

# TMs and GIs: the EUIPO's perspective

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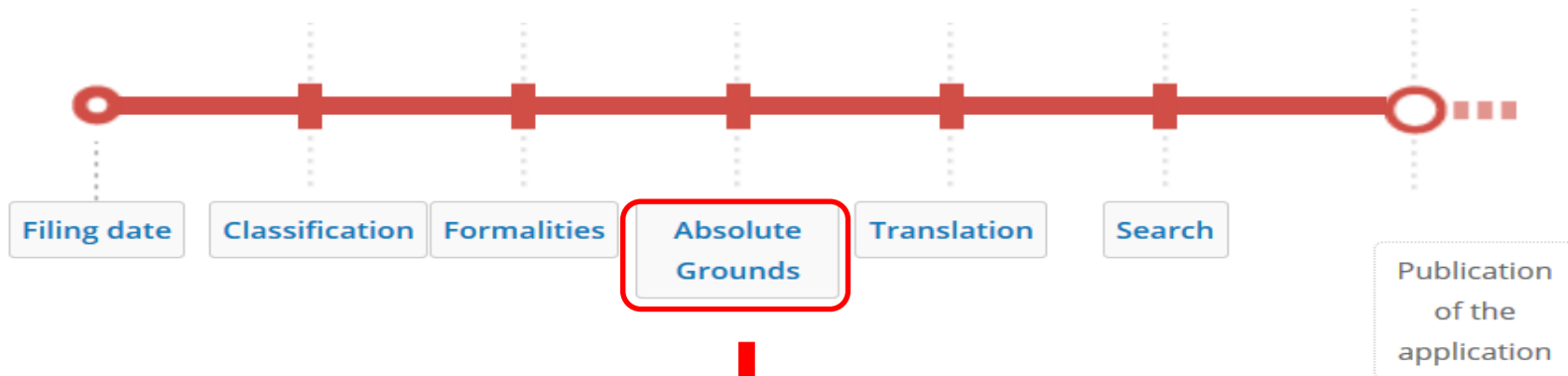
## PRELIMINARY NOTE

# REGISTRATION PROCESS OF A EUTM THE EX OFFICIO EXAMINATION



## PRELIMINARY NOTE

### EXAMINATION PERIOD



### EX OFFICIO EXAMINATION OF, AMONG OTHERS, CONFLICTS WITH GIs



## PRELIMINARY NOTE

### Regulation 2017/1001, Article 7 (1) (j):

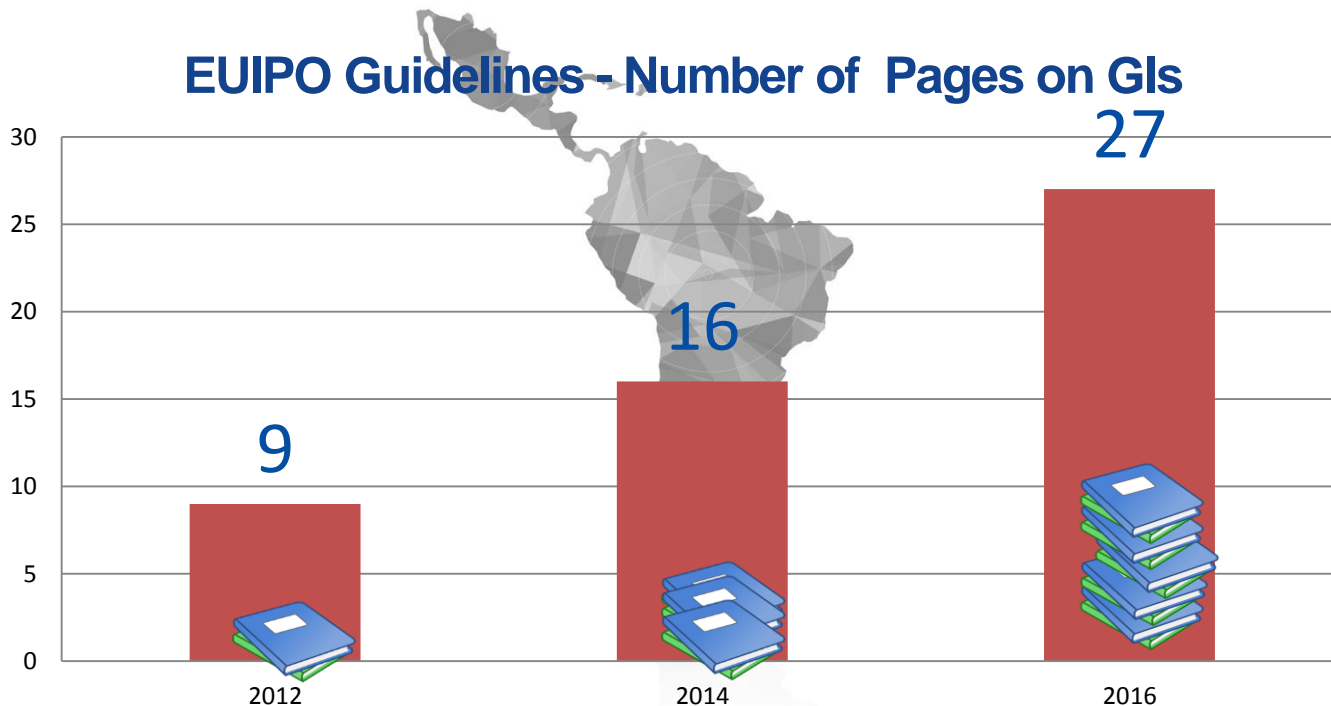
The following shall not be registered:

(...)

(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;

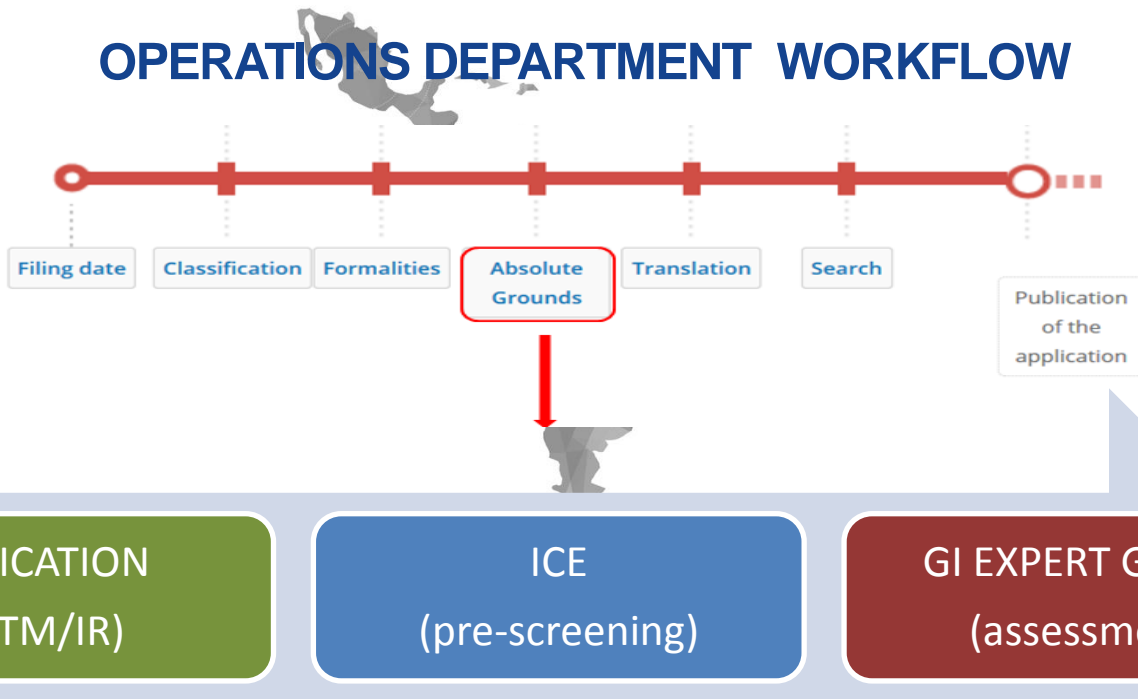


## EFFORT - GUIDELINES



## EFFORT - DEDICATED TEAM

### OPERATIONS DEPARTMENT WORKFLOW



## EFFORT- DEDICATED TEAM

### GI EXPERT GROUP

- **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

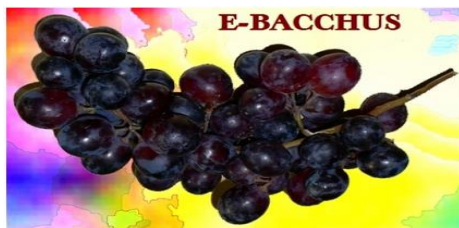
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GROUP

+/- 240 objections



# CONSTRAINTS - TOOLS

## Lack of one single database for all protected GIs



AGRICULTURE AND RURAL DEVELOPMENT  
**DOOR**

Total: 1533		GIs from non-European countries protected in the EU			Date: 26/06/2018	Version 1.0
<p>This list is for information purposes only. Only the legal texts of the respective agreements published in the Official Journal of the EU have legal value.</p> <p>Some agreements use terms such as "name of origin" or "product designations" rather than "geographical indication". For all legal provisions, refer to the texts of the relevant agreements.</p> <p>Meaning of asterisk (*): *Kosovo under United Nations Security Council Resolution 1244.</p>						
Name of 3rd country GI protected in EU	Transcription (if exists)	Legal instrument establishing Protection	Applicable date of Protection EU	Country	Sector	Class



Register of geographical designations of Aromatized drinks based on wine products

- Nürnberger Glühwein
- Samoborski bermet
- Thüringer Glühwein
- Vermouth de Chambéry
- Vermouth di Torino



## CONSTRAINTS – LEGAL MATRIX

IP title originating from (protected by)	Foodstuffs	Wines/ Aromatised wines	Spirit drinks	Non- Agricultural products
From <u>MS or 3<sup>rd</sup> countries</u> EU-wide protection (4 EU Regulations)	✓ Parma, Café de Colombia	✓ Rioja, Vale dos Vinhedos (Brazil), Vermouth di Torino	✓ Cognac, Pisco from Perú	✗ (no legislation)
From a <u>MS</u> (national legislation)	✗ (EU law exhaustive)	✗ (EU law exhaustive)	✗ (EU law exhaustive)	✓ Herend Porcelaine
From a <u>MS</u> (MS int'l agreement)	✗ (EU law exhaustive)	✗ (EU law exhaustive)	✗ (EU law exhaustive)	✓ Herend Porcelaine
From <u>3<sup>rd</sup> countries</u> (EU int'l agreements)	✓ Korean White Ginseng	✓ Alexander Valley (US)	✓ Tequila from Mexico	✗ (no agreement)
From <u>3<sup>rd</sup> countries</u> (MS int'l agreements)	✗ (EU law exhaustive)*	✗ (EU law exhaustive)*	✗ (EU law exhaustive)*	✓ Kilim carpets



## CONSTRAINTS – ALIEN LEGAL CONCEPTS

- Difficulties in the application of concepts alien to trade mark law, perceived as vague
- Lack of sufficient guidance by the Courts

Regulation 1151/2012

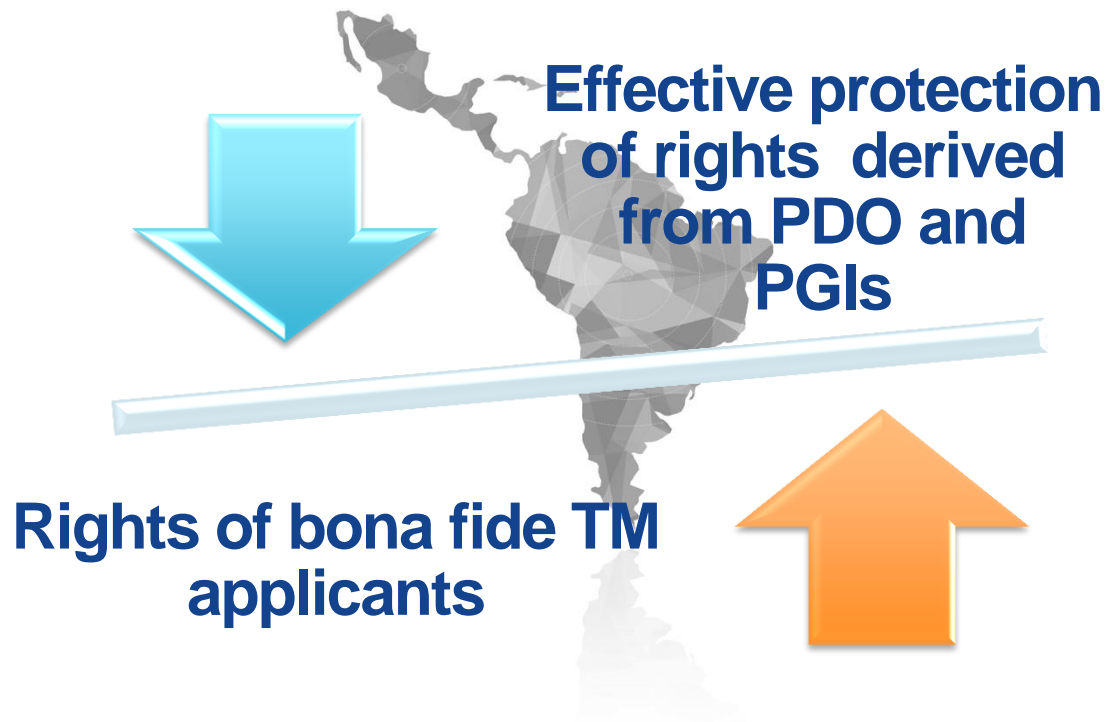
### Article 13

#### 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 packing 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.



## CONSTRAINTS – APPROPRIATE BALANCE OF RIGHTS



	Individual trade mark	Collective trade mark	Certification trade mark
<b>Definition</b>	Distinguishing the goods or services of <b>one undertaking</b> from those of other undertakings	Distinguishing the goods or services of the <b>members of the association</b> from those of other undertakings	Distinguishing the goods or services which are <b>certified by the proprietor</b> of the mark from those which are not so certified
<b>Essential function</b>	Commercial origin	Collective commercial origin (Association)	Certification
<b>Right to Use</b>	Proprietor or anyone licensed by the proprietor	Any member of the proprietor group	Not the proprietor

## 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

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## FUTURE

- **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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