

EUIPO's PRACTICE ON GEOGRAPHICAL INDICATIONS AND TRADE MARKS

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GEOGRAPHICAL INDICATIONS



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



GEOGRAPHICAL INDICATIONS

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



} = Geographical Indications (GIs)

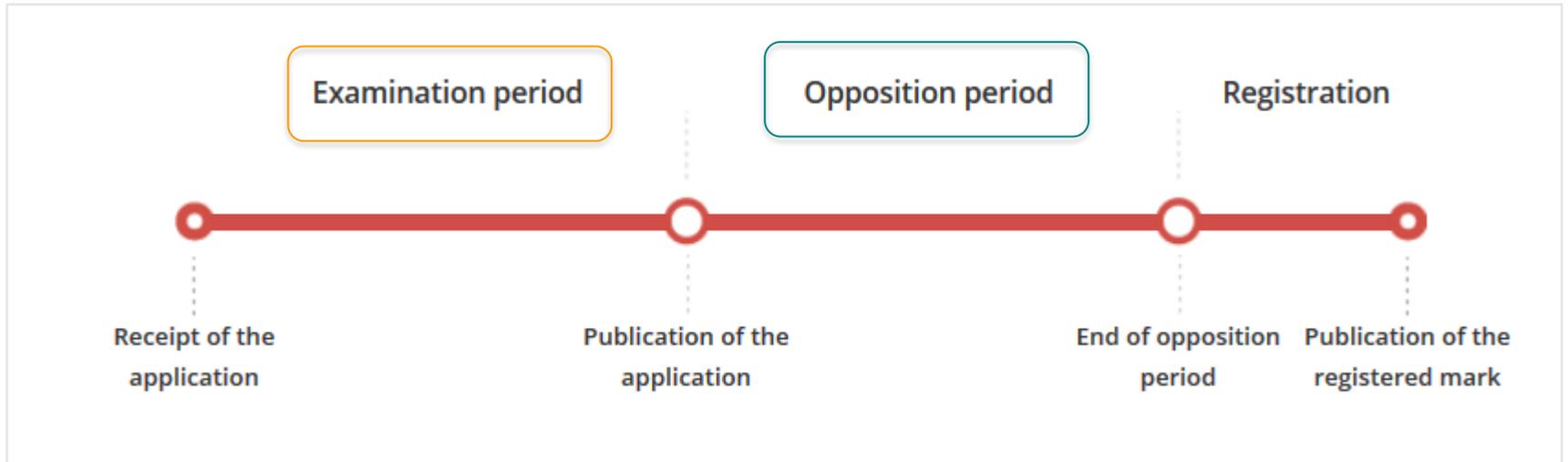
REGISTRATION PROCESS EUTM

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.

ARTICLE 7(1)(j) EUTMR – NATIONAL LAW

Areas

AGRICULTURAL GIs

- **Sectors:** wine, spirit drinks, foodstuffs and agricultural products and aromatised wines
- Registered by the **Commission** (DG AGRI)
- Protected pursuant to **EU legislation** (including international agreements)

NON-AGRICULTURAL GIs

- **Sectors:** include leather, stone, cutlery, carpets etc.
- Administered by **MS** depending on relevant national legislation
- Protected under **national legislation** (including international agreements concluded by MS)

EU LEGAL FRAMEWORK – EUIPO PRACTICE AS THE GENEVA ACT



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.

GIs from non-EU 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]

•International Agreements with EU (1,554)

- いぶりがっこ / Iburigakko, Food, Japan
- 北海道 / Hokkaido, Wine, Japan

SITUATIONS COVERED BY THE EU REGULATIONS

- The EUTM application **uses** the GI, that is, it **consists solely** of a whole GI or contains a whole GI in addition to other word or figurative elements
 - In respect of products that do not comply with the product specification
 - Insofar as such use exploits the reputation of a GI
- EUTM application contains or consists of a **misuse, imitation or evocation** of a PDO/PGI.
- **Other misleading indications and practices.**

GEOGRAPHICAL INDICATIONS – ABSOLUTE GROUNDS

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

- registered GI
- conflict with GI
- identical/comparable goods



GI|view

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

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. 20 R252/2014
Art. 21 R2019/787

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)

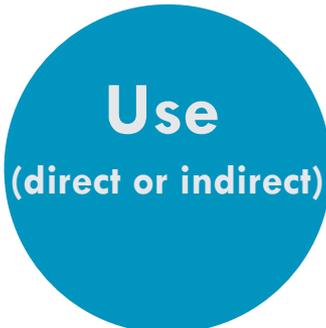


- **C-614/17 QUESO MANCHEGO/ ROCINANTE, 02.05.2019**

- 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.



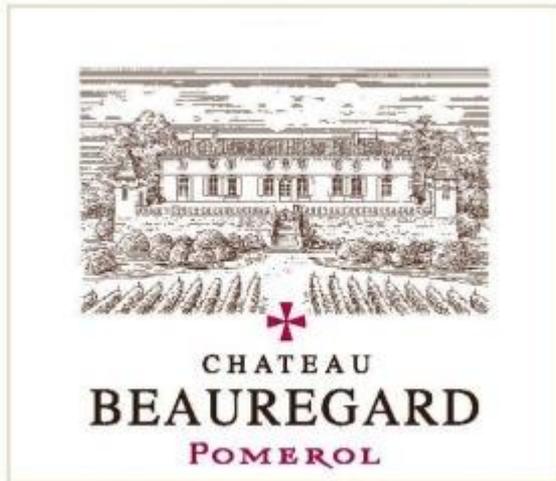
EUIPO PRACTICE



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 of services e.g. honey v. retail of honey)
- ‘Comparable products’ – restrictive, independent of ‘similarity’ concept in RG .
- (dissimilar in RG)

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)


CHAMPAGNE
Demièvre

EUTM No 17819533



Goods and Services

Inter alia, class 33: *wine conforming to the specifications of the protected designation of origin 'Champagne'*



Potential issues

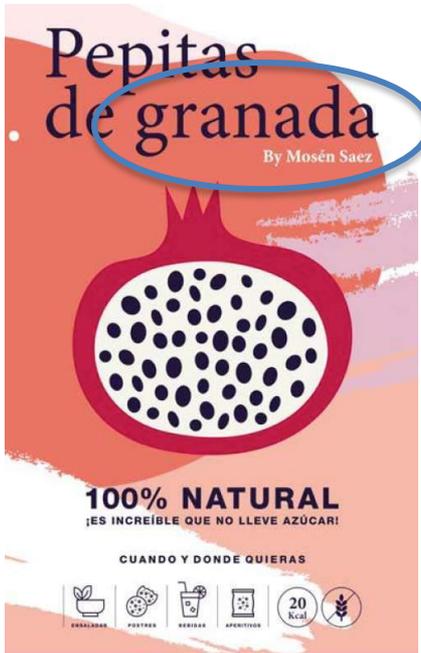
Possible conflict with the PDO CHAMPAGNE (PDO-FR-A1359) for *wine*



Result

Registered as applicant correctly designated the goods in Class 33.

EXAMPLE –IDENTITY (USE)



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 Andalucia. In the sign, the reference to “granada” is clearly to the fruit. No conflict

EUTM No 18 080 466

EUIPO PRACTICE

Misuse
Imitation
Evocation

- 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*)
- proximity of the goods concerned is a factor but AG EUIPO does not go into dissimilarity.

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
(PDO-IT-0576)



Result

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

EXAMPLE - PRACTICE

False
Misleading
Indications
or 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?
- 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

EXAMPLE - 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

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 (*Scotch W*)

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*)

ARTICLE 7(1)(j) EUTMR – CHECKLIST FOR EX OFFICIO OBJECTION

Checklist for objecting to a TM registration (Classes 29 to 33 agricultural GIs)

1. **Check if GI/DO registered/applied for:** relevant databases
2. **Check if conflict:** set the scope of protection of GI per the relevant legal instruments
3. **Apply specialty principle:** only object to identical products or, when relevant comparable or contain GI as ingredient
4. **Possibility to overcome objection:** suggest limitation





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Thank you