



QUESTIONS & ANSWERS



Specialised training for IPO staff: Interrelations between TM and GIs

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Zoom



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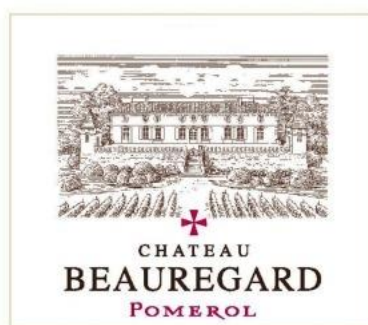
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Questions and Answers

- 1) In one of the case studies you presented you spoke about goods covered by Pomerol GI and goods of the conflicting trade mark. Could you elaborate further?

[The issue related to overcoming the objection by means of a limitation] In this particular case, it is not a question of conflicting trade marks on wines. It is the case in which an applicant comes forward with the label you have seen in the presentation,



and says simply “wines” in the list of goods and services. Since the GI is pre-registered for the term “Pomerol”, the subsequent trade mark wanting to use this GI on the label, has to limit its wines - in the list of goods and services - to this specific wine “Pomerol”.

No one is here saying that the producer wanting to register the trademark comes from a different or conflicting region. The producer comes from the same wine region of “Pomerol” and now wants to register a trade mark. And he is perfectly entitled to use “Pomerol” - but only for the wines following the product specifications of the GI. By trying to remove any doubt that this use of “Pomerol” in this trademark is conflicting in any way with the registered GI, we are asking the applicant to expressly say within the application “he is a producer of Pomerol wine”.

- 2) In terms of the scope of protection, are you saying that protection is only given to the Geographical area and not to the product?

It is quite the opposite actually: protection is given to the product, and not the geographical area. The protection is not given to the area if there is no particular product being protected under this name.

You need to have the (i) area, (ii) a product and a (iii) link between them for something to be called a GI.

- 3) Question on whether or not you can use in the Nice list of goods and services the name of a GI itself.

The Office is trying to avoid this type of use of GIs as descriptive use throughout goods and services. If we come across such an application, we would go back to the applicant requesting to use the full correct wording (ex. "wine complying with the specification of Champagne"). Full correct description of the product is required. With regard to use of limitations the right wording is critical.

- 4) In the presentation on whether goods are comparable, you mentioned that beer does not fall in a particular category. Kindly further clarify please.

Whereas something like beer and wine might be similar for purposes of likelihood of confusion, they would not be 'comparable goods' in the area of GIs, indeed, they are regulated by two different regulations. Beer is under food regulation (GI related to food stuffs), while wine has its own GI regulation.

- 5) Can a trademark be accepted as a sign containing a denomination of origin accompanied by other denominative and figurative elements for which the applicant is the owner of the denomination of origin at community level?

Even if the applicant is the Association itself, they would still have to limit the goods according to the GI specifications.

- 6) Would the registration of a GI affect a pre-existing Trademark?

No, it would not. [assuming the trademark was not filed in bad faith]. This situation is dealt with by respective GI Regulations, for example see Article 14(2) of regulation No 1151/2012.

- 7) How does an IP Office deal with the issue where an applicant successfully applies for an unregistered GI as a trademark, and subsequently the relevant Association applies to have the same product registered as a GI?

There would not be a bar to the GI being registered in that situation. The two have different legal basis. The subsequent GI application would be examined according to the GI regulation in place and the existence of a previous TM would not be a bar.

- 8) What GI databases can be used to conduct searches for relative and absolute grounds in relation to trademarks with geographical indications?

The easiest is the eAmbrosia database, which is managed by the European Commission. It is a GI database, publicly available. It contains all three registers online (food registered GIs, wine GIs, spirits GIs).

<https://www.google.com/search?client=firefox-b-e&q=eambrosia>

If you are looking for case law, the Office has a tool called e-search case law, in which you can search by ground. It includes the Boards of Appeals decisions, the Courts decisions, the Oppositions division, etc.

<https://euipo.europa.eu/eSearchCLW/>