

**Paper on the management of trademark applications
conflicting with geographical names protected at the EU level
by the Office for the Harmonization in the Internal Market (OHIM)**

Introduction

The Organization for an International Geographical Indications Network (oriGIn)

The Organization for an International Geographical Indications Network (oriGIn) is an international network of geographical indications, representing 250 organizations and over two-million producers from some 40 countries. oriGIn advocates for a more effective legal protection and enforcement of GIs at the national, regional and international level and promotes the recognition of the fundamental role of origin products in the sustainable development of local communities.

Relevant EU legislation

The relevant EU legislation affecting GIs – *the Council Regulation (EC) No 510/2006 of 20 March 2006 on the Protection of Geographical Indications and Designations of Origin for Agricultural Products and Foodstuffs, the Regulation (EC) No. 1234/2007 of 22 October 2007 establishing a common organisation of agricultural markets and on specific provisions for certain agricultural products (Single CMO Regulation), Regulation (EC) No. 110/2008 of the Parliament and the Council of 15 January 2008 on the Definition, Description, Presentation, Labeling and the Protection of Geographical Indications of Spirit Drinks repealing Council Regulation (EEC) No. 1576/89 and the Council Regulation (EC) No. 40/94, of 20 December 1993, on the Community Trade Mark* – confers a high degree of protection to Protected Designations of Origin (PDOs) and Protected Geographical Indications (PGIs) for agricultural products and wines as well as to Geographical Indications (GIs) for spirits, both in terms of exclusive rights and role of public authorities in ensuring the respect and enforcement of such rights.

The relevant EU laws are crystal clear in this regard. Article 13, paragraph 1 of Regulation (EC) 510/2006 defines the protection enjoyed by PDOs and PGIs, which goes much behind the mere risk of confusion to encompass “any direct or indirect commercial use of a registered name in respect of products not covered by the registration in so far as those products are comparable to the products registered under

that name or in so far as using the name exploits the reputation of the protected name, as well as any misuse, imitation or evocation, even if the true origin of the product 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". Moreover, Article 14, paragraph 1 of the above-mentioned Regulation protects PDOs/PGIs against trademark applications corresponding to any of the situations referred to in Article 13. By stating that these kinds of applications must be refused, the EU legislation clearly puts the burden of carrying out a thorough examination of such applications and, under the above-mentioned circumstances, refusing the ones conflicting with PDOs/PGIs, on the OHIM (as well as on national trademark offices). In this context, it is worth reminding that the provisions set forth in Regulation (EC) 510/06 must be observed by the OHIM in its registration practice, as expressly provided for in Art. 164 of the Community trade mark regulation (CTMR)¹.

As to the protection and relations with trademark applications, Articles 118 *quaterdecies* and *terdecies* of Regulation 1234/2007 contain equivalent provisions with respect to PDOs and PGIs for wines. Likewise, Articles 16 and 23 of Regulation (EC) 110/2008 contain equivalent provisions with respect to GIs for spirits.

The CTMR goes exactly in the same direction. By virtue of Article 7 (g), (j) and (k), PDOs/PGIs as defined in Regulation (EC) 510/2006, as well as geographical indications identifying wines or spirits, have been granted *ex-officio* protection. In other words, trademarks containing, consisting of a PDO-PGI or corresponding to one of the situations covered by Article 13 of Regulation (EC) 510/2006 – as well as trademarks for wines or spirits which contain or consist of a geographical indication identifying wines or spirits with respect of product not having that origin – shall not be registered by the OHIM.

Current situation

OHIM's practice in dealing with trademark applications conflicting with geographical names protected at the EU level

oriGIn has welcomed OHIM's initiative to create a database containing the list of GIs for wines, spirits, agricultural products and foodstuffs protected under the

¹ Cfr. Court of First Instance, Case T 291/03, Judgement 12 September 2007, paragraph 53-56.

Community Regulations and Bilateral Treaties.

In spite of this initiative, however, and much like before the creation of the database, oriGIn's members have been facing the challenge represented by OHIM's practice of accepting trademark applications conflicting with PDOs/PGIs. On the one hand, such a practice places the burden on legitimate PGI/PDO producers' associations to oppose any trademark identical, confusingly similar, or corresponding to the situations referred to in the scope of protection of such geographical names, with major implications in terms of financial resources and time. Moreover, such practice creates a private right that may contradict the collective one upheld by the European law to the benefit of producers' organizations.

On the other hand, the EU consumers certainly do not benefit from the current situation. In fact, the above-mentioned practice provides incentives for bad faith registrations and for the use of trademarks containing or consisting of geographical names, thus misleading consumers as to the true origin of products.

OHIM's practice of publishing trademark applications conflicting with PDOs/PGIs or GIs – provided that the applicant restricts the application to products originating from the geographical area of a given PDO/PGI (for agricultural products or wines) or of a given GI (for spirits) – is inconsistent with the EU legislation and does not take into account the very nature of geographical indications. These are not mere indications of source, but rather signs conveying valuable information concerning the quality of products, obtained in accordance with strict specifications, which are verified by independent bodies. Restricting the application to products originating from the geographical area of a given PDO/PGI or GI does not itself constitute a proof of the respect of the product specification.


Moreover, the practice shows that the OHIM commonly disregards third party observations. As mentioned in Communication No 2/09 of the President of the OHIM on 9 November, 2009, observers normally do not receive any communication from the OHIM, apart from the acknowledgement of receipt of their observations. Observers are not informed as to the outcome of the re-examination, not even when the observations raise serious doubts about the “registrability” of a given sign.

Practical examples

We have classified the numerous applications for CMTs conflicting with PDOs/PGIs and GIs published or registered by the OHIM in violation of the EU


legislation into 3 categories. To illustrate this, for each category we have provided one concrete case:

i. Applications containing the registered name of a PDO-PGI or GI filed by illegitimate parties with respect to comparable products


Trade mark	Trade mark N.	Owner	Class	Filing date	Status	GI concerned
PURO palapa TEQUILA REPOSADO 100' AGAVE 38' 0.7L 	CTM, 006211999	Sierra Madre Trend Food GmbH	33	20/08/2007	Registered	Tequila, protected in the EU by virtue of the Agreement between the European Community and the United Mexican States on mutual recognition and protection of Appellations for spirit drinks

- ii. *Applications containing imitations, evocations or other misleading uses of a PDO-PGI or GI filed by illegitimate parties with respect to comparable products²*

- Evocation


Trade mark	Trade mark N.	Owner	Class	Filing date	Status	GI concerned
	CTM 000648733	Nuova Sala S.R.L.	29	22/10/1997	Registered	PDO Parmigiano Reggiano, registered under Regulation 510/2006

- Name of an administrative area within the PDO-PGI or GI relevant geographical zone

Trade mark	Trade mark N.	Owner	Class	Filing date	Status	GI concerned
	CTM 9799263	Ayuntamiento de Tavernes de la Valldigna	31, 32, 35	10/03/2011	Published	PGI Citricos Valencianos, registered under Regulation 510/2006

² This category includes many sub-categories. We have mentioned here the subcategories which are the most difficult to detect by trademark offices: evocation, even concerning the name of an administrative area within the PDO-PGI or GI relevant geographical zone.

iii. Applications containing the registered name of a PDO-PGI or GI filed by illegitimate parties with respect to non comparable products

Trade mark	Trade mark N.	Owner	Class	Filing date	Status	GI concerned
	CTM 004635553	Accelerate S.A.L.	30, 43	05/10/2005	Registered	PGI Café de Colombia, registered under Regulation 510/2006

oriGIn recommendations

From a general perspective, OHIM must conduct a thorough examination of applications conflicting with PDOs/PGIs for agricultural products and wines and with GIs for spirits. To this end, observations by third parties - as provided for by Art. 40 of the CTMR - could prove to be an extremely useful tool to collect relevant information. In our view, the OHIM must pay attention to observations, even if the observer is not a party in the proceedings. Should observations concern Article 14, paragraph 1 of Regulation (EC) 510/06 and/or Article 7, letters (j), (k), (h and (i) of the CTMR, attention to observations must be even higher, in light of the challenges to implement such prohibitions in an *ex-officio* examination.

From a practical perspective, we have come-up with the following recommendations to provide OHIM with concrete elements to deal with trademark applications conflicting with PDOs/PGIs for agricultural products and wines and with GIs for spirits. These recommendations have been formulated with specific regard to the EU Regulations on geographical indications. They are not intended to interpret and/or contradict any further rule and/or practice concerning geographical indications (including specific provisions contained in GI groups' internal regulations touching upon the relations between trademarks and PDOs/PGIs or GIs) which is in force in any single EU Member State.

A. Applications containing the registered name of a PDO-PGI or GI filed by illegitimate parties with respect to comparable products:

We believe this scenario is straightforward:

- When dealing with such an application, the examiner should consult the OHIM database of GIs as well as the official European Commission's databases (DOOR, E-BACCHUS and E-SPIRIT-DRINKS).
- If the trademark contains or consists of the name of a PDO-PGI (or a GI in the case of spirits), such application must be refused.

B. Applications containing imitations, evocations or other misleading uses of a PDO-PGI or GI filed by illegitimate parties with respect to comparable products:

Cases of misuse, imitation or the name of a PDO/PGI or GI, or accompanied by an expression such as 'style', 'type', 'method', 'as produced in', 'imitation' or similar, are relatively easy to detect. The recommendations of paragraph A would therefore apply also to such cases. We believe though that the cases of "evocation", including when the name of an administrative area within the PDO-PGI or GI relevant geographical zone is concerned, deserve specific attention:

Evocation:

- When dealing with such an application, the examiner should consult the OHIM database of GIs as well as the official European Commission's databases (DOOR, E-BACCHUS and E-SPIRIT-DRINKS).
- Moreover, the examiner should make an effort to evaluate the application against the definition of "evocation" consolidated through the European case law and reject it if the evocation of a PDO-PGI (or a GI in the case of spirits) can be clearly assessed. In this regard, it is worth mentioning Case C-87/97, PDO Gorgonzola v Cambozola trademark, Court of Justice of the European Communities (ECJ), Judgment of March 4, 1999 (see in particular paragraph 26: "it is possible for a protected designation to be evoked where there is no likelihood of confusion between the products concerned and even where no

Community protection extends to the parts of that designation which are echoed in the term or terms at issue”) and Case C-132/05, European Commission v Federal Republic of Germany, Court of justice of the European communities (Grand Chamber), Judgment of February 26, 2008 (see in particular paragraphs 48/49: *“That proximity and the phonetic and visual similarities referred to in paragraph 46 above are such as to bring to the mind of the consumer the cheese protected by the PDO ‘Parmigiano Reggiano’, when he is confronted by a hard cheese, grated or intended to be grated, bearing the name ‘Parmesan’. In those circumstances, the use of the name ‘Parmesan’ must be regarded, in the sense of Article 13(1)(b) of Regulation No 2081/92, as an evocation of the PDO ‘Parmigiano Reggiano’.*

- As this can turn out to be a very difficult task for trademark examiners, the “observations by third parties” procedure represents a tremendous opportunity for the OHIM to gather useful information about a potential evocation of a protected geographical name.

Names of administrative areas within the PDO-PGI or GI relevant geographical zone:

- When dealing with such applications, the examiner should consult the OHIM database of GIs as well as the official European Commission’s databases (DOOR, E-BACCHUS and E-SPIRIT-DRINKS).
- Moreover, the examiner should make an effort to evaluate the application against the fact that the use of names of administrative area within the PDO-PGI or GI relevant geographical zone might infringe the right deriving from protected geographical name at issue³. If so, such applications must be rejected.
- As limited sources of information might be available to guide an examiner in such an evaluation, observations by third parties represent a tremendous opportunity for the OHIM to gather useful information in this regard.

³ See OHIM Resolution on Opposition n. B 1 354 689, Consejo Regulador de la IGP Cítricos Valencianos v. Asociación Profesional de Exportadores de Frutos de la Provincia de Castellón, 27/01/2011. See also General Court of the European Union (EGC) Case T 237/08 – Trademark Cuvee Palomar and GI VALENCIA for wines.

C. Registrations containing the registered name of a PDO-PGI or GI filed by illegitimate parties with respect to non comparable products

- When dealing with such an application, the examiner should consult the OHIM database of GIs as well as the official European Commission's databases (DOOR, E-BACCHUS and E-SPIRIT-DRINKS).
- Moreover, Art. 13 of Regulation (EC) 510/2006 provides for protection against "any direct or indirect commercial use of a registered name in respect of products not covered by the registration in so far as those products are comparable to the products registered under that name or in so far as using the name exploits the reputation of the protected name". As Art. 14 of the same Regulation protects PDOs/PGIs against the registration of trademarks corresponding to any of the situations referred to in Art. 13, the OHIM should evaluate the application against the risk of exploiting the reputation of the PDO-PGI (or GI for spirits) at issue⁴. We believe this represents a more classical IPR approach within the examination procedure and OHIM must constantly implement it. In the example presented above – "Colombiano Coffee House" for a chain of bars/restaurants selling espressos – there is in our view a clear attempt to exploit the reputation of the famous PGI "Café de Colombia", which was the first non-European GI to be protected in the EU.
- Observations by third parties represent a tremendous opportunity for the OHIM to gather useful information in this regard.

⁴ With regard to PGIs, it has to be kept in mind that most registrations have been granted because of the reputation of the name which is, therefore, *in re ipsa* for such PGIs.