



Protection of Geographical Indications in the Market (EU system)

Aitor Pomares | July 21, 2020

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GI registered under the **EU sui generis system**:
Scope of protection defined in the specific EU Regulation.



GI protected via **bilateral Agreement EU / third country**:
Scope of protection defined in the Agreement.

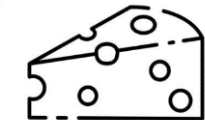


Objectives of the GI system

- Fair competition for producers of agricultural products and foodstuffs having value-adding characteristics and attributes.
- Availability to consumers of reliable information pertaining to such products.
- Uniform respect throughout the Union for the intellectual property rights related to names of those products.



Same level of protection



PDO



PGI



GIs



GIs



Scope of protection

- a) Any **direct or indirect commercial use** of a registered name:
 - in respect of **comparable products**, 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', or similar, including when those products are used as an **ingredient**.
- c) Any **other false or misleading indication** as to the 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.

CJ, 7/6/2018, C-44/17, *Scotch Whisky Association*: graduated list of prohibited conducts.



Equal protection afforded:

- In the **Market**
- In the **Trademark Register:**
 - ✓ Registration of a later trademark the use of which would contravene the protection of a GI shall be refused or invalidated.
 - ✓ Complementary with Trademark legislation.

Ex officio protection: Member States shall take appropriate administrative and judicial steps to prevent or stop the unlawful use of GIs.

Right to use the GI:



Any operator marketing a product conforming to the corresponding Specification - technical requirements - (art. 12.1 Reg. EU 1151/2012), where compliance has been verified by the control body/authority before placing the product on the market (Art. 37 Reg. EU 1151/2012).



Prohibition of use:

Any product not complying with the GI Specification, even if it has been produced in the defined geographical area.



a) *Any direct or indirect commercial use in respect of comparable products*

CJ 14/7/2011, Cases C-4/10 and C-27/10, BNI Cognac:

- Products which have common objective characteristics
- Which are consumed on identical occasions
- Distributed through the same channels
- Subject to similar marketing rules

a) *Exploitation of the reputation*

EUIPO's Board of Appeal 14/4/2020, R 1132/2019-4:



PDO Champagne vs. Champagnola (word mark)

Class 30: Bread, pastry and confectionery; baking preparations, etc.

The reputation of the PDO 'Champagne' is linked with luxury. 'Champagne' sparkling wine is at the very upper end of the price range and consumed on special occasions. It is common to have breakfast in the form of a 'champagne breakfast' (Champagnerfrühstück, Sektrfrühstück), where a glass of sparkling wine adds to the distinctive and special atmosphere. (...)

The contested goods will all appear to be more 'prominent', 'glamorous' or special in taste when brought in conjunction with 'Champagne' sparkling wine.

a) *including when those products are used as an ingredient.*

CJ, Case C-393/16, Champagne sorbet

The product contained authentic wine PDO Champagne as an ingredient (12%)



Take(s) unfair advantage of the reputation of the PDO if that ingredient does not confer on that foodstuff one of its essential characteristics

It is not a question of identifying in the foodstuff the essential characteristics of the ingredient protected by a PDO but of establishing that that foodstuff has an essential characteristic connected with that ingredient. That characteristic will often be the aroma or taste imparted by that ingredient.

If the taste of the foodstuff is more attributable to other ingredients it contains, the use of such a name will take unfair advantage of the reputation of the PDO concerned.



b) Protection against ‘services’

GC, 18/9/2015, cases T-359/14 and T-387/13, Café de Colombia.

EUIPO Opp. Div. 2/2/2015 B2133828:



PGI **Café de Colombia** vs **COLOMBUENO** (word mark)

Class 43: Services for providing food and drink.

The protected coffee may in fact be served in the context of the provision of food and drink covered by the contested application, which may cover, within its scope, services provided by cafeterias and coffee-houses. Also, coffee may be transformed in the restaurant industry. Although the goods and services belong to different market sectors, it is not uncommon that producers of coffee expand their commercial activity to neighbouring markets.

The contested sign, if used in the context of the relevant services in Class 43, will cause the relevant consumer to recall the protected geographical indication ‘Café de Colombia’.



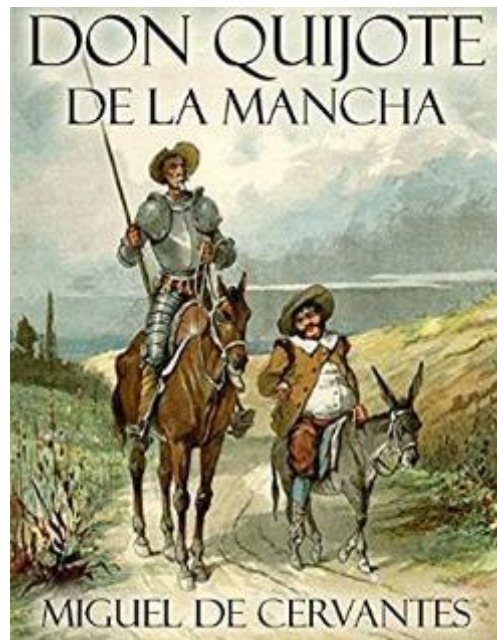
b) *Evocation*

CJ, Case C-614/17, Queso Manchego – Spanish Supreme Court 18/7/2019

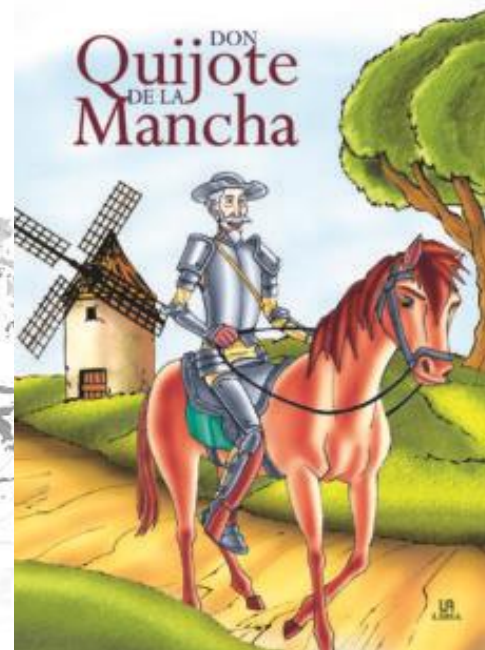


- *Evocation: the image triggered in the consumer's mind is that of the product protected by the PDO.*
- *Not only words are capable of evoking the PDO, but also figurative signs*
- *Including where such figurative signs are used by a producer established in that region, but whose products, similar or comparable to those protected by the PDO, are not covered by it.*





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b) *Evocation*

d) *Any other practice liable to mislead the consumer as to the true origin of the product*

Alicante Second Instance Court 31/10/2013



b) Evocation

c) Any other false or misleading indication as to the origin, nature or essential qualities of the product that is used on the packaging



b) Even if the true origin of the product is indicated



La Rioja Second Instance
Court 27/9/2012




Actions against infringement

- **Administrative actions:** before the competent authority/authorities designated by each Member State.
- **Civil actions:** damages will (generally) be possible.
- **Criminal actions:** for the more serious offenses (e.g. falsifications of the ‘seal of guarantee’, important volume of infringing products).





THANK YOU

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