

## Complaints Unit

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

Genève, November 14, 2014

## COMPLAINT

### CTM Files Number:

**CTM No 010167674 “PISCO”**

**CTM No 010167682 “PISCO SOUR”**

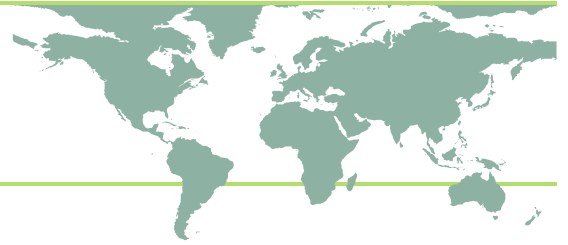
**Identity of Complaint: Massimo Vittori (Managing Director of oriGIn) on behalf of oriGIn**

Dear Sirs,

I am writing to 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 concerning the legal reasoning of decisions granted by the OHIM. When an entity managing a Geographical Indication disagrees with the legal reasoning of a decision, it must follow the appropriate OHIM proceedings to try to reverse it.

As a result, it is not the aim of oriGIn to enter into discussions as to the legal reasoning of a decision, but merely to highlight what we believe is a serious mistake with respect to the implementation of the relevant European legislation on GIs as well as of the practice of the



Office as codified in its Manual. Moreover, I wish to clarify that oriGIn files this complaint accordingly to the goals it pursues as well as the tasks it has been entrusted with.

We refer to the **CTM applications No 010167674 “PISCO” and No 010167682 “PISCO SOUR”**.

On 18 July 2011, the OHIM received the CTM applications No 010167674 “PISCO” and No 010167682 “PISCO SOUR” for ‘*alcoholic beverages*’ in class 33.

After receiving third party observations, on 27 January 2012, the Operations Department raised an objection since it considered that the ground for refusal set forth in Art. 7(1)(j) CTMR applied as the application conflicted with the GI ‘Pisco’.

In order to overcome the *ex officio* objection, the applicant limited the goods designated in the CTM application as follows: ‘*Alcoholic beverages, brandy; with the protected geographical indication “PISCO”*’. Following this, the OHIM withdrew the objection.

Then, the INSTITUTO NACIONAL DE DEFENSA DE LA COMPETENCIA Y DE LA PROTECCIÓN DE LA PROPIEDAD INTELECTUAL (hereafter, the “INDECOPI”) opposed to both CTM applications. After having concluded the Opposition proceedings with the rejection of the oppositions, the INDECOPI appealed the Decision of the Opposition Division and the files are being examined by the Board of Appeal.

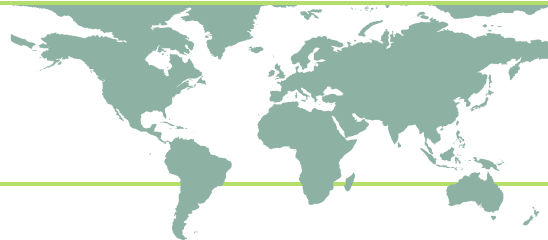
In light of the above, our concern is that the contested CTM applications overcame the examination of absolute grounds in breach of Article 7(1)(j) CTMR and in obvious contradiction with the practice of the Office. First of all, the restriction mentioned by the applicant of the CTMs “PISCO” and “PISCO SOUR” does not follow the proper wording established in the Guidelines:

*[name of the product] complying with the specifications of the [PDO/PGI ‘X’]*

But the restriction of the CTM applications at issue not only are not in accordance with the proper wording set out in the Guidelines, but also consists of one of the wordings which is expressly rejected: according to the Guidelines, “*Restrictions such as [name of the product] with the [PDO/PGI ‘X’] are not acceptable*”.

The Guidelines for Examination state the following as regards Article 7(1)(j) CTMR:

*“Restriction of goods can be a complex task, which may depend to a large extent on a case-by-case examination.*



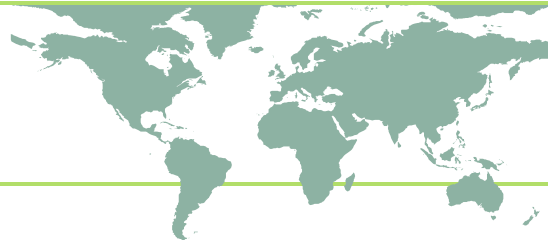
- **Products of the same type** as those covered by the PDO/PGI must be restricted in order to meet the specifications of the PDO/PGI. The proper wording is '[name of the product] complying with the specifications of the [PDO/PGI 'X']'. No other wording should be proposed or allowed. **Restrictions such as '[name of the product] with the [PDO/PGI 'X']' or '[name of the product] originating in [name of a place]' are not acceptable.**

PDO/PGI in the Community trade mark	Acceptable list of goods
<b>Slovácká</b> (PDO-CZ-A0890)	Wine complying with the specifications of the PDO 'Slovácká'

- The **category of products** that includes those covered by the PDO/PGI should be restricted to designate 'wines' that comply with the specifications of the PDO/PGI. For spirit drinks, the restriction should designate the exact category of product (e.g. 'whisky', 'rum', 'fruit spirit', in accordance with Annex III of Regulation (EC) No 110/2008) that complies with the specifications of the Geographical Indication.

PDO/PGI in the Community trade mark	Original specification (not acceptable)	Acceptable list of goods	Explanation
<b>TOKAJI</b> (PDO-HU-A1254)	Wines	Wine complying with the specifications of the PDO 'Tokaji'	The CTM can be accepted only for wine covered by the PDO

**Comparable products** are restricted to those products, within the category of comparable products, covered by the PDO/PGI”.



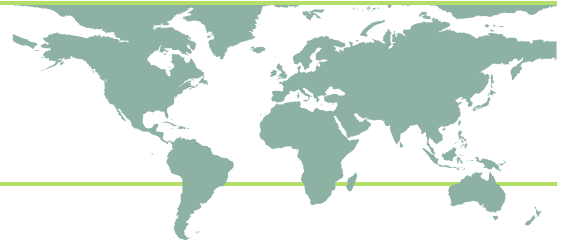
PDO/PGI in the Community trade mark	Original specification (not acceptable)	Acceptable list of goods	Explanation
<b>MOSLAVINA</b> (PDO-HR-A1653)	Alcoholic beverages (except beers)	Wine complying with the specifications of the PDO Moslavina'; Alcoholic beverages other than wines	The CTM can be accepted only for wine covered by the PDO, and for alcoholic beverages other than wines.

Moreover, the restriction is inaccurate and inoperable. The limitation mentions 'alcoholic beverages', which is a very broad expression covering a wide range of spirits that are not protected under the relevant Geographical Indication (for instance, vodka, rum, whisky, etc). It also mentions, 'brandy', a specific spirit drink, which clearly does not correspond the one protected under the Geographical Indication "Pisco".

Likewise, the Office decision to withdraw its objections seems to us not in line with the relevant EU legislation nor with its own practice.

Furthermore, with the above-mentioned decision, 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 Article 23 of Regulation (ED) 110/2008.

For the above reasons, by submitting this COMPLAINT, we would like to request the re-opening of the examination of the CTM applications No 010167674 "PISCO" and No 010167682 "PISCO SOUR" on absolute grounds, having regard, in particular, to the third party observations filed by the representative of the INSTITUTO NACIONAL DE DEFENSA DE LA COMPETENCIA Y DE LA PROTECCIÓN DE LA PROPIEDAD INTELECTUAL "INDECOPI" on 12 March 2012. In this regard, we recall that the re-opening of the examination on absolute grounds is expressly provided in the **Guidelines for Examination in the Office, Part B, Examination**, page 6:



*“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.”*

In this respect, it is worth recalling that in the file of CTM No. 6.211.999 “PURO TEQUILA PALAPA”, the Board of Appeal, in Decision of 19 December 2011, remitted the application for registration to the Operations Department of the Office for a new examination according to Art. 7(1)(j) CTMR. The Operations Department found that the trade mark “PURO TEQUILA PALAPA” did fall within the scope of article 7(1)(j) and asked the applicant to restrict the designated goods. Since the applicant did not answer said proposal, the trade mark was finally refused.

I remain at your disposal for any further clarification and look forward to hearing from you.

Yours faithfully,

A handwritten signature in blue ink, reading "Massimo Vittori".

Massimo Vittori  
Managing Director of oriGIn