019].

<sup>17</sup> “Who’s allowed to sell ‘Macedonian wine?’”, dw.gr, <https://www.dw.com/en/whos-allowed-to-sell-macedonian-wine/a-48040910> [accessed 21 October 2019].

<sup>18</sup> “Na zdravje! Macedonia’s first wine Geographical Indication Association is registered”, fao.org, <http://www.fao.org/support-to-investment/news/detail/en/c/180002/> [accessed 21 October 2019].

<sup>19</sup> “PGI Macedonia”, Greek Wine Insider, <https://www.greekwineinsider.com/en/wine-category/pge/pge-perifereiakon-enotiton.html> [accessed 21 October 2019].

<sup>20</sup> “PGI Macedonia”, New Wines of Greece, [http://www.newwinesofgreece.com/lista\\_oionou\\_pge\\_diamerismaton\\_perifereion/en\\_pgi\\_macedonia.html](http://www.newwinesofgreece.com/lista_oionou_pge_diamerismaton_perifereion/en_pgi_macedonia.html) [accessed 21 October 2019].

<sup>21</sup> “Frequently Asked Questions: Geographical Indications”, WIPO, [https://www.wipo.int/geo\\_indications/en/faq\\_geographicalindications.html](https://www.wipo.int/geo_indications/en/faq_geographicalindications.html) [accessed 21 October 2019].

<sup>22</sup> Article 100 of the Regulation [EU] No

1308/2013 Of The European Parliament and 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.

<sup>23</sup> Article 234, Law on Industrial Property by the Former Yugoslav Republic of Macedonia [2009], (nowadays North Macedonia).

<sup>24</sup> “Who’s allowed to sell ‘Macedonian wine?’”, dw.gr, <https://www.dw.com/en/whos-allowed-to-sell-macedonian-wine/a-48040910> [accessed 21 October 2019].

<sup>25</sup> C-478/07- Budějovický Budvar, Judgment of the Court (Grand Chamber) of 8 September 2009, Budějovický Budvar, národní podnik v Rudolf Ammersin GmbH, ECLI:EU:C:2009:521, para. 95.

Michael Blakeney states that

*“conflicts typically arise where products on which homonymous GIs are used, are sold into the same market. The problem is accentuated where the homonymous GIs in question are used on identical products. Honest use of such GIs should be possible, because the indications designate the true geographical origin of the products on which they are used. However, concurrent use of homonymous GIs in the same territory may be problematic where the products on which a GI is used have specific qualities and characteristics which are absent from the products on which the homonym of the GI is used.”<sup>26</sup>*

In this case, the use of the homonymous GI would be misleading, since expectations concerning the quality of the products on which the homonymous GI is used are not met.

According to the Prespa Agreement, both parties agree that their strategic cooperation shall extend to all sectors such as trade, economy, agriculture, etc. In conjunction with that, it must not be forgotten that the two countries are neighbouring and thus there are many geomorphological commonalities which could be of relevance when it comes to the different grape varieties of the wines produced. In that view, the misleading character of the homonymous GIs becomes even greater, thus it is highly unlikely that the two countries will find a way for their homonymous GIs to coexist when sharing the same markets without misleading the average consumer about the true origin of the products.

## 5. TM PROTECTION FOR “MACEDONIA”

### 5.1 Descriptive character

For years, the protection of TMs with the term “Macedonia” from Greek Macedonian producers has been more or less neglected, even though the solution of the naming dispute between the two countries has been pending.

There have been only a few national and EU registrations of TMs compared to the number of unregistered TMs. After the breakup caused by the ratification of the Prespa Agreement, great attention was paid to the importance of registering and protecting TMs with the name “Macedonia” from the Greek Macedonian producers and entrepreneurs. The Greek government encouraged the producers to proceed to the filing of applications at the EUIPO (European Union Intellectual Property Office) and the national office for the registration of TMs.<sup>27</sup> Given the Greek Macedonian producers’ fear of losing the right to use the term “Macedonia” to designate their products and the need for Greece to expand their commercial activities within the EU, the Greek government stated that it will support the Greek Macedonian producers who wish to promote their products under the name “Macedonia”.<sup>28</sup> Also the use of the designation “Central” for Greek Macedonian TMs was suggested in order to create a distinction between the country and the Greek region. That was the case in a recently filed application for a national TM under the name “AG| CLUSTER Agri-food Cluster of Central Macedonia”.<sup>29</sup> In addition, a number of campaigns started with the aim of raising awareness of the brand name “Macedonia” and advertising the Greek region.<sup>30</sup> For that purpose, a new logo has been created consisting of the Greek letter “μ” and the phrase “Macedonia, the divine great land”.<sup>31</sup>

On the other side, North Macedonia has been actively filing applications for registrations of TMs with the term “Macedonia” for products and services in both a national and an international level under the Madrid System. A number of them were refused, such as the combined national marks “Cabernet Sauvignon Macedonia” and “Chardonnay Macedonia” for wines while others, such as the combined mark “Macedonia” for the services in class 39 and 41 of the Nice classification system, were registered.<sup>32</sup>

Under these circumstances, questions arise regarding the validity of such marks in relation to the absolute

<sup>26</sup> Michael Blakeney, “The Protection of Geographical Indications, Law and Practice”, Elgar Intellectual Property Law and Practice Series, 2014, p. 26.

<sup>27</sup> “Firms with Macedonia-related names need to clinch rights”, e-kathimerini <http://www.ekathimerini.com/237308/article/ekathimerini/business/firms-with-macedonia-related-names-need-to-clinch-rights> [accessed 21 October 2019].

<sup>28</sup> “The 5 commitments made by Mitsotakis regarding the Macedonian products” [Greek article], protothema.gr, <https://www.protothema.gr/politics/article/877661/pede-desmeuseis-mitsotaki-gia-ta-makedonika-proioda/> [accessed 21 October 2019].

<sup>29</sup> TM View Database, <https://www.tmdn.org/tmview/welcome> [accessed 21 October 2019].

<sup>30</sup> “Macedonian products are Greek products”,

Macedonian Products made in Greece, <https://www.macedonianproducts.gr> [accessed 21 October 2019].

<sup>31</sup> “Thessaloniki, this is the logo for the Macedonian products”, star.gr, <https://www.star.gr/eidiseis/politiki/477903/to-logoty-po-gia-ta-makedonika-proionta-ths-elladas> [accessed 21 October 2019].

<sup>32</sup> TM View Database, <https://www.tmdn.org/tmview/welcome> [accessed 21 October 2019].

<sup>33</sup> T-197/13, MONACO, Judgment of the General Court of 15 January 2015 — MEM v OHIM (MONACO), EU:T:2015:16, para. 47.

<sup>34</sup> Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, The Protection of Country Names Against Registration and Use as Trademarks, WIPO/STrad/INF/7, p. 4.

<sup>35</sup> Article 7(1) (c), Regulation (EU) 2017/1001 of

the European Parliament and of the Council 14 June 2017 on the European Union trade mark.

<sup>36</sup> T-379/03, Cloppenburg, Judgment of the General Court (Second Chamber, Extended Composition) of 25 October 2005, EU:T:2005:373, para. 36.

<sup>37</sup> “Macedonian Halva”, eSearch Plus, <https://euipo.europa.eu/eSearch/#details/trademarks/004039186> [accessed 21 October 2019].

<sup>38</sup> C-108/97 and C-109/97, Chiemsee, Judgment of the Court of 4 May 1999 Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger, EU:C:1999:230, para. 31.

grounds for refusal, both on a national and on the EU level. Will a TM with the term “Macedonia” be registrable or will it be refused?

The EU position was formulated by the General Court as follows:

*“In the EU, it is established that it is in the public interest that geographical indications remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods or services concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods or services with a place that may give rise to a favourable response.”<sup>33</sup>*

Under the EUTMR, TMs consisting of geographical terms are considered to be descriptive as well as not inherently distinctive and thus cannot be registered as TMs. Such is the case also in the national legislation for the protection of TMs in both countries, where accordingly TMs with geographical names fall under the scope of the absolute grounds for refusal. Similarly, according to the EUIPO Guidelines for Examination (Trade Marks and Designs), descriptive terms can consist of geographical terms, which are described as every existing name of a place, for example a country, city, lake or river. This list is not exhaustive. Adjectival forms are not sufficiently different from the original geographical term to cause the relevant public to think of something other than that geographical term. In assessing the registration of a geographical term as a mark, the assessment is whether the term describes objective characteristics of the goods or services.<sup>34</sup>

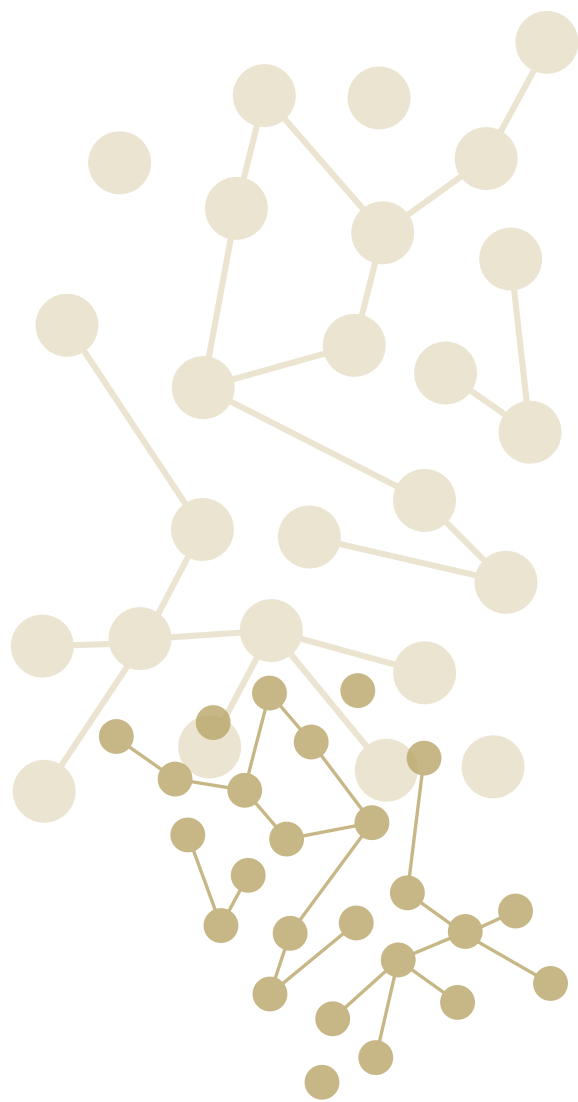
The first step in assessing a geographical term is to determine whether it is understood as such by the relevant public. Article 7(1)(c) EUTMR<sup>35</sup> does not in principle preclude the registration of geographical names that are unknown to the relevant public — or at least unknown as the designation of a geographical location. Whether or not this is the case will be determined by taking as a basis a reasonably well-informed consumer who has sufficient common knowledge but is not a specialist in geography. For an objection to be raised, the Office must prove that the geographical term is known by the relevant public as designating a place.<sup>36</sup>

Additionally, under the provisions of the EUTMR and national laws, TMs consisting of or containing geographical terms such as the name “Macedonia” can be registered only when they are considered to be distinctive. In particular, distinctiveness for this category of TMs could either be acquired through use or when the geographical term is accompanied by other distinctive terms such as figurative marks, other words, slogans, etc. A lucid example of such practice is the figurative TM “Haitoglou, Macedonian Halva” which has been successfully registered in the EUIPO and other national offices (France, Sweden, Italy and the United Kingdom). The TM is considered to be distinctive since the term “Macedonia” is accompanied by other terms which are inherently distinctive when assessed in relation to the perception of the average consumer. The TM also contains a figure of a woman wearing a traditional costume indicating that the product derives from the Greek

region Macedonia. The figure is characteristic in a way that the average consumer would directly link the mark with the product. Additionally, Macedonian Halva has been intensely marketed and advertised in various countries within the EU; therefore, acquired distinctiveness could be a tenable argument when assessing the validity of the TM.<sup>37</sup>

At this point it is worth stating that in establishing acquired distinctiveness, account may be taken of, inter alia, the following factors:

*“the market share held by the mark with regard to the relevant goods or services; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark for the relevant goods or services; and the proportion of the relevant public who, because of the mark, identifies the goods or services as originating from a particular undertaking.”<sup>38</sup>*



## 5.2 Geographical indications vs. trade mark protection

As previously mentioned in Section 4, both countries have put great emphasis on the protection of the geographical indication “Macedonia” for agricultural products and wines. On that basis, questions arise regarding the future of TMs consisting of or containing PGIs and PDOs of the name “Macedonia”.

Under the Article 7(1)(j) of the EUTMR, TMs consisting of or containing PGIs and PDOs cannot be registered for goods identical or comparable to the products protected under the PGI or PDO. The provision concerns only PGIs and PDOs which have been registered in the EU or have been registered in a national office of a non-EU country which has signed a trade agreement with the EU. National non-EU PGIs and PDOs enjoy protection only on a national level and thus only national TMs applications could be refused under similar provisions. Nevertheless, such TMs may be considered descriptive and/or deceptive under Article 7(1)(c) and (g) of the EUTMR as seen above.<sup>39</sup>

In 2001, North Macedonia signed a Stabilisation and Association Agreement with the EU which regulates the protection and control of wine names. In particular, according to Article 6 in Annex II of the Additional Protocol of the Interim Agreement, the registration of a TM for wine which contains or consists of a protected name under the Agreement shall be refused or at the request of the party concerned, invalidated. The Agreement concerns wines originating from the two contracting parties, namely the EU and the Republic of North Macedonia.<sup>40</sup>

In addition, according to the Article 177(1)(8) of the Law on Industrial Property of North Macedonia,

*“[A] TM which contains or consists of a geographic sign which serves to signify wines or other strong alcoholic drinks, if the reported sign refers to wines or alcoholic drinks which are not from that geographical area shall be refused.”<sup>41</sup>*

In 2018, following these provisions, a national application for the word mark “WINES OF MACEDONIA” for wines was refused by the national office of North Macedonia. As mentioned previously, the TMs “Cabernet Sauvignon Macedonia” and “Chardonnay Macedonia” for wines have also been refused. Under these circumstances it becomes clear that TMs containing the PGI or PDO “Macedonia” for wines will be refused or invalidated either as national marks or within the EU even now that North Macedonia’s accession to the EU is pending.<sup>42</sup>

As far as it concerns other agricultural products, the provisions of the EU Regulations would cover only PGIs and PDOs of the name “Macedonia” for Greek products such as the small “Florina peppers”, “Kozani crocus” or

the “Macedonian Ouzo”. That is the case since Greece is officially a Member State of the EU and all the national PGIs and PDOs have been accepted and protected under the EU Regulations. Regarding the agricultural products of North Macedonia, no trade agreement concerning the protection of PGIs for agricultural products exists with the EU. As a result, protection of the PGI for the Macedonian salad “Ajvar” does not exist within the EU and TMs which identify identical or comparable goods can be registered in the EUIPO.

## 5.3 “Macedonia” as a country name

One of the intriguing issues when it comes to TMs with the term “Macedonia” is that, first and foremost, the term constitutes part of the official name of the “Republic of North Macedonia” under Article 1(3)(a) of the Prespa Agreement. As stated above, before the Agreement the constitutional name of the country “The Republic of Macedonia” had been recognized by a significant number of countries. Furthermore, many used the short term “Macedonia” to describe the country, contrary to the provisional reference FYROM. Although there are no provisions under the EUTMR and the international agreements providing specific grounds for the refusal and invalidation of TMs consisting or containing country name, such provisions are found in the national laws of the two countries, namely Greece and North Macedonia.

Article 177(1)(10)(11) of the Law on Industrial Property of the Republic of North Macedonia states that:

*“[A] sign which contains name or abbreviated name of a country shall not be protected by a TM, except with authorization from the competent authority of the country. In addition to that, a sign which contains the name or abbreviation of that name, of the Republic of Macedonia, as well as their imitations, shall not be protected by a TM, except with authorization from a competent state administrative body.”*

A similar provision is found in Article 123(3)(a) of the Greek Law No 4052/2012, in which it is stated that names of States shall be refused from registration as TMs:

*“This prohibition includes in practice, not only the official or formal name, but also the common name, the translation, transliteration of that name, as well as the abbreviated name of the State.”<sup>43</sup>*

In addition, the Greek office refuses ex officio TM applications which consist solely or are comprised of a country name, based on an absolute ground of refusal. Nevertheless, governments officially represented can oppose or request cancellation of possible accepted TMs including their country names.

It is common knowledge in most jurisdictions that the relevant time for the assessment of the validity of a TM under the absolute grounds for refusal is the time of application of the TM. Consequently, the evaluation of validity must be based on the existing name of the country at the time of application and thus the former versions of it before the Prespa Agreement.

It follows that the two countries will face difficulties when it comes to the registration and validity of national TMs containing the term “Macedonia”. Taking into account the commercial collaboration of the two countries and the number of Greek Macedonian companies trading in the markets of North Macedonia, national TM registrations are common practice. In particular, the economic relations and cooperation of the two countries have resumed to such an extent that Greece is now considered one of the Republic's most important foreign economic partners and investors.<sup>44</sup> Even though up until today, there is no evidence of a “Macedonia” national TM invalidation or refusal under the aforementioned provisions, this is not an unlikely scenario in the future.

## 6. TRADE MARK CONFLICTS BETWEEN THE COUNTRIES

One of the biggest concerns after the Prespa Agreement is the possible TM conflicts between the two countries, mostly after the entrance of the Republic of North Macedonia in the EU. In view of that, lawyers and legal practitioners in Greece encourage entrepreneurs to file applications in the EUIPO in order to secure their priority in relation to upcoming registrations from North Macedonian businesses. As long as the three years' time-period is pending, priority will play a detrimental role when it comes to TM conflicts since both parties will try to claim their priority first for TMs with the term “Macedonia”.<sup>45</sup>

The right to priority is found in Article 4 of the Paris Convention:

*“[any] person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a TM, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.”*

Similarly, the right to priority is found in Article 8(2) of the EUTMR:<sup>46</sup>

*“[W]here earlier TMs are defined as TMs with a date of application for registration which is earlier than the date of application for registration of the EUTM. Such TMs could be:*

- (i) EUTMs;
- (ii) TMs registered in a Member State, or, in the case of Belgium, the Netherlands or Luxembourg, at the Benelux Office for Intellectual Property;
- (iii) TMs registered under international arrangements which have effect in a Member State;
- (iv) TMs registered under international arrangements which have effect in the Union.”

<sup>39</sup> Article 7(1) (c) and (j) of the Regulation (EU) 2017/1001 of the European Parliament and of the Council 14 June 2017 on the European Union trade mark.

<sup>40</sup> Interim Agreement between the European Community and the former Yugoslav Republic of Macedonia, on reciprocal, recognition, protection and control of wine names and the reciprocal recognition, protection and control of designations for spirits and aromatised drinks (Annex II, III). “Wine Bilateral Agreements with third countries”, [https://ec.europa.eu/agriculture/wine/third-countries\\_en](https://ec.europa.eu/agriculture/wine/third-countries_en) [accessed 21 October 2019].

<sup>41</sup> Article 177(1) (8), Law on Industrial Property by the Former Yugoslav Republic of Macedonia (2009), (Inowadays North Macedonia).

<sup>42</sup> TM View Database, <https://www.tmdn.org/>

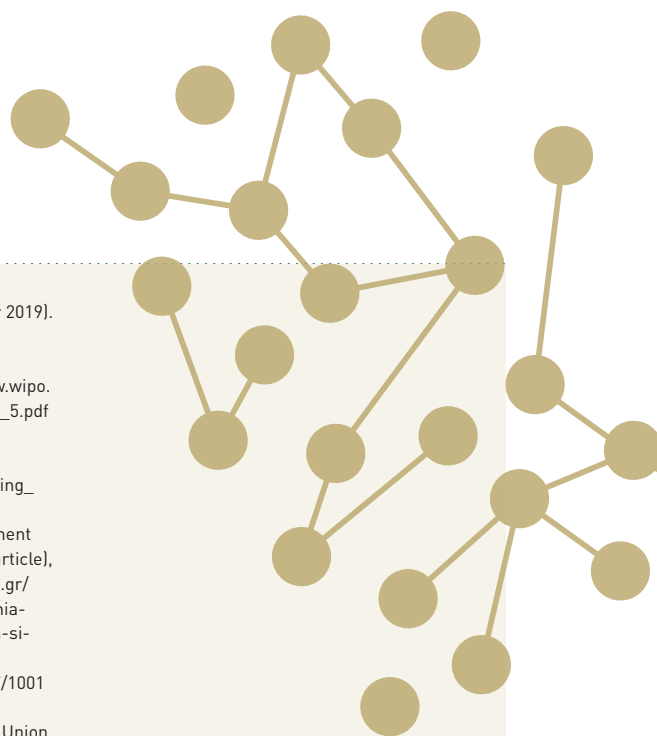
[tmview/welcome](https://www.tmdn.org/tmview/welcome) [accessed 21 October 2019].

<sup>43</sup> “Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications”, [https://www.wipo.int/edocs/mdocs/sct/en/sct\\_38/sct\\_38\\_5.pdf](https://www.wipo.int/edocs/mdocs/sct/en/sct_38/sct_38_5.pdf) [accessed 14 November 2019].

<sup>44</sup> “Macedonia naming dispute”, [https://en.wikipedia.org/wiki/Macedonia\\_naming\\_dispute](https://en.wikipedia.org/wiki/Macedonia_naming_dispute) [accessed 21 October 2019].

<sup>45</sup> “St. koutchohinas, the Prespa Agreement and the value of trademarks”, (Greek article), Economy 365, <http://www.economy365.gr/article/85940/st-koytsohinas-h-symfonia-ton-prespon-kai-i-axia-ton-emporikon-simatou> [accessed 21 October 2019].

<sup>46</sup> Article 8(2) of the Regulation (EU) 2017/1001 of the European Parliament and of the Council 14 June 2017 on the European Union trade mark.





Furthermore, the EUIPO, when assessing a TM application, recognizes not only a priority claim but also a seniority claim and an exhibition priority claim. In particular, a TM proprietor can claim the seniority of the TM when the proprietor already holds a prior identical national or international TM registration with effect in one or several Member States for identical goods or services. The proprietor can raise the claim even if the earlier TM has not been renewed. In addition, a TM proprietor can claim priority when he/she has displayed goods or services under the mark applied for at an officially recognised exhibition.<sup>47</sup>

From the aforementioned, it becomes clear that when an earlier TM is similar or identical to a later mark for goods and services that are similar or identical, the earlier mark will prevail. This is also found in Article 60(1)(a) of the EUTMR where it is stated that a EUTM shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where there is an earlier TM as referred to in Article 8(2) and the conditions set out in paragraph 1 or 5 of that Article are fulfilled.<sup>48</sup>

Once the Republic of North Macedonia becomes a Member State of the EU, the proprietors of national TMs could claim their seniority from the TM registrations in the national office. This could constitute an obstacle taking into consideration the amount of Greek “Macedonian” unregistered TMs contrary to the number of national TM registrations from North Macedonian entrepreneurs. Besides that, likelihood of confusion between the marks and the goods and services must be established when it comes to infringement cases.

As means of defence and possible grounds for opposition, Greek Macedonian producers who use the term “Macedonia” in the course of trade, but have not yet registered their marks at a national or international level, could still claim protection. In particular, under article 8(4) of the EUTMR

*“upon opposition by the proprietor of a non-registered TM or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to Union legislation or the law of the Member State governing that sign: (a) rights to that sign were acquired prior to the date of application for registration of the EUTM, or the date of the priority claimed for the application for registration of the EU trade mark; (b) that sign confers on its proprietor the right to prohibit the use of a subsequent TM.”<sup>49</sup>*

In other words, Greek Macedonian producers who use unregistered TMs could oppose the registration of an EUTM when priority is established and when such marks could be protected under Greek TM law, namely Article 124 (3) (a) of the Law No. 4072/2012 on Trademarks.

In conjunction with that, one of the most prominent requirements of Article 8(4) of the EUTMR is the existence of prior use of the TM in the course of trade where there is more than mere local significance. According to the guidelines of the EUIPO the criterion of

*“‘more than mere local significance’ is more than just a geographical examination. The economic impact of the use of the sign must also be evaluated. For such evaluation various factors such as the intensity of use (sales made under the sign), the length of use, the spread of the goods (location of the customers) and the advertising under the sign and the media used for that advertising, including the distribution of the advertising are taken into account.”<sup>50</sup>*

For Greek Macedonian producers who have already established a strong and stable presence in the Greek markets and more specifically in Macedonia, reaching the threshold of the criterion would be feasible. Great examples of well-known Greek Macedonian companies are “MEVCAL” and the famous wine producer “BOUTARIS” whose products are sold and exported not only in Greece but also in EU countries. Following that, increasing the advertising campaigns and sales of Greek Macedonian companies as well as raising awareness about unregistered TMs would be beneficial alongside their registration at the EUIPO.

<sup>47</sup> EUIPO PPT “How to avoid deficiencies RCD”, Seminar IP For You, Athens 8 October 2019 and “Application and Registration Procedure”, EUIPO, <https://euipo.europa.eu/ohimportal/en/application-procedure> [accessed 18 November 2019].

<sup>48</sup> Article 60(1)(a) of the Regulation (EU) 2017/1001 of the European Parliament and of the Council 14 June 2017 on the European Union trade mark.

<sup>49</sup> Article 8(4) of the Regulation (EU) 2017/1001 of the European Parliament and of the Council 14 June 2017 on the European Union trade mark.

<sup>50</sup> EUIPO Trade Mark Guidelines, Part C,

Section 4, <https://guidelines.euipo.europa.eu/1004922/903985/trade-mark-guidelines/section-4-rights-under-article-8-4--and-8-6--eutmr> [accessed 21 October 2019].

<sup>51</sup> Heather Ann Forrest, “Protection of Geographic Names In International Law and Domain Name System Policy”, Wolters Kluwer Law & Business, 2013, p. 180.

<sup>52</sup> “Mitsotakis to Zaev, I wouldn’t sign the Prespa Agreement”, (Greek Article), [iefimerida.gr, https://www.iefimerida.gr/politiki/kyriakos-mitsotakis-zoran-zaev-syneleysi-toy-oiie](https://www.iefimerida.gr/politiki/kyriakos-mitsotakis-zoran-zaev-syneleysi-toy-oiie) [accessed 21 October 2019].

<sup>53</sup> “France halts EU enlargement”, [euractiv.com, https://www.euractiv.com/section/](https://www.euractiv.com/section/)

[enlargement/news/france-halts-eu-enlargement/](https://enlargement/news/france-halts-eu-enlargement/) [accessed 21 October 2019].

## 7. CONCLUDING REMARKS

According to Heather Ann Forrest,

*“the naming dispute was a unique constellation as it has highlighted the importance of a country’s sovereignty which gives the State not only the authority to choose a name, but also to limit others’ use of the selected name within its territory.”<sup>51</sup>*

In this case, a fair balance had to be made between the two countries. After the Prespa Agreement and the final solution of the naming dispute, a new conflict arose regarding the products of the two countries and the use of the name “Macedonia” to identify them.

In a series of recent upcoming new items and opinions regarding the future of these products, some of the important aspects of TM and GI law regarding the aforementioned conflict have been highlighted; the difficulties of reaching the threshold of coexistence between the homonymous GIs; the problem of assessing the validity of TMs consisting of or containing the geographical name “Macedonia”; the possible ways of avoiding refusal under the absolute grounds for refusal; and the importance of priority when TMs are in conflict. With that in mind, it is not much to suggest that the “Macedonian” products conflict has been a great example of the importance of IP rights in our lives. TM and GI protection play a significant role not only in the economic and commercial development of a country but also its need to secure social, cultural, and historical values that lay under one name, in this case the name “Macedonia”. In addition, given the number of agricultural products designated by the name “Macedonia”, one can see the intrinsic connection between TM and GI protection on the one hand and the food and agricultural production of a country, on the other. As in any other TM or GI dispute, the assessment of the conflicting factors will be on a case by case basis. During this process, it is possible for both parties to aim for mutually beneficial solutions based on the common need for a distinction between the “Macedonian” products of each country. Even though no safe conclusions can be drawn since the dispute is pending, the analysis provides a solid framework of the application of legal IP rules in “Macedonia” conflict between the two countries and the difficulties



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that may arise.

Lately, the Greek Prime Minister Kiriakos Mitsotakis has made clear to the Prime Minister of North Macedonia, Zoran Zaev that the biggest priority after the Prespa Agreement is to find a solution regarding the TMs and GIs with the name “Macedonia”.<sup>52</sup> In the meantime, the entrance of North Macedonia to the EU is still pending with the Greek Prime Minister reluctant in absence of safe solutions regarding the future of the “Macedonian” products. Also, given France’s veto to North Macedonia’s accession to the EU, one could easily notice the important role of the TM and GI conflict in the future of a whole country.<sup>53</sup> Could TM and GI protection have a bigger role from a political perspective as well? What would the team of experts bring to the table regarding the “Macedonian” products conflict? Will the two countries still be able to use the term “Macedonia” to identify their products or will the right to use and register the term be granted to only one of them? Lastly, could this conflict between the two neighbouring countries be the cause of new amendments in TM and GI legislation? The outcome of the conflict is yet uncertain and only the future will tell if the conclusions of this article were drawn correctly and in the right direction.

