

Mr. António Campinos
Office for the Harmonization of the Internal Market
Avenida Europa, s/n
E-03008 Alicante
Spain

Geneva, 6 February 2013

Re: OHIM's practice regarding the protection of PGIs and PDOs against trade marks for services

Dear Mr. Campinos,

Following our meeting last week, I would like to provide you with more details regarding our concerns on the current OHIM's practice on trade mark applications with respect services conflicting with PDOs / PGIs.

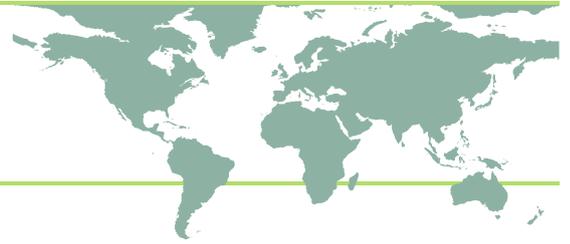
According to Article 13 paragraph 1 letter (a) of the recently adopted Regulation (EU) No 1151/2012, PDOs/PGIs shall be protected against acts of exploitation of protected names' reputation. This can be the case when the protected name is used in relation to non comparable products, including services linked to the relevant product. Furthermore, the wording of letter (b) of Article 13.1 has been amended in the recently adopted Regulation (EU) No 1151/2012 so it now includes "services" within the scope of protection of PDOs and PGIs.

However, the inconsistent drafting of Article 14, dealing with the conditions under which the registration of trademarks conflicting with PDOs and PGIs should be denied, raises a problem. Article 14, in fact, together with a reference to the registration of a trademark the use of which would contravene Article 13(1), still refers to trademarks which relate to a "product of the same type" as those that shall be refused. Due to an overly restrictive interpretation of the content of Article 14, the OHIM worryingly tends to grant trademark protection with respect to services to those names consisting, containing or evoking PDOs/PGIs, without carrying out the possible exploitation of a reputation test.

To illustrate this, concern we would like to highlight the following cases affecting an oriGIn member:

- CTM n° 9225798 "COLOMBIANO" for 'Services for providing food and drink; restaurants, bars and cocktail bar services; catering services; stores administering of food and drink indoor or take away; food & Beverage services; sandwich bars, snack bars' in Class 43.
- CTM n° 84786378 "CCH CO.LOM.BIANO H.O.U.S.E for 'Restaurant and coffee shop services, services for providing food and drink'.

Both trademarks have been granted by the OHIM, notwithstanding an opposition and an application for invalidity filed by the Federación Nacional de Cafeteros de Colombia based on its PGI "Café de



Colombia” for coffee, even though in both cases the applicant and the owner has admitted during the proceedings its intention of to commercialize coffees from origins different from Colombia. The outcome of these cases is encouraging the applicant, a Lebanese company and related physical persons, to file further applications for COLOMBIA trade marks designating coffee shop services.

Instead of applying Article 14 in such a restrictive way, we believe that the overall protection given to PDOs and PGIs – which is not defined only by article 14 but also, and especially, by Article 13.1 – should be taken into account. Otherwise, we will face the twisted result that a trademark which is granted by the OHIM, by virtue of Article 14, shall not be used in the market place since it indeed infringes a PDO/PGI in accordance with Article 13.1. Furthermore, our proposed interpretation is supported by the Recitals 32 and 55 of the Regulation (EU) No 1151/2012 on quality schemes for agricultural products and foodstuffs:

“Protection of designations of origin and geographical indications should be extended to the misuse, imitation and evocation of the registered names on goods as well as on services in order to ensure a high level of protection and to align that protection with that which applies to the wine sector”.

“The criteria by which subsequent trademarks should be refused or, if registered, invalidated on the ground that they conflict with a prior designation of origin or geographical indication should correspond to the scope of protection of designation of origin or a geographical indication laid down”.

Finally, other important intellectual property organisations, like the WIPO, have held that the “*exception to the principle of specialty exists for geographical indications having a reputation*” (cf. report “Possible solutions for conflicts between trademarks and geographical indications and for conflicts between homonymous geographical indications” issued by the WIPO on June 8, 2000, available at www.wipo.int/geo_indications/en/sct.html).

I thank you in advance for the kind attention you will give to this crucial issue for our Members and I am convinced that a solution can be found to this problem, to the benefit of the overall community trademark system as well as of the PDO-PGI system. Meanwhile, I remain at your disposal for any further information you might require.

Yours Sincerely,

Massimo Vittori
Managing Director, oriGIn