Practice of the EUIPO
Trade Marks and Geographical Indications

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Geographical Indications

- Article 7(1)(j)
- Possible conflict
Geographical Indications and Absolute Grounds

Article (1)(j), (k) and (l) and GI Regulations:

- Regulation (EU) 1151/2015
- Regulation (EU) 1308/2013
- Regulation (EC) 110/2008
- Regulation (EU) 251/2014
### Geographical Indications and Absolute Grounds

<table>
<thead>
<tr>
<th>Product Areas</th>
<th>PGIs under EU law*</th>
<th>PGIs under national law**</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Foodstuffs, Agricultural products, Wines, Spirit drinks and Aromatised wines</strong></td>
<td>Yes</td>
<td>no</td>
</tr>
<tr>
<td><strong>Non-agricultural field (e.g. handicraft)</strong></td>
<td>n/a</td>
<td>Yes</td>
</tr>
</tbody>
</table>

*Including international agreements concluded by the EU

**Including international agreements concluded by MS
Three cumulative conditions for Article 7(1)(j) to apply:

- Registered PDO/PGI
- Conflict with PDO/PGI
- Identical/comparable goods
Geographical Indications and Absolute Grounds

Registered PDO/PGI

- **Wines** incl. traditional terms for wines (TTWs) **E-Bacchus**
- **Spirits** **E-Spirit-Drinks**
- **Agricultural products and foodstuffs** (including beer, flowers, essential oils, cork) incl. traditional specialties guaranteed (TSGs) **Door**
- **Aromatised wines**: no database. There are only 5
  - Nürberger Glühwein,
  - Samoborski bermet,
  - Thüringer Glühwein,
  - Vermouth de Chambéry,
  - Vermouth di Torino
Geographical Indications and Absolute Grounds

Situations covered by EU Regulations

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;
5. Use of the EUTM application would exploit the **reputation** of PDOs/PGIs
Geographical Indications and Absolute Grounds

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<table>
<thead>
<tr>
<th>PDO/PGI</th>
<th>European Union trade mark</th>
</tr>
</thead>
<tbody>
<tr>
<td>MADEIRA (PDO-PT-A0038)</td>
<td>MADEIRA (Collective EUTM No 3 540 911)</td>
</tr>
<tr>
<td>MANZANILLA (PDO-ES-A1482)</td>
<td>MANZANILLA (Collective EUTM No 1 723 345)</td>
</tr>
<tr>
<td>DRESDNER CHRISTSTOLLEN (DE/PGI/005/0704)</td>
<td>DRESDNER CHRISTSTOLLEN (Collective EUTM No 262 949)</td>
</tr>
<tr>
<td>PROSCIUTTO DI PARMA (IT/PDO/0117/0067)</td>
<td>PROSCIUTTO DI PARMA (Collective EUTM No 1 116 458)</td>
</tr>
</tbody>
</table>
Geographical Indications and Absolute Grounds

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TORONTO ✓
EXCAVADORA ✓ vs. PARMA TUTTO ×
IMPORT ✓
Geographical Indications and Absolute Grounds

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– Definition of evocation:

where the term used to designate a product incorporates part of a protected designation, so that when the consumer is confronted with the name of the product, the image triggered in his mind is that of the product whose designation is protected” (C-75/15 Verlados at §21)

A link must be made with the product whose designation is protected but there is no need for likelihood of confusion!
Geographical Indications and Absolute Grounds

3 EUTM application contains or consists of an *imitation* or *evocation* of a PDO/PGI

a) Incorporates the significant part of a protected GI

*PDO ‘CHIANTI CLASSICO’ →*

*PDO ‘GORGONZOLA’ → ‘CAMBOZOLA’*
Geographical Indications and Absolute Grounds

3 EUTM application contains or consists of an *imitation* or *evocation* of a PDO/PGI

a) Incorporates the significant part of a protected GI

b) Contains an equivalent adjective/noun

PDO ‘Mel do Alentejo’
→ ‘Mel alentejana’

PDO: Sambuca di Sicilia
PDO: Sicilia
PGI: Terre Siciliance
Geographical Indications and Absolute Grounds

3 EUTM application contains or consists of an imitation or evocation of a PDO/PGI

a) Incorporates the significant part of a protected GI
b) Contains an equivalent adjective/noun

c) Translations

PGI ‘Pâtes d’Alsace’ → Alsatian Pasta

PGI ‘Cognac’ → KONJAKKI (FI)

PDO ‘Bourgogne ordinaire’ →
Geographical Indications and Absolute Grounds

3 EUTM application contains or consists of an imitation or evocation of a PDO/PGI

a) Incorporates a significant part
b) Contains an equivalent adjective/noun
c) Translations


PDO ‘Feta’ → Plain feta as produced in Greece
PDO ‘Rioja’ → Rioja Style Red Wine
Geographical Indications and Absolute Grounds

3 EUTM application contains or consists of an imitation or evocation of a PDO/PGI

- a) Incorporates a significant part
- b) Contains an equivalent adjective/noun
- c) Translations

EUTM triggers in the consumer’s mind a link with the product whose designation is protected

Criteria taken into account by the Court:
- Whether there is a visual, phonetic or conceptual relationship between the terms;
- Degree of closeness of the goods concerned;
- Whether the part of the PDO/PGI which is included in the trade mark forms a logical and conceptual unit within the mark or not. If so, evocation is dismissed;
Geographical Indications and Absolute Grounds

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4. **Other misleading** indications and practices;

5. Use of the EUTM application would exploit the **reputation** of PDOs/PGIs;

<table>
<thead>
<tr>
<th>PDO/PGI</th>
<th>European Union trade mark (invented examples)</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>PORTO</strong></td>
<td>EUTM depicting the ‘Dom Luís I Bridge’ in the city of Porto</td>
<td>A picture of the Dom Luís I Bridge and its riverside is a well-known emblem of the city of Porto. Use of this image for wines other than those covered by the PDO ‘Porto’ would fall under Article 103(2)(c) and (d) of Regulation (EU) No 1308/2013.</td>
</tr>
</tbody>
</table>
Geographical Indications and Absolute Grounds

Situations covered by EU Regulations

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Not taken into account in AG
Geographical Indications and Absolute Grounds

Situations covered by EU Regulations

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;
5. Use of the EUTM application would exploit the **reputation** of PDOs/PGIs

Limits to the scope of protection:

- Descriptive terms;
- Generic terms (camembert, brie, gouda...);
- Terms commonly used in trade;
- Surnames or family names;
- Names of countries
# Geographical Indications and Absolute Grounds

## Trade marks in conflict with two or more GIs

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

Relevant Goods under EU Regulations

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1. Identical products - specifications
2. Comparable products
3. Ingredients
4. How to restrict
Geographical Indications and Absolute Grounds

Relevant Goods under EU Regulations

WAY TO RESTRICT (ingredients)

- Consider items in the list goods applied for that can contain the product protected by the PGI/PDO as ingredient

Example

EUTM ABC Hajdusa applied for vegetables, condiments, mustard
PGI ‘Hajdusagi Torma’ protects horseradish.

Horseradish, condiments containing horseradish and mustard containing horseradish, all the aforementioned goods complying with the specifications of ‘PGI Hajdusagi Torma’
Geographical Indications - Examples
Geographical Indications - Examples
Geographical Indications - Examples
THANK YOU

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