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

**Examination period**
Receipt of the application

**Opposition period**
Publication of the application

**Registration**
End of opposition period

**Cancellation**
Publication of the registered mark
CONTEXT: CONSTRAINTS

- Perceived as vague
- Differences with TM law

EUIPO examiner

- Alien legal concepts
- Limited case-law

Evolution latest years
Need rulings on facts

EU Regulations
International agreements
National laws

Complex legal matrix
CONCEPTS

Identity

- 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.

Similarity

- Interpreted to set a high degree of protection of GIs.

Imitation

- BUT balance of rights: effective protection GIs vs rights of bona fide trade mark applicants.
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

- **Identity**: trade mark contains/consists of the GI
- **Similarity**: high degree of visual and aural similarity
- **Use**: (direct or indirect)
- **Scope of protection extended to dissimilar goods and services if exploitation of reputation of GI proven (relative grounds)
- **Case law**: C-44/17 Scotch Whisky, C-393/16 Champagner sorbet

- **Similarity**: visual, aural or conceptual similarity e.g. terms share characteristic beginning or ending, conceptual proximity
- **Imitation and evocation**: overlapping terms
- **Test**: the public establishes a sufficiently clear and direct link between the term in the TM and the GI
- **Indicators of the true origin of the product not to be taken into account**
- **Excludes attacking dissimilar goods and services**
- **Case law**: C-44/17 Scotch Whisky, C-614/17 Queso Manchego, C-75/15 Verlados, C-56/6P Port Charlotte
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 / Portwijin (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)

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)

Goods and Services
Inter alia, tomates

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

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
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)

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
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

Thank you