

EUIPO's Practice on TMs & GIs

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CONTENT

TMs

Individual

Collective

Certification

GIs

Nature

Means of protection

Scope of protection



Ex-officio examination
of TM applications

GIs as earlier rights

	GIs	Individual TM	Collective TM	Certification TM
Definition	Name or indication which identifies a product with specific geographical origin	Distinguishing the goods or services of one undertaking from those of other undertakings	Distinguishing the goods or services of the members of an association from those of other undertakings	Distinguishing goods or services certified by the proprietor from those not so certified
Essential Function	Geographical Origin	Commercial Origin	Collective Commercial Origin	Compliance with Certification Scheme
Geo Terms	YES	NO	YES	NO (EU) YES (National)
Right To Use	Any operator complying with specifications	Proprietor and Licensees	Association Members Bona Fide Third Parties	Certified Users Bona Fide Third Parties* Not the Proprietor

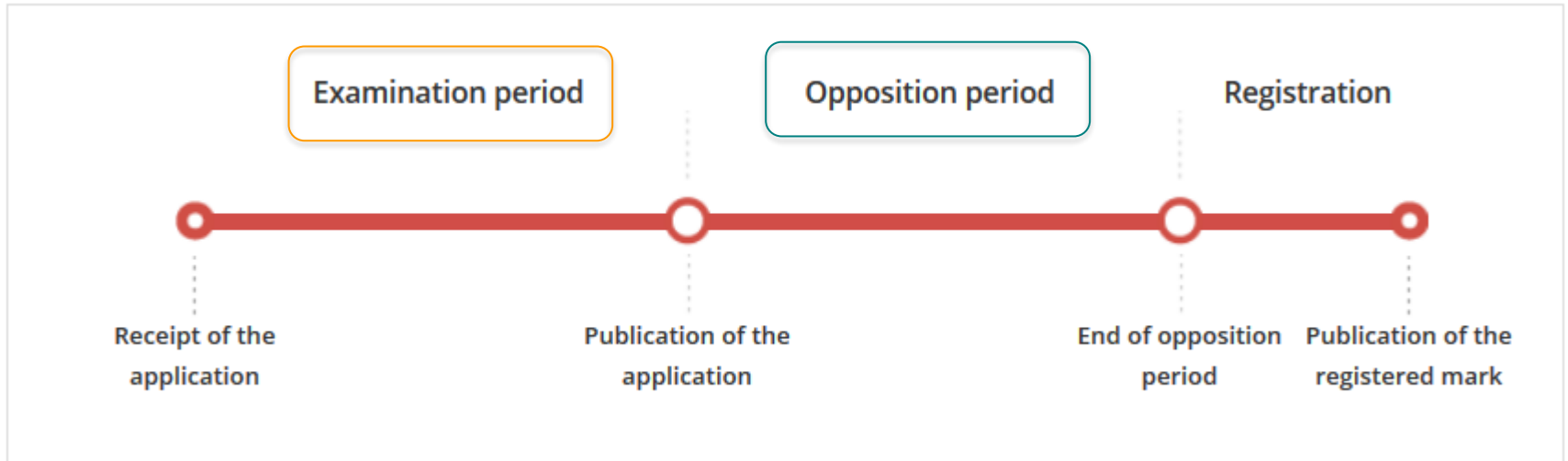
REGISTRATION PROCES EUTM

EX OFFICIO EXAMINATION

Conflict with, among others,
protected geographical indications
Article 7(1)(j) EUTMR

INTER PARTES PROCEEDINGS

Protected geographical indication invoked
as an earlier right by
opponent/cancellation applicants
Article 8(6) EUTMR



GEOGRAPHICAL INDICATIONS – ABSOLUTE GROUNDS

Three cumulative conditions for Article 7(1)(j) EUTMR to apply:

- registered GI
 - conflict with GI
 - identical/comparable goods
-
- GIview <https://www.tmdn.org/giview/>

General remarks: how EUIPO interprets EU Regulations

Commercial Use (direct or indirect)

- Trade mark contains/consists of the GI
- High degree of visual and aural similarity (*Scotch Whisky*)
- Scope of protection extended to dissimilar goods and services if **exploitation** of reputation of GI proven

Misuse Imitation Evocation

- Public establishes a sufficiently clear and direct link between TM and GI (*Verlados*)
- Visual, aural or conceptual similarity e.g. terms share characteristic beginning or ending, conceptual proximity (*Scotch Whisky*)
- Indicators of the true origin of the product not to be taken into account (*Scotch W*)

False Misleading Indications or practices

- Whether or not an indication (an element in the trademark, word, image, container) is 'liable to convey a false impression as to [the product's] origin or to the nature or essential qualities of the product' (*Scotch Whisky*)

HOW TO INTERPRET THESE CONCEPTS? CASE – LAW

- **C-44/17 SCOTCH WHISKY/GLEN BUCHENBACH, 07.06.2018**

- The Scotch Whisky Association contested the marketing (via website) of whisky – not Scotch whisky – sold under the designation ‘Glen Buchenbach’.
- ECJ addressed the conducts under Article 16(a) to (c) of R110/2008 (commercial use, evocation base on conceptual proximity, misleading indications and context of use)



- **C-614/17 QUESO MANCHEGO/ ROCINANTE, 02.05.2019**

- Queso Manchego Foundation invoked Article 13(1)(b) of R510/2006 against labels bearing the word ‘Rocinante’ & including pictorial elements typical of the region of “La Mancha”, used to market cheese not conforming with the specifications of the PDO ‘queso manchego’.
- ECJ: a registered PDO may be evoked through the use of figurative signs (such as the image of the literary character Don Quixote de La Mancha), irrespective of whether the goods originate from a producer established in that region, but whose (similar or comparable) products do not comply with the PDO.



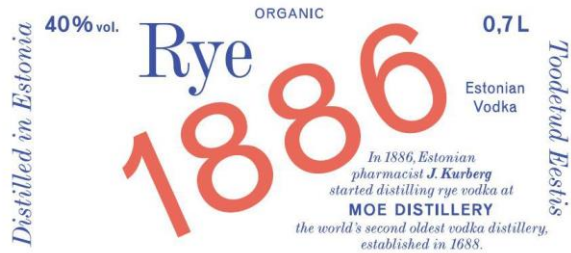
EUIPO PRACTICE



Use
(direct or indirect)

- Trademark contains/consists of the GI
- High degree of visual and aural similarity
- Identical products, also covers:
 - commercially relevant ingredient (may determine the choice of the main product e.g. apples v jam)
 - the specific object of a services e.g. honey v. retail of honey)
- ‘Comparable products’ – restrictive, independent of ‘similarity’ concept in RG .
- (dissimilar in RG)

EXAMPLE – IDENTITY (USE)



EUTM No 18 226 764



Goods and Services

Class 33 – alcoholic beverages (except beers)



Potential issues

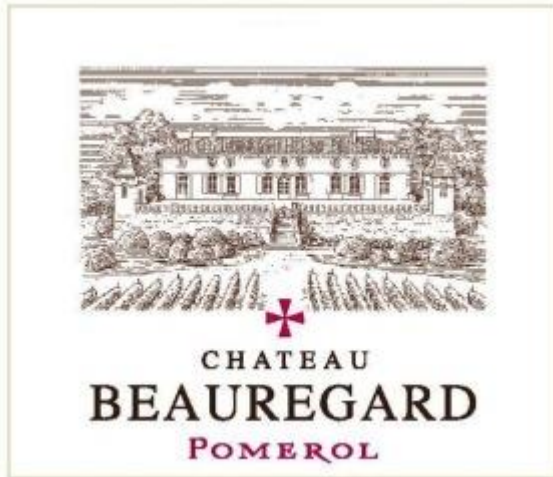
Possible conflict with geographical indication
ESTONIAN VODKA (PGI/EE/01971)



Result

Application registered after limitation to products complying with the specification of the GI

EXAMPLE – IDENTITY (USE)



EUTM No 17 889 185



Goods and Services

Wines



Potential issues

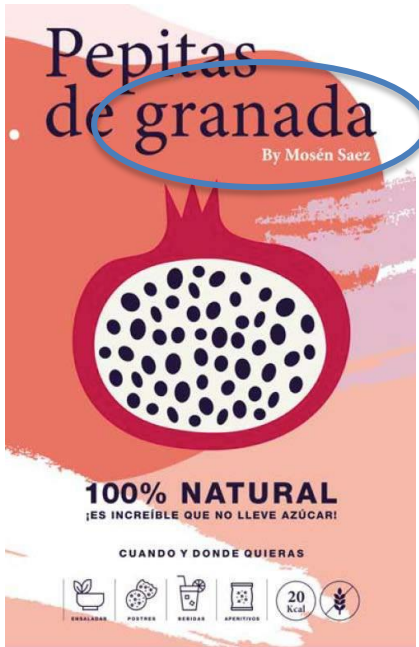
Possible conflict with geographical indication
POMEROL (PDO-FR-10273)



Result

Application registered (after limitation)

EXAMPLE –IDENTITY (USE)



Goods and Services

Inter alia, agricultural products, non-alcoholic and alcoholic beverages



Potential issues

Conflict with geographical indication GRANADA (PDO-ES-A1475) for wines?



Result

GRANADA in Spanish refers both to “pomegranate” and to the geographical place in Andalucia. In the sign, the reference to “granada” is clearly to the fruit. No conflict

EUTM No 18 080 466

EUIPO PRACTICE

Misuse
Imitation
Evocation

- Misuse: false indications
- Imitation and evocation: overlapping terms
- Evocation: the public establishes a sufficiently clear and direct link between the term in the TM and the GI (*Verlados*)
- Visual, aural or conceptual similarity e.g. terms share characteristic beginning or ending, conceptual proximity (*Scotch Whisky*)
- Not cumulative conditions: mere conceptual proximity enough, e.g. via use of figurative signs (*Queso Manchego*)
- Indicators of the true origin of the product not to be taken into account (*Scotch Whisky*)
- proximity of the goods concerned is a factor but AG EUIPO does not go into dissimilarity.

EXAMPLE – EVOCATION



EUTM No 15 420 607



Goods and Services

Whisky; Blended whisky; Whisky liqueurs



Potential issues

Possible conflict with geographical indication
SCOTCH WHISKY (PGI-GB-01854)



Result

Application registered after limitation to “all
aforementioned goods complying with the
specifications of the PGI Scotch Whisky”

EXAMPLE – EVOCATION



EUTM No 18 015 193



Goods and Services

Inter alia, tomatoes



Potential issues

Possible conflict with geographical indication
POMODORINO DEL PIENNOLO DEL VESUVIO
(IT/PDO/0005/0576)



Result

Application registered after limitation to products
complying with the specification of the GI

EXAMPLE - NO CONFLICT

Cavalcade

EUTM No 17 929 998



Goods and Services

Wines



Potential issues

Conflict with geographical indication CAVA (PDO-ES-A0735)?



Result

The public will not dissect artificially the sign, perceive the term CAVA and link it to the wine. No conflict

EXAMPLE - PRACTICE

False
Misleading
Indications
or practices

- Test: whether or not an indication (an element in the trade mark, word, image, container) is ‘liable to convey a false impression as to [the product’s] origin’ or to the nature or essential qualities of the product” (*Scotch Whisky*)
- Does it extend to reproduction of the shape or the appearance which are characteristic of a product?
- The context in which the possible misleading indication is used is not to be taken into account (*Scotch Whisky*)
- The Office relies on third party observations

EXAMPLE - MISLEADING



EUTM No 018 022 404



Goods and Services

Inter alia, non-alcoholic beverages, beer



Potential issues

Conflict with the PGI TEQUILA (PGI-MX-01851)

If the mark has 'tequila' on it, it must actually contain real tequila in a determined percentage, so it cannot be applied for goods in Class 32



Result

Application withdrawn after being objected by EUIPO

CONCLUSION



Certification



Collective



GI



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Thank you