

Upholding GIs in the trade mark examination and appeal processes

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TOO MANY SOURCES RUINS THE LAW

23/04/2019, R 2723/2017-5, Lucky Lasso Kentucky Straight Bourbon Whiskey / Protected designation of origin or a geographical indication Bourbon Whiskey:

13 For ease of understanding, the following table lists the provisions relevant to this case:

- 94/357 COUNCIL DECISION of 21 February 1994 on the conclusion of an Agreement in the form of an Exchange of Letters between the European Community and the United States of America on the mutual recognition of certain distilled spirits/spirit drinks.
- 1267/94 COMMISSION REGULATION (EC) No 1267/94 of 1 June 1994 applying the agreements between the European Union and third countries on the mutual recognition of certain spirit drinks
- 1576/89 COUNCIL REGULATION (EEC) No 1576/89 of 29 May 1989 laying down general rules on the definition, description and presentation of spirit drinks.
- 936/2009 COMMISSION REGULATION (EC) No 936/2009 of 7 October 2009 applying the agreements between the European Union and third countries on the mutual recognition of certain spirit drinks.
- 110/2008 REGULATION (EC) No 110/2008 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 15 January 2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks and repealing Council Regulation (EEC) No 1576/89.



Omissions

Article 7 EUTMR: shall not be registered:

trade marks which are excluded from registration, pursuant to **Union legislation or national law or to international agreements** to which the Union or the Member State concerned is party, providing for protection of designations of origin and geographical indications;

Article 8(6) EUTMR:

Upon opposition by any person authorised under the relevant law to exercise the rights arising from a designation of origin or a geographical indication, the trade mark applied for shall not be registered where and to the extent that, pursuant to the **Union legislation or national law** providing for the protection of designations of origin or geographical indications:

Omissions

23/04/2019, R 2723/2017-5, Lucky Lasso
Kentucky Straight Bourbon Whiskey / Protected
designation of origin or a geographical indication
Bourbon Whiskey:

23. As stated in the contested decision, though Article 8(6) EUTMR does not explicitly mention geographical indications protected under international agreements, the **reference to ‘Union legislation’ and ‘national law’ naturally includes international agreements as they form part of the legal order of the Union or the Member State which is a party to the international agreement.**



Different concepts?

14/12/2017, R 1320/2017-2, BLANC DE
BLANCS CENTINELA CONO SUR

Association agreement between Chile and the EU dated
18 November 2002 (OJ L 352, 30.12.2002)

A prohibition on registration of trade marks is enshrined in
Article 7 of Annex V (Agreement on trade in Wines) and it
provides that ‘registration of a trademark for wine [...]’
which is identical with, or similar to, or contains a
geographical
indication [...] shall be refused’.

No reference to ‘misuse, imitation or evocation’.

Different concepts?

Agreement between the European Union and the Government of the People's Republic of China on cooperation on, and protection of, geographical indications 6 November 2019

Article 4:

- (a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which **misleads** the public as to the geographical origin of the good;
- (b) (any use of a geographical indication **identifying an identical or similar** product not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation, transcription¹ or transliteration, or accompanied by expressions such as "kind", "type", "style", "imitation" or the like;
- (c) any use of a geographical indication identifying an identical or similar product not compliant with the product specification of the protected name.

Different concepts?

14/11/2013 R 566/2013-1 – Lembergerland

Agreement between the European Community and the Republic of South Africa on trade in wine signed at Paarl on 28 January 2002

Article 5: identical to art. 103 Reg. No 1308/2013



Database?

Article 104 Reg. No 1308/2013

Register

The Commission shall establish and maintain an electronic register of protected designations of origin and protected geographical indications for wine which shall be publicly accessible. Designations of origin and geographical indications pertaining to products of third countries that are protected in the Union pursuant to an international agreement to which the Union is a contracting party may be entered in the register. Unless specifically identified in that agreement as protected designations of origin within the meaning of this Regulation, such names shall be entered in the register as protected geographical indications.

Cooperation with EUIPO: GI View?

Database of all international Agreements?

Date the Agreement came into force?

USELESS

Relationship with trade marks?

Article 102

Relationship with trade marks

1. The registration of a trade mark that contains or consists of a protected designation of origin or a geographical indication which does not comply with the product specification concerned or the use of which falls under Article 103(2), and that relates to a product falling under one of the categories listed in Part II of Annex VII shall be: refused



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Evocation, misuse, imitation: 3 words, one concept?

13 (1) (b) EU Regulation No. 1151/2012

Art. 103 (2) (b) of EU Regulation 1308/2013

21 (2) (b) of EU Regulation No. 2019/787

20 (2) (b) of EU Regulation No. 251/2014

Opinion of Advocate general Jacobs delivered on 17 December 1998 in Case C-87/97 (Gorgonzola)

33. I concur with the observations of the Commission to the effect that, on the basis of the wording of the provision ('any misuse, imitation or evocation') and the aims of the Regulation (which as indicated above include consumer protection), the term 'evocation' is objective, so that it is not necessary to show that the owner of the mark intended to evoke the protected name. The scheme of the provision supports the view that 'evocation' requires less than 'imitation' or 'misuse'.









Legal standing

Art. 8(6) EUTMR:

Upon opposition by **any person authorized under the relevant law** to exercise the rights arising from a designation of origin or a geographical indication

Public interest litigation and *Actio popularis*?

Legal standing

TRIPS- Article 22 (2):

In respect of geographical indications, Members shall provide the legal means for interested parties to prevent: [...]

Legal standing

Paris Convention- Article 10 ter (2):

(2) The [countries of the Union] undertake, further, to provide measures to **permit federations and associations representing interested industrialists, producers, or merchants**, provided that the existence of such federations and associations is not contrary to the laws of their countries, to take action in the courts or before the administrative authorities, with a view to the repression of the acts referred to in Articles 9, 10, and 10bis, in so far as the law of the country in which protection is claimed allows such action by federations and associations of that country.

Legal standing

Panel Report in EC – Trademarks and Geographical Indications (US), para. 7.170.

"The Panel accepts that an 'interested party' is a person who is entitled to receive protection under Articles 22 and 23 of the TRIPS Agreement. However, in the Panel's view, Article 10(2) of the Paris Convention (1967) does not set out a criterion for eligibility for protection. Article 10(2) is a deeming provision for the term 'interested party' used in Article 9(3) of the Paris Convention (1967), as made applicable under Article 10(1). Once a person has qualified as a national, Article 10(2) may provide guidance on whether that person may be treated as an interested party for the purposes of Articles 22 and 23 of the TRIPS Agreement.

Legal standing

Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications: art. 11 (3)

(3) [Use in a Trademark] Without prejudice to Article 13(1), a Contracting Party shall, ex officio if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a later trademark if use of the trademark would result in one of the situations covered by paragraph (1).

Legal standing

Art. 45 reg. no. 1151/2012 (Food): Role of groups

A group 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;

Legal standing

Art. 45 reg. no. 1151/2012 (Food): Role of groups

One group per GI?





Reputation

or where using the name exploits the reputation of the protected name, including where those products are used as an ingredient;

(ii) in so far as such use exploits the reputation of a geographical indication;

Reputation

Reputation under PGI Regulation not to be confused with reputation article 8(5) EUTMR

Fame, renown, notorious

‘renommée’ and ‘reputation’ French

‘renombre’ and ‘reputación’ Spanish

‘renume’ and ‘reputatia’ Romanian

‘reputatie’ and ‘bekend’ Dutch

‘renoma’ and ‘reputację’ Polish

‘prestígio’ and ‘reputação’ Portuguese

Reputation

The reputation of a PDO depends on its image in the minds of consumers, and that image, in turn, depends essentially on particular characteristics and, more generally, **on the quality of the product** (14/09/2017, C-56/16 P, PORT CHARLOTTE, EU:C:2017:693, § 81-82; 23/04/2018, T-43/15, CRM v Commission, EU:T:2018:208, § 45; 16/05/2000, C-388/95, Belgique/Espagne, EU:C:200:244, § 56; 20/05/2003, C-469/00, RAVIL, EU:C:2003:295, § 49).

Exploits the reputation

21/04/2020, R 993/2019-2, Portwo gin / Porto
49 When compared to the wording of article 8(5)
EUTMR which refers to an ‘unfair advantage’ it
can be concluded that the notion of ‘exploitation’
is less demanding.

Exploits the reputation change to “take undue advantage”

20/12/2017, C 393/16, CHAMPAGNER SORBET,
EU:C:2017:991, § 40-41:

The case law defines the notion of **‘exploitation of the reputation’ of a PDO** within the meaning of Article 103(2)(a)(ii) of Regulation No 1308/2013 as the use of a PDO ‘that seeks to **take undue advantage of the reputation** enjoyed by the PDO’ in particular by means of a transfer of image

