

# INTERPLAY BETWEEN TMs AND GIs

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## TMs

Individual

Collective

Certification

## GIs

Nature

Means of protection

Scope of protection

Ex-officio examination  
of TM applications

GIs as earlier rights

## COLECTIVE MARKS



Similar outside, some differences inside

Article 74(1) EUTMR –Definition

**‘EU trade mark described as such when the mark is applied for and is capable of distinguishing the goods or services of the members of the association which is the proprietor of the mark from those of other undertakings’**

# COLECTIVE MARKS

Description

Regulations of Use

Ownership

Specific ground of refusal: Misleading

Together with their individual marks to indicate that undertakings belong to a certain association, identify origin of G&S but collective origin

## The ‘geographic origin exception’

Derogation from Article 7(1)(c) ...signs or indications that may serve, in trade, to designate the geographical origin of the goods and services may constitute EU collective marks subject to a safeguard declaration.



## CERTIFICATION MARKS – EU LEVEL



Description

Regulations of Use

Ownership

Specific ground of refusal:  
Misleading

Art. 83 (1) EUTMR: An EU certification mark shall be described as such [...] and is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, with the exception of geographical origin, from goods and services not so certified. (2) Any natural or legal person may apply [...] provided that such person does not carry on a business involving the supply of goods or services of the kind certified.

# GEOGRAPHICAL INDICATIONS



## GEOGRAPHICAL INDICATIONS - Scope of protection

- Valuable **Intellectual Property Right** (collective right)
- Protection to the **name** not to the product
- Against any **misuse, imitation or evocation** and any other practice liable to mislead the consumer, if earlier in time
- Right to use: applies to **any operator** within the geographical area respecting product specification
- Protection **unlimited in time** (but possibility of cancellation compliance with the product specification is no longer ensured)

## GEOGRAPHICAL INDICATIONS - Actors/Benefits

- **Name is reserved** to products respecting the specification
- **Name is not reserved to 1 single owner**, but can be used by **all producers respecting the specification**
- **Administrative protection** by public authorities
- Differentiation on the market allows often a **better price** and better division of the **added value**



	GIs	Individual TM	Collective TM	Certification TM
Definition	Name or indication which <b>identifies a product with specific geographical origin</b>	Distinguishing the goods or services of <b>one undertaking</b> from those of other undertakings	Distinguishing the goods or services of the <b>members of an association</b> from those of other undertakings	Distinguishing goods or services <b>certified by the proprietor</b> from those not so certified
Essential Function	Geographical Origin	Commercial Origin	Collective Commercial Origin	Compliance with Certification Scheme
Geo Terms	<b>YES</b>	<b>NO</b>	<b>YES</b>	<b>NO (EU)</b> <b>YES (National)</b>
Right To Use	Any operator complying with specifications	Proprietor and Licensees	Association Members <b>Bona Fide Third Parties</b>	Certified Users <b>Bona Fide Third Parties*</b> <b>Not the Proprietor</b>

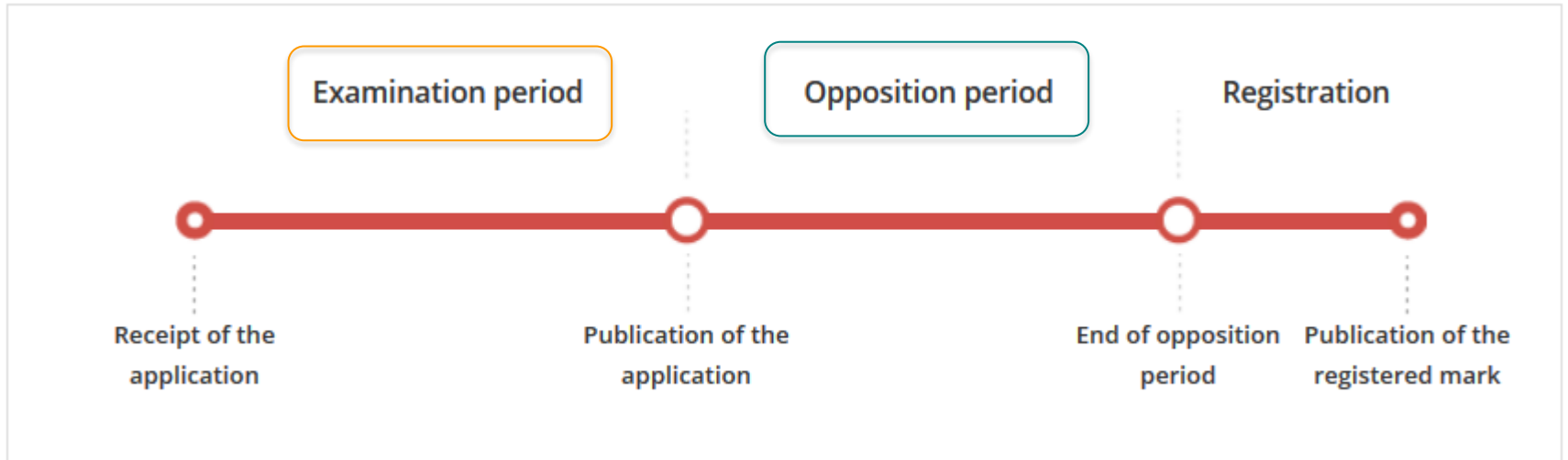
# REGISTRATION PROCES EUTM

## EX OFFICIO EXAMINATION

Conflict with, among others,  
protected geographical indications  
Article 7(1)(j) EUTMR

## INTER PARTES PROCEEDINGS

Protected geographical indication invoked  
as an earlier right by  
opponent/cancellation applicants  
Article 8(6) EUTMR



## EU legislation GIs

- Regulation (EU) No 1308/2013 - *wines*;
- Regulation (EU) 2019/787 - *spirit drinks*;
- Regulation (EU) No 1151/2012 - *agricultural products and foodstuffs*.
  
- GIs that enjoy protection in the EU through **international agreements to which the EU is a party** Article 7(j) EUTMR.

## GIs from third countries in the EU

- GIs registered directly
  - Tequila [PGI-MX-01851]
  - Café de Colombia [PGI-CO-0467]
  - Darjeeling [PGI-IN-0659]
  - Napa Valley [PDO-US-17738]
  - Basmati [Published: PGI-IN-2425]
- International Agreements with EU (1,554)
  - Villa Alegre, Wine, Chile

## EUIPO PRACTICE TO COME

### GEOGRAPHICAL INDICATIONS – GENEVA ACT

Council Decision (EU) 2019/1754 of 7 October 2019 approved the accession of the EU to the Geneva Act of the Lisbon Agreement on Appellations of Origin and GIs which entered into force on 26 February 2020.

GIs from non-EU countries protected at EU level via the Geneva Act:

- can form basis for objections pursuant to Article 7(1)(j) EUTMR, and
- can be relied on in oppositions under Article 8(6) EUTMR.

## EUIPO's LEGAL FRAMEWORK

### ARTICLE 7(1)(j) EUTMR:

*(1) The following shall not be registered:*

*(j) trade marks which are excluded from registration, pursuant to **Union legislation or national law** or to **international agreements** to which the Union [...] is party, providing for protection or designation of origin and GIs.*

### Three cumulative conditions for Article 7(1)(j) EUTMR to apply:

- The GI must be registered

**GI**view

- Trade mark application must be in conflict with a GI
- Goods applied for must be identical, comparable to those covered by the GI (or a good in which the GI product is a commercially relevant ingredient)

## GEOGRAPHICAL INDICATIONS AND ABSOLUTE GROUNDS

<u>Product Areas</u>	EU law*	National law**
Foodstuffs, Agricultural products, Wines, Spirit drinks and Aromatised wines	Yes	no
Non-agricultural field (e.g. handicraft)	n/a	Yes

\*Including international agreements concluded by the EU

\*\*Including international agreements concluded by MS

## PROHIBITIONS –LINK TO EU REGULATIONS -TERMINOLOGY

**Commercial  
Use**

**Misuse  
Imitation  
Evocation**

**False  
Misleading  
Indications  
or practices**

- Graduated list of prohibited conducts (from least to most subtle link with GI)
- Apply in situations of registration or commercial use (ex officio/opposition/cancellation).
- EUIPO interprets them to set a high degree of protection of GIs
- BUT balance of rights: effective protection GIs vs rights of bona fide trade mark applicants

Art. 13 R1151/2012  
Art. 103 R1308/2013  
Art. 21 R2019/787



## General remarks: how EUIPO interprets EU Regulations

### Commercial Use (direct or indirect)

- Trade mark contains/consists of the GI
- High degree of visual and aural similarity (*Scotch Whisky*)
- Scope of protection extended to dissimilar goods and services if **exploitation** of reputation of GI proven

### Misuse Imitation Evocation

- Public establishes a sufficiently clear and direct link between TM and GI (*Verlados*)
- Visual, aural or conceptual similarity e.g. terms share characteristic beginning or ending, conceptual proximity (*Scotch Whisky*)
- Indicators of the true origin of the product not to be taken into account

### False Misleading Indications or practices

- Whether or not an indication (an element in the trademark, word, image, container) is 'liable to convey a false impression as to [the product's] origin or to the nature or essential qualities of the product' (*Scotch Whisky*)

## HOW TO INTERPRET THESE CONCEPTS? CASE – LAW

- **C-44/17 SCOTCH WHISKY/GLEN BUCHENBACH, 07.06.2018**

- The Scotch Whisky Association contested the marketing (via website) of whisky – not Scotch whisky – sold under the designation ‘Glen Buchenbach’.
- ECJ addressed the conducts under Article 16(a) to (c) of R110/2008 (commercial use, evocation base on conceptual proximity, misleading indications and context of use)



- **C-614/17 QUESO MANCHEGO/ ROCINANTE, 02.05.2019**

- Queso Manchego Foundation invoked Article 13(1)(b) of R510/2006 against labels bearing the word ‘Rocinante’ & including pictorial elements typical of the region of “La Mancha”, used to market cheese not conforming with the specifications of the PDO ‘queso manchego’.
- ECJ: a registered PDO may be evoked through the use of figurative signs (such as the image of the literary character Don Quixote de La Mancha), irrespective of whether the goods originate from a producer established in that region, but whose (similar or comparable) products do not comply with the PDO.



# Change of practice on GI limitations in G&S 2022

## SITUATIONS COVERED BY EU REGULATIONS

Use

Misuse  
Imitation  
Evocation

False  
Misleading  
Indications,  
practices

- Graduated list of prohibited conducts (from the strongest to the most subtle link with GI)
- Apply in situations of registration or commercial use (*ex officio/opposition/cancellation*)
- EUIPO interprets them to set a high degree of protection of GIs
- BUT balance of rights: effective protection GIs vs rights of bona fide trade mark applicants – *Objection suggesting limitation*

## CURRENT PRACTICE ON SUGGESTED LIMITATIONS

- Applicant may overcome the objection by **limiting the identical goods and/or goods where GI is a relevant ingredient** to comply with the product specifications of the GI

*The proper wording is '[type of product] complying with the specifications of the [PDO 'X']/PGI 'X']'. No other wording should be proposed or allowed.*

- No limitation is possible for **comparable** goods as they cannot comply with the product specifications

## CURRENT PRACTICE ON SUGGESTED LIMITATIONS

Conflicting GI	Original list of goods	Limitation according to current practice
<p><b>POMME DU LIMOUSIN</b> PDO-FR-0442 (apples)</p>	<p>Preserved, frozen, dried and cooked fruits</p>	<p>Preserved, frozen, dried and cooked <u>apples complying with the specifications of the PDO ‘Pomme du Limousin’</u></p>
<p><b>TEQUILA</b> PGI-MX-01851 (agave spirit drinks)</p>	<p>Spirit drinks</p>	<p>Agave spirit drinks <u>complying with the specifications of the PGI ‘Tequila’</u></p>
<p><b>PROSCIUTTO DI PARMA</b> PDO-IT-0067 (ham)</p>	<p>Pizzas</p>	<p>Pizzas <u>with ham complying with the specifications of the PDO ‘Prosciutto di Parma’</u></p>
<p><b>SLOVÁCKÁ</b> PDO-CZ-A0890 (wine)</p>	<p>Wines, spirits</p>	<p>Wine <u>complying with the specifications of the PDO ‘Slovácká’, spirits</u></p>

## PROPOSED PRACTICE ON SUGGESTED LIMITATIONS

- Simplification and homogenization of the wording of limitations suggested by AG examiners
- Flexibility as to the wording of the limitation

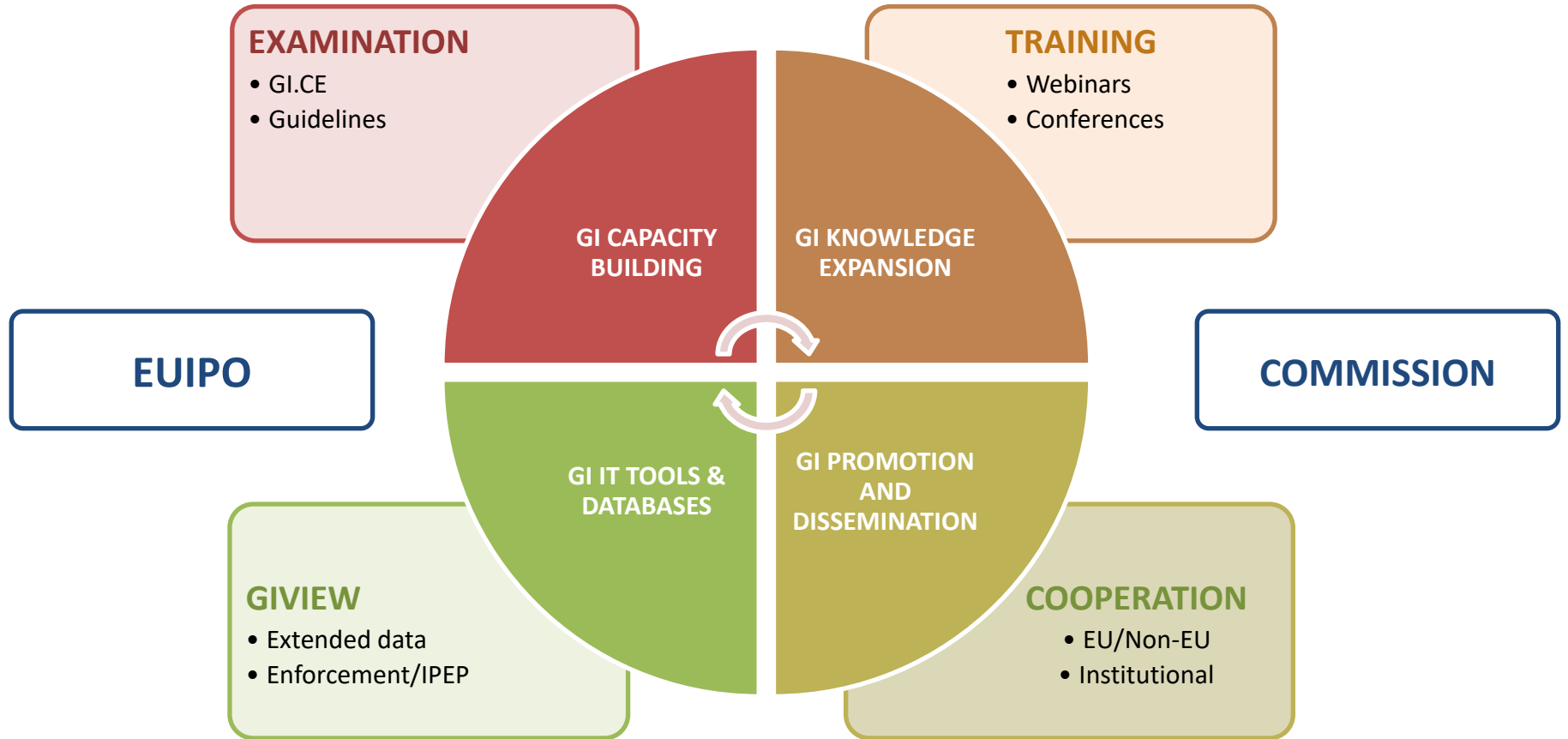
*The wording recommended by the Office is '[GI name] (GI) [product covered by the GI]'. Other limitations are, however, acceptable as long as the applicant clearly identifies the GI and the use thereof.*

## PROPOSED PRACTICE ON SUGGESTED LIMITATIONS

Conflicting GI	Original list of goods	Limitation according to new practice
<b>POMME DU LIMOUSIN</b> PDO-FR-0442 (apples)	Preserved, frozen, dried and cooked fruits	Pomme du Limousin (GI) apples preserved, frozen, dried and cooked
<b>TEQUILA</b> PGI-MX-01851 (agave spirit drinks)	Spirit drinks	Tequila (GI) agave spirit drinks
<b>PROSCIUTTO DI PARMA</b> PDO-IT-0067 (ham)	Pizzas	Pizzas with Prosciutto di Parma (GI) ham
<b>SLOVÁCKÁ</b> PDO-CZ-A0890 (wine)	Wines; spirits	Slovácká (GI) wines; spirits



# **GEOGRAPHICAL INDICATIONS at the EUIPO**



# GI CAPACITY BUILDING



## G-ICE

- Dedicated experts
- Continuous knowledge sharing
- Peer review



## EXAMINATION

- Food
- Wine
- Spirit drinks
- Bilateral
- Lisbon Agreement / Geneva Act

+ Examination – GIs & TMs relationship

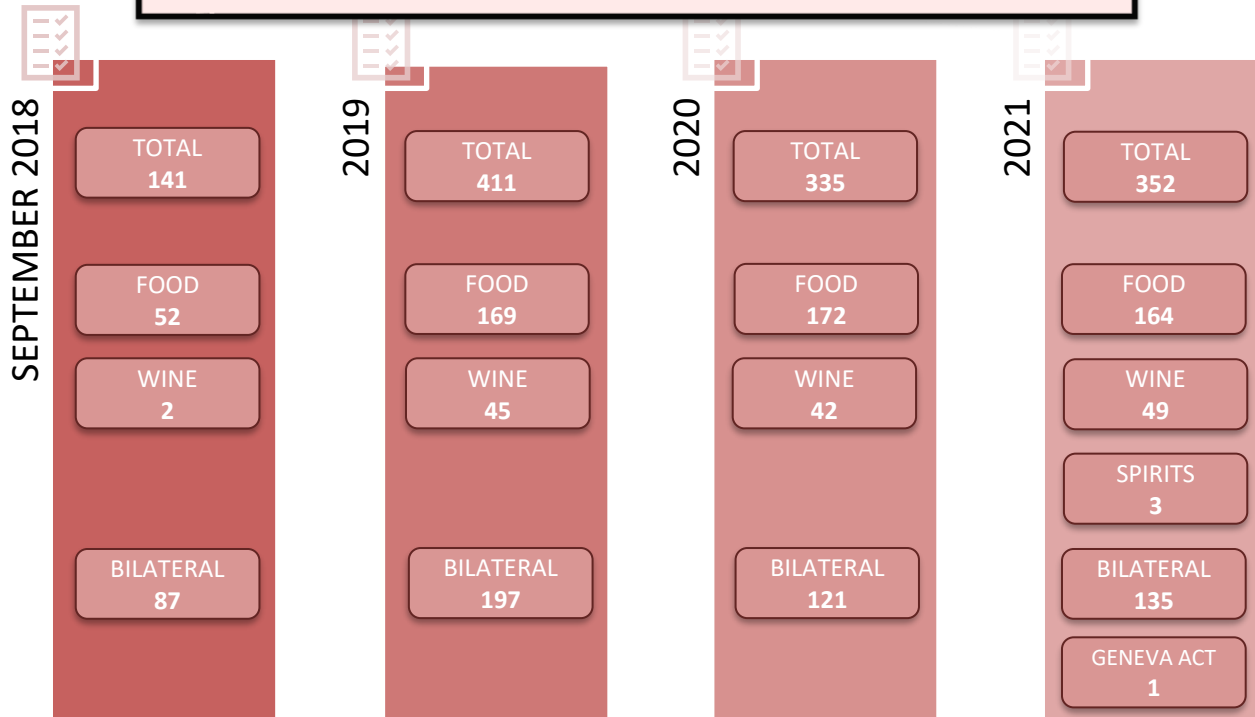


## GUIDELINES

- Input
- Revision
- Examples
- Training

# GI CAPACITY BUILDING

FILES EXAMINED/4 YEARS = 1.239



# GI KNOWLEDGE EXPANSION



## TRAINING

- Training provided by AGRI
- Training provided by WIPO



## WEBINARS

- On GIs
- On recent GI case-law
- On relationship with TMs



## CONFERENCES

- 2018 conference
- 2020 conference

# GI PROMOTION & DISSEMINATION



- Training to EU GI competent authorities
- IPOs on GIs



- IP KEYs on GIs
- Asia, Africa, Caribbean, etc.



- COM
- DG AGRI
- DG GROW
- DG TRADE

# GI IT TOOLS & DATABASES



## OFFICIAL DATA

- eAmbrosia
- Bilateral agreements
- Protection in the EU and beyond



## EXTENDED DATA

- Competent authority
- Producer groups
- Maps
- Photos, etc.



## ENFORCEMENT

- IPEP link
- Information for control bodies
- Information to public

# GIView

<https://www.tmdn.org/giview/>

[GIview video](#)

Μαστίχα Χίου / Masticha Chiou



**Country/ies of origin**

Greece

**Priority date**

24/01/1997

**Status**

Registered

**Type**

Protected Designation of Origin (PDO)

**File number**

PDO-GR-1558

**Product type**

Food

**Basis of protection**

EU register

**Product category**

Class 2.7. Natural gums and resins

Dalmatinski pršut



**Country/ies of origin**

Croatia

**Priority date**

03/03/2014

**Status**

Registered

**Type**

Protected Geographical Indication (PGI)

**File number**

PGI-HR-01205

**Product type**

Food

**Basis of protection**

EU register

**Product category**

Class 1.2. Meat products (cooked, salted, smoked, etc.)





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Thank you