

Protection of GIs in EU: Practical Aspects, TMs VS GIs

Online Workshops on Implementing Best Practices of Protection Systems for Geographical Indications in EU

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31 March 2021



Goals



You will learn about the EU scheme for GIs and its added value



You will be aware of the particular legal status of the GIs



You will get familiarized with the scope of the GI protection under AGRI Law and under TM Law



You will get the reference of the EU case law on the matter and what's on going right now in the General Court and in the Commission



Index

Key facts



Case law



Open questions



a bit of law, facts and figures on GIs



Market and geography

- Indication of source:
 - Information to consumers
 - Fanciful: Seat Ibiza
 - Type of product: Kiev cake
 - Quality and certification: certification schemes and quality schemes (GIs)



GIs goods are
sold at a price
2.07 times higher

They fall within
the scope of
industrial and
commercial
property rights

Better protection
benefits
producers of
quality products
and not least
SME

Key facts

Case law

Open questions

Economic added value

- A sales value of approx. **€75 billion**
- higher gross margins
 - global value premium rate 2.14 in 2010, dropping slightly to 2.07 in 2017 ([DG AGRI report 2020](#))
 - the importance of France;
 - the importance of wines, whose share in the value premium was 65 %;
 - the higher value premium rate for processed products (food, wines, spirit drinks) than raw agricultural products (fruits and vegetables and fresh meats).

Other added values

protection of
IP rights

visibility and
access to
new markets

access to
promotion
funds and
investment
aid

support
under rural
development

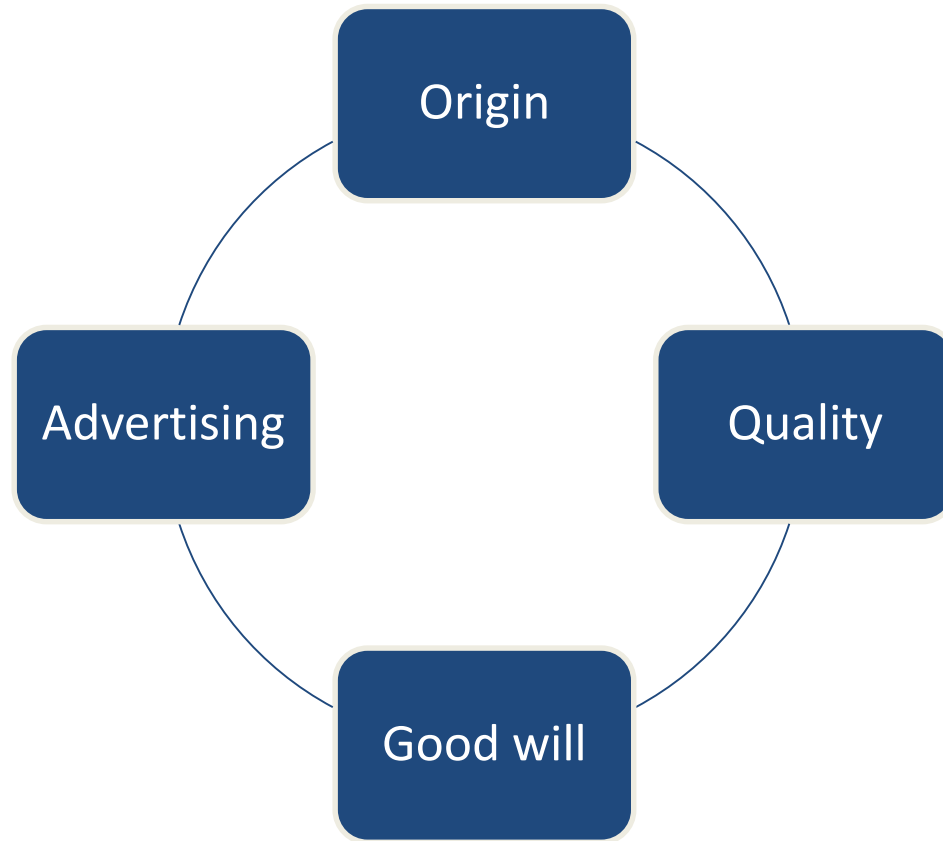
synergies on
the GI
territory

Key facts

Case law

Open questions

GI functions



Key facts

Case law

Open questions

Quality



Good will

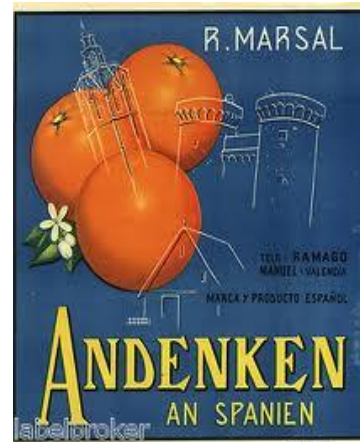


Key facts

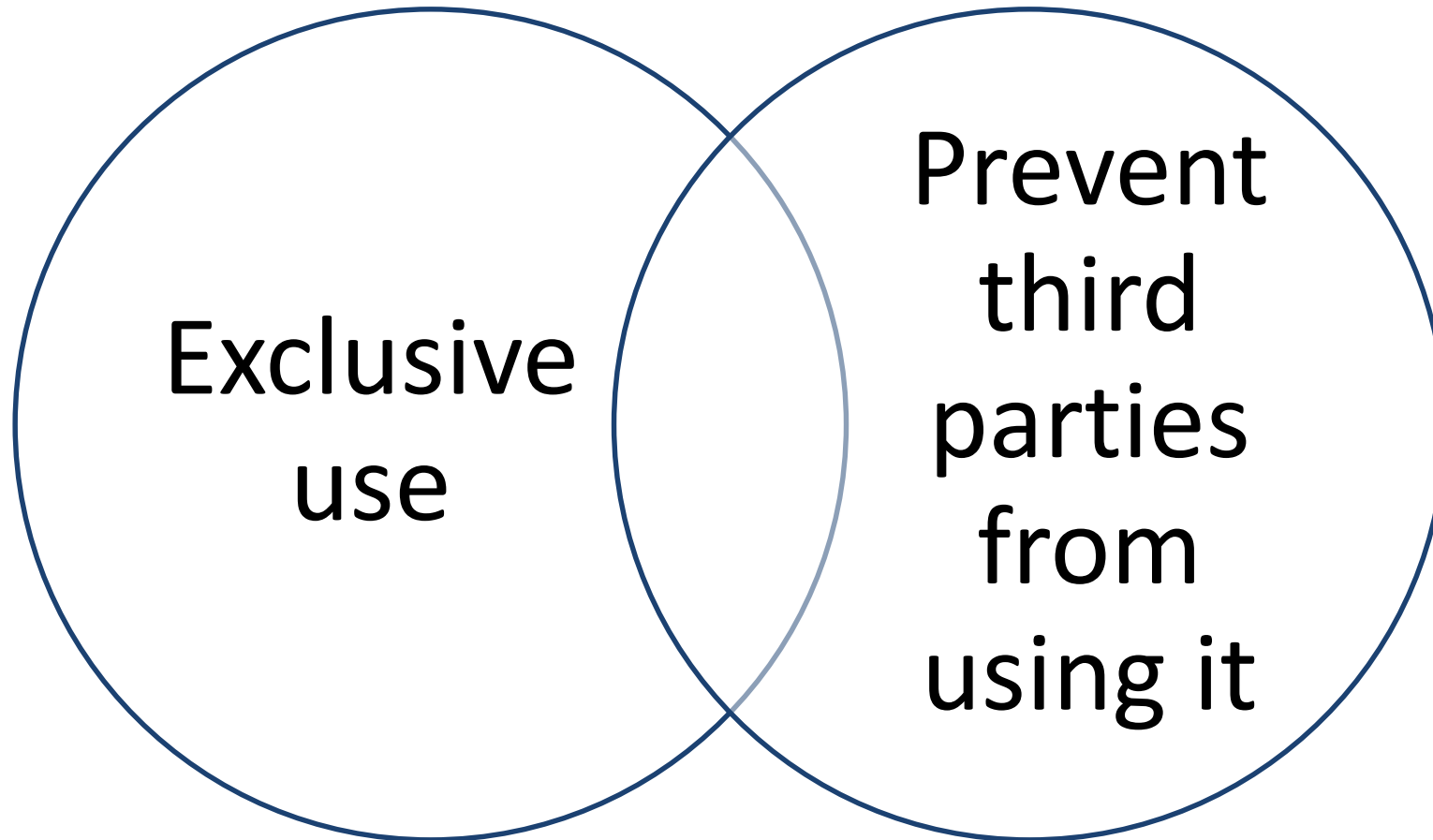
Case law

Open questions

Advertising



GI content

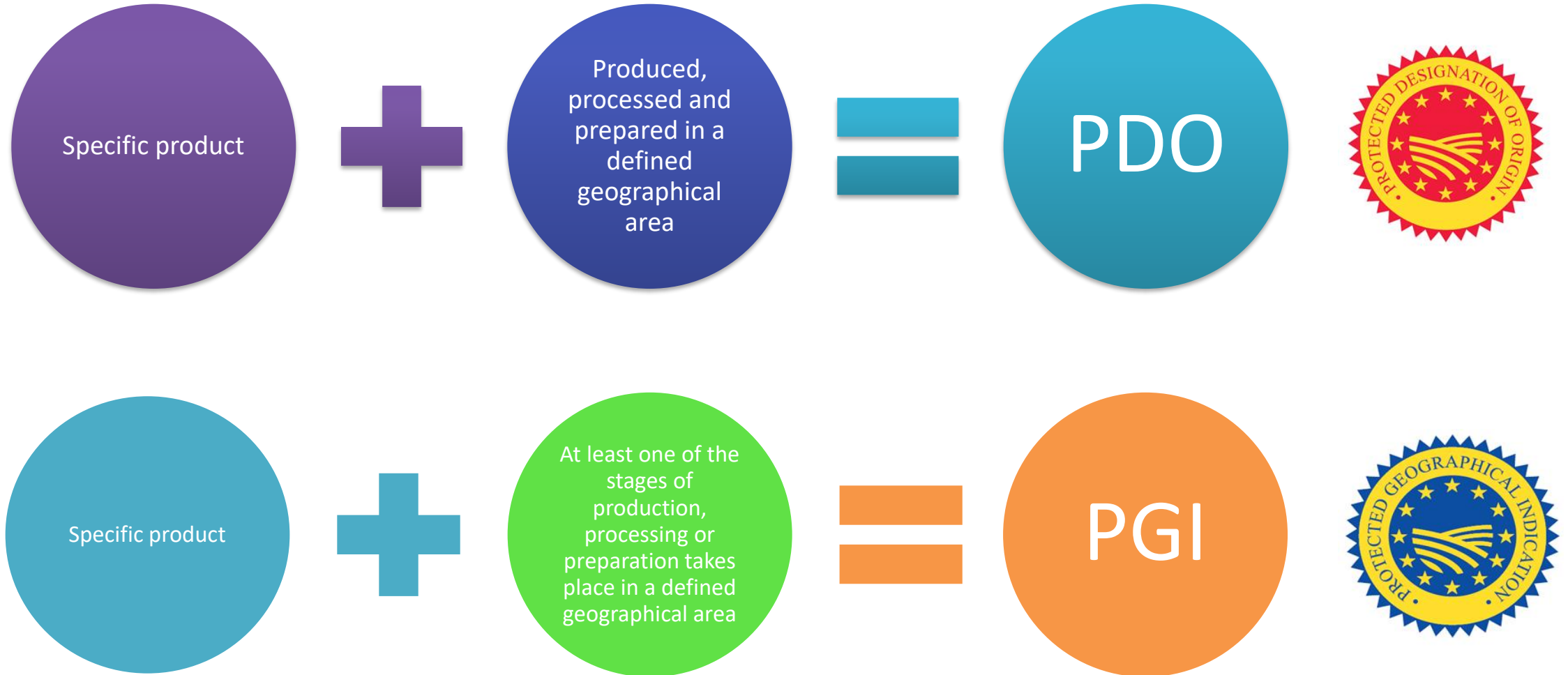


Key facts

Case law

Open questions

GI Protection under AGRI LAW





Search for Geographical Indications across the European Union and beyond

Country ▾

Geographical Indication / File number

Search

<https://www.tmdn.org/giview/>

Latest GI updates

Taureau de Camargue
PDO-FR-0041

Type
Food

Category
Class 1.1



Country
France

Status
Registered

Priority date
21/04/1997

[View GI ID card »](#)

Lucques du Languedoc
PDO-FR-01375

Type
Food

Category
Class 1.6



Country
France

Status
Registered

Priority date
24/09/2015

[View GI ID card »](#)

Coteaux des Baronnies
PGI-FR-A1159

Type
Wine

Category
Wine



Country
France

Status
Registered

Priority date
17/03/1978

[View GI ID card »](#)

Search 

Wine Register

Food Register

Spirit drinks

Aromatised Wine Register

3833 Records

Product Type	Country	Type	File number	Name	Product Category	Status	Date	
Food	Italy	Protected Designation of Origin (PDO)	PDO-IT-02449	Pistacchio di Raffadali	Class 1.6. Fruit, vegetables and cereals fresh or processed	Registered	22/03/2021	
Food	Italy	Protected Geographical Indication (PGI)	PGI-IT-1533-AM01	Pera Mantovana	Class 1.6. Fruit, vegetables and cereals fresh or processed	Published	19/03/2021	
Wine	Romania	Protected Designation of Origin (PDO)	PDO-RO-A0139-AM01	Iași	Wine	Published	19/03/2021	
Food	France	Protected Geographical Indication (PGI)	PGI-FR-02765	Cancoillotte	Class 1.4. Other products of animal origin (eggs, honey, various dairy products except butter, etc.)	Applied	19/03/2021	
Food	Italy	Protected Geographical Indication (PGI)	PGI-IT-02764	Castagna di Roccamonfina	Class 1.6. Fruit, vegetables and cereals fresh or processed	Applied	16/03/2021	
Food	Spain	Protected Designation of Origin (PDO)	PDO-ES-0046-AM02	Avellana de Reus	Class 1.6. Fruit, vegetables and cereals fresh or processed	Applied	15/03/2021	
Wine	Romania	Protected Designation of Origin (PDO)	PDO-RO-A0027-AM01	Recaș	Wine	Published	12/03/2021	
Food	Spain	Protected Geographical Indication (PGI)	PGI-ES-0264-AM02	Garbanzo de Fuentesauco	Class 1.6. Fruit, vegetables and cereals fresh or processed	Published	11/03/2021	
Food	Cyprus	Protected Geographical Indication (PGI)	PGI-CY-02762	Τερτζιελούθκια / Tertziellouthkia	Class 2.5. Pasta	Applied	05/03/2021	
Food	Cyprus	Protected Geographical Indication (PGI)	PGI-CY-02763	Μακαρόνια της Σμίλας / Makaronia tis Smilas / Μακαρόνια του Σκλινιτζιού / Makaronia toy Sklinitziou	Class 2.5. Pasta	Applied	05/03/2021	

GI Protection under AGRI LAW



TSG- highlights traditional character, either in the composition or means of production



Other categories: EU's outermost regions, mountain product and product of Island Farming

GI Protection under AGRI LAW

GIs are legally
protected
against

- any direct or indirect commercial use of the protected name in respect of products not covered by the registration in so far as those products are comparable to the products registered under that name
- any misuse, imitation or evocation;
- any other false or misleading indication;
- any other practice liable to mislead the consumer.

GI Protection under Trade mark LAW

CHAMPAGNE
(PDO-FR-A1359)

BEAUJOLAIS
(PDO-FR-A0934)

SCOTCH WHISKY

RIOJA
(PDO-ES-A0117)



CHAMPAGNE VEUVE DEVANLAY
(EUTM No 11 593 381)

(EUTM No 1 561 646)

(EUTM No 15 420 607)

**RIOJA WINE
UKRAINE**



It consists solely of a whole PDO/PGI ('direct use');

It contains a whole PDO/PGI in addition to other word or figurative elements ('direct or indirect use');

it contains or consists of an imitation or evocation of a PDO/PGI;

other misleading indications and practices;

Its use would exploit the reputation of PDOs/PGIs.

**Absolute
ground of
refusal**

GI Protection under Trade mark LAW

Relative ground of refusal

- specific ground of opposition for GIs.
- it does not require proving that the GI was used in the course of trade of more than mere local significance.

GI Protection under Trade mark LAW

Application for invalidity -Article 53(1)(d)

- in conjunction with Article 8(6) EUTMR)
- it had to already be protected at the time of filing the contested EUTM and be entitled to prohibit use of a subsequent trade mark

Jigsaw falling into place

GC/CJ Judgments

Key facts

Case law

Open questions

SEVEN TOP CASE LAW



Key facts

Case law

Open questions

GI Protection under AGRI Law: WHY?

C-569/18 Mozzarella di Bufala

- to help producers
- to secure higher incomes
- to protect those entitled to use GIs



GI Protection under Quality Food Law?

C-785/18 Comté
C-569/18 Mozzarella
di Buffala

within the framework
of the common
agricultural policy
(CAP)



Requirements: *terroir*
and *savoir faire*



GI Protection: who does what?

C-785/18 Comté
T-43/15 Piadina
Romagnola



Division of powers

- For the MS to check the application
- For the Commission to check that the application contains the information required (i.e. standing orders) and it is not vitiated with errors.
- For the National Courts to verify decisions taken by national authorities on minor amendments

Aceto balsamico di Modena

now Article 13(1)(b) Regulation 1151/2012



CONSORZIO
TUTELA

C-432/18

- *Protection does not extend to the use of the non-geographical terms of that name such as ‘aceto’ and ‘balsamico’*

L 175/8

EN

Official Journal of the

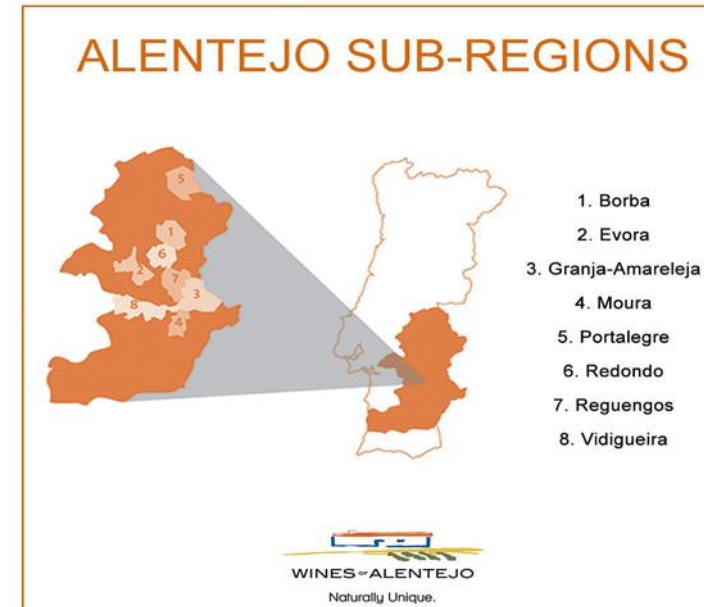
- (10) It appears that Germany and Greece did not refer to the entire name, i.e. ‘Aceto Balsamico di Modena’ in their objections regarding the generic nature of the name proposed for registration, but only to some elements of it, namely the words ‘aceto’, ‘balsamico’ and ‘aceto balsamico’, or to translations thereof. However, protection is granted to the term ‘Aceto Balsamico di Modena’ as a whole. Individual non-geographical components of that term may be used, even jointly and also in translation, throughout the Community, provided the principles and rules applicable in the Community’s legal order are respected.

Adegaborba.pt

Article 3(1)(c) of Directive 2008/95

C-629/17

- ‘Borba’ is a geographical name or, even if proven, it is a PDO
- The sign is devoid of distinctive character



Glenn lesson 1

Article 16(b) of Regulation No 110/2008

C-44/17

- Absence of aural or visual similarity
- Evocation by conceptual proximity by partial incorporation of the GI



Key facts

Case law

Open questions

Glenn lesson 2

Article 16(b) of Regulation No 110/2008

C-44/17

- ‘Indirect use’ relates to the type of commercial activity
 - The indication appears in supplementary marketing or information sources (AG Opinion)



Key facts

Case law

Open questions

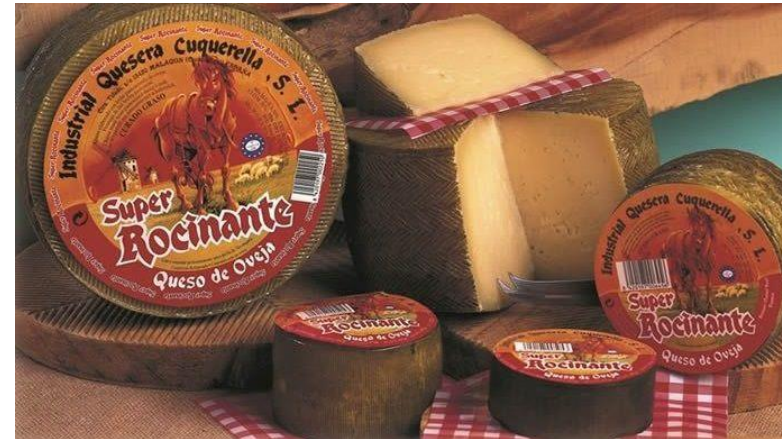
Manchego lesson 1

now Article 13(1)(b) Regulation 1151/2012

C-614/17

- a registered name may be evoked through the use of figurative signs

bony horse, and landscapes with windmills and sheep



N° 375985 W



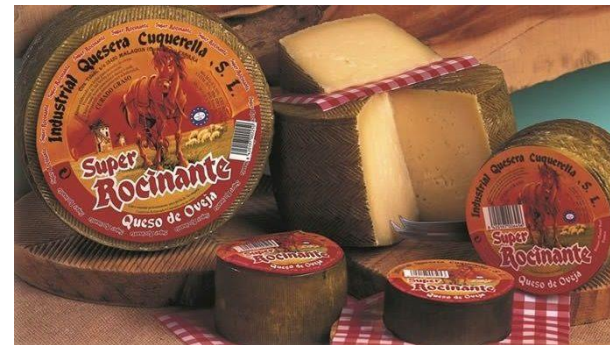
Manchego lesson 2

C-614/17

- including when are used by a producer established in that region for similar or comparable products but not covered by the GIs.



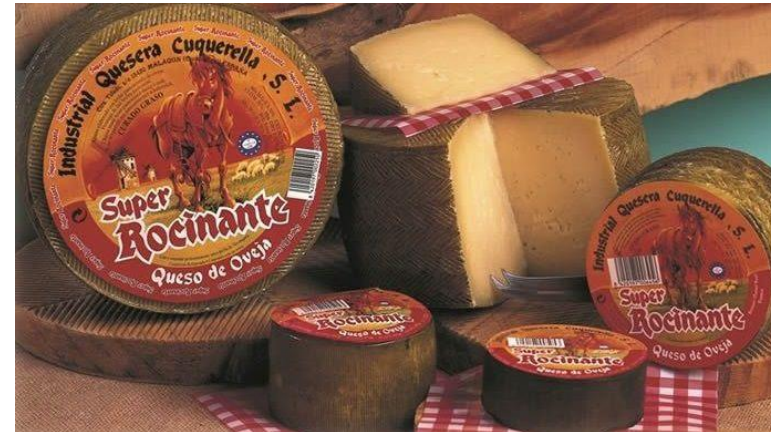
bony horse, and landscapes with windmills and sheep



Manchego lesson 3

C-614/17

- Average consumers: those of the MS of origin or of the one of the GI and in which the product is mainly consumed.



Cave de Tain v Cava

Article 103(2)(b) of Regulation (EU) No 1308/2013

T-774/16

- Protection does not extend against evocation when the differences between the signs precluded evocation



Morbier

Article 13(1)(d) of Regulation (EU) No 1152/2012

C-490/19

- Reproduction of the shape or appearance characterizing a product covered by a GI is forbidden where may lead the consumer to confusion.



GI's Jigsaw

**Exclusive
use**

It does not
serve as use of
a TM
(Kurbiskernol)

The protected term (Grana
Padano, Torta del Casar,
Palomar, *Aceto Balsamico di
Modena*)

Key facts

Case law

Open questions

GI's Jigsaw

Prevents
third parties
from using it

Direct or indirect use
(Chianti, Bavaria,
Riojavina, Colombiano
Coffee House, Torta
del Casar, Champagne
Sorbet, Glenn);

No generic erosion
allowed (Salami
Felino, Sorbet,
adegaborba.pt)

reproduction
may mislead
the European
consumer
(Morbier)

Misuse (colombiano
coffee house), imitation
or evocation
(Gorgonzola, Parmisan,
BNIC, Toscoro,
Viiniverla, Port
Charlotte, Manchego)
and 'any other false or
misleading indication'
(Glenn)

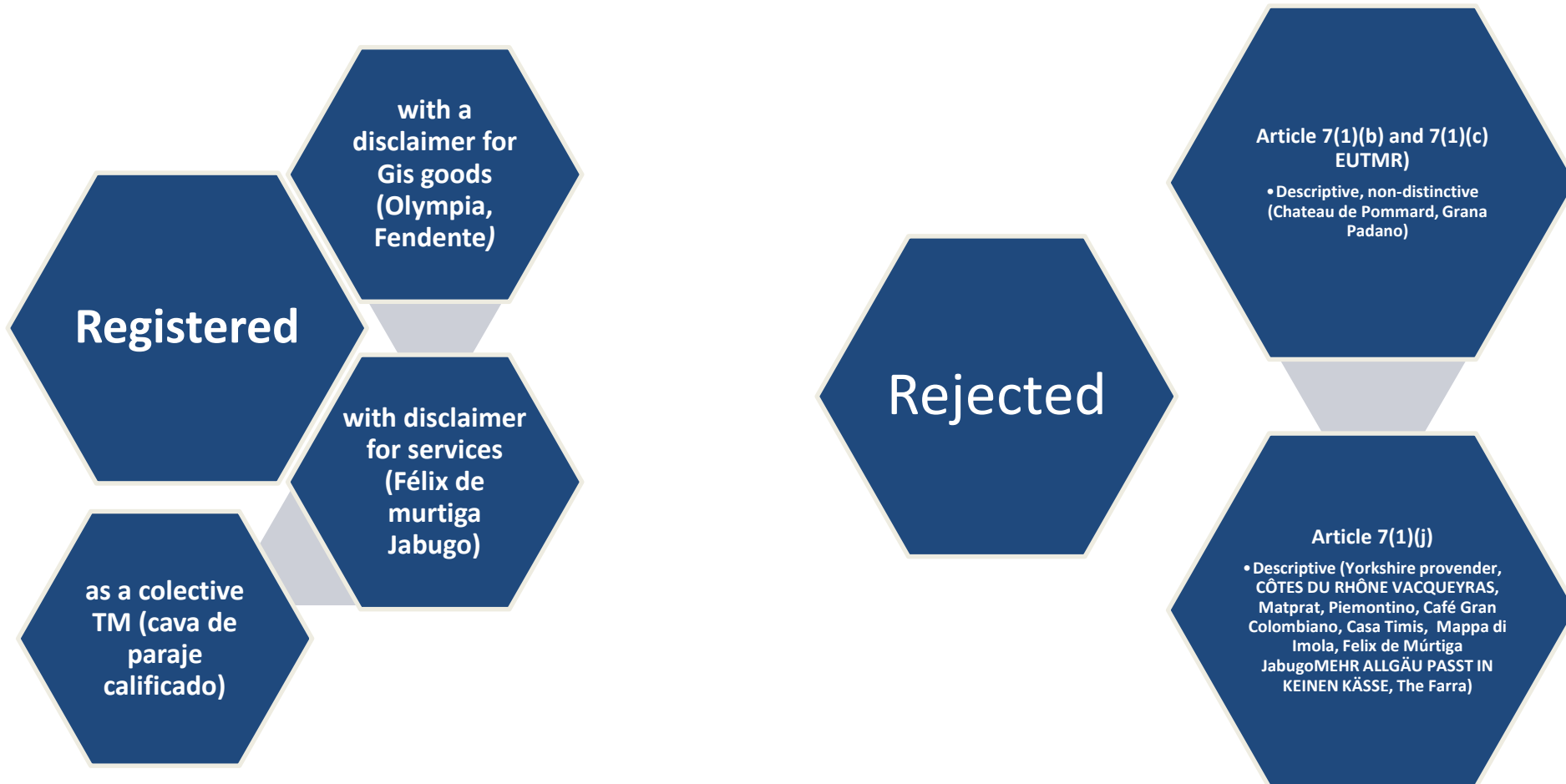
Boards of Appeal

Key facts

Case law

Open questions

Absolute grounds Boards' jigsaw



Descriptive, Non-distinctive (Article 7(1)(b) and 7(1)(c) EUTMR)

Case references : R 2650/2019-5

*

EUTM

CHÂTEAU DE POMMARD

Cl. 33, 43, 45



**Contested decision confirmed,
application partially rejected**



**TM registered without disclaimer
for services in Class 45**

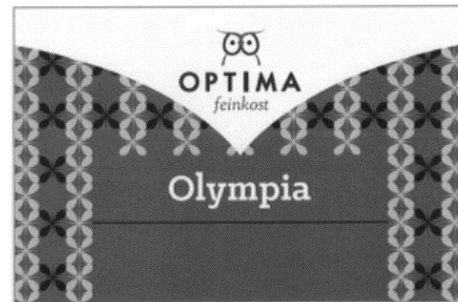
TM with a GI limitation

Case reference : R 1229/2017-5

*

EUTM

Cheese, processed peppers;
olives, preserved; olive paste and
olive oil in accordance with the
specifications of the PGI 'Olympia'



Cl.29



Trade mark registered

Descriptive (Article 7(1)(c) and 7(1)(j) EUTMR)

Case references : R 674/2017-1

*

The presence of 'YORKSHIRE' is sufficient to evoke the PGI 'YORKSHIRE WENSLEYDALE' and the PDI 'YORKSHIRE FORCED RHUBARB' not only for identical but also comparable products as, among others, milk, jellies, jams, baked goods or dessert puddings

EUTM

YORKSHIRE PROVENDER

CI0 29 y 30.



Contested decision confirmed, application rejected

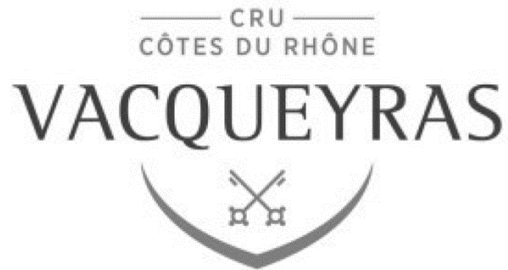
Deceptive element, Geographical origin (Article 7(1)(j) EUTMR)

Case references : R 2305/2017-5

*

EUTM

As a result of the mere presence of the terms 'CÔTES DU RHÔNE' and 'VACQUEYRAS', which are both AOCs, the trade mark applied for cannot be accepted for registration



Cl. 33



Contested decision confirmed, application rejected

Non-distinctiveness (Article 7(1)(j) EUTMR)

Case references : R 26/2018-5

*

EUTM

The presence of the word 'PRAT' is therefore sufficient to evoke, in the minds of a significant proportion of the Spanish-speaking public, the PGI 'Pollo y Capón del Prat'.



Cl.9,16,29,35,41,43,44

Contested decision confirmed, application partially rejected.
Not registrable for meat & poultry in Class 29

✓ TM registered without disclaimer for the rest of the requested G&S

Non-distinctiveness (Article 7(1)(j) EUTMR)

Case references 2110/2017-1

EUTM

A cheese bearing the trade mark
'PIEMONTINO' will generate, in
the mind of European
consumers, the image of the
name of the PDO
It is not casual



Cl. 29



Contested decision confirmed, application rejected

Non-distinctiveness (Article 7(1)(j) EUTMR)

Case references 477/2017-1

- The Examiner rejected the EUTM based on Article 7.1.c and b).
- Examination on AG was reopened by the Board

Non-registrable for coffee and coffee extracts, neither for comparable products (coffee substitutes, malt coffee) nor for goods using coffee as ingredient ('non-alcoholic beverages flavoured with coffee, coffee beer')

EUTM



Cl.30, 32



Application rejected.

Non-distinctiveness (Article 7(1)(j) EUTMR)

Case references 1315/2019-5

EUTM

The applicant is already the proprietor of for several G&S including Class 33.
It evokes the PGI 'Viile Timișului'



Cl.33



Contested decision confirmed, application rejected.

Descriptive and non-distinctive (Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR, Article 74(2) EUTMR)

Case references 500/2017-2

EUTM

Exception Art. 74(2) EUTMR
applies

CAVA DE PARAJE CALIFICADO

Cl.33, 35 and 39



Contested decision annulled. Application allowed

Descriptive, Non-distinctive. Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR

Case references R 2191/2018-2

EUTM

It is descriptive and it lacks of distinctiveness for services like commercial activities, events, fairs, catering, bar, in Classes 35, 41, 45

GRANA PADANO

Cl.35, 41 and 45



Decision confirmed. Application rejected

Non-distinctiveness. Article 7(1)(j) EUTMR,

Case references R 1223/2019-5

EUTM

The common element IMOLA represents the part of the PGI 'Colli di Imola' by which the relevant consumer identifies the geographical origin of the goods, an Italian location located in the region of Emilia Romagna

MAPPA DI IMOLA



CI.33



Decision confirmed. Application rejected

Non-distinctiveness. Article 7(1)(j) EUTMR,

Case references R 1223/2019-5

EUTM



Cl.29, 35, 42

Non-registrable even with a disclaimer 'Jamón de Huelva' 'Jabugo' because the term was not protected



TM registered without disclaimer for services in Class 35 and 43



Non-distinctiveness. Article 7(1)(j) EUTMR,

Case references R 1920/2019-1

EUTM

MEHR ALLGÄU PASST IN KEINEN KASSE

Cl.29



Contested decision confirmed, application rejected.

Non-distinctiveness. Article 7(1)(j) EUTMR,

Case references R 1450/2020-5

EUTM



CI.33



Decision annulled. Trade mark registered with a disclaimer

Non-distinctiveness. Article 7(1)(j) EUTMR, Article 103(2)(a) CMO

Case references R 2230/2017-2

EUTM

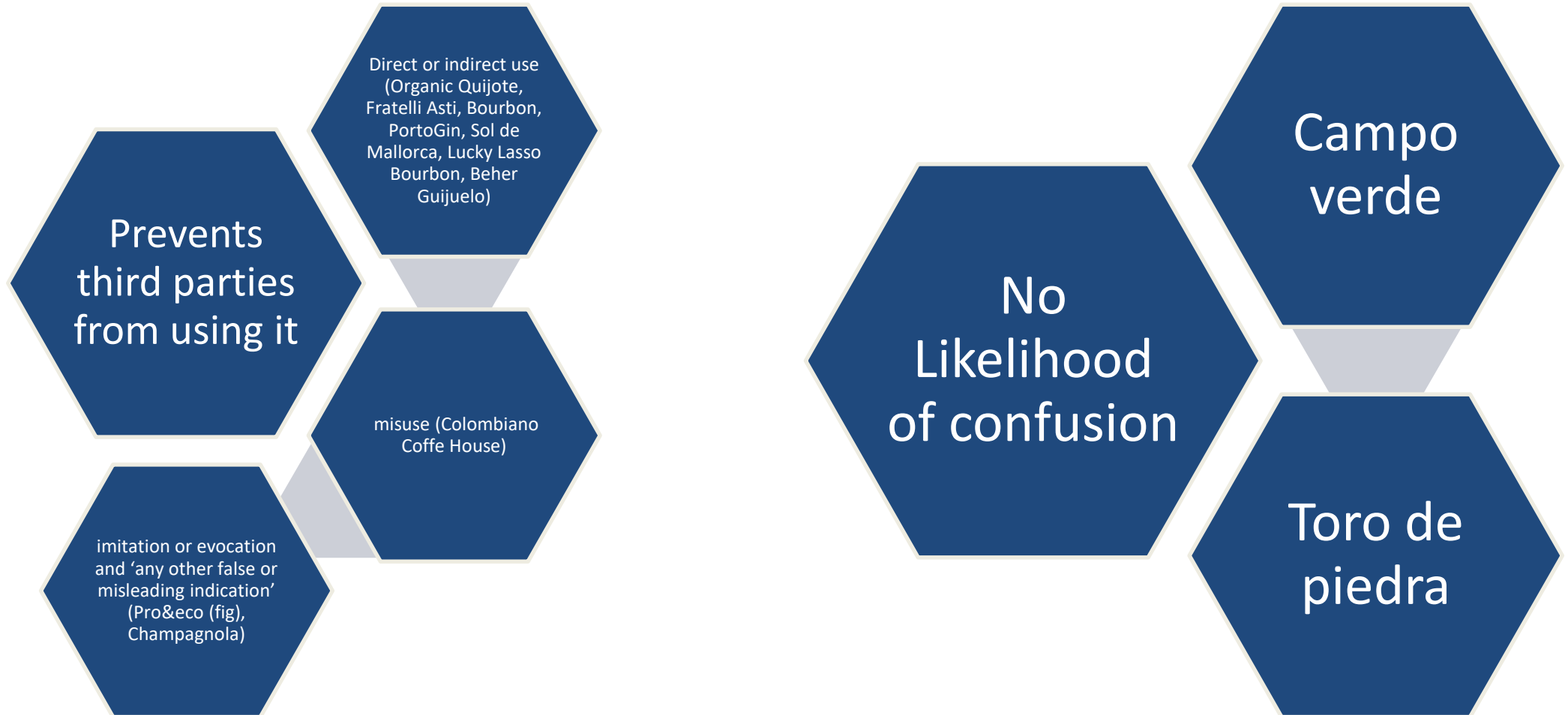
THE FARRA

Cl.33



Contested decision confirmed, application partially rejected.

Relative grounds Boards' jigsaw



Likelihood of confusion and geographical origin (Article 8(1)(b) and 8(6) EUTMR)

Case references : R 282/2020-5

EUTM applied for	Prior right
<p>Campo Verde (Word mark)</p>	<p>VINHO VERDE PORTUGAL</p>
Cl. 29, 30, 31, 32, 33	Cl. 33



Opposition rejected

Likelihood of confusion (Article 8(1)(b) EUTMR)

Case references : R 2751/2019-4

EUTM applied for



Cl. 33

Prior right

TORO Denominación de Origen



(EUTM)



(Spanish TM)

Cl. 33, 35, 39



Opposition rejected

Likelihood of confusion (Article 8(1)(b) EUTMR)

Case references : R 993/2019-2

EUTM applied for

PORTWO GIN

Cl. 33 Spirits

Prior right

PORTO



Opposition upheld. Contested decision set aside.

Likelihood of confusion (Article 8(1)(b) EUTMR)

Case references : R 237/2020-4

EUTM applied for

Sol de Mallorca

Cl. 32 Soft drinks, alcohol
free

Prior right

**VI DE LA TERRA DE
MALLORCA**



Opposition upheld. Contested decision set aside.

Likelihood of confusion (Article 8(1)(b) and 8(6) EUTMR)

Case references : R 2723/2017-5

EUTM applied for

**Lucky Lasso Kentucky Straight
Bourbon Whiskey**

Cl. 33 Bourbon whiskey

Prior right

Bourbon



Opposition upheld. Contested decision set aside.

Likelihood of confusion (Article 8(1)(b), 8(5) and 8(4)EUTMR)

Case references : R 1428/2016-2

EUTM applied for



Cl. 33

Prior right



Cl. 33, 35



Opposition upheld. Contested decision set aside.

Likelihood of confusion (Article 8(1)(b), 8(5) and 8(4)EUTMR)

Case references : R 2079/2017-1

EUTM applied for



Cl. 33

Prior right

Lady Asti

Cl. 33



Opposition upheld. Contested decision set aside.

Likelihood of confusion (Article 8(1)(b) EUTMR, Article 8(6) EUTMR, Article 8(5) EUTMR)

Case references : R 425/2019-1

EUTM applied for



Cl. 33

Prior right

PROSECCO

Cl. 33



Opposition upheld. Contested decision set aside.

Likelihood of confusion (Article 8(1)(b) EUTMR, Article 8(6) EUTMR, Article 8(5) EUTMR)

Case references R 942/2018-4

EUTM applied for



Cl. 29, 35

Prior right

GUIJUELO

Cl. 29, 35



Opposition upheld. Contested decision set aside.

Likelihood of confusion (Article 8(6) EUTMR)

Case references R 1132/2019-4

EUTM applied for	Prior right
CHAMPAGNOLA	CHAMPAGNE
Cl. 30, 40	Cl. 33



Opposition upheld. Contested decision set aside.

Article 53(1)(c) of Regulation No 207/2009 in conjunction with Article 8(4) of Regulation No 207/2009

Case references : R 251/2016-1 (allocated after T-359/14)

EUTM applied for



Cl. 30, 43

Prior right

Café de Colombia



EUTM cancelled.

Procedural issue

Opposition on the ground of Article 8(6)
EUTMR and 103(2) of Regulation (EU)
No 1308/2013

R 286/2017-2 Porto maltese / Porto,
R-726/2017-2 Porto marine Hotel vs Porto
Wines
R-1897/2017-2 Porto vintage vs vintage (fig.)

at the admissibility stage the opponent shall indicate ONLY:

- (i) whether it is a geographical indication,
- (ii) its name
- (iii) whether it is a national or an EU quality sign

- *There is no requirement at the admissibility stage, i.e., in the notice of opposition, on part of the opponent to expressly claim that the opposition is based on the reputation of the PGI/PDO*

let's test whether it is clear enough

On

GI's case law

Ongoing cases

Open questions

Key facts

Case law

On going cases
Open questions

Champagne



Protection extends to services?

C-783/19



Key facts

Case law

On going cases
Open questions

Spreewälder Gurken



Legitimate interest: to whom concerns any alleged devaluation or damage to the reputation or prestige of the product

C-53/20

Key facts

Case law

On going cases
Open questions

Next reform

Open questions

Key facts

Case law

On going cases
Open questions

Points of discussion

Owners and users

Generics and banalisation of the origin

Scope of protection (food, foodstuffs, stones, services, etc.)

Gis' board: to manage, to control and to sanction?

Technical issues to be tackle

Time limits for the registration

Delimitation of the powers of the Administrations dealing with a file

Registration of expressions containing terms with a generic character

Concepts to be defined: comparable goods; reputation; misuse

Withdrawal of a GI

Key facts

Case law

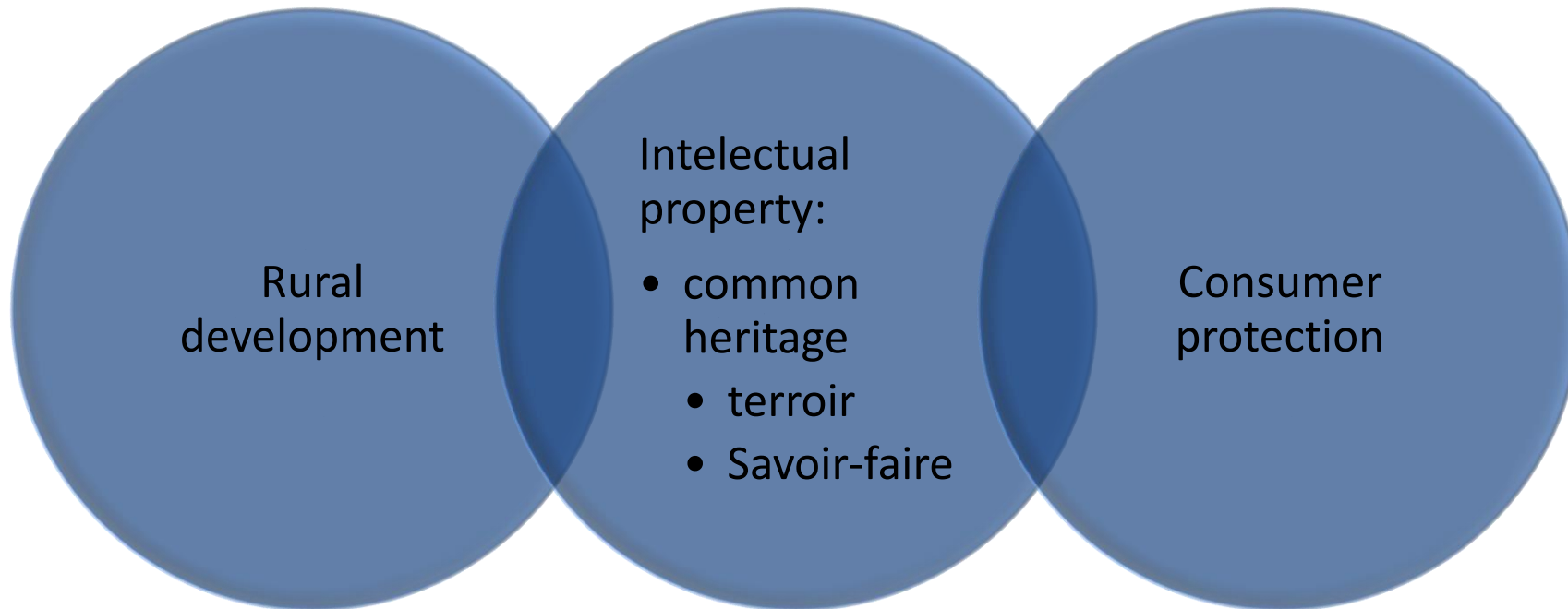
On going cases
Open questions

conclusion

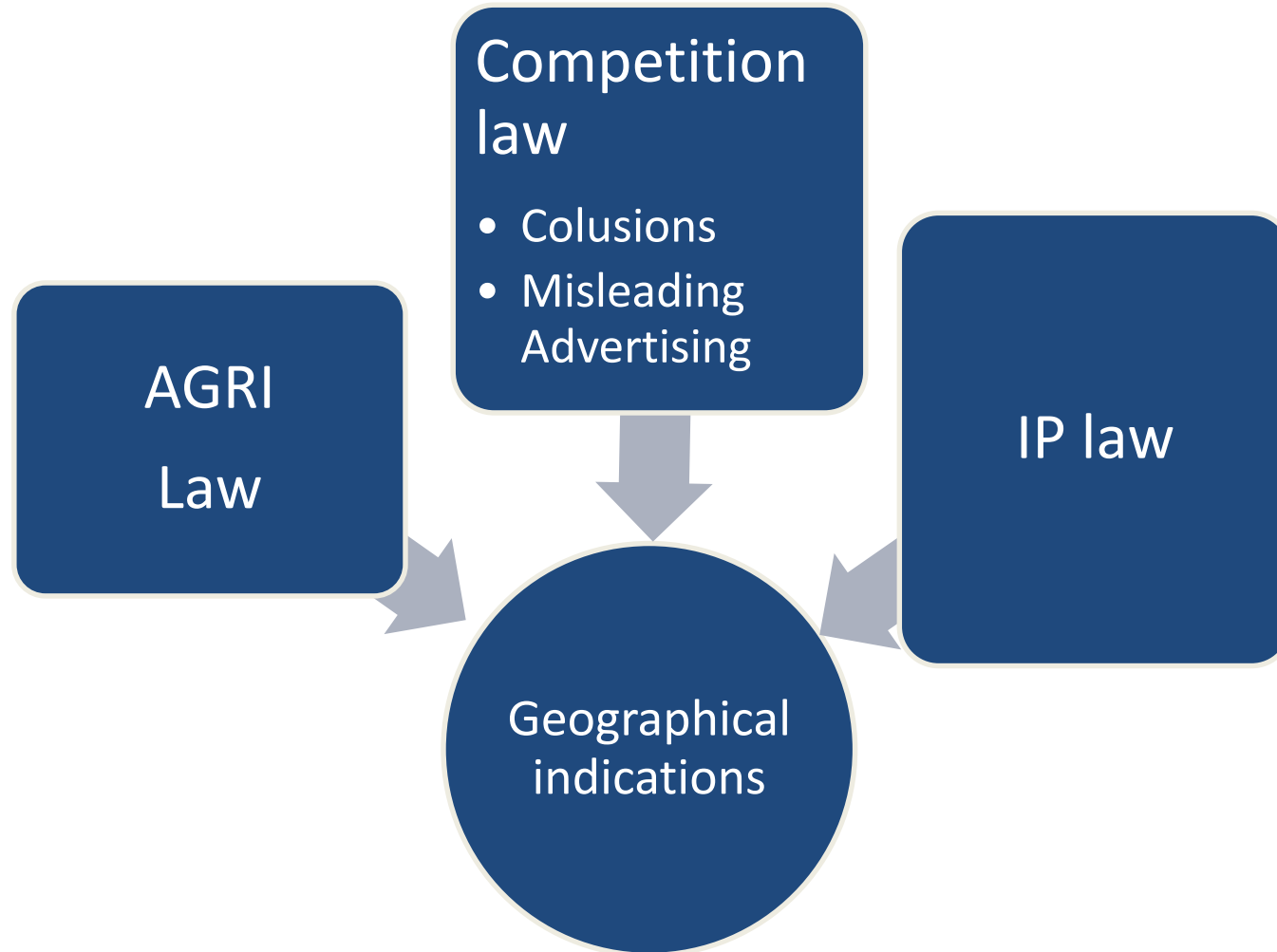
Competitiveness and food quality



Public interest and GIs



GI legal environment



**principles to be applied
when a conflict
between GIs and TM
occurs**

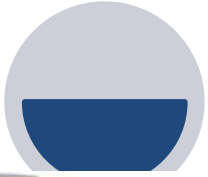


priority

exclusivity

truthfulness

GI as a commercial and IP matter



C-389/15 Geneva Act of Lisbon Agreement



Interinstitutional File:
2018/0214(NLE)

Brussels, 31 July 2018
(OR. en)

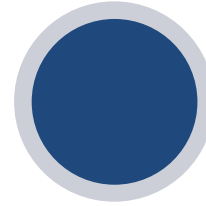
11510/18

PI 106

PROPOSAL

From:	Secretary-General of the European Commission, signed by Mr Jordi AYET PUIGARNAU, Director
date of receipt:	27 July 2018
To:	Mr Jeppe TRANHOLM-MIKKELSEN, Secretary-General of the Council of the European Union
No. Cion doc.:	COM(2018) 350 final
Subject:	Proposal for a COUNCIL DECISION on the accession of the European Union to the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications

Delegations will find attached document COM(2018) 350 final.



Commercial aspects of IP

Exclusive competence of the European Union



EUIPO Academy Learning Portal and Tuesday webinars



EUIPO Academy Learning Portal offer on GIs



SEMINAR
Strengthening geographical indications **Basic** **New**

1091 min. EN

<https://euipo.europa.eu/knowledge/course/view.php?id=4177>

TUESDAY WEBINARS



WEBINAR
How much protection for GIs? Recent case law **Advanced**

33 min. EN

<https://euipo.europa.eu/knowledge/course/view.php?id=3828>



www.euipo.europa.eu



@EU_IPO



EUIPO

Thank you