



TECHNICAL ASPECTS OF RELATIONSHIP BETWEEN GIS AND TMS

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CARIFORUM



EU-CARIFORUM Regional project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

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TMs

Individual

Collective

Certification

PGIs

Nature

Means of
protection

Scope of protection

Ex-officio
examination of TM
applications

PGIs as earlier
rights

PROTECTING TMS WITHIN THE EU

**‘Traditional’ approach
(national marks state-
by-state)**

- Harmonization of different national TM laws within EU (AG, RG, requirement of use, right to prohibit use of later TMs)

The EU system

- A registered EU trade mark (‘EUTM’) (one register [EUIPO], one application and one registration proceeding, uniform protection across EU)

**Interplay (‘coexistence’)
between EU and
national TM protection**

- National offices and courts treat EUTM as valid unless cancellation action pending (at national or at EU level)
- EUTM to be refused if AG applies only in part of EU
- EUTM may be refused on basis of earlier national rights

a. Legal instrument: EU Directive (EU) 2015/2436 ('TMD')

- to be 'transposed' into national law by all Member States

b. Legal instruments: EU Regulations

- ETMR (EU) 2017/1001; EUTMDR (EU) 2018/625 and EUTMIR (EU) 2018/626 - directly applicable

c. CJEU

- national courts request CJEU's interpretation
- Appeals from EUIPO

-
- a. **Main function of a TM:**
- **Identify the commercial origin of G&S**
 - **Distinguish G&S from those offered by other undertakings**
 - **Important for provider and consumer of G&S**
- b. **Additional functions possible (e.g. guarantee of quality, communication, advertising, image, investment)**

TM confers exclusive right and to prohibit use by competitors of (later) identical or similar marks:

- when consumer would be confused as to business origin of the G&S

Ex.: PICO – PICCO (both for medical devices)

- when a TM's reputation acquired on the market would be exploited or diluted without justification

Ex.: goods made of leather

- no limitation in time (TMs can be renewed)

ReejBori

Ray-Ban

COLLECTIVE 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’

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



Article 83 EUTMR - Definition

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.

GIS - OVERVIEW

- **PDO:** Protected Designation of Origin
- **PGI:** Protected Geographical Indication



= Geographical Indications (GIs)



GEOGRAPHICAL INDICATIONS

1. Defined geographical area + 2. Specific product + 3. Link between 1. and 2. = **PDO**
PGI



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**

GEOGRAPHICAL INDICATIONS – CONSUMER/BENEFITS

- Has a guarantee about:
 - **Origin** of the product
 - **Quality** of the product (specification)
 - **Authenticity** of the product (no imitation)
- Guarantee is **assured by controls** on production site and on the market.
- Quality schemes prevent the standardization of wine products and offers a **wider choice** to consumers

- **Rural development**
 - In particular GIs encourage the preservation of:
 - **Biodiversity**
 - **Local savoir-faire and tradition**
 - **Landscapes** → positive impact on tourism
 - As an important part of our **culture**, GIs contribute to social cohesion, rural development

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

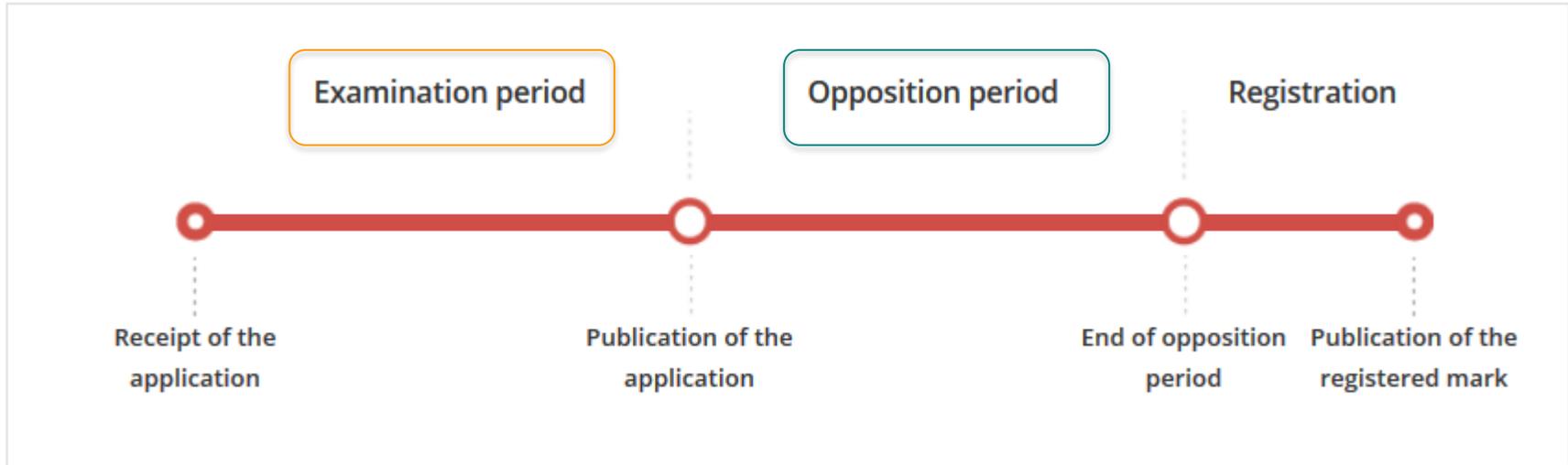
REGISTRATION PROCESS EUTM

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) No 251/2014 - *aromatised 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

- 33 non-EU* GIs registered directly
 - Café de Valdesia [PDO-DO-1197]
 - Trinidad Montserrat Hills Cocoa [Applied: PGI-TT-2442]
- International Agreements with EU (1,554)
 - Villa Alegre, Wine, [Chile](#)

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.

GEOGRAPHICAL INDICATIONS AND ABSOLUTE GROUNDS

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

*Including international agreements concluded by the EU

**Including international agreements concluded by MS

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

A protected designation of origin and protected geographical indications, as well as the wine using that protected name in conformity with the product specification, shall be protected against:

- (a) any direct or indirect commercial use of that protected name:
 - (i) by comparable products not complying with the product specification of the protected name; or
 - (ii) in so far as such use exploits the reputation of a designation of origin or a geographical indication;
- (b) any misuse, imitation or evocation, even if the true origin of the product or service is indicated or if the protected name is translated, transcribed or transliterated or accompanied by an expression such as ‘style’, ‘type’, ‘method’, ‘as produced in’, ‘imitation’, ‘flavour’, ‘like’ or similar;
- (c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product, on the inner or outer packaging, advertising material or documents relating to the wine product concerned, as well as the packaging 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.

PROHIBITIONS – LINK TO EU REGULATIONS - TERMINOLOGY

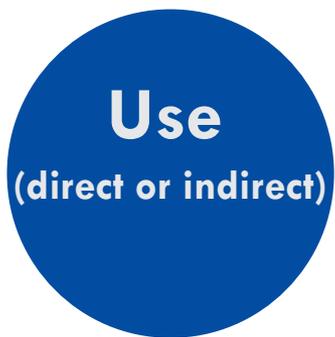
**Commercial
Use**

**Misuse
Imitation
Evocation**

**False
Misleading
indications**

- Graduated list of prohibited conducts (from least to most subtle link with GI)
- Identically interpreted 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. 20 R252/2014
Art. 21 R2019/787



Use
(direct or indirect)

- Trademark contains/consists of the GI
- High degree of visual and aural similarity
- Identical products, also covers:
 - commercially relevant ingredient (may determine the choice of the main product e.g. apples v jam)
 - the specific object a services e.g. honey v. retail of honey)
- ‘Comparable products’ – restrictive, independent of ‘similarity’ concept in RG .
- (dissimilar in RG)

EXAMPLE: IDENTITY (USE)



EUTMs No 11 907 334 and No 2 281 970



Goods and Services

Alcoholic beverages (except beer)



Potential issues

Possible conflict with geographical indication

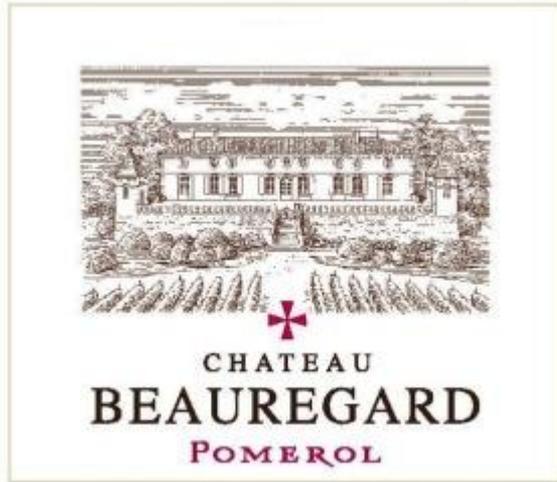
Porto / Port / vinho do Porto / Port Wine / vin de Porto / Oporto / Portvin / Portwein / Portwijn (PDO-PT-A1540)



Result

Application registered (after limitation to *Wines in conformity with the specifications of the protected geographical indication 'OPORTO'*; Alcoholic beverages (except beers and wines)

EXAMPLE: IDENTITY (USE)



EUTM No 17 889 185



Goods and Services

Wines



Potential issues

Possible conflict with geographical indication
POMEROL (PDO-FR-10273)



Result

Application registered (after limitation)

EXAMPLE: IDENTITY (USE)

LEMBERGERLAND



Goods and Services

Cl. 33 'alcoholic beverages (except beers)'



Potential issues

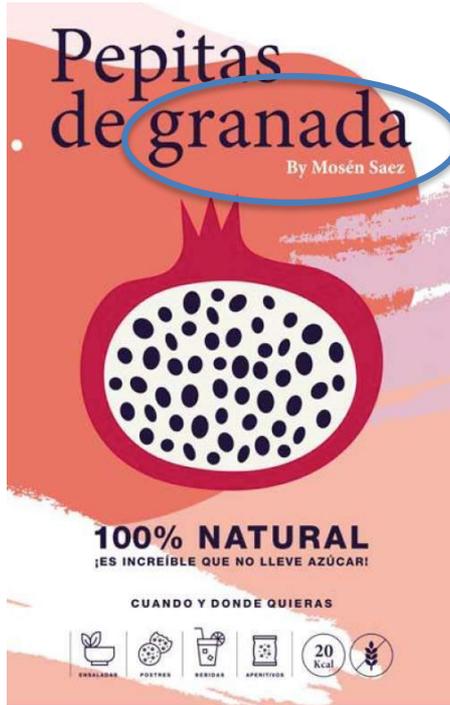
Possible conflict with geographical indication
LEMBERG – Annex II Agreement between EU and the
Republic of South Africa

Result

Deletion of Class 33 limitation

EUTM No 11134947

EXAMPLE: NO CONFLICT



EUTM No 18 080 466



Goods and Services

Inter alia, agricultural products, non-alcoholic and alcoholic beverages



Potential issues

Conflict with geographical indication GRANADA (PDO-ES-A1475) for wines?



Result

GRANADA in Spanish refers both to “pomegranate” and to the geographical place in Andalucía. In the sign, the reference to “granada” is clearly to the fruit. No conflict

EXAMPLES: OPPOSITION – IDENTITY (USE)

PROSECCO PRINCESS

EUTM No 17 203 274



Contested goods and services

Services in Class 35 (e.g. *retail of alcoholic beverages, rental of sales stands, consultancy*) and Class 43 (e.g. *providing food and drink, temporary accommodation*)



Opposition

Consorzio di Tutela della Denominazione di Origine Controllata Prosecco argued that the sign exploited the reputation of PROSECCO (PDO-IT-A0516)



Result

In light of evidence and arguments of the opponent, the opposition was upheld.

HOW TO INTERPRET THESE CONCEPTS? RECENT 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.



Imitation
Evocation
Misuse

- Misuse: false indications
- Imitation and evocation: overlapping terms
- Evocation: the public establishes a sufficiently clear and direct link between the term in the TM and the GI (*Verlados*)
- Visual, aural or conceptual similarity e.g. terms share characteristic beginning or ending, conceptual proximity (*Scotch Whisky*)
- Not cumulative conditions: mere conceptual proximity enough, e.g. via use of figurative signs (*Queso Manchego*)
- Indicators of the true origin of the product not to be taken into account (*Scotch Whisky*)
- Excludes attacking dissimilar goods and services? (TBD – *Champagne / 'Champanillo' on tapas bars*)

EXAMPLE: EVOCATION



EUTM No 15 420 607



Goods and Services

Whisky; Blended whisky; Whisky liqueurs



Potential issues

Possible conflict with geographical indication
SCOTCH WHISKY (PGI-GB-01854)



Result

Application registered after limitation to “all
aforementioned goods complying with the
specifications of the PGI Scotch Whisky”

EXAMPLE: EVOCATION



EUTM No 18 015 193



Goods and Services

Inter alia, tomatoes



Potential issues

Possible conflict with geographical indication
POMODORINO DEL PIENNOLO DEL VESUVIO
(IT/PDO/0005/0576)



Result

Application registered after limitation to products
complying with the specification of the GI

EXAMPLE: EVOCATION

PDO 'CHIANTI CLASSICO' →



PDO 'GORGONZOLA' → 'CAMBOZOLA'

EXAMPLE: NO CONFLICT

Cavalcade

EUTM No 17 929 998



Goods and Services

Wines



Potential issues

Conflict with geographical indication CAVA (PDO-ES-A0735)?



Result

The public will not dissect artificially the sign, perceive the term CAVA and link it to the wine. No conflict



Other
misleading
practices

- Test: whether or not an indication (an element in the trade mark, 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*)
- Does it extend to reproduction of the shape or the appearance which are characteristic of a product? (TBD – *Morbier*)
- The context in which the possible misleading indication is used is not to be taken into account (*Scotch Whisky*)
- The Office relies on third party observations

EXAMPLES: MISLEADING



EUTM No 018 022 404



Goods and Services

Inter alia, non-alcoholic beverages, beer



Potential issues

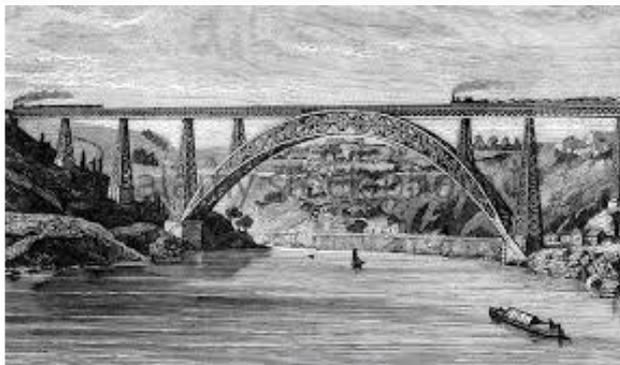
Conflict with the PGI TEQUILA (PGI-MX-01851)

If the mark has 'tequila' on it, it must actually contain real tequila in a determined percentage, so it cannot be applied for goods in Class 32



Result

Application withdrawn after being objected by EUIPO



www.stermy.com - BAE2X6

PDO/PGI	European Union trade mark (invented examples)	Explanation
<p>PORTO (PDO-PT-A1540)</p>	<p>EUTM depicting the 'Dom <u>Luís</u> I Bridge' in the city of Porto</p>	<p>A picture of the Dom <u>Luís</u> I Bridge and its riverside is a well-known emblem of the city of Porto. Use of this image for <i>wines</i> other than those covered by the PDO 'Porto' would fall under Article 103(2)(c) and (d) of Regulation (EU) No 1308/2013.</p>

Situations covered

1. EUTM application **consists** solely of a whole PDO/PGI (**'direct use'**);
2. EUTM application **contains** a whole PDO/PGI in addition to other word or figurative elements (**'direct or indirect use'**);
3. EUTM application contains or consists of an **imitation** or **evocation** of a PDO/PGI;
4. Other **misleading** indications and practices;

Use of the EUTM application would exploit the **reputation** of PDOs/PGIs not taken into account in AG.

Limitation will resolve the problem except!

Trade marks in conflict with two or more GIs

Term	Products	Example	Relevant PGI/PDO	Outcome
Different	Identical	RIOJA RIBERA DE DUERO <i>Wine</i>	Rioja (PDO) Ribera de Duero (PDO)	No limitation possible
Identical or similar	Identical	MARIOLA MODENA <i>Vinegar</i>	Aceto Balsamico di Modena (PGI) Aceto Balsamico Tradizionale di Modena (PDO)	Limitation (either, or for both)
Identical or similar	Different	MALLORCA SUN <i>Meat, bread, pastry</i>	Sobrasada de Mallorca (PGI) Ensaimada de Mallorca (PGI)	Limitation (for both)
Identical or similar	Comparable	AXN MODENA <i>Meat</i>	Prosciutto di Modena (PDO) Zampone di Modena (PGI) Cotechino di Modena (PGI)	Limitation (either or for all, deceptive goods deleted)
Homonyms	Identical	PISCO MISTRAL GRAN NOBEL (fig) <i>Pisco</i>	PISCO (Peru) PISCO (Chile)	Limitation (one or the other)

GIs IN RELATIVE GROUND DISPUTES

ARTICLE 8(6) EUTMR

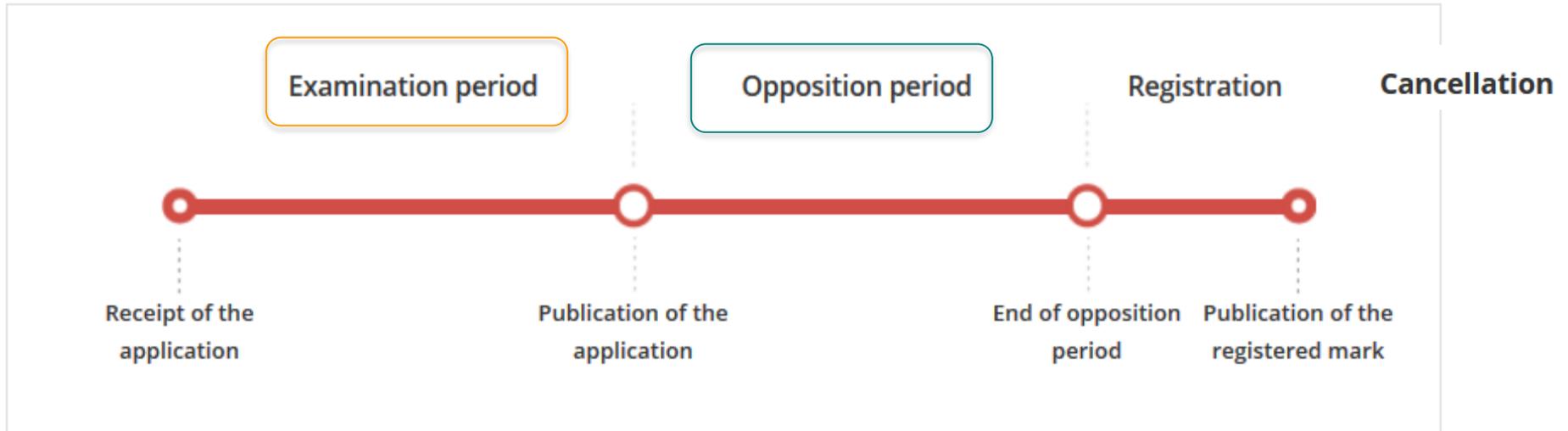
CONTEXT OF EXAMINATION OF GI/TM CONFLICTS

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



LEGAL CONTEXT – ARTICLE 8(6) EUTMR

Who

Upon opposition **by any person authorised** under the relevant law to exercise the rights arising from a designation of origin or a geographical indication, the trade mark applied for shall not be registered where and to the extent that, pursuant to **the Union legislation or national law** providing for the protection of designations of origin or geographical indications:

- (i) **an application** for a designation of origin or a geographical indication had already been submitted, in accordance with Union legislation or national law, **prior** to the date of application for registration of the EU trade mark or the date of the priority claimed for the application, subject to its subsequent registration;

- (ii) that designation of origin or geographical indication **confers the right to prohibit the use of a subsequent trade mark.**

Legal
basis

International
agreement

Use in
commerce

What earlier
rights

LEGAL CONTEXT – ARTICLE 7(2)(e) EUTMDR SUSTANTIATION OF THE OPPOSITION

the opposing party shall also file evidence of the **existence, validity and scope of protection of its earlier mark or right**, as well as evidence proving its **entitlement to file the opposition**. In particular, the opposing party shall provide the following evidence:

Entitlement
opponent

where the opposition is based on an earlier designation of origin or geographical indication within the meaning of Article 8(6) of Regulation (EU) 2017/1001, evidence of its **acquisition, continued existence and scope of protection including**, where the earlier designation of origin or geographical indication is invoked **pursuant to the law of a Member State, a clear identification of the content of the national law relied upon by adducing publications of the relevant provisions or jurisprudence;**

Substantiation
GI

General
rule

General
rule

Member State
legislation

PROOF OF EXISTENCE AND VALIDITY OF EARLIER RIGHT

GI protected via EU Regulations or EU international agreement

- Proof of the protection/application for protection of the GI (e.g. publication in OJ) with sufficient data to determine all the relevant particulars of the GI (protected name, relevant dates, goods)
- No need to submit copy of the relevant EU Regulation

GI protected at national level (MS legislation – MS international agreements)

- Proof of the protection/application for protection of the GI under national law
- Proof that the protection confers on the beneficiary of the GI a direct right of action against unauthorised use
- Clear identification of the content of the national law (online sources)

In the language of the proceedings!

EXAMPLE – GI protected under EU Regulation

B 3 060 646 PERÚ PISCO BAR (FIG)/PISCO filed by Instituto Nacional de Defensa de la Competencia y de la Protección de la Propiedad Intelectual "INDECOPI" (Perú)

Documents on existence and validity of GI:

- Application for protection of the GI Pisco before the EU Commission
- OJ C series publication of the technical file Pisco with details of the protected goods
- OJ L series publication with the registration of Pisco (i.e. amending Annex III of Regulation No 110/2008 on spirit drinks)

L 289/48 ES Diario Oficial de la Unión Europea 31.10.2013

REGLAMENTO (UE) N° 1065/2013 DE LA COMISIÓN

de 30 de octubre de 2013

que modifica el anexo III del Reglamento (CE) n° 110/2008 del Parlamento Europeo y del Consejo relativo a la definición, designación, presentación, etiquetado y protección de la indicación geográfica de bebidas espirituosas

LA COMISIÓN EUROPEA,

Viso el Tratado de Funcionamiento de la Unión Europea,

Viso el Reglamento (CE) n° 110/2008 del Parlamento Europeo y del Consejo, de 15 de enero de 2008, relativo a la definición, designación, presentación, etiquetado y protección de la indicación geográfica de bebidas espirituosas y por el que se deroga el Reglamento (CEE) n° 1576/89 del Consejo (*), y, en particular, su artículo 17, apartado 8,

Considerando lo siguiente:

- (1) La República del Perú ha solicitado el registro de «Pisco» como indicación geográfica en el anexo III del Reglamento (CE) n° 110/2008, de conformidad con el procedimiento establecido en el artículo 17, apartado 1, de dicho Reglamento. «Pisco» es un aguardiente de fruta tradicionalmente producido en Perú, procedente de la fermentación y destilación de uvas.
- (2) Las principales especificaciones del expediente técnico del «Pisco» se publicaron en el Diario Oficial de la Unión Europea (*) a efectos del procedimiento de oposición, de conformidad con el artículo 17, apartado 6, del Reglamento (CE) n° 110/2008. Puesto que la Comisión no recibió ninguna objeción de conformidad con el artículo 17, apartado 7, del Reglamento (CE) n° 110/2008, la denominación debe incluirse en el anexo III de dicho Reglamento.
- (3) Según el Acuerdo por el que se establece una asociación entre la Comunidad Europea y sus Estados miembros, por una parte, y la República de Chile, por otra,

aprobado mediante la Decisión 2002/979/CE del Consejo (*), «Pisco» es una denominación protegida de bebidas espirituosas originarias de Chile. Procede, por tanto, precisar que la protección de la indicación geográfica «Pisco» para los productos originarios de Perú no entorpezca el uso de dicha denominación para los productos originarios de Chile.

- (4) Procede, por tanto, modificar el Reglamento (CE) n° 110/2008 en consecuencia.
- (5) Las medidas previstas en el presente Reglamento se ajustan al dictamen del Comité de las Bebidas Espirituosas.

HA ADOPTADO EL PRESENTE REGLAMENTO:

Artículo 1

En el anexo III del Reglamento (CE) n° 110/2008, en la categoría de producto «9. Aguardiente de fruta», se añade la entrada siguiente:

	«Pisco (*)»	Perú
(*) La protección de la indicación geográfica «Pisco» en virtud del presente Reglamento se aplicará sin perjuicio de la utilización de la denominación «Pisco» para los productos originarios de Chile protegidos en virtud del Acuerdo de Asociación entre la Unión Europea y Chile de 2002.		

Artículo 2

El presente Reglamento entrará en vigor el día siguiente al de su publicación en el Diario Oficial de la Unión Europea.

El presente Reglamento será obligatorio en todos sus elementos y directamente aplicable en cada Estado miembro.

EU INTERNATIONAL AGREEMENT

Example

Free Trade Agreement
(FTA) EU and Republic of
Korea: **prohibits
misleading practices,
unfair competition**

Opponent does not need
to submit copy of EU
legislation

L 127/48

EN

Official Journal of the European Union

14.5.2011

(a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good;

(b) the use of a geographical indication identifying a good for a like good ⁽¹⁹⁾ not originating in the place indicated by the geographical indication in question, even where the true origin of the good is indicated or the geographical indication is used in translation or transcription or accompanied by expressions such as 'kind', 'type', 'style', 'imitation' or the like; and

(c) any other use which constitutes an act of unfair competition within the meaning of Article 10 bis of the Paris Convention.

2. This Agreement shall in no way prejudice the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where such name is used in such a manner as to mislead consumers.

3. If geographical indications of the Parties are homonymous, protection shall be granted to each indication provided that it has been used in good faith. The Working Group on Geographical Indications shall decide the practical conditions of use under which the homonymous geographical indications will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled. If a geographical

by use, if that possibility is provided for by the legislation concerned, in the territory of a Party before the date of the application for protection or recognition of the geographical indication, provided that no grounds for the trademark's invalidity or revocation exist in the legislation of the Party concerned. The date of application for protection or recognition of the geographical indication is determined in accordance with Article 10.23.2.

Article 10.22

Enforcement of protection

The Parties shall enforce the protection provided for in Articles 10.18 through 10.23 on their own initiative by appropriate intervention of their authorities. They shall also enforce such protection at the request of an interested party.

Article 10.23

Relationship with trademarks

1. The registration of a trademark that corresponds to any of the situations referred to in Article 10.21.1 in relation to a protected geographical indication for like goods, shall be refused or invalidated by the Parties, provided an application for registration of the trademark is submitted after the date of application for protection or recognition of the geographical indication in the territory concerned.

2. For the purposes of paragraph 1:

(a) for geographical indications referred to in Articles 10.18 and 10.19, the date of application for protection or recognition shall be the date when this Agreement enters into force, and

General remarks: how EUIPO interprets EU Regulations

Use

- 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

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 (*Scotch W*)

Other misleading 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*)

EXPLOITATION OF REPUTATION



Contested goods and services

Services in Class 43 (e.g. *bar services; catering services; provision of food and drinks*)



Opposition

INDECOPI argued that the sign exploited the reputation of PISCO (PGI-PE-01825) protected for *fruit spirit drink*



Result

In light of the evidence and arguments of the opponent, the opposition was upheld under Article 8(6). Solid evidence of INDECOPI investment in promoting PISCO and arguments linking the product with the contested services and the potential exploitation of reputation

EUTM No 17 192 899

B 3 060 646 PERÚ PISCO BAR (FIG)/PISCO

CONDE DE CUBA



Contested goods and services

Goods and services in Class 34 (*tobacco, tobacco products, vaporizers, articles to use with tobacco, matches*) and Class 43 (*animal boarding; Rental of furniture, linens and table settings*)



Opposition

Cubatabaco argued that the sign evoked the DO CUBA for tobacco or otherwise exploited its reputation (CUBA protected in France via the Lisbon Agreement)



Result

In light of the arguments of the opponent, the opposition was **PARTIALLY** upheld for *tobacco, tobacco products, vaporizers and electronic cigarettes* (evocation). It was dismissed for the remaining goods and services (no evocation, lack of evidence/arguments of exploitation of reputation)

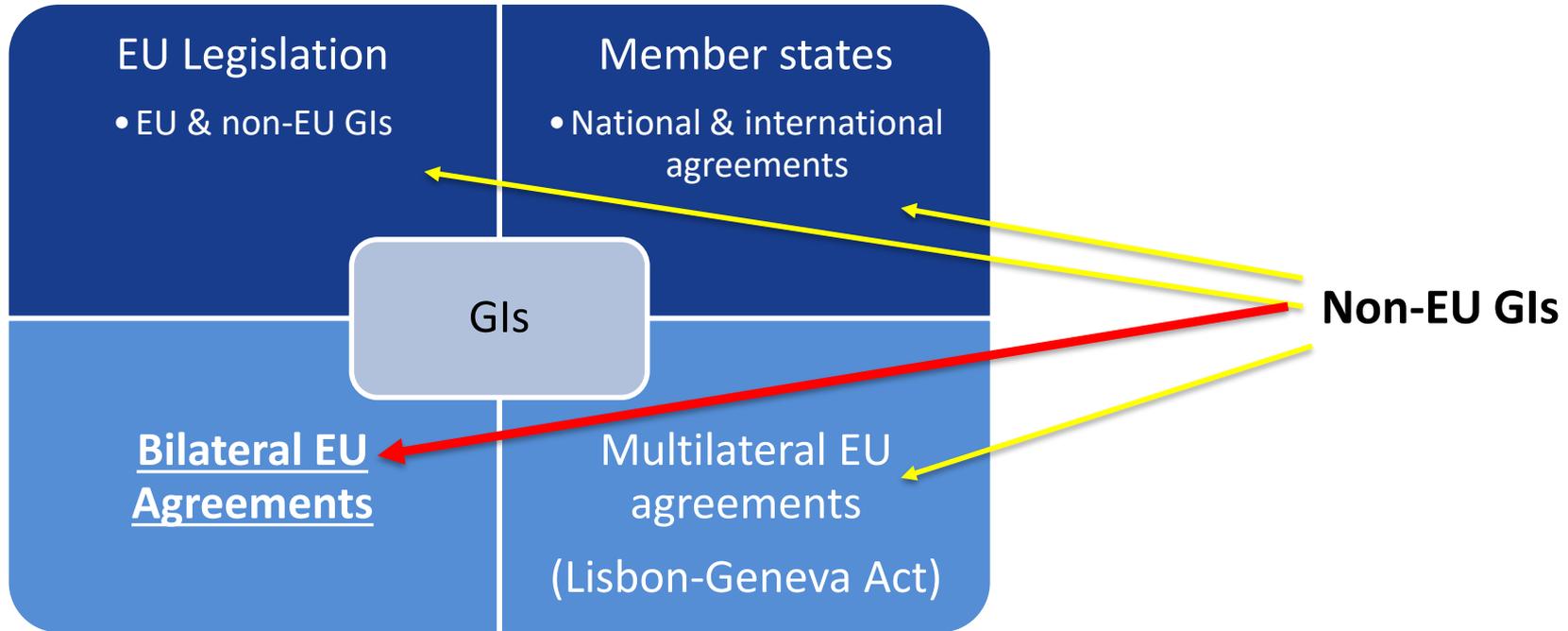
EUTM No 15 207 848

B 2 689 134 CONDE DE CUBA/CUBA

CONCLUSION



CONCLUSION



CONCLUSION

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

*Including international agreements concluded by the EU

**Including international agreements concluded by MS

CONCLUSION

Use
(exploitation of
Reputation)

Evocation

**Other
misleading
practices**

The End

Thank you!



Obbrigado!





THANK YOU
GRACIAS
MERCÍ
BEDANKT



CARIFORUM



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