


Information Session on Geographical Indications
Genericity of Geographical Indications in Uruguay

SCT 42 – Ompi

Geneva, Switzerland
November 6, 2019.



Regulations applicable to Geographical Indications

- ❖ **Law 17.011, del 25/08/1998**
 - Geographical Indications and Appellations of Origin: arts. 73 a 79

- ❖ **Regulatory Decree 34/999, del 3/02/1999**
 - Appellations of Origin: arts. 64 a 72.

- ❖ In what is not specifically provided for, the general dispositions for trademarks apply.

- ❖ Sui Generis System .

Register of Geographical Indications

❖ Law 17.011, Article 76:

Creating the register of geographical indications and appellations of origin in the National Directorate of Industrial Property, notwithstanding the Registry in the orbit of the National Institute of Viticulture, with respect to geographical indications and designations of origin of national producers.

Geographical Indication Concept

❖ Law 17.011, Article 74

A Geographical Indication is the identification of a product or service as originated in a country, region or locale, when a certain quality, reputation or other characteristic is fundamentally attributable to that geographical origin.

...

Required requirements and characteristics of the Geographical Indications

- ❖ Use limited to producers and service providers established in the geographical location in question.
- ❖ The granting of the same corresponds to the competent body in the matter. In winemaking it is the National Institute of Viticulture.
- ❖ Compliance with quality requirements
- ❖ It does not confer exclusive rights on the generic or descriptive terms that integrate it
- ❖ The use of I.G. is prohibited. that constitute an act of unfair competition or confusing with other registered or in process of registration.

Where does the concept of “generic” come from?

- ❖ Non-registrable signs in Uruguayan legislation, Law 17,011

Absolute nullities: article 4, numerals 9, 10, 11 and 12

- ❖ Article 4, numeral 10:

The designations usually used to indicate the nature of the products or class, gender or species to which they belong

"Generic" concept

- ❖ The nature of a thing is defined as virtue, quality or property of it, also defined as the species, gender or class, understood as such, to the set of elements similar to each other that have one or more common characters
- ❖ A generic sign is, by its very essence, a sign devoid of distinctive character.
- ❖ The decisive criterion for granting a generic character designation is the meaning that it has for consumers and entrepreneurs in the common language and in the constant and loyal customs of trade, avoiding monopolizing an element that must be freely available to all competitors. It is essential to always put the sign in relation to the products or services for which the trademark is requested. The same sign may be generic for some products and perfectly valid for others.

Sentences of the Administrative Contentious Court

- ❖ Judgments of the Administrative Contentious Court
 - “... This Court has indicated that a denomination is generic precisely because it is usual: The denomination that is usually used to designate a product or service, is the denomination that designates that product or service. The generic name is thus the expression that refers to the product or service and is used by the public to designate them; corresponds to the general vocabulary, so that no person can be granted the exclusive right to use that word, since it would create a position of advantage over other entrepreneurs...”

Exam system

❖ The examiner will consult:

❖ DNPI database:

- if there are matching terms

❖ Specific concept of each term that composes the denomination:

- the meaning that it has for consumers and entrepreneurs in the common language and in the constant and loyal customs of commerce

❖ Different databases

- as they are collected by other laws

❖ Websites

- how these terms are collected by different means

❖ Translations

- determine the meaning in the Spanish language

❖ TCA sentences

Decisions on the terms referred



Exam System

❖ Decide:

meaning of the term for consumers and entrepreneurs in the common language and in the constant and loyal customs of commerce

❖ Avoid:

❖ That the term be monopolized, and should be freely available to all competitors

❖ Fundamental:

Always put the sign in relation to the products or services It can be generic for some products and for others not

Caso “Champagne”

Num.exp.	Fec.Novedad	Nombre de la Marca	Clases	Nombre titular	Status
<input type="checkbox"/>					
<input type="checkbox"/> 337941	06/03/2002	CHAMPAGNE CANARD-DUCHENE	NCL(0) 33	CHAMPAGNE ALAIN THIENOT [FR]	Concedida
<input type="checkbox"/> 366337	18/10/2005	CHAMPAGNE	NCL(0) 30	FLEISCHMANN NABISCO URUGUAY S.A. [UY]	Concedida
<input type="checkbox"/> 378154	21/02/2007	HOTEL CHAMPAGNE	NCL(0) 43	JORGE GABRIEL PROFUMO BOURDETTE [UY]	Desestimada
<input type="checkbox"/> 379647	16/04/2007	CHOCOLATE, MARKETING & CHAMPAGNE	NCL(0) 38 41	IDEALCOR S.A. [UY]	Desestimada
<input type="checkbox"/> 401070	15/04/2009	STRAWBERRIES AND CHAMPAGNE	NCL(0) 3	VICTORIA'S SECRET STORES BRAND MANAGEMENT, INC. [US]	Desestimada
<input type="checkbox"/> 405829	24/09/2009	LA NOCHE DEL CHAMPAGNE	NCL(0) 41	MICRUS S.A. [UY]	Desestimada
<input type="checkbox"/> 413842	30/06/2010	COMTES DE CHAMPAGNE	NCL(0) 33	TAITTINGER COMPAGNIE COMMERCIALE ET VITICOLE CHAMPENOISE(RC.S.490 341 062) [FR]	Concedida
<input type="checkbox"/> 449204	03/10/2013	CHAMPAGNE HOME & DECO	NCL(0) 20 21 35 42	CHAMPAGNE S.A. [UY]	Desestimada

(Des)activar selección | Seleccionar/deseleccionar todos | Agregar a grupo de tramites

- **Expediente:** Marca Nro. 449204
- **Signo:** CHAMPAGNE HOME & DECO (mixta)
- **Titular:** CHAMPAGNE S.A.
- **Clase(s):** 20, 21, 35 y 42
- Montevideo, *28 de marzo de 2017*
- **CONSIDERATIONS**
- **it is clear that according to**
- **numeral 4 of article 4 of law 17,011, designations of origin ARE NOT**
- **RECORDABLE AS BRANDS, constituting absolute nullities. In purity the**
- **numeral regulates two hypotheses of absolute nullity: on the one hand the denominations of**
- **origin, and on the other hand - as evidenced by the use of the copulative conjunction “and” - the**
- **indications of provenance and geographical names that are not sufficiently**
- **original and distinctive or that its use may cause confusion.**
- **That appellations of origin are not registrable as trademarks per se, it is seen**
- **confirmed by article 45 of law 17,011 which states:**
- **“Appellations of origin may not be registered as guarantee marks**
- **regulated by this law, which in any case will be governed by its provisions**
- **specific.”**
- **Note that the impediment to registration as guarantee marks of the denominations of**
- **origin is not conditional on its distinctive character or that its employment cannot raise**
- **confusion.**

- ❖ Until certain date, records granted.
- ❖ To understand that it was a generic term that referred to a sparkling wine, and thus was recognized by the consuming public
- ❖ Subsequently, they were denied in application of article 4 numeral 4 of Law 17,011
- ❖ And also in application of Decree 283/93 of 06/16/1993

Decree 283/93

16 June, 1993

- ❖ Regulation by INAVI of the conditions of preparation, presentation and circulation of wines of preferential quality.

- ❖ CHAPTER IV - GEOGRAPHICAL INDICATIONS

- Article 15

When the label refers to a geographical indication, region of origin or designation of origin, the product must have a certification issued by the inspection body or entity competent, that accredits the right to use the denomination.



Thank you

Esc. Gabriela Espárrago
Área de Signos Distintivos
Dirección Nacional de la Propiedad Industrial
Gabriela.Esparrago@miem.gub.uy

