

TMs and GIs: the EUIPO's perspective

Katarina KOMPARI
05 March 2019

CONTENT

Effort

- Guidelines
- Dedicated team

Constraints

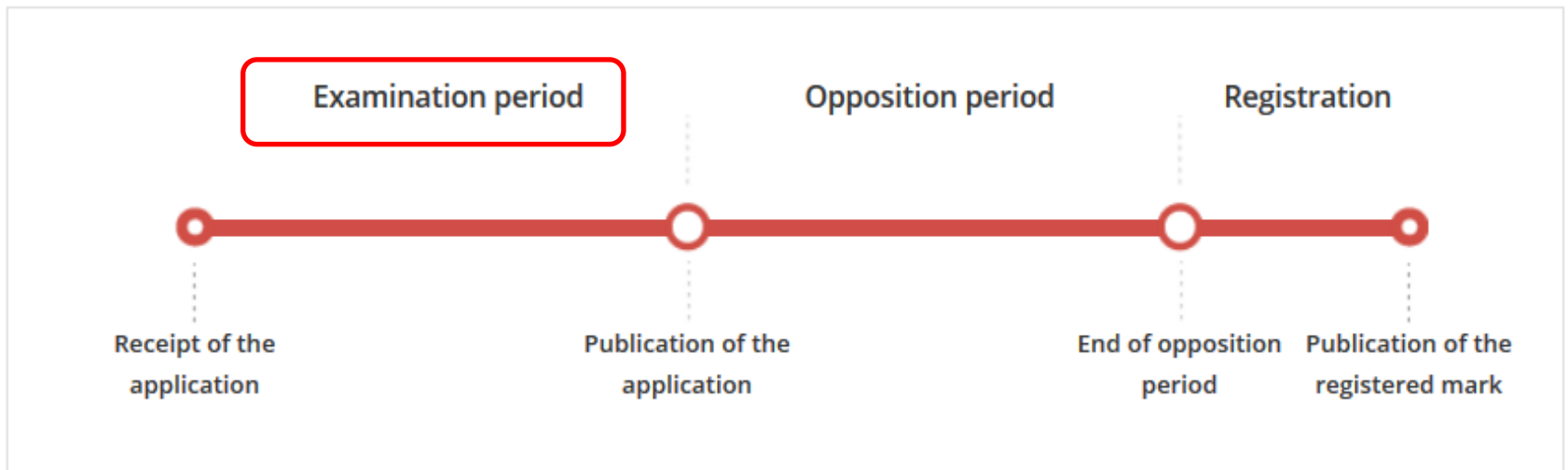
- Tools
- Alien legal concepts
- Balance of rights

Future

- Case-law clarifications
- Users awareness
- Improvement of tools

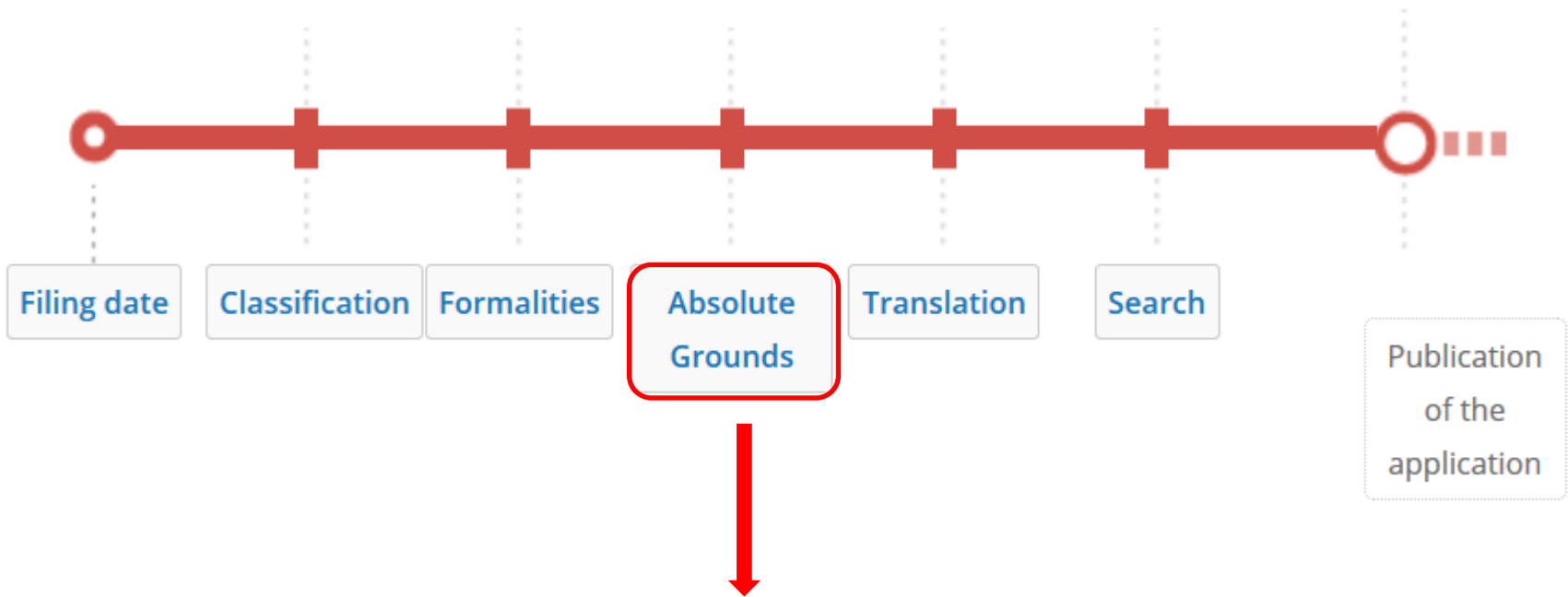
PRELIMINARY NOTE

REGISTRATION PROCESS OF A EUTM THE EX OFFICIO EXAMINATION



PRELIMINARY NOTE

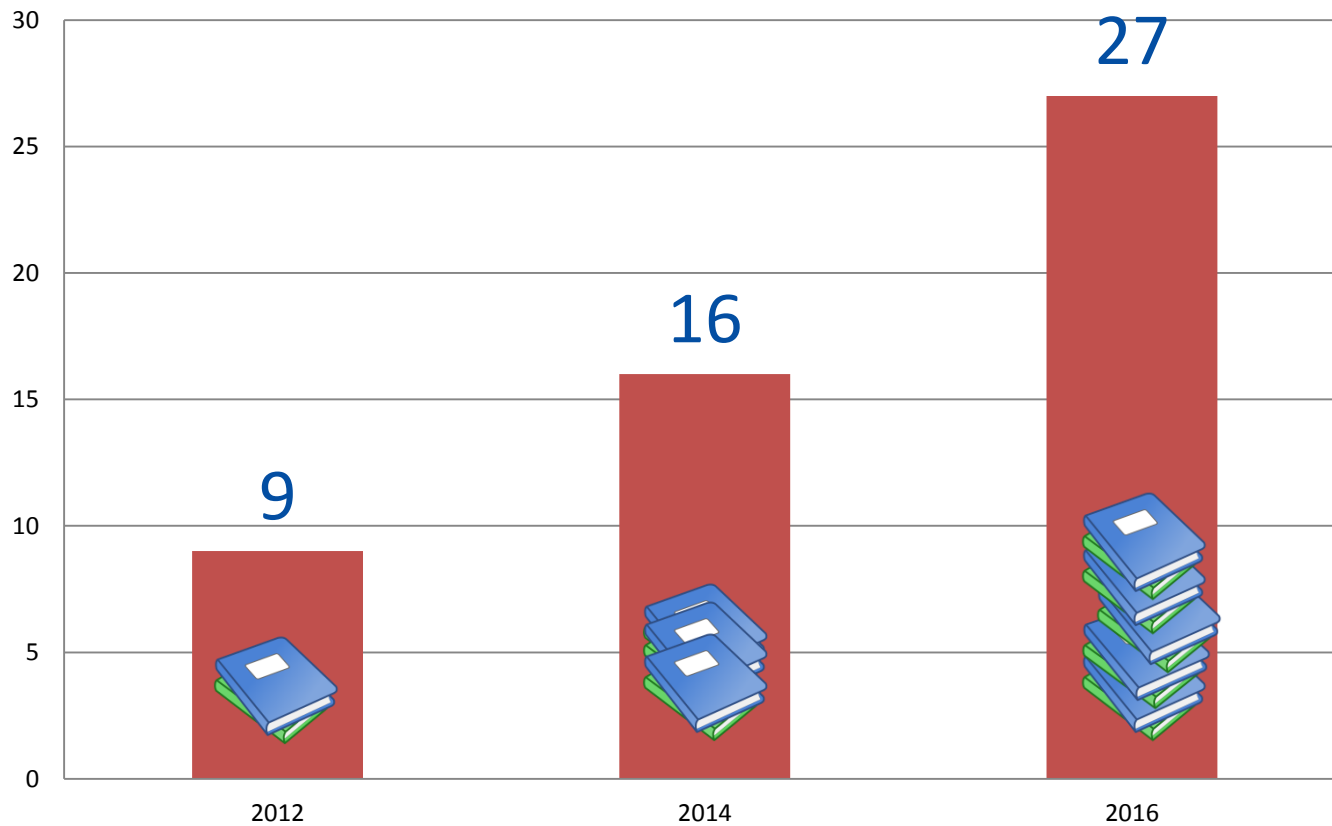
EXAMINATION PERIOD



**EX OFFICIO EXAMINATION OF, AMONG OTHERS,
CONFLICTS WITH GIs**

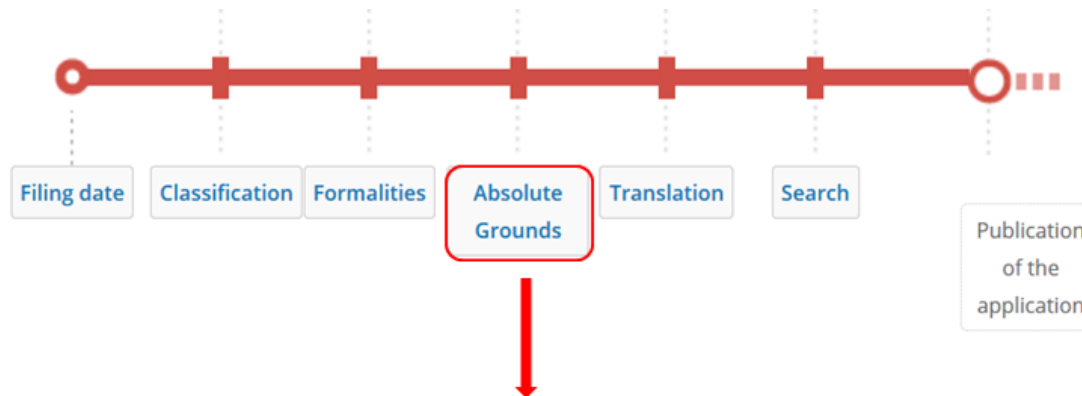
EFFORT - GUIDELINES

EUIPO Guidelines - Number of Pages on GIs



EFFORT - DEDICATED TEAM

OPERATIONS DEPARTMENT WORKFLOW



APPLICATION
(EUTM/IR)

ICE
(pre-screening)

GI EXPERT GROUP
(assessment)

EFFORT- DEDICATED TEAM

GI EXPERT GROUP

- **Origin:** complexity in examination of GIs
- **Kick-off:** September 2017
- **Members:** 12 OD examiners + 2 observers from ICLAD
- **Meetings:** weekly.
- **Tasks:** Assessment of all potential TMs in conflict with GIs and drafting of objections
- **Knowledge sharing:** interesting cases reported to all examiners; liaison with inter-partes examiners (opposition – cancellation)
- **Impact on practice:** liaison with Legal Affairs Service

EFFORT - DEDICATED TEAM

GI EXPERT GROUP

+/- 240 objections

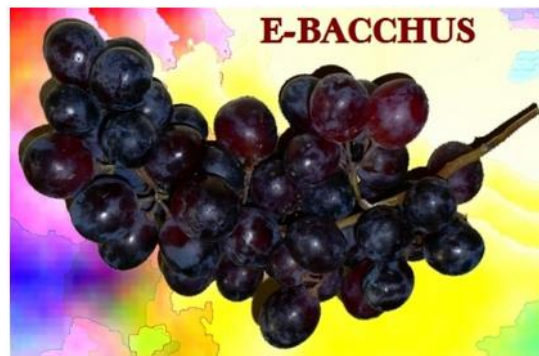
CONSTRAINTS - TOOLS

Lack of one single database for all protected GIs



AGRICULTURE AND RURAL DEVELOPMENT DOOR

Total: 1533		GIs from non-European countries protected in the EU			Date: 26/06/2018	Version 1.0
<p><small>This list is for information purposes only. Only the legal texts of the respective agreements published in the Official Journal of the EU have legal value. Some agreements use terms such as "name of origin" or "product designations" rather than "geographical indication". For all legal provisions, refer to the texts of the relevant agreements. Meaning of asterisk (*): *Kosovo under United Nations Security Council Resolution 1244.</small></p>						
Name of 3rd country GI protected in EU	Transcription (if exists)	Legal instrument establishing Protection	Applicable date of Protection EU	Country	Sector	Class























Register of geographical designations of Aromatized drinks based on wine products

- Nürnberger Glühwein
- Samoborski bermet
- Thüringer Glühwein
- Vermouth de Chambéry
- Vermouth di Torino



CONSTRAINTS – LEGAL MATRIX

IP title originating from (protected by)	Foodstuffs	Wines/ Aromatised wines	Spirit drinks	Non-Agricultural products
<u>From MS or 3rd countries</u> EU-wide protection (4 EU Regulations)	 Parma, Café de Colombia	 Rioja, Vale dos Vinhedos (Brazil), Vermouth di Torino	 Cognac, Pisco from Perú	 (no legislation)
From a <u>MS</u> (national legislation)	 (EU law exhaustive)	 (EU law exhaustive)	 (EU law exhaustive)	 Herend Porcelaine
From a <u>MS</u> (MS int'l agreement)	 (EU law exhaustive)	 (EU law exhaustive)	 (EU law exhaustive)	 Herend Porcelaine
<u>From 3rd countries</u> (EU int'l agreements)	 Korean White Ginseng	 Alexander Valley (US)	 Tequila from Mexico	 (no agreement)
<u>From 3rd countries</u> (MS int'l agreements)	 (EU law exhaustive)*	 (EU law exhaustive)*	 (EU law exhaustive)*	 Kilim carpets

CONSTRAINTS – ALIEN LEGAL CONCEPTS

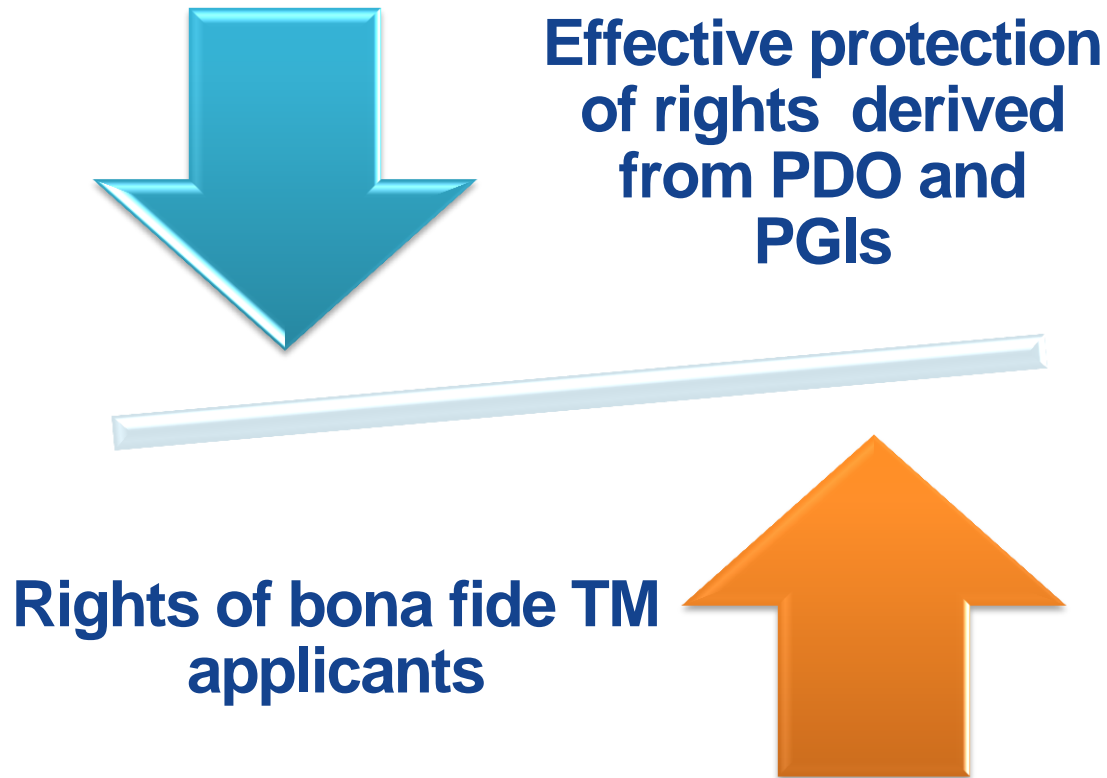
- Difficulties in the application of concepts alien to trade mark law, perceived as vague
- Lack of sufficient guidance by the Courts

Article 13

Protection

1. Registered names shall be protected against:
 - (a) any **direct or indirect commercial use** of a registered name in respect of products not covered by the registration where those products are **comparable** to the products registered under that name or where using the name exploits the reputation of the protected name, including when those products are used as an **ingredient**;
 - (b) any **misuse, imitation or evocation**, even if the true origin of the products or services is indicated or if the protected name is translated or accompanied by an expression such as 'style', 'type', 'method', 'as produced in', 'imitation' or similar, including when those products are used as an ingredient;
 - (c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product that is used on the inner or outer packaging, advertising material or documents relating to the product concerned, and the packing of the product in a container liable to convey a false impression as to its origin;
 - (d) any other practice liable to mislead the consumer as to the true origin of the product.

CONSTRAINTS – APPROPRIATE BALANCE OF RIGHTS



CONSTRAINTS – RESULT

Checklist for objecting to a TM registration

1. **Registered GI/DO:** checking ALL databases
2. **There is a conflict according to the *sui generis* law:** setting the scope of protection of GI per the VARIOUS legal instruments
3. **Specialty principle:** products are identical or comparable or contain GI as ingredient

GI EXPERT GROUP



EXAMPLES – DIRECT USE

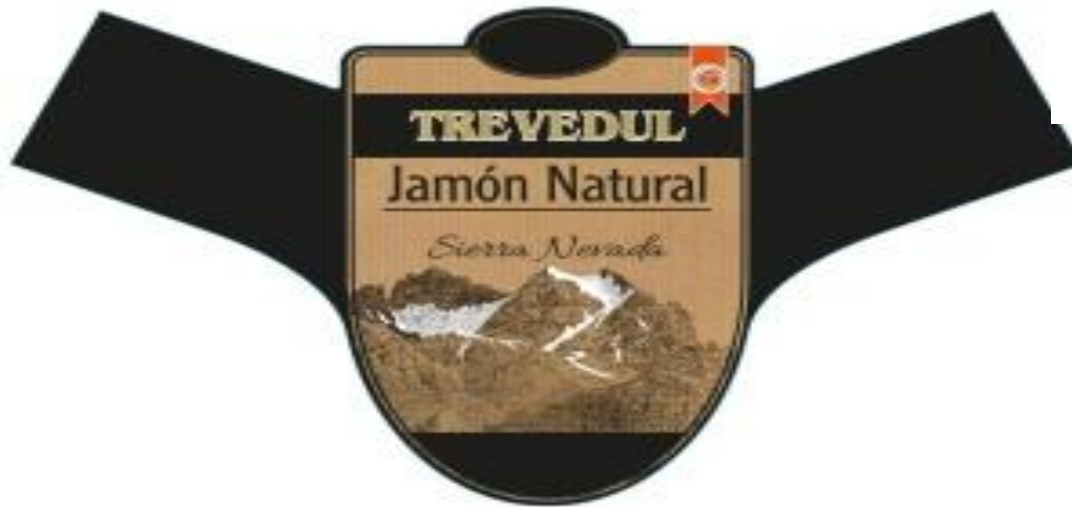


THE EAST INDIA COMPANY PORT

- **EUTM 17492778** applied alcoholic beverages including *port wine* and *spirits*.
- Potential conflict with **PDO PORT**
- EUIPO proposal for **limitation** as far as *wine* was concerned (i.e. *wine complying with the specifications of the protected designation of origin 'Port'*)
- EUIPO considered that the TM was **deceptive** for non-wine products (e.g. *spirits*)
- Limitation accepted by the Applicant and did not comment on deceptiveness
- EUTM registered only for wines complying with the PDO

EXAMPLES - EVOCATION

TREVEDUL JAMÓN
NATURAL SIERRA
NEVADA



- **EUTM 17394925** applied for *natural ham from Sierra Nevada*
- Potential conflict with **PGI Jamón de Trevélez**
- **Evocation** of the PGI
- EUIPO proposal for **limitation**: *cured natural ham complying with the specification of the PGI Jamón de Trevélez.*
- No reply from the Applicant

EXAMPLES – INGREDIENTS



- **EUTM 017887009** applied for *Biscuits filled with coffee cream; Wafers filled with coffee cream; Coffee-based pralines* in Class 30
- Potential conflict with **PGI Café de Colombia**
- EUIPO proposal for **limitation**: goods filled in with cream made of /based on *coffee complying with the specifications of the PGI Café de Colombia*
- Applicant accepted limitation

FUTURE

- **Case-Law:**
 - ECJ judgments on application of EU Regulations (C-614/17 Queso Manchego; C-432/18 Aceto Balsamico Modena)
 - More GC/ECJ judgments expected on specific cases of GIs/trade marks conflicts
- **Increase users' knowledge:** less third party observations, less objections
- **Tools:** improve database via DG AGRI – EUIPO cooperation



www.euipo.europa.eu



@EU_IPO



EUIPO

Thank you