



Geographical Indications and Trade Marks: EU Trade Mark's perspective

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Protection to geographical indications vs. trade marks (a EU trade mark's perspective):

- Some questions of fact;
- Some questions of law;
- Protection 'ex officio';
- Oppositions against TMs based on earlier PGIs;
- Other cases

Questions of fact



Questions of Law

Legal Framework

- EU Trade Mark Regulation;
 - Remission to GIs Regulations and International Agreements
- EU Regulations on GIs and EU International Agreements;
 - Material law applicable;
 - Lex specialis
- OHIM Guidelines (new practice)

Scope of protection GIs vs CTMs

Means of protection in CTM registration procedure

- 'Proactive' protection:
 - Absolute ground for refusal (examination);
 - 'Ex officio' control by OHIM
- 'Reactive' protection:
 - Relative ground for refusal (oppositions based on an earlier PGI) + Cancellation (AG and RG);
 - On request (inter partes procedure)

Proactive protection: examination 'ex officio'

Examination by OHIM of trade marks which may conflict with a PGI:

- Which cases? Reproductions, imitations, etc. of a PGI;
- For which products? Identical and comparable products to those of the PGI;
- What do we apply? EU trade mark and GI Regulations and Int. Agreements;
- By whom? Ex-officio by OHIM examiners
- When? When a trade mark application is received;
- Result? If goods are not limited, the TM application is rejected

Relevant PDOs / PGIs:

Registered under EU Regulations (from EU
or from 3rd countries)

Protected under EU International
Agreements



Situations of conflict:

- * As defined in the material law
- * TM contains or consists of the PGI/PDO
- * Imitations and evocations
- * Other misleading indications



CTM consists of the PGI/PDO:

Word marks

'MADEIRA'

Considered descriptive

(Collective CTM No 3 540 911)

Acceptable only as collective trademarks
(goods complying with the GI)

CTM contains the PDO/PGI:

Word or figurative trademarks

Distinctiveness of figurative elements is irrelevant

TM goods must comply with the PGI specifications



Imitations and evocations:

Contains an equivalent adjective/noun

PDO 'Mel do Alentejo' → 'Mel alentejana'

Translations

PGI 'Pâtes d'Alsace' → Alsatian Pasta

'De-localizers'

PDO 'Feta' → Greek style plain feta



Other misleading indications:

Evocative figurative elements

Restrictive interpretation



Protection 'ex officio'

Protection for identical and 'comparable' goods

'Comparable goods' → Autonomous concept

'Comparable goods' ≠ 'Similar goods' in trademark law

Ingredients when commercially relevant



Protection 'on request'

Oppositions against a published TM based on a PGI

- Remission to material law (EU Regulations, International Agreements, etc.);
- Law governing the PGI must confer the right to prohibit use;
- GI 'holder' must be identified;

Protection 'on request': oppositions

Remission to material law:

EU Law: GIs protected under EU Regulations or EU International Agreements;

National Law: GIs protected under National Law of a EU Member State (only in some cases)

Protection 'on request': oppositions

Law governing the GI must confer the right to prohibit use of a TM

GI 'holder' must be identified

International agreements: self-executing?



Other means of protection

Third party observations

Requests for cancellation



Thank you for your attention

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OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET
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Thank You



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