

# Issues relating to the use of GIs as product's ingredients and the registration of collective trademarks by producer groups

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EUTM n° 1753284

EUTM n° 1116458

EUTM n° 18135524



“PROSCIUTTO DI PARMA” “PARMA”

Class 29: Cheese / Parma ham / Prosciutto produced in accordance with the specifications of the protected designation of origin “Prosciutto di Parma”.

## Article 12

### Names, symbols and indications

5. Without prejudice to Directive 2000/13/EC, the collective geographical marks referred to in Article 15 of Directive 2008/95/EC may be used on labels, together with the protected designation of origin or protected geographical indication.

## Article 45

### Role of groups

The group of producers working with the GI product is entitled to:

(b) take action to ensure adequate legal protection of the protected designation of origin or protected geographical indication and of the intellectual property rights that are directly connected with them.

## Article 32

### Producer groups

2. A producer group may exercise in particular the following tasks:

(da) engage in appropriate action to ensure protection of the geographical indication and of the intellectual property rights that are directly connected with it, including filing applications for actions with custom authorities in accordance with Regulation (EU) No 608/2013 and preventing or countering any measures which are, or risk being, detrimental to the reputation of the geographical indication concerned

## Article 35

### Relationships between geographical indications and trade marks

5. Without prejudice to Regulation (EU) No 1169/2011, guarantee or certification marks referred to in Article 28(4) of Directive (EU) 2015/2436 and collective marks referred to in Article 29(3) of that Directive, as well as collective marks and certification marks as referred to in Chapter VIII of Regulation (EU) 2017/1001 may be used on labels, together with the geographical indication.

### ***Spanish Law (Law 6/2015):***

Article 16. Tasks of the groups of producers.

a) Promotion and defence of the protected product, registering trade marks, domain names and other IP rights that complement the specific GI system

### ***Italian Law (Law 21 December 1999):***

Articles 14, 16: Possibility for the Consorzi to register collective marks, under the condition to authorize the use to all the producers complying with the specifications of the PDO

## *Not only GIs!*

### *Other geographically descriptive collective marks*

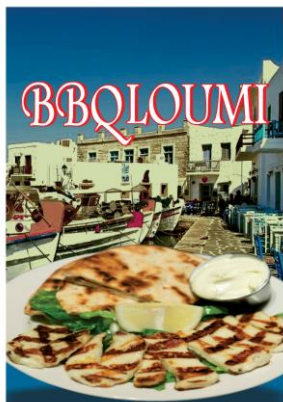
- EUTM n° 18132842 “**Swiss**”
- Class 14: Horological and chronometric instruments; watches; parts and fitting for the aforesaid goods.
- Fédération de l'Industrie Horlogère Suisse (FH)
- EUTM n° 16643678 “**SWISS CERTIFIED ROASTERS**”
- Class 30: Coffee; Coffee-based beverages; Artificial coffee; Coffee pods; Coffee extracts; Coffee flavorings; Coffee mixtures; Substitutes (coffee -); Iced coffee; Ground coffee; Coffee beverages with milk; All the aforesaid products of Swiss origin.
- SCHWEIZER RÖSTERGILDE



## The turning point

- Collective EUTM nº 1082965 “**HALLOUMI**” for ‘Cheese’ (cl. 29) in the name of the Foundation for the Protection of the Traditional Cheese of Cyprus named Halloumi.
- Applied for on 22/2/1999 and registered on 29/11/1999.

Oppositions →



\*Later application of the **PDO Halloumi**

72. (...) Article 7(1)(b) and Article 7(3) EUTMR apply to EU collective marks. Consequently, those marks must in any event (...) be distinctive.

73. [Article 74(2) EUTMR] is not an exception to that requirement of distinctiveness. While that provision **permits**, by way of derogation from Article 7(1)(c) of that regulation, **registration as EU collective marks of signs which may serve to designate the geographical origin of goods or services, it does not, on the other hand, allow the signs thus registered to be devoid of distinctiveness.** Where an association applies for registration, as an EU collective mark, of a sign which may designate a geographical origin, it is therefore incumbent on it to ensure that that sign has elements which enable the consumer to distinguish the goods or services of its members from those of other undertakings.

76. the term ‘halloumi’, the sole element of which that earlier mark consists, designates a particular type of cheese produced according to a special recipe and that the distinctiveness of such a mark, which is restricted to designating a type of product, is weak.

**No LOC**



## ASSESSMENT OF DISTINCTIVENESS (7.1.b EUTMR)

### *Guidelines:*

Services / Goods	Rejected	Accepted
Tourist services	'ALICANTE'	'ASSOCIATION OF GUIDES OF THE CITY OF ALICANTE'
Edible oils	'OIL FROM THE VALENCIAN REGION'	'REGULATORY BOARD OF THE PDO OIL FROM THE VALENCIAN REGION'

You better include the name of the owner association!



Registered



Registered



Registered



Registered

“Blue  
Pyrenees”

Refused



Individual	Individual	Individual	Collective
33: Alcoholic beverages (except beer).	30: Coffee, teas, cocoa; Processed grains; Honey; Spices...	30: Coffee, tea... 31: Fruits...	29: Caviar, trout, foodstuffs elaborated with trout... 31: Trout (live animals).



**Collective EUTM nº 18482810**



**Refusal Decision** of 18/11/2021:

*The relevant public will simply perceive the sign '100% PYRÉNÉES EAU VIVE DES PYRÉNÉES' as a non-distinctive indication conveying that the products come entirely from the Pyrenees.*

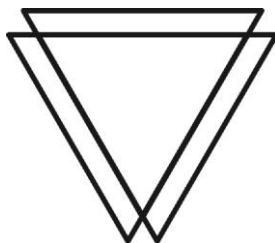
*Given that the combination of elements '100% PYRÉNÉES EAU VIVE DES PYRÉNÉES' is a laudatory combination, in order for said combination to be registered as a trademark, it should contain figurative elements or characteristics that draw the attention of the average consumer, elements that would facilitate to recall and identify the sign with a particular commercial origin. But this is not the case here.*



**Refused** collective mark on the basis of 7(1)(b) EUTMR:

***EUIPO: Does not enable the consumer to distinguish the goods of the members of the association from those of other undertakings.***

**Accepted** individual marks:



***Do they enable the consumer to distinguish the goods/services of one undertaking from those of other undertakings?***



## *Misleading as to the character or meaning of the mark*

**76(2) EUTMR:** An application for an EU collective mark shall also be refused if the public is liable to be misled as regards the character or the significance of the mark, in particular if it is likely to be taken to be something other than a collective mark.

### **EUIPO's Guidelines: Refusal** if:

- If it conveys a strong certification message: in contradiction of the function of the collective mark.
- If it consists of (i) a GI or (ii) a logo contained in the GI product specification: the public will believe that this is a GI rather than a collective mark, whose function is to indicate the membership of an association.



## Misleading as to the character or meaning of the mark

### EUIPO's practice:

GI's product specifications



EU collective mark



Südtiroler Speck Konsortium  
Consorzio Tutela Speck Alto Adige



Consumer will wrongly  
believe this is a GI and  
not a collective mark

## *Misleading as to the character or meaning of the mark*

**Those collective marks are not misleading as to the character of the mark.**

The real problem is:

### **GI EU specific Regulations:**

*GIs may be used by any operator marketing a product conforming to the corresponding specification (no requirement of membership to a group of producers).*

### **EUTMR:**

*Art. 74(1): the mark is applied for and is capable of distinguishing the goods or services of the members of the association which is the proprietor of the mark from those of other undertakings.*

*Art. 75(2). The regulations governing use of a mark shall authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark.*

## *Misleading as to the character or meaning of the mark*

Application of Art. 76(2) EUTMR to collective marks applied for by the legitimate group of producers and restricted to products complying with the GI specifications is just a subterfuge:

- Consumers understand there is a GI and a collective mark (the same way they understand it when the name of the group is attached to the sign).
- Even if mixing both, that message would never be misleading: the GI exists, the designated goods comply with the GI specifications and the applicant is the legitimate group.
- GIs are names, not figurative signs.
- Inclusion of the figurative sign in the GI specifications does not grant protection for it.
- However, the groups of producers are entitled to *“take action to ensure adequate legal protection of the protected designation of origin or protected geographical indication and of the intellectual property rights that are directly connected with them”* (art. 45.1.b Regulation 1151/2012).
- There is no real ground for refusal applicable to these marks.



## Misleading as to the character or meaning of the mark

*“Verified sustainable agriculture · Region of Murcia”*



29: Meat; Fish; Milk products; Edible oils and fats...

30: Coffee, teas and cocoa; Condiments...

31: Raw and unprocessed agricultural products; Fresh fruits and vegetables...

32: Beer; Non-alcoholic beverages; Juices...

33: Alcoholic beverages (except beer)...

Applicant: COMUNIDAD AUTONOMA DE LA REGIÓN DE MURCIA

Individual mark

**Published**

What about the general rule  
of Art. 7(g)? Deceptive marks

Third party's observations dismissed

## *Products used as ingredients*

Commission Communication — Guidelines on the labelling of foodstuffs using protected designations of origin (PDOs) or protected geographical indications (PGIs) as ingredients - 2010/C 341/03

Recommendations on the use of registered names:

- List of ingredients of a foodstuff: no conditions
- Mentioned in or close to the trade name of a foodstuff, labelling, presentation and advertising – 3 conditions:
  1. Not contain any other ‘comparable ingredient’
  2. Be used in sufficient quantities to confer an essential characteristic on the foodstuff concerned
  3. The percentage of incorporation of an ingredient with a PDO or PGI should ideally be indicated in or in close proximity to the trade name of the relevant foodstuff or, failing that, in the list of ingredients

12% DOP «Champagne»



## **Article 28**

### **Ingredients in the names of processed products**

2. Without prejudice to Article 27, the geographical indication designating a product ingredient may be used in the name of the related processed product, where:

- a) the processed product does not contain any other product comparable to the product ingredient designated by the geographical indication included in its name;
- b) the concerned product ingredient is used in sufficient quantities to confer an essential characteristic on the processed product concerned; and
- c) the percentage of the concerned product ingredient in the processed product is indicated in the label.

The first subparagraph shall not apply to spirit drinks.



- **Products used as ingredients:** if the goods covered by the GI can be used as a commercially relevant ingredient (in the sense that it may determine the choice of the main product) of any of the goods included in the EUTM application, a restriction will be requested. This is because [Article 13\(1\)\(a\) and \(b\) of Regulation \(EU\) No 1151/2012](#) expressly extends the scope of protection of a GI registered for a given product 'when those products are used as an ingredient';

GI in the EUTM	Original specification (which is not acceptable)	Acceptable list of goods	Explanation
<a href="#">PROSCIUTTO DI PARMA</a> (PDO-IT-0067) for ham	<i>Pizzas</i>	<i>Pizzas with '<a href="#">Prosciutto di Parma</a>' (GI) ham</i>	This topping is the main ingredient of a pizza and the one that determines the consumer's choice.



GI in the EUTM	Original specification (which is not acceptable)	Acceptable list of goods	Explanation
<p><b><u>SCOTCH WHISKY</u></b> (PGI-GB-01854) <i>for whisky</i></p>	<p><i>Cocktails</i></p>	<p><i>'<u>Scotch Whisky</u>' (GI) whisky-based cocktails</i></p>	<p>The EUTM can be accepted for cocktails made of whisky complying with the specifications of the GI.</p> <p>Contrary to wines, <i>cocktails, other than whisky-based</i> are not acceptable to the extent that they may be deceptive.</p>

A restriction is not necessary if the goods covered by the GI are used as a secondary, not commercially relevant, ingredient of the claimed goods.

GI in the EUTM	Original specification	Acceptable list of goods	Explanation
<p><u>ACEITE DE LA ALCARRIA</u> (PDO-ES-0562) <i>for olive oil</i></p>	<p><i>Pastry</i></p>	<p><i>Pastry</i></p>	<p>The goods do not need to be restricted by the mere fact that <i>oil</i> is used in their preparation. <i>Oil</i> is a secondary ingredient that is not commercially relevant.</p>



## **Trade mark “CAVARQUIA BARCELONA” for “PDO Cava sparkling wine –based cocktails”**

Confirms the refusal of the mark

*“In this debate on the viability of registering the trademark there is no place for any analysis of the quality or components of any product, a task for which, moreover, the Spanish Patent and Trademark Office has no competence”.*



**Thank you for your attention**