




GIs within TM law: Separation Anxiety?

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Strengthening GIs, Nov 2020

GIs as TMs: The reasons...

- Historical: TM registration pre-dates *sui generis* GIs
 - Often best available **national** option (priority date)
- Madrid system for **International Registration**
 - Strategic reasons for international protection
 - Collective marks globally recognised
- Restricted GI **subject matter**
 - Only wines (e.g. US, Australia)
 - Exclude Non-Agri products in the EU e.g. crafts
- Restricted **sign-types**
 - Only names registrable in the EU: PARMA v 
- **Domain name system** doesn't adequately recognise GIs as prior rights



Central question: “Fit”



- Can 'group' marks be included within a system designed around individual marks?
- TM → indicate specific commercial source
 - Distinctiveness requirement
- Coll or Cert Mark describes product attributes
 - Descriptive
- Descriptive ≠ distinctive
- Has implications for scope of protection
 - > distinctiveness → > scope
 - converse is also true

The problem

TM: Indicating geographical origin as descriptive 'baggage'? A bad thing...

GI: Indicating geographical origin as part of brand appeal? A great thing...

Descriptive Trademarks



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Two understandings of distinctiveness

- Source distinctiveness → *where does the product come from?*
 - **Different** for TMs and GIs
 - Apple (single commercial undertaking, which makes product distinctive)
 - Prosciutto di Parma (geographical source, which makes product type distinctive)
 - But treated as descriptive
 - Used by many undertakings
- Differential distinctiveness → *telling them apart?*
 - **Similar** for TMs and GIs; **both can work as valuable brands**
 - Coke v Pepsi
 - Champagne v Cava v Prosecco

Narrowing Options for GIs as TMs

- Individual marks?
 - Remain descriptive (Art 7(1)(c) EUTMR objection)
 - Can't use licensing → quality certification (C-689/15 Gözze)
 - Liable to be revoked for non-use in accordance with essential function
- Certification marks
 - Certification of geographical origin not permitted for EUTMs
 - But can exist as national geographical certification marks
- Collective marks: permitted but...
 - Weak protection (C-766/18 P *Halloumi*)
 - Proposal to treat as non-distinctive (Art 7(1)(b) objection)





Hollowing Out Collective Marks

1. A Different Essential Function

C-143/19 *Der Grüne Punkt* (12 Dec 2019), [52]-[53]

- [The] essential function of an EU collective mark is to distinguish the goods or services of the members of the association which is the proprietor of the mark from those of other undertakings...
- Thus, unlike an individual mark, a collective mark does not have the function of indicating to the consumer ‘the identity of origin’ of goods or services in respect of which it is registered, since that function, which seeks to guarantee to the consumer that the goods or services concerned have been manufactured or supplied under the control of a single undertaking which is responsible for their quality, is specific to individual marks

See also C-673/15 P to C-676/15 P *The Tea Board v EUIPO* (20 Sep 2017)

Trade mark information

| | |
|-----------------------|---|
| Name | INTERNATIONAL ASSOCIATION OF CONFERENCE INTERPRETERS AIIC |
| Filing number | 002718633 |
| Basis | EUTM |
| Date of receipt | 31/05/2002 |
| Type | Word |
| Nature | Collective |
| Nice classes | 9, 38, 41 (Nice Classification) |
| Vienna Classification | |

Are geographical collective marks different?

CTMR 2009 case law considered this issue:

Art 7(1)(c): **Descriptive marks are not distinctive; prohibited unless Acquired Distinctiveness**

- ‘trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’ are not to be registered.

Art 66(2): **derogation for geographical collective marks; permitted**

- ‘In derogation from Article 7(1)(c), signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute [EU] collective marks’
- *Reason? They continue to be geographically descriptive of origin while also being distinctive of membership in a club;*
- ***Here membership is proxy for place/product distinctiveness: the only reason we care who is in the Prosciutto di Parma club is because we like the ham from that region!***
- However AG Kokott in *Halloumi*: ‘provision is a **foreign body** in trade mark law’ [71]

C-673/15 P et al *Darjeeling* (2017)

- Prior collective marks for tea (cl 30):



- DARJEELING &

v.



- For clothes, undergarments etc in cl 25, 35, 38

- In **2010**, Delta filed for 4 Darjeeling TMs in cl 25 (lingerie), 35 (retailing of lingerie; advertising) and 38 (internet communication services);
- Opposition by Tea Board based on prior coll word and fig marks in cl. 30 tea
- NB: Darjeeling only registered as a GI in **2011**, not a prior right
- EUIPO OD rejected oppositions; BoA upheld OD; GC and CJEU agreed

(i) g/s too dissimilar for LoC (as measured by nature, intended purpose, not complementary, distribution channels etc);

(ii) not enough evidence for Art 8(5): reputation with the relevant public

Significance of Art 66(2)?

- Art 66(2) [now Art 74(2)] → signal different function for geographical collective mark?
 - **A rule specifically crafted to allow GIs into TM law; so retain the GI function?**
 - To designate the geographical origin of the product and its associated qualities
 - *Why raise this argument?*
 - To allow Coll. CTM owner to modify LoC test
 - Bypass problem that lingerie and tea were dissimilar goods; too dissimilar for regular LoC
 - Instead argue [modified] LoC
 - Delta's products might be seen by some consumers as having same geographical origin as Coll. CTM; similar goods in that sense

EUIPO, GC, CJEU **rejected** this:

- Geographical collective marks are a sub-category of collective marks and all of them must distinguish on the basis of association membership
 - Can have subsidiary 'certification of origin and associated quality' function, but this does not change their essential function → association membership
 - All the other provisions of EU TM law, including normal LoC test, still apply unless specifically exempted

Collective marks different from GIs

Darjeeling, AG Mengozzi, [53]; CJEU, [64]

- Protected geographical indications and collective marks consisting of a geographical indication are subject to regimes which, although they share certain common elements such as, for example, the obligation to register and the existence of regulations setting out the conditions of use of the sign, are otherwise very different.

Differences include:

- Type of signs protected [names only for GIs]
- Type of goods [wines, spirits, agricultural products & foodstuffs for GIs]
- Stringent requirements concerning the link between the product and the territory for PGIs
- Generic character [GIs better insulated]
- Renewal of registration and the revocation of rights for lack of genuine use (for marks)
- GIs enjoying appreciably wider scope of protection.

Collective marks consisting of geographical indications and protected geographical indications are different signs which have different objectives and which are subject to different rules.



2. Nibbling away at protection: C-766/18 P *Halloumi* (2020)

- Foundation for Halloumi opposed registration for foodstuffs, cheese, catering services by M. J. Dairies
 - i.e. identical/similar products
- Opposition rejected by EUIPO, aff'd on appeal
- 'The reasoning on which these decisions are based is, in essence, that the HALLOUMI mark corresponds to the designation of a well-known Cypriot cheese, with the result that it has only low distinctive character. In the light of the differences with the mark applied for, [prior tribunals] did not therefore establish a likelihood of confusion'. [AG16]

Arguments on (unsuccessful) appeal

- EUIPO: generic for a type of cheese → weak mark → no LoC (signs not sufficiently similar; emphasised differences); GC largely upheld BoA
- H Foundation: Cannot assess distinctiveness for geog. collective marks the same as
 - Individual marks → single commercial source
 - Other collective marks → membership in an association
- 1. Imposes an inappropriate burden of proof (presuming weakness; rebut)
- 2. Registered marks presumed to have (minimum) degree of distinctiveness – LoC possible even for weak marks (*BSH etc*)
- Must analyse collective marks within general f/w of CTMR, including LoC, in light of modified EF for collective marks – GC adopted correct approach
 - Cannot assess DC of geographical collective marks differently
 - Degree of DC is relevant for that LoC analysis (and evidence of acquired distinctiveness can support LoC)
 - Implicitly reinforces presumption that geographical marks indicating type of cheese weakly distinctive; require AD to overcome



Geog. collective marks:
The future?

EUIPO Draft Guidelines 2020

- “Even geographically descriptive EU collective marks (Article 74(2) EUTMR) must be capable of fulfilling the essential function of a collective mark to indicate the collective commercial origin of the goods sold under that trade mark” [C-673/15 P etc DARJEELING; C-766/18 P HALLOUMI].
- Seemingly, emphasising collective association in the mark and adding a figurative element permits registration
- However if Rioja is seen as a weakly distinctive element, then what is the value of such a mark?



EUTM file information

DARJEELING

004325718



Options for the future

- Treat geographical collective marks as if they have a certification mark function
- Why were geographical certification marks excluded from the EUTMR?
 - GIs a better fit with product certification function (origin + quality)
 - No formal explanation for the exclusion; ‘geographical origin’ removed during the drafting process (???)
 - **Revive this option**
- Acquired distinctiveness – but significant evidentiary hurdles across EU (*KitKat*)
- Add a figurative element/additional word elements to geographical collective mark (but scope of protection?)
 - Protect distinctive and dominant elements even for ‘weakly distinctive’ marks
- *Or else lose the very practical value of trade mark registration for GIs, which has existed for decades*
 - Expropriation claims for eroding property rights?