

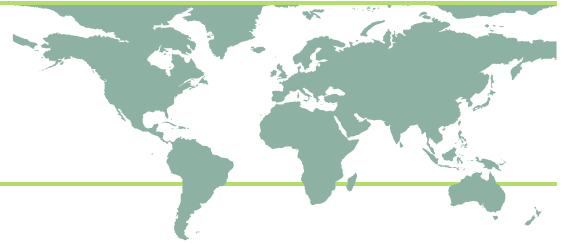
**Proposal for a Regulation of the European Parliament and the Council
amending Council Regulation 207/2009/EC on the Community Trade Mark:
relevant articles impacting on GIs**

- i. **The new Article 7 (j) and (k) of the Regulation on absolute ground for refusal:** [“The following shall not be registered:] (j) trade marks which are excluded from registration pursuant to national or Union legislation or international agreements to which the Union or the Member State concerned is party, providing for protection of designations of origin and geographical indications; (k) trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional terms for wine”;
- ii. **The new Article 8 (4a) of the Regulation on relative grounds for refusal:** “Upon opposition by any person authorised under the relevant law to exercise the rights flowing from a protected designation of origin or a geographical indication, the trade mark applied for shall not be registered where and to the extent that, pursuant to Union legislation or the law of a Member State providing for the protection of designations of origin or geographical indications: (i) an application for a designation of origin or a geographical indication had already been submitted according to Union legislation or the law of a Member State prior to the date of application for registration of the European Union trade mark or the date of the priority claimed for the application, subject to its subsequent registration; (ii) that designation of origin or geographical indication confers on this person the right to prohibit the use of a subsequent trade mark”.

Comments: Both articles should prevent the registration of community trade marks conflicting with PDO, PGI and GIs protected in the EU (registered under the relevant Regulations or protected via international agreements to which the EU is a party) or protected at the national level in EU Member States (including the ones protected via international agreements to which a Member State is a party). However, the effective protection of PDO, PGI and GIs vis-à-vis their registration as trade marks in the EU will depend as well on the concrete application of such rules by the Office for Harmonization in the Internal Market (OHIM) and by national trade mark offices. On the activities carried out by oriGIn to make sure the OHIM and national offices implement correctly the relevant EU Regulations on GIs, please see the following page <http://www.origin-gi.com/component/content/article/184-uk/activities/policy-and-advocacy/4810-gis-and-trademarks-en-qb-4.html>

- iii. **The new Article 74b(1) of the Regulation on certification marks:** “A European Union certification mark shall be a European Union trade mark which is described as such when the mark is applied for and is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, with the exception of geographical origin, from goods and services which are not so certified”.

Comments: While introducing at the EU level the certification mark scheme, it will not be possible to use it to certify the geographical origin of products.



iv. The new Article 9 (5) of the Regulation on goods in transit: “Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the European Union trade mark, the proprietor of a European Union trade mark shall also be entitled to prevent all third parties from bringing goods, in the course of trade, into the Union without being released for free circulation there, where such goods, including packaging, come from third countries and bear without authorization a trade mark which is identical to the European Union trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark. The entitlement of the proprietor of a European Union trade mark pursuant to the first subparagraph shall lapse if during the proceedings to determine whether the European Union trade mark has been infringed, initiated in accordance with the provisions of Regulation (EU) 608/2013 concerning customs enforcement of intellectual property rights, evidence is provided by the declarant or the holder of the goods that the proprietor of the European Union trade mark is not entitled to prohibit the placing of the goods on the market in the country of final destination”.

Comments: This is an interesting precedent which should be explored in the field of GIs. The possibility to seize goods coming from third countries and bearing without authorization a trade mark which is identical to the European Union trade mark registered in respect of such goods or which cannot be distinguished in its essential aspects, which are in transit in the EU (so even though such goods will not be diverted into the EU market) should be provided also for goods bearing GIs. In light of the relevant amount of resources the EU is devoting to the protection and promotion of European GIs in third countries, this would be a coherent consequence.