



Complaints Unit

Operations Support Department
Office for the Harmonization in the Internal Market
Avenida Europa, s/n
E-03008 Alicante
Spain

Geneva, March 26, 2014

COMPLAINT

CTM File Number: CTM No 12025391 “CAFFE’ COLOMBI MILANO LA PASSIONE PER L’ESPRESSO”

Identity of Complainant: Mr. Massimo Vittori, Managing Director of oriGIn, 1 rue de Varembeé, 1202 Geneva – CH

Dear Sirs,

I am writing you in the capacity of Managing Director of the *Organization for an International Geographical Indication Network* –oriGIn--, whose goals are the achievement of a more effective legal protection of geographical indications at the national, regional and international level and the promotion of geographical indications as a tool for sustainable development for local producers and communities.

oriGIn is aware that the Complaints Unit does not have the competence to answer complaints about the legal reasoning of the decisions adopted by OHIM. When an entity managing a Protected Designation of Origin (hereafter, PDO) or a Protected Geographical Indication (hereafter, PGIs) – such as a Spanish *Consejo Regulador* or an Italian *Consorzio*-- disagrees with the legal reasoning of a decisions adopted by the Office, it follows the appropriate proceedings.

However, we file this complaint in the performance of the tasks which oriGIn has been entrusted with, according to its goals and objectives. In this framework, it is not the aim of oriGIn to enter into discussions as to the legal reasoning of a given decision, but merely to highlight a serious mistake which infringes the European legislation on PDO/PGI as well as the practice of the Office put forward in its Manual, and encourage OHIM to correct it.

More specifically, we refer to the **CTM applications No 12025391 “CAFFE’ COLOMBI MILANO LA PASSIONE PER L’ESPRESSO”** and **No 11855723 “CAFFE’ COLOMBI”**.



On 29 May 2013, it was filed the CTM application No 11855723 “CAFFE’ COLOMBI” (word mark) for goods and services in classes 11, 30 and 35 (‘coffee’ and other goods and services related with coffee).

On 13 June 2013, the Operations Department raised an objection since it was considered that the applied sign failed in the ground for refusal set forth in Art. 7(1)(k) CTMR in connection with the PGI ‘Café de Colombia’:

“1. The following shall not be registered:

*(k) trade marks which **contain or consist** of a designation of origin or a geographical indication registered in accordance with 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 (1) when they correspond to one of the situations covered by Article 13 of the said Regulation and regarding the same type of product, on condition that the application for registration of the trade mark has been submitted after the date of filing with the Commission of the application for registration of the designation of origin or geographical indication”.*

On 30 July 2013, the applicant withdrew the objected application and filed the following CTM application No 12025391 “CAFFE’ COLOMBI MILANO LA PASSIONE PER L’ESPRESSO” (covering identical goods and services than the previous one):



The new CTM application was published on 5 September 2013, without having received any objection from the Office. Despite containing exactly the same word elements that gave rise to the objection in the prior sign, this time the Office did not raised a new objection.

On 8 November 2013, the Federación Nacional de Cafeteros de Colombia (FNCC) –the legal entity managing the PGI ‘Café de Colombia’—filed third party observations against the registration of the aforementioned CTM application, on the basis of 7(1)(g) and 7(1)(k) CTMR.

On 17 December 2013, the Operations Department sent a communication to the applicant, issued by the examiner Eric Viala, according to which the third party observations did not give rise to serious doubts as to the registrability of the CTM.



The above demonstrates that the applicant managed to overcome the absolute ground for refusal laid down in Art. 7(1)(k) CTMR by merely adding to the sign the wording “MILANO LA PASSIONE PER L'ESPRESSO”. Such a decision not only infringes Art. 7(1)(k) CTMR and Arts. 13 and 14 of Regulation (EU) 1151/2012 of 21 November 2012 on quality schemes for agricultural products and foodstuffs, but it also disregards the Manual of the Office:

“If the goods in a CTM application are identical or comparable to those protected by a PGI/PDO, in accordance with what was stated in the previous paragraph, this absolute ground of refusal should be raised in the situations below.

(...)

*Article (7)(1)(k) CTMR also applies where the trade mark itself **contains or consists of a term or sign which is ‘evocative’ of the PDO/PGI.***

According to case-law (judgment of 04/03/1999, C-87/97, ‘CAMBOZOLA’, para. 25; and judgment of 26/02/2008, C-132/05, ‘PARMESAN’, para. 44), this notion ‘covers a situation where the term used to designate the product incorporates part of a protected designation, so that when the consumer is confronted with the name of the product, the image triggered in his mind is that of the product whose designation is protected.’

It is possible for a PGI/PDO to be evoked even where there is no actual confusion in the market between the trade mark and the PGI/PDO and even where no Community protection extends to the part of the designation which is echoed in the term or terms at issue (CAMBOZOLA, para. 26). It is also possible for a PGI/PDO to be evoked, although the denomination is not liable to mislead the public (CAMBOZOLA, para. 42).

In summary, the question is whether the elements (visual, phonetic and conceptual) that the trade mark and the PGI/PDO have in common, and the proximity between the products, are such as to trigger associations (‘the image’) of the product bearing the protected name in the mind of the relevant public when encountering the trade mark applied for”.

To summarize, pursuant to Art. 7(1)(k) CTMR, a sign containing or consisting of a PDO/PGI cannot be registered. It is immaterial whether the sign also contains other elements. Therefore, if a given sign is deemed to fall in the absolute ground for refusal set forth in Art. 7(1)(k), the addition of further elements cannot prevent the sign from falling in said ground for refusal. In any case, the applicant should have removed the conflicting elements from the applied sign (but the addition of new ones shall not suffice at all). That is why the decision seems to have been taken under the *likelihood of confusion* approach and not under the approach of the absolute ground for refusal provided in Art. 7(1)(k) CTMR. The above-mentioned approach followed by the Office does not constitute a mere ‘legal reasoning’ subject to discussion; such a decision involves a serious



precedent that infringes the Law of the European Union on PDO/PGI and its well-established case-law. Furthermore, under the above-referred approach, the OHIM's fails to comply with its commitment as authority entrusted with the defence of PDOs / PGIs against CTM applications pursuant to Article 7(1) and 164 CTMR and 14 Regulation 1151/2012.

For the above reasons, I hereby submit this COMPLAINT and request the re-open of the examination on absolute grounds of the CTM application No. 12025391 "CAFFE' COLOMBI MILANO LA PASSIONE PER L'ESPRESSO", having regard, in particular, to the third party observations filed by the representative of the Federación Nacional de Cafeteros de Colombia on 8 November 2013. In this regard, we recall that the re-open of the examination on absolute grounds is expressly provided in the Manual of the Office¹:

*"The examiner may also re-open the examination on absolute grounds on any other ground and at any time prior to registration, namely either when observations of third parties are filed before publication of the application, or **when the examiner finds on their own motion that a ground for refusal has been overlooked**. After publication of the application, this faculty should be made use of only in clear-cut cases".*

Meanwhile, we remain at your disposal for any further clarification you might require in this respect.

Yours faithfully,

A handwritten signature in blue ink that reads "Massimo Vittori".

Massimo Vittori
Managing Director, oriGIn

¹ Part B "Examination", Section 1, 3.1. "Procedural aspects concerning observations by third parties and review of absolute grounds" (pág. 6).