



Practice of the EUIPO Trade Marks and Geographical Indications

Katarina KOMPARI | Lima | 28 March 2019

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OVERVIEW

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

Product Areas	PGIs under EU law*	PGIs under 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

Geographical Indications and Absolute Grounds

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

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PDO/PGI	European Union trade mark
MADEIRA (PDO-PT-A0038)	MADEIRA (Collective EUTM No 3 540 911)
MANZANILLA (PDO-ES-A1482)	MANZANILLA (Collective EUTM No 1 723 345)
DRESDNER CHRISTSTOLLEN (DE/PGI/005/0704)	DRESDNER CHRISTSTOLLEN (Collective EUTM No 262 949)
PROSCIUTTO DI PARMA (IT/PDO/0117/0067)	PROSCIUTTO DI PARMA (Collective EUTM No 1 116 458)

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TORONTO ✓
EXCAVADORA ✓
IMPORT ✓

vs.

TOROLOCO ✗
PARMATUTTO ✗



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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'

SICILIANO

PDO: Sambuca di Sicilia
PDO: Sicilia
PGI: Terre Siciliane

Geographical Indications and Absolute Grounds

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- 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

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

d) De-localizers:

‘style’, ‘type’, ‘method’, ‘as produced in’, ‘imitation’, etc.

PDO ‘Feta’ → Plain feta as produced in Greece

PDO ‘Rioja’ → Rioja Style Red Wine

Geographical Indications and Absolute Grounds

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- c) Translations
- d) De-localizers: 'style', 'type', 'method', 'as produced in', 'imitation', etc.

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;

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4. **Other misleading indications and practices;**
5. Use of the EUTM application would exploit the **reputation** of PDOs/PGIs

PDO/PGI	European Union trade mark (invented examples)	Explanation
PORTO (PDO-PT-A1540)	EUTM depicting the 'Dom <u>Luís I</u> Bridge' in the city of Porto	A picture of the Dom <u>Luís I</u> 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.

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Not taken into account in AG

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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

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)

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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