



DESCRIPTIVE; GENERIC MARKS; and GEOGRAPHICAL TERMS vs GIs

MONIKA TOMCZYNSKA | MANILA | 1 OCTOBER 2025

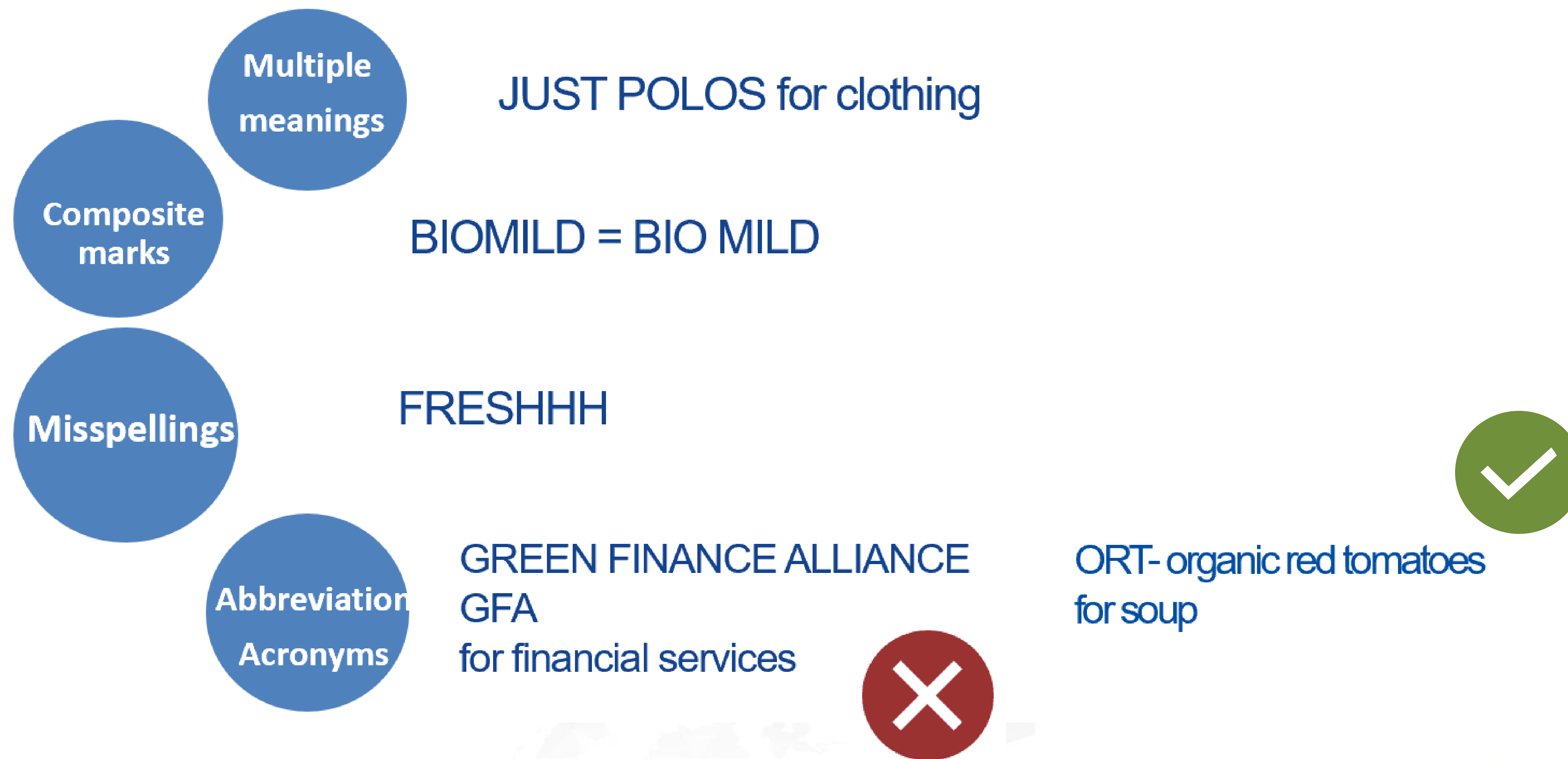
www.ipkey.eu

DESCRIPTIVENESS



Under Article 7(1)(c) EUTMR, ‘trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’ are not to be registered.

For a sign to be caught by the prohibition set out in that provision, there must be a sufficiently **direct and specific relationship between the sign and the goods and services in question** to enable the public concerned **immediately** to perceive, without further thought, a description of the goods and services in question or of one of their characteristics (22/06/2005, T 19/04, Paperlab, EU:T:2005:247, § 25; 27/02/2002, T 106/00, Streamserve, EU:T:2002:43, § 40).



GENERIC MARKS





What are they?

Article 7(1)(d) EUTMR excludes from registration signs that consist exclusively of words or indications that have become customary in the current language or in the bona fide and established practices of the trade at the relevant point in time. In this context, the customary nature of the sign usually refers to something other than the properties or characteristics of the goods or services themselves.

16/03/2006, [T-322/03](#), Weisse Seiten, EU:T:2006:87, § 52

GEOGRAPHICAL TERMS



It is in the **public interest** that signs that may serve to designate the geographical origin of goods or services remain available, not least because they may be an **indication of the quality and other characteristics** of the categories of goods concerned, and may also, in various ways, influence consumer preferences by, for instance, **associating the goods or services with a place** that may elicit a favourable response (15/01/2015, T-197/13, MONACO, EU:T:2015:16, § 47; 25/10/2005, T-379/03, Cloppenburg, EU:T:2005:373, § 33).



Grounds?

Descriptiveness

Lack of distinctiveness

Deceptive character

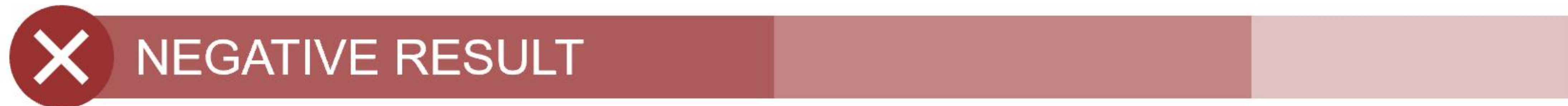
Philippines Direct (Word)
[003108586](#) Nice classes 9; 35; 38



Port Charlotte (Word)
18/11/2015, [T-659/14](#), PORT CHARLOTTE,
EU:T:2015:863
The judgment was appealed before the CJEU
(14/09/2017, [C-56/16 P](#), PORT CHARLOTTE,
EU:C:2017:693), but the grounds of
deceptiveness were not examined.
Nice classes 33



Descriptiveness



T-105/23 and T-106/23

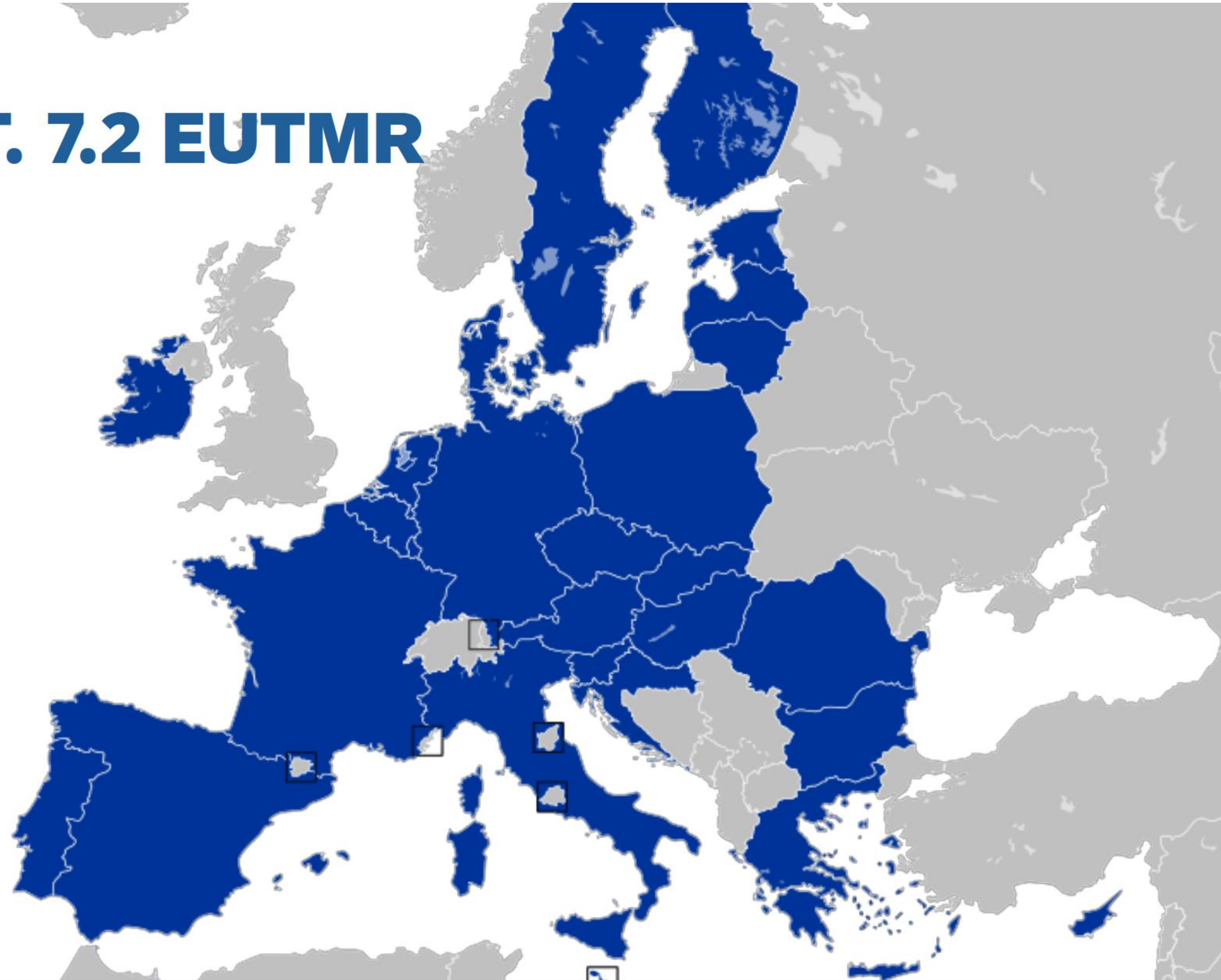
ICELAND



Cl. 29, 30 and 35



ART. 7.2 EUTMR



Acquired distinctiveness

**EVERY RULE HAS AN
EXCEPTION**

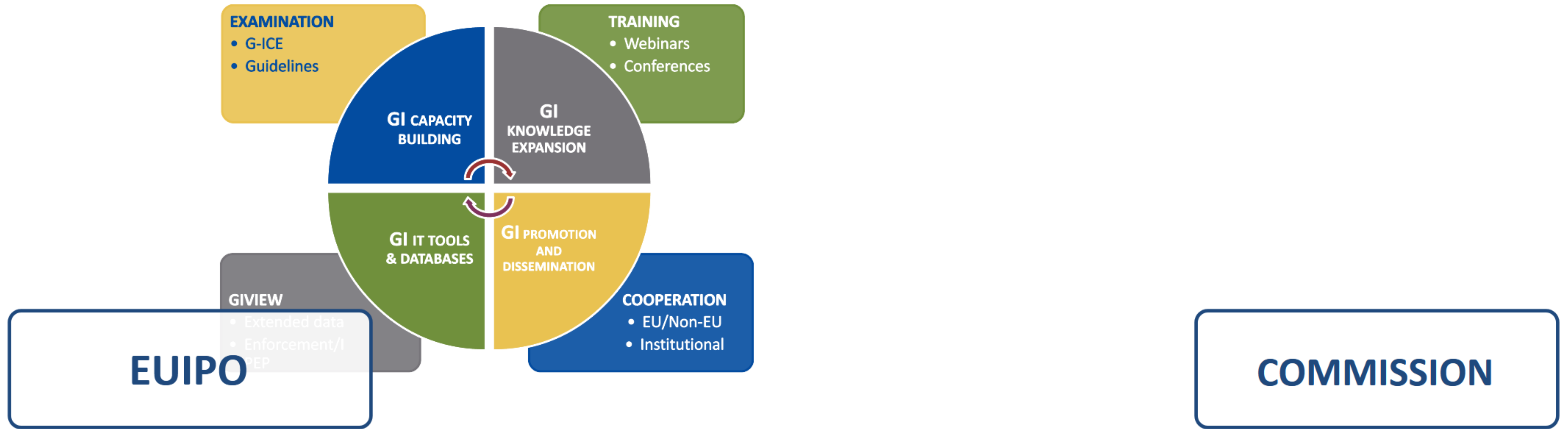
**Art. 7.3
EUTMR**



Geographical Terms vs GIs







<https://www.tmdn.org/giview/>

GIview

English



Search for Geographical Indications across the European Union and beyond

Country

Geographical Indication / File number

Champagne

Search

GIview

English

8 results found

Results per page 20

Country

Champagne

List

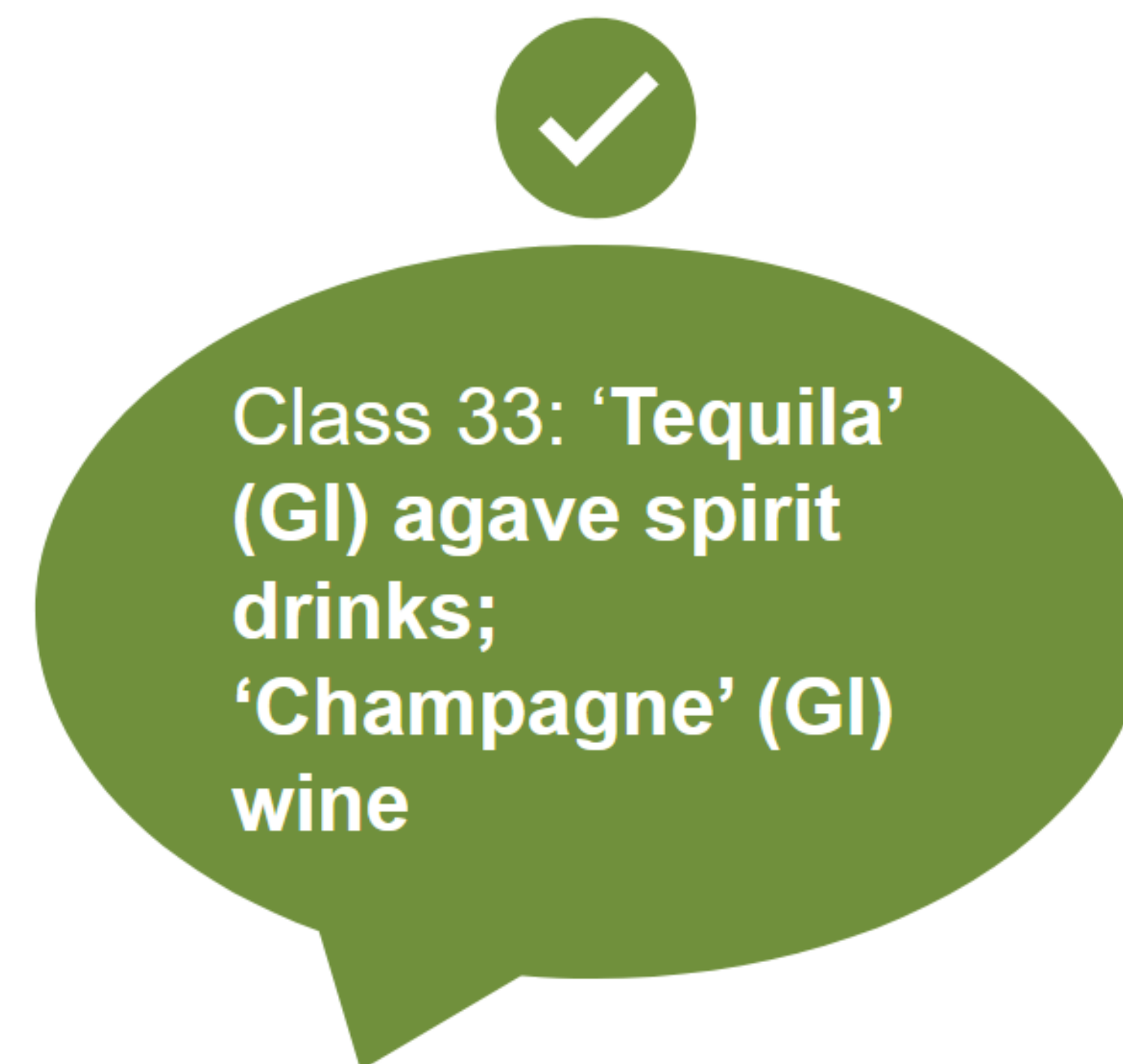
Map

Filters	Product name	Product type	Country	Priority date / Status
<div>Product type</div> <div><input type="checkbox"/> Wine</div> <div><input type="checkbox"/> Food</div> <div><input type="checkbox"/> Spirit drink</div> <div><input type="checkbox"/> Other</div> <div>Filter by categories</div>	Champagne PDO-FR-A1359	Wine	France	18/09/1973 Registered
	Ratafia champenois PGI-FR-02062	Spirit drink 33. Liqueur	France	12/06/1989 Registered
	Marc de Champagne / Eau-de-vie de marc de Champagne PGI-FR-02063	Spirit drink 6. Grape marc spirit or grape marc	France	12/06/1989 Registered
	Volailles de la Champagne PGI-FR-0172	Food Class 1.1 Fresh meat (and offal)	France	21/06/1996 Registered
	Eau-de-vie de Cognac / Eau-de-vie des Charentes / Cognac	Spirit drink 4. Wine spirit	France	12/06/1989 Registered

Classification of goods and services



NEGATIVE RESULT



POSITIVE RESULT



Article 7(1)(j) EUTMR

018696773 - Buckley Irish Whiskey

Class 33 *Spirits; Spirits [beverages]; Distilled spirits.*



Relative grounds: Actions based on 8(6) EUTMR




Article 8(6) EUTMR:

Upon opposition by any person authorised under the relevant law to exercise the rights arising from a designation of origin or a geographical indication, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Union legislation or national law providing for the protection of designations of origin or geographical indications:

1. An application for a designation of origin or a geographical indication had already been submitted, in accordance with Union legislation or national law, prior to the date of application for registration of the EU trade mark or the date of the priority claimed for the application, subject to its subsequent registration;
2. That designation of origin or geographical indication confers the right to prohibit the use of a subsequent trade mark.

The importance of a proper specification in the list of goods and services to avoid OPPOSITIONS

Earlier GI (s)	Contested sign	Case No
<p>CAVA</p> <p>(PDO-ES-A0735)</p> <p>for <i>wines</i></p>	 <p>EUTM No 16 564 271 applied for <i>wines, sparkling wines, all in conformity with the specifications of the PDO "Cava"</i>.</p>	<p>16/10/2020, B 2 935 669</p> <p>(exploitation of reputation)</p>
<p>Assessment : Where the specification of an EUTM application is limited, in relation to goods identical to the product covered by the GI, to goods in conformity with the specification of the relevant protected GI, which is the case of the contested mark, the function of the GI in question is safeguarded in relation to those products because the EUTM application only covers products from the particular geographic origin and the special qualities connected therewith.</p>		

The importance of a proper specification in the list of goods and services to avoid OPPOSITIONS



applied for Class 33 "Rioja" GI
wines

Would an **OPPOSITION**
on basis of Article 8(6)
EUTMR invoking
GI "Rioja"
succeed?

the function of the GI is respected **with proper specification in the list of goods/services, limiting the goods/services to those complying with GI specification**



The legal context of proof of entitlement in EUTMR

Article 8(6) EUTMR, Article 46 EUTMR/Article 63 EUTMR *by any person authorised under the relevant law to exercise the rights arising from a designation of origin or a geographical indication*
Article 7 /Article 16 EUTMDR *entitlement to file the action, acquisition, continued existence, and scope of protection of the earlier right, a clear identification of the content of the national law*

 must refer to the relevant law (EU, national) which confers on you, the

beneficiary of the GI, a direct right of action against unauthorised use

 **Article 95 EUTMR** applies – the examination of the Office is restricted to the facts, evidence and arguments provided by the parties



Entitlement example 1 – in the contest of Regulation No 1151/2012





Opposition filed by
 Fundación "Consejo
 Regulador de la
 Denominación de
 Origen Queso
Manchego" on the
 basis of Article 8(6)
 EUTMR invoking
Queso Manchego

GIview English ▾

Country: manchego

Back to search results <>

Queso Manchego

Country/ies of origin Spain	Type Protected Designation of Origin (PDO)	Product type Food	Basis of protection EU register
Priority date 21/06/1996	File number PDO-ES-0087		
Status Registered	Product category Class 1.3. Cheeses		
Legal instrument of protection at EU level Official Journal L 148, 21.06.1996			
Publications Official Journal L 148, 21.06.1996 Official Journal C 255, 08.10.2008 Official Journal L 166, 27.06.2009 Official Journal L 43, 16.02.2012			
Amendment Amendment pending			
Protections under international agreements <div> Armenia Bosnia and Herzegovina Canada China Costa Rica El Salvador Georgia Guatemala Honduras Iceland Japan Kosovo Liechtenstein Moldova Nicaragua Panama Serbia Singapore South Africa South Korea Switzerland Ukraine United Kingdom Vietnam </div>			

Country authorities

MINISTERIO DE AGRICULTURA, PESCA Y ALIMENTACIÓN Secretaría General de Agricultura y Alimentación, Dirección General de Industria Alimentaria, Subdirección General de Control de la Calidad alimentaria y Laboratorios Agroalimentarios

P^a Infanta Isabel, 1
28071 Madrid
Spain
<https://www.mapa.gob.es/es/>

Producer groups

Fundación "Consejo Regulador de la Denominación de Origen Queso Manchego"

Avenida del Vino, s/n. Aptdo Correos 228.
13300 VALDEPEÑAS (Ciudad Real)
Spain
☎ (+ 34) 926 32 26 66
www.quesomanchego.es

Control bodies

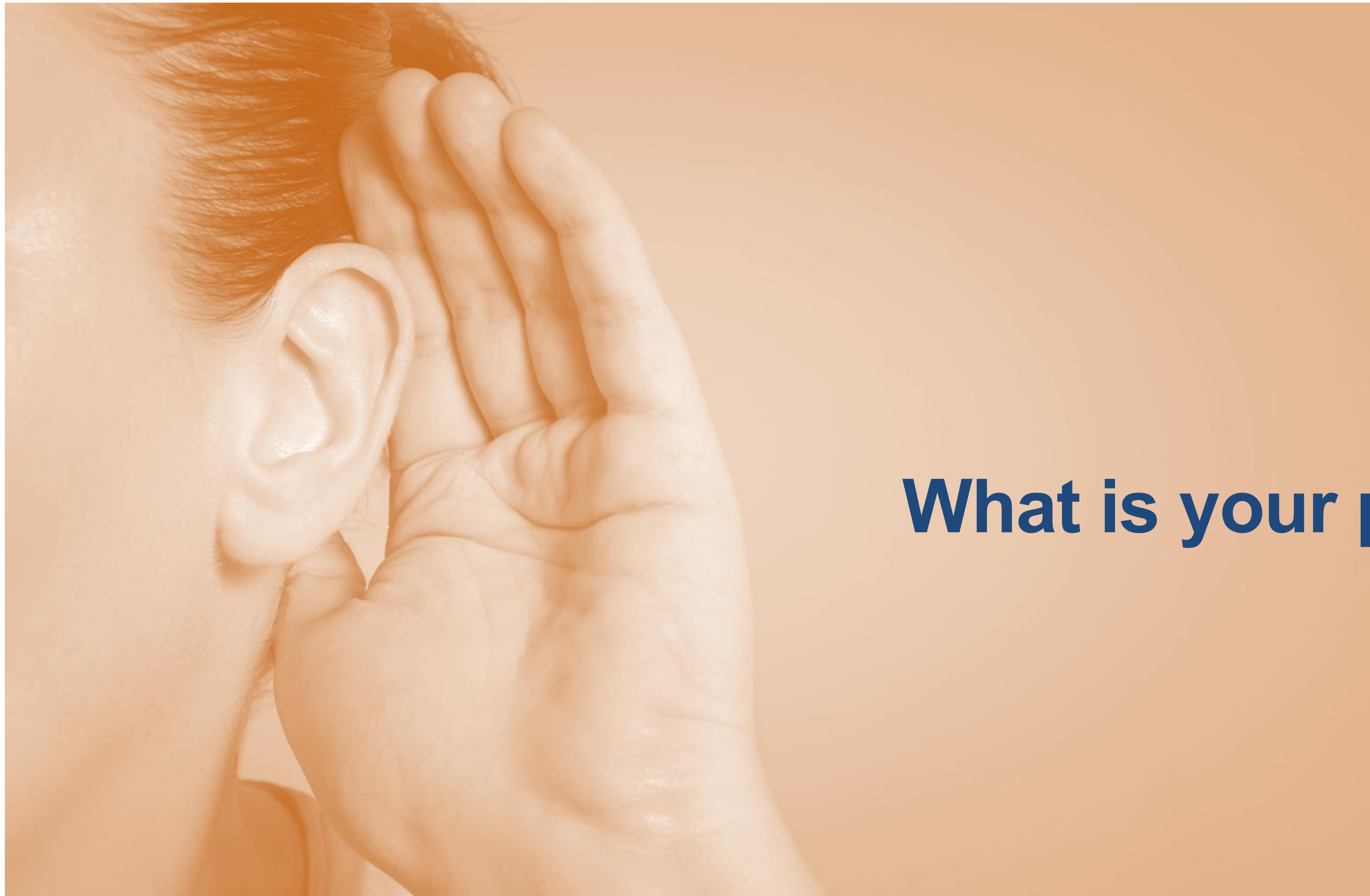
Fundación "Consejo Regulador de la Denominación de Origen Queso Manchego"

Avenida del Vino, s/n Aptdo Correos 228 13300 VALDEPEÑAS (Ciudad Real). Tlf: + 34 926 32 26 66. Fax: + 34 926 32 27 12. e-mail: certificacion@quesomanchego.es.
www.quesomanchego.es

Competent control authorities

Consejería de Agricultura Agua y Desarrollo Rural. Dirección General de Alimentación

C/ Doctor Mateo Maza 4 45002 Toledo Tlf: (+34) 925 766700



What is your practice?





THANK YOU

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