TMs and GIs: the EUIPO's perspective

Katarina KOMPARI | Lima | 28 March 2019

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**CONTENT**

**Effort**
- Guidelines
- Dedicated team

**Constraints**
- Tools
- Alien legal concepts
- Balance of rights

**Future**
- Case-law clarifications
- Users awareness
- Improvement of tools
REGISTRATION PROCESS OF A EUTM
THE EX OFFICIO EXAMINATION
PRELIMINARY NOTE

EXAMINATION PERIOD

Filing date  Classification  Formalities  Absolute Grounds  Translation  Search

EX OFFICIO EXAMINATION OF, AMONG OTHERS, CONFLICTS WITH GIs

Publication of the application
 Regulation 2017/1001, Article 7 (1) (j):
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 or the Member States concerned is party, providing for protection of designations of origin and geographical indications;
EUIPO Guidelines - Number of Pages on GIs

- 9 pages in 2012
- 16 pages in 2014
- 27 pages in 2016
EFFORT - DEDICATED TEAM

OPERATIONS DEPARTMENT WORKFLOW

APPLICATION (EUTM/IR)

ICE (pre-screening)

GI EXPERT GROUP (assessment)
EFFORT- DEDICATED TEAM

- **Origin**: complexity in examination of GIs
- **Kick-off**: September 2017
- **Members**: 12 OD examiners + 2 observers from ICLAD
- **Meetings**: weekly.
- **Tasks**: Assessment of all potential TMs in conflict with GIs and drafting of objections
- **Knowledge sharing**: interesting cases reported to all examiners; liaison with inter partes examiners (opposition – cancellation)
- **Impact on practice**: liaison with Legal Affairs Service
EFFORT - DEDICATED TEAM

GI EXPERT GROUP

+/- 240 objections
Lack of one single database for all protected GIs

AGRICULTURE AND RURAL DEVELOPMENT

Total: 1533

<table>
<thead>
<tr>
<th>Name of 3rd country GI protected in EU</th>
<th>Transcription (as exists)</th>
<th>Legal instrument establishing Protection</th>
<th>Applicable date of protection (EU)</th>
<th>Country</th>
<th>Sector</th>
<th>Class</th>
</tr>
</thead>
<tbody>
<tr>
<td>Nürnberger Glühwein</td>
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<td>Samoborski bernet</td>
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<tr>
<td>Thüringer Glühwein</td>
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<tr>
<td>Vermouth de Chambáry</td>
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<tr>
<td>Vermouth di Torino</td>
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</tr>
</tbody>
</table>
## CONSTRAINTS – LEGAL MATRIX

<table>
<thead>
<tr>
<th>IP title originating from (protected by)</th>
<th>Foodstuffs</th>
<th>Wines/ Aromatised wines</th>
<th>Spirit drinks</th>
<th>Non- Agricultural products</th>
</tr>
</thead>
<tbody>
<tr>
<td>From <strong>MS or 3rd countries</strong> EU-wide protection (4 EU Regulations)</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓ (no legislation)</td>
</tr>
<tr>
<td></td>
<td>Parma, Café de Colombia</td>
<td>Rioja, Vale dos Vinhedos (Brazil), Vermouth di Torino</td>
<td>Cognac, Pisco from Perú</td>
<td></td>
</tr>
<tr>
<td>From a <strong>MS</strong> (national legislation)</td>
<td>✗ (EU law exhaustive)</td>
<td>✗ (EU law exhaustive)</td>
<td>✗ (EU law exhaustive)</td>
<td>✗ Herend Porcelaine</td>
</tr>
<tr>
<td>From a <strong>MS</strong> (MS int’l agreement)</td>
<td>✗ (EU law exhaustive)</td>
<td>✗ (EU law exhaustive)</td>
<td>✗ (EU law exhaustive)</td>
<td>✗ Herend Porcelaine</td>
</tr>
<tr>
<td>From <strong>3rd countries</strong> (EU int’l agreements)</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓ (no legislation)</td>
</tr>
<tr>
<td></td>
<td>Korean White Ginseng</td>
<td>Alexander Valley (US)</td>
<td>Tequila from Mexico</td>
<td></td>
</tr>
<tr>
<td>From <strong>3rd countries</strong> (MS int’l agreements)</td>
<td>✗ (EU law exhaustive)*</td>
<td>✗ (EU law exhaustive)*</td>
<td>✗ (EU law exhaustive)*</td>
<td>✗ Kilim carpets</td>
</tr>
</tbody>
</table>
• Difficulties in the application of concepts alien to trade mark law, perceived as vague

• Lack of sufficient guidance by the Courts

Article 13
Protection
1. Registered names shall be protected against:

(a) any direct or indirect commercial use of a registered name in respect of products not covered by the registration where those products are comparable to the products registered under that name or where using the name exploits the reputation of the protected name, including when those products are used as an ingredient;

(b) any misuse, imitation or evocation, even if the true origin of the products or services is indicated or if the protected name is translated or accompanied by an expression such as ‘style’, ‘type’, ‘method’, ‘as produced in’, ‘imitation’ or similar, including when those products are used as an ingredient;

(c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product that is used on the inner or outer packaging, advertising material or documents relating to the product concerned, and 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.

Regulation 1151/2012
CONSTRATINS – APPROPRIATE BALANCE OF RIGHTS

Effective protection of rights derived from PDO and PGIs

Rights of bona fide TM applicants
<table>
<thead>
<tr>
<th><strong>Individual trade mark</strong></th>
<th><strong>Collective trade mark</strong></th>
<th><strong>Certification trade mark</strong></th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Definition</strong></td>
<td>Distinguishing the goods or services of one undertaking from those of other undertakings</td>
<td>Distinguishing the goods or services of the members of the association from those of other undertakings</td>
</tr>
<tr>
<td><strong>Essential function</strong></td>
<td>Commercial origin</td>
<td>Collective commercial origin (Association)</td>
</tr>
<tr>
<td><strong>Right to Use</strong></td>
<td>Proprietor or anyone licensed by the proprietor</td>
<td>Any member of the proprietor group</td>
</tr>
</tbody>
</table>
CONSTRAINTS – RESULT

Checklist for objecting to a TM registration

1. **Registered GI/DO:** checking **ALL** databases
2. **There is a conflict according to the *sui generis* law:** setting the scope of protection of GI per the **VARIOUS** legal instruments
3. **Specialty principle:** products are identical or comparable or contain GI as ingredient

GI EXPERT GROUP
• **Case-Law:**
  - ECJ judgments on application of EU Regulations (C-614/17 Queso Manchego; C-432/18 Aceto Balsamico Modena)
  - More GC/ECJ judgments expected on specific cases of GIs/trade marks conflicts

• **Increase users’ knowledge:** less third party observations, less objections

• **Tools:** improve database via DG AGRI – EUIPO cooperation
THANK YOU

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