



Strengthening geographical indications

IP Protection of GIs: Scope of protection of
GIs relating to components of compound-
GI-name

LEGAL CONTEXT

Regulation No 1151/2012:

PROSCIUTTO DI



Art. 3(6): definition of "generic terms"

Art. 5(2): Requirements for "geographical indication"

Art. 6(1) Generic nature

Art. 13(1) and (2) Protection

Art. 14(1) Relation between trademarks and "geographical indication"

Art. 41(1), (2) and (3) Exception for certain prior use: "generic terms"

TORTA DEL



Relevant case law

Starting from Case T291/03 Consorzio per la tutela del Formaggio Grana Padano / Biraghi S.p.A.



- The frequency with which a term appears on the internet is not, of itself, capable of establishing the generic nature of a name.
- The BOA was not in a position to come to the conclusion that registration of the mark GRANA BIRAGHI did not constitute an infringement of the PDO '*grana padano*' .
- The BOA also erred in finding that the name '*grana*' was generic and that the existence of the PDO '*grana padano*' did not preclude the registration of the mark GRANA BIRAGHI for the purpose of the above Article 14.

The BOA is required to carry out a detailed analysis of all the factors which could establish the generic character of an agricultural product or foodstuff and in particular:

- the **legal, economic, technical, historical, cultural and social evidence** which makes it possible to carry out the necessary detailed analysis is, inter alia, the relevant national and EU legislation
- survey of consumers organised in order to understand their perception of the name in question
- opinion of the scientific group of expert for designations of origin and geographical indications set up by Commission decision,
- other factors, such as inter alia, the definition of a name as generic in the *Codex Alimentarius*

Relevant case law

Passing through the ongoing Case T-826/16 Consejo Regulador de la Denominación de Origen «Torta del Casar» V Consejo Regulador de la Denominación de Origen Protegida «Queso de La Serena»



The Court annulled the contested decision stating on the one hand that the Board of Appeal erred in pointing out that the term "Torta" does not designate a geographical area as such, but the mere shape of the cheese without having analysed in details if the term "Torta" constituted a traditional name within the meaning of Regulation 1151/2012 and on the other hand by excluding that the trademark applied for would evoke the PDO "Torta del Casar" for the mere reason that the term "Torta" did not indicate a geographic location.

An expert has been appointed to:

1. Analyze the designations of origin at issue and in particular scope of protection, historical sales volumes, impact on the local economy;
2. Legal situation in Spain, including Codex Alimentarius;
3. Trademark situation in Spain



Relevant case law:

and with an eye on Case C-432/18 Consorzio Tutela Aceto Balsamico di Modena V BALEMA GmbH



The GC stated: Aceto Balsamico di Modena is protected as a whole and the protection is not extended to its compounds "aceto", "balsamico", "aceto balsamico" (art. 13(1)(1)(a) – *direct use*)

ACETO BALSAMICO DI MODENA

The German Federal Court of Justice in its judgment of May 28, 2020 stated:

"The fact that the protection of a protected geographical indication (in this case: "Aceto Balsamico di Modena") does not extend to the use of the individual non-geographical elements of the same (in this case: "Aceto", "Balsamico", "Aceto Balsamico ") in a product name does not exempt from examining whether, taking into account its the additional linguistic and visual characteristics of the products, such a use represents an evocation pursuant to art. 13(1)(1)(b) of Regulation (EC) no. 1151/2012."

Thank you!

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Caring for a balance of IP rights

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