

Trade mark and GI conflict: identity, similarity and imitation – An IP Office perspective

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CONTEXT: REGISTRATION PROCESS OF A EUROPEAN UNION TRADE MARK (EUTM)

Ex officio examination

Conflict with, among others,
protected geographical indications
Article 7(1)(j) EUTMR

Registration

Use in
commerce

Inter partes proceedings

Protected geographical indication invoked
as an earlier right by
opponent/cancellation applicants
Article 8(6) EUTMR

Examination period

Opposition period

Registration

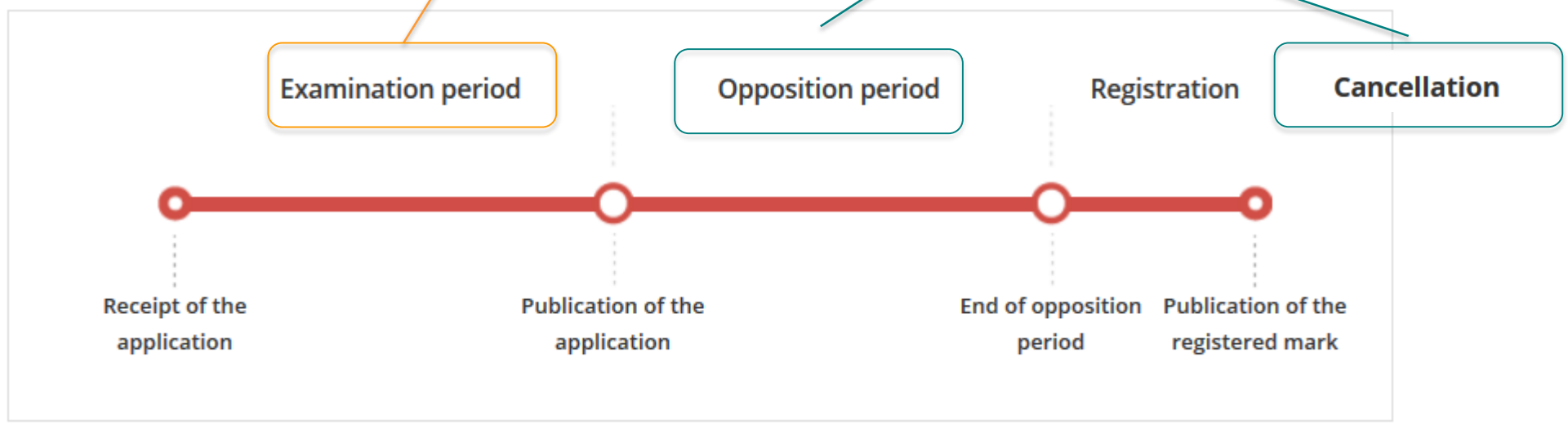
Cancellation

Receipt of the
application

Publication of the
application

End of opposition
period

Publication of the
registered mark



CONTEXT: CONSTRAINTS

Perceived as vague
Differences with TM law

Alien
legal
concepts

EUIPO
examiner

Limited
case-law

Evolution latest years
Need rulings on facts

EU Regulations
International agreements
National laws

Complex
legal
matrix

CONCEPTS

Identity

Similarity

Imitation

- Concepts come into play when TM examiner assesses a potential conflict between a trade mark and protected geographical indication
- Identically interpreted in situations of registration or commercial use (ex officio/opposition/cancellation). EUIPO has no competence for infringement cases
- Interpreted to set a high degree of protection of GIs
- BUT balance of rights: effective protection GIs vs rights of bona fide trade mark applicants

CONCEPTS: EUIPO PRACTICE

Identity

Similarity

Imitation

VS

Use
(direct or indirect)

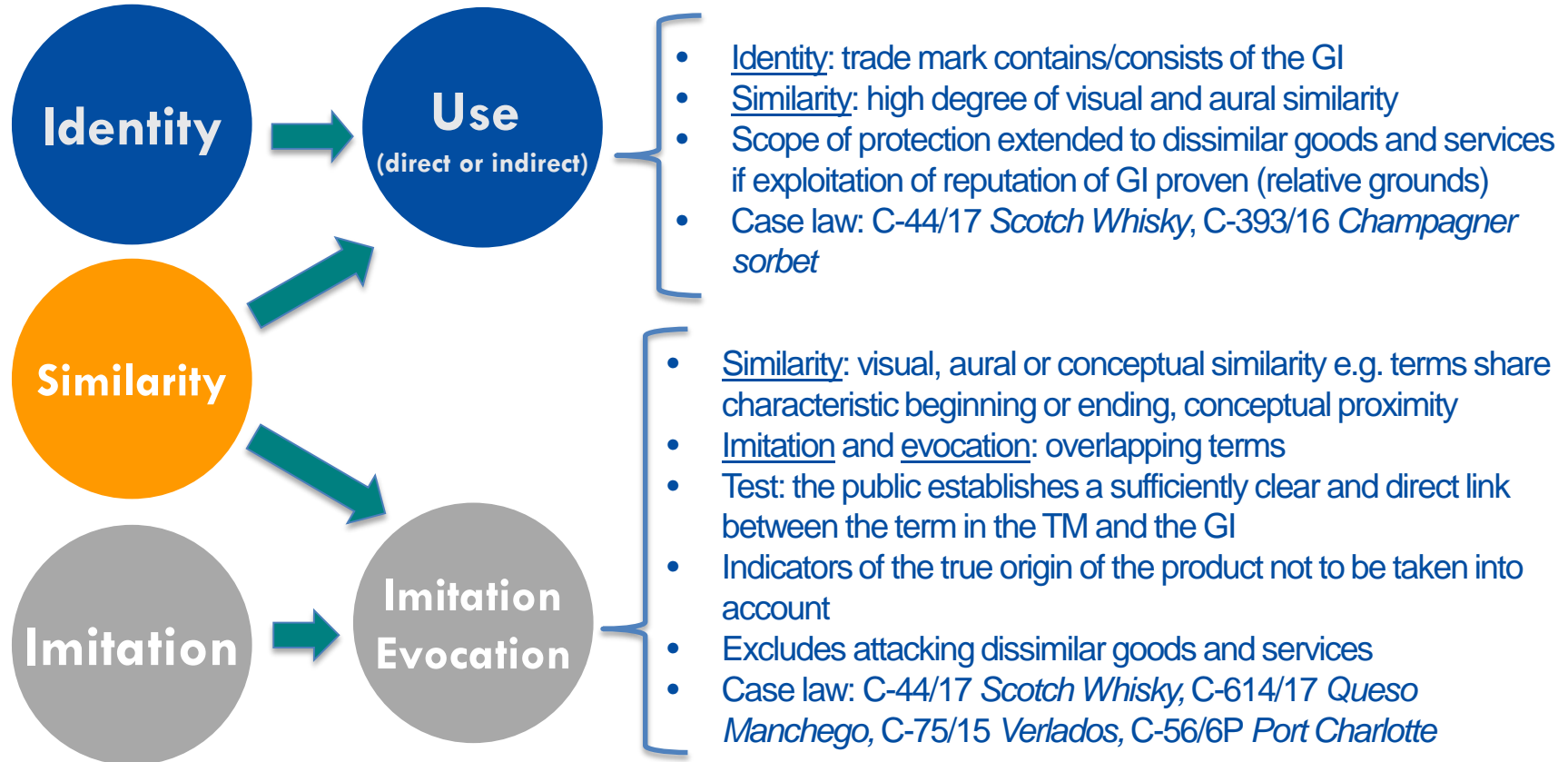
Imitation
Evocation

Article 13

Protection

1. Registered names shall be protected against:
 - (a) any **direct or indirect commercial use** of a registered name in respect of products not covered by the registration where those products are **comparable** to the products registered under that name or where using the name exploits the reputation of the protected name, including when those products are used as an **ingredient**;
 - (b) any **misuse, imitation or evocation**, even if the true origin of the products or services is indicated or if the protected name is translated or accompanied by an expression such as 'style', 'type', 'method', 'as produced in', 'imitation' or similar, including when those products are used as an ingredient;
 - (c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product that is used on the inner or outer packaging, advertising material or documents relating to the product concerned, and the packing of the product in a container liable to convey a false impression as to its origin;
 - (d) any other practice liable to mislead the consumer as to the true origin of the product.

CONCEPTS: DEFINITION - CASE-LAW



EXAMPLE: IDENTITY (USE)



EUTMs No 11 907 334 and No 2 281 970



Goods and Services

Alcoholic beverages (except beer)



Potential issues

Possible conflict with geographical indication

Porto / Port / vinho do Porto / Port Wine / vin de Porto / Oporto / Portvin / Portwein / Portwijn (PDO-PT-A1540)



Result

Application registered (after limitation to *Wines in conformity with the specifications of the protected geographical indication 'OPORTO'*; Alcoholic beverages (except beers and wines)

EXAMPLE: VISUAL AND AURAL SIMILARITY (EVOCATION)

**MEZCALOSFERA
DE MEZCALOTECA**

IR No 1 384 844



Goods and Services
Inter alia, alcoholic beverages



Potential issues
Possible conflict with geographical indication
MEZCAL (protected under the EU/MX agreement)



Result
Application registered after elimination of alcoholic
beverages

EXAMPLE: VISUAL, AURAL AND CONCEPTUAL SIMILARITY (EVOCATION)



EUTM No 18 015 193



Goods and Services

Inter alia, tomatoes



Potential issues

Possible conflict with geographical indication
POMODORINO DEL PIENNOLO DEL VESUVIO
(IT/PDO/0005/0576)



Result

Application registered after limitation to products
complying with the specification of the GI

EXAMPLE: NO CONFLICT

Cavalcade

EUTM No 17 929 998



Goods and Services

Wines



Potential issues

Conflict with geographical indication CAVA (PDO-ES-A0735)?



Result

The public will not dissect artificially the sign, perceive the term CAVA and linked it to the wine.
No conflict

EXAMPLE: OPPOSITION – IDENTITY (USE)

PROSECCO PRINCESS

EUTM No 17 203 274



Contested goods and services

Services in Class 35 (e.g. *retail of alcoholic beverages, rental of sales stands, consultancy*) and Class 43 (e.g. *providing food and drink, temporary accommodation*)



Opposition

Consorzio di Tutela della Denominazione di Origine Controllata Prosecco argued that the sign exploited the reputation of PROSECCO (PDO-IT-A0516)



Result

In light of evidence and arguments of the opponent, the opposition was upheld.

EXAMPLE: OPPOSITION - AURAL AND VISUAL SIMILARITY (USE/EVOCATION)

CHAMPAGNOLA

EUTM No 16 471 922



Contested goods and services

Class 30: Bread, pastry; baking preparations; Class 40: services related to bakeries.



Opposition

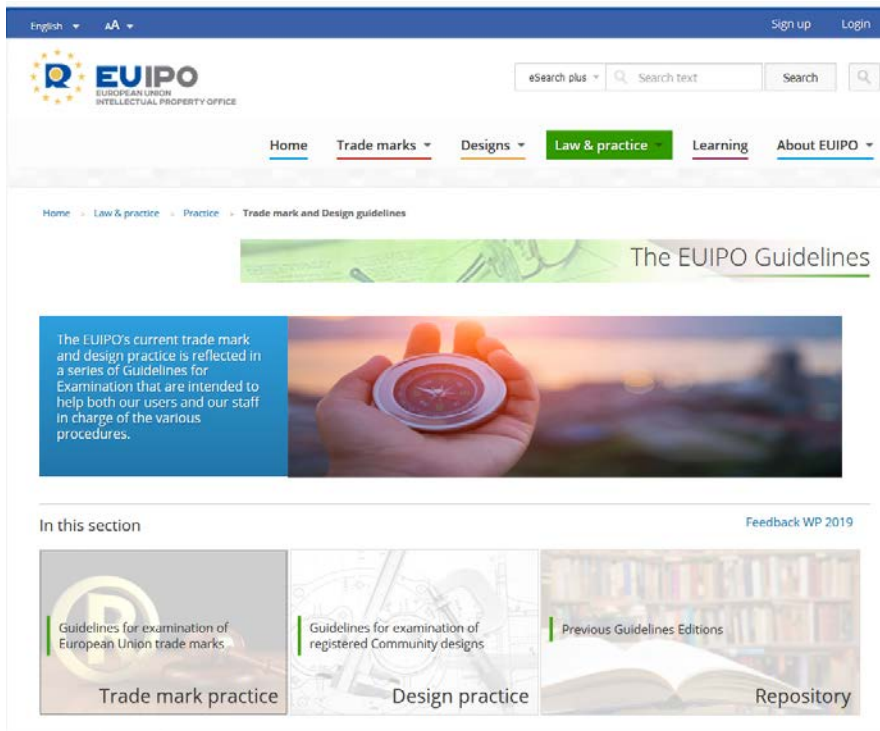
Opponent (Comité Interprofessionnel du vin de Champagne) argued that the sign exploited the reputation of/evoked CHAMPAGNE (PDO-FR-A1359)



Result

Opposition rejected. No evocation considering the products; no proof of exploitation of reputation.
UNDER APPEAL

WANT TO KNOW MORE?



The screenshot shows the EUIPO website interface. At the top, there is a navigation bar with 'English', 'AA', 'Sign up', and 'Login'. Below this is the EUIPO logo and a search bar. The main navigation menu includes 'Home', 'Trade marks', 'Designs', 'Law & practice' (highlighted in green), 'Learning', and 'About EUIPO'. The breadcrumb trail reads 'Home > Law & practice > Practice > Trade mark and Design guidelines'. The main heading is 'The EUIPO Guidelines'. A text box on the left states: 'The EUIPO's current trade mark and design practice is reflected in a series of Guidelines for Examination that are intended to help both our users and our staff in charge of the various procedures.' Below this is an image of a hand holding a coin. The 'In this section' area contains three tiles: 'Trade mark practice' (with a registered trademark symbol), 'Design practice' (with a registered design symbol), and 'Repository' (with an image of books).

EUIPO Guidelines on Trade Mark Practice

Part B Examination, Section 4 Absolute grounds for refusal - Chapter 10 Geographical indications (Article 7(1)(j) EUTMR)

Part C Opposition, Section 4 Rights under Article 8(4) and 8(6) EUTMR, Article 8(6) EUTMR — the Protection of Geographical Indications

<https://euipo.europa.eu/ohimportal/en/guidelines>



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Thank you