

***GUIDELINES FOR EXAMINATION OF
EUROPEAN UNION TRADE MARKS***

***EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE
(EUIPO)***

PART B

EXAMINATION

SECTION 4

ABSOLUTE GROUNDS FOR REFUSAL

Table of Contents

2.7 Public policy or morality, Article 7(1)(f) EUTMR	4
2.7.1 ‘Public policy’	4
2.7.1.1 Concept and categories.....	4
2.7.2 Accepted principles of morality.....	5
2.8 Deceptiveness: Article 7(1)(g) EUTMR	8
2.8.1 Examination of the deceptive character	8
2.8.2 Market reality and consumers’ habits and perceptions	9
2.8.3 Trade marks with geographical connotations relating to the location of the applicant or the place of origin of the goods/services	10
2.8.4 Trade marks making reference to an ‘official’ approval, status or recognition	11
2.8.5 Relation with other EUTMR provisions.....	12
2.9 Protection of flags and other symbols — Article 7(1)(h) and (i) EUTMR	13
2.9.1 Protection of armorial bearings, flags, other state emblems, official signs and hallmarks indicating control and warranty under Article 7(1)(h) EUTMR — Article 6ter(1)(a) and (2) PC.....	14
2.9.1.1 Examination of marks consisting of or containing a state flag	17
2.9.1.2 Examination of marks consisting of or containing armorial bearings and other state emblems.....	21
2.9.1.3 Examination of marks consisting of or containing official signs and hallmarks indicating control and warranty.....	24
2.9.2 Protection of armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organisations under Article 7(1)(h) EUTMR — Article 6ter(1)(b) and (c) PC.....	24
2.9.3 Protection of badges, emblems or escutcheons other than those covered by Article 6ter of the Paris Convention under Article 7(1)(i) EUTMR	31
2.10 Article 7(1)(j) EUTMR	37
2.10.1 General remarks on EU Regulations.....	38
2.10.1.1 Definition of geographical indications under EU Regulations	38
2.10.1.2 Relevant provisions governing conflicts with trade marks	39
2.10.2 Relevant PDOs/PGIs under EU Regulations	41
2.10.2.1 Relevant point in time.....	41
2.10.3 Situations covered by the EU Regulations	42
2.10.3.1 EUTM consists solely of a whole PDO/PGI (‘direct use’).....	43
2.10.3.2 EUTM contains a whole PDO/PGI in addition to other word or figurative elements (‘direct or indirect use’).....	43
2.10.3.3 EUTM contains or consists of an imitation or evocation of a PDO/PGI	46
2.10.3.4 Other misleading indications and practices	49
2.10.3.5 The exploitation of the reputation of PDOs/PGIs.....	50
2.10.3.6 Limits to the scope of protection.....	51
2.10.3.7 Trade marks in conflict with two or more PDOs/PGIs.....	52
2.10.4 Relevant goods under EU Regulations	55
2.10.4.1 Comparable products	55
2.10.4.2 Restrictions of the list of goods.....	57
2.10.5 PDOs/PGIs not protected under EU Regulations.....	60
2.10.5.1 PDOs/PGIs protected at national level in an EU Member State	60
2.10.5.2 PDOs/PGIs from third countries	61
2.10.5.3 Relationship with other EUTMR provisions	64
2.11 Article 7(1)(k) EUTMR	64
2.11.1 General remarks on EU Regulations.....	64
2.11.1.1 Definition of traditional terms for <i>wine</i> under EU Regulations.....	65

2.11.1.2	Relevant provisions governing conflicts with trade marks	66
2.11.2	Relevant TTWs under EU Regulations	67
2.11.2.1	Relevant point in time	67
2.11.3	Situations covered by Article 113(2) of Regulation No 1308/2013.....	67
2.11.4	Relevant goods.....	68
2.11.4.1	Restrictions of the list of goods.....	69
2.11.5	International agreements.....	69
2.11.6	Relationship with other EUTMR provisions	69
2.12	Article 7(1)(l) EUTMR	69
2.12.1	General remarks on EU Regulations.....	70
2.12.1.1	Definition of traditional specialities guaranteed under EU Regulations	70
2.12.1.2	Relationship with trade marks	71
2.12.2	Relevant goods under EU Regulations	71
2.12.2.1	Relevant point in time.....	71
2.12.3	Situations covered by Article 24 of Regulation (EU) No 1151/2012.....	71
2.12.4	Relevant goods.....	72
2.12.4.1	Restrictions of the list of goods.....	72
2.12.5	International agreements.....	72
2.12.6	Relationship with other EUTMR provisions	73
2.13	Article 7(1)(m) EUTMR	73
2.13.1	Legislative framework.....	73
2.13.2	Definition of plant variety denomination	74
2.13.3	Situations covered by Article 7(1)(m) EUTMR	74
2.13.3.1	Registered plant variety denominations	74
2.13.3.2	Relevant point in time.....	75
2.13.3.3	The EUTM application consists of, or reproduces in its essential elements, the plant variety denomination	75
2.13.3.4	Plant varieties of the same or closely related species	76
2.13.4	Relationship with other EUTMR provisions.....	77
2.14	European Union collective marks.....	78
2.14.1	Character of collective marks	78
2.14.2	Ownership.....	79
2.14.3	Particularities as regards absolute grounds for refusal	80
2.14.3.1	Descriptive signs	80
2.14.3.2	Misleading character as to its nature.....	81
2.14.3.3	Regulations of use contrary to public policy and morality	81

2.7 Public policy or morality, Article 7(1)(f) EUTMR

Article 7(1)(f) EUTMR excludes from registration trade marks that are contrary to public policy or to accepted principles of morality. The rationale of Article 7(1)(f) EUTMR is to preclude trade marks from registration where granting a monopoly would contravene the state of law or would be perceived by the relevant public as going directly against the basic moral norms of society.

The Office considers that ‘public policy’ and ‘accepted principles of morality’ are two different concepts, which often overlap.

The question whether the goods or services applied for can be legally offered in a particular Member State’s market is irrelevant for the question whether the sign itself falls foul of Article 7(1)(f) EUTMR (judgment of 13/09/2005, T-140/02, ‘Intertops’, para. 33). Whether or not a mark is contrary to public policy or accepted principles of morality must be determined by the intrinsic qualities of the mark applied for and not by the circumstances relating to the conduct of the person applying for the trade mark (judgment of 13/09/2005, T-140/02, ‘Intertops’, para. 28). In its judgment of 20/09/2011, T-232/10, ‘Soviet Coat of Arms’, the General Court held that the concepts of ‘public policy’ and ‘acceptable principles of morality’ must be interpreted not only with reference to the circumstances common to all Member States but by taking into account ‘the particular circumstances of **individual Member States** which are likely to influence the perception of the relevant public within those States’ (para. 34).

The legislation and administrative practice of certain Member States can also be taken into account in this context (i.e. for assessing subjective values), not because of their normative value, but as evidence of facts which make it possible to assess the perception of the relevant public in those Member States (judgment of 20/09/2011, T-232/10, ‘Soviet Coat of Arms’, para. 57). In such a case, the illegality of the EUTM applied for is not the determining factor for the application of Article 7(1)(f) EUTMR but rather is of evidential value with regard to the perception of the relevant public in the Member State(s) in question.

Considering that the specific circumstances of **individual** Member States may not be widely known in the European territory, the objection letter should explain these circumstances clearly in order to make sure that the applicant is able to fully understand the reasoning behind the objection and is able to respond accordingly.

2.7.1 ‘Public policy’

2.7.1.1 Concept and categories

This objection derives from an assessment based on objective criteria. ‘Public policy’ refers to the body of Union law applicable in a certain area, as well as to the legal order and the state of law as defined by the Treaties and secondary EU legislation, which reflect a common understanding on certain basic principles and values, such as human rights. As indicated above, national legislation may also be taken into account, not because of its normative value, but as evidence of facts which make it possible to assess the perception of the relevant public in those Member States.

The following is a non-exhaustive list of examples of when signs will be caught by this prohibition.

1. On 27/12/2001 the Council of the European Union adopted Common Position 2001/931/CFSP on the application of specific measures to combat terrorism (OJ L 344, 28/12/2001, p. 93) later updated by Council Common Position 2009/64/CFSP (OJ L 23, 27/01/2009, p. 37 and available online at: <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2009:023:0025:0029:EN:PDF>) which contains a list of individuals and groups facilitating, attempting to commit or committing terrorist acts in EU territory. Any EUTM applied for which can be deemed to support or benefit an individual or a group on that list will be rejected as being against public policy.
2. Use of the symbols and names of Nazi organisations is prohibited in Germany (§ 86a dt. StGB (German Criminal Code), BGBl. Nr. I 75/1998) and in Austria (§ 1 öst. Abzeichengesetz (Austrian Law on Insignias), BGBl. Nr. 84/1960 in conjunction with § 1 öst. Verbotsgesetz (Austrian Prohibition Law), BGBl. Nr. 25/1947). Any EUTM applied for which uses such symbols or names will be rejected as being against public policy.

2.7.2 Accepted principles of morality

This objection concerns subjective values, but these must be applied as objectively as possible by the examiner. The provision excludes registration as European Union trade marks of blasphemous, racist or discriminatory words or phrases, but only if that meaning is clearly conveyed by the mark applied for in an unambiguous manner; the standard to be applied is that of the reasonable consumer with average sensitivity and tolerance thresholds (judgment of 09/03/2012, T-417/10, ‘¡Que bueno ye! Hijoputa’, para. 21).

It is normally necessary to consider the goods and services for which registration of the mark is sought, since the relevant public may be different for different goods and services and, therefore, may have different thresholds with regard to what is clearly unacceptably offensive. For example, as the Grand Board held in its decision of 06/07/2006, R 0495/2005-G – ‘SCREW YOU’, para. 29, ‘a person who is sufficiently interested in [sex toys] to notice the trade marks under which they are sold is unlikely to be offended by a term with crude sexual connotations.’ Nevertheless, although the Court has held that the goods and services applied for are important for identifying the relevant public whose perception needs to be examined, it has also made it clear that the relevant public is not necessarily only that which buys the goods and services covered by the mark, since a broader public than just the consumers targeted may encounter the mark (judgment of 05/10/2011, T-526/09, ‘Paki’, paras 17 and 18 respectively). Accordingly, the commercial context of a mark, in the sense of the public targeted by the goods and services, is not always the determining factor in whether that mark would breach accepted principles of morality (judgment of 09/03/2012, T-417/10, ‘¡Que bueno ye! Hijoputa’, para.24). See also decision of 15/03/2013, R 2073/2012-4, – ‘CURVE’, paras 17-18 (T-266/13 – pending).

It is not only signs with ‘negative’ connotation that can be offensive. The banal use of some signs with a highly positive connotation can also be offensive (e.g. terms with a religious meaning or national symbols with a spiritual and political value, like ATATURK for the European general public of Turkish origin (decision of 17/09/2012, R 2613/2011-2 – ATATURK, para. 31)).

There need not be illegality for this part of Article 7(1)(f) EUTMR to be applied: there are words or signs that would not lead to proceedings before the relevant authorities

and courts, but that are sufficiently offensive to the general public to not be registered as trade marks (decision of 01/09/2011, R 0168/2011-1 – ‘fucking freezing! by TÜRPIZ’, para. 16). Furthermore, there is an interest in ensuring that children and young people, even if they are not the relevant public of the goods and services in question, do not encounter offensive words in shops that are accessible to the general public. Dictionary definitions will in principle provide a preliminary indication as to whether the word in question carries an offensive meaning in the relevant language (decision of 01/09/2011, R 0168/2011-1 – ‘fucking freezing! by TÜRPIZ’, para. 25) but the key factor must be the perception of the relevant public in the specific context of how and where the goods or services will be encountered.

On the other hand, the Boards of Appeal took the view that the word KURO did not convey to the Hungarian public the offensive meaning of the word ‘kúró’ (meaning ‘fucker’ in English), since the vowels ‘ó’ and ‘ú’ are separate letters which are distinct from ‘o’ and ‘u’ and they are pronounced differently (decision of 22/12/2012, R 482/2012-1 – ‘kuro’, paras 12 et seq.).

There is a clear risk that the wording of Article 7(1)(f) EUTMR could be applied subjectively so as to exclude trade marks that are not to the examiner’s personal taste. However, for the word(s) to be objectionable, it (they) must have a clearly offensive impact on people of normal sensitivity (judgment of 09/03/2012, T-417/10, ‘¡Que buena puta! Hijoputa’, para. 21).




The concept of morality in Article 7(1)(f) EUTMR is not concerned with bad taste or the protection of individuals’ feelings. In order to fall foul of Article 7(1)(f) EUTMR, a trade mark must be perceived by the relevant public, or at least a significant part of it, as going directly against the basic moral norms of the society.

There is no need to establish that the applicant *wants* to shock or insult the public concerned; the objective fact that the EUTM applied for *might* be seen as such a shock or insult is sufficient (decision of 23/10/2009, R 1805/2007-1 – ‘Paki’, para. 27, confirmed by judgment of 05/10/2011, T-526/09, ‘Paki’ para. 20 et seq.).

Finally, application of Article 7(1)(f) EUTMR is not limited by the principle of freedom of expression (Article 10 European Convention on Human Rights) since the refusal to register only means that the sign is not granted protection under trade mark law and does not stop the sign being used — even in business (judgment of 09/03/2012, T-417/10, ‘HIJOPUTA’, para. 26).

Examples of rejected EUTM applications (public policy and/or morality)

Sign	Relevant Consumer	Public policy/morality	Case No
BIN LADIN	General consumer	Morality & public policy — the mark applied for will be understood by the general public as the name of the leader of the notorious terrorist organisation Al Qaeda; terrorist crimes are in breach of public order and moral principles (para. 17).	R 0176/2004-2
CURVE 300	General consumer	Morality — ‘CURVE’ is an offensive and vulgar word in Romanian (it means ‘whores’).	R 0288/2012-2
CURVE	General consumer	Morality — ‘CURVE’ is an offensive and vulgar word in Romanian (it means ‘whores’).	R 2073/2012-4 (T-266/13 – pending)

Sign	Relevant Consumer	Public policy/morality	Case No
	General consumer	Morality — 'fucking' is an offensive and vulgar word in English.	R 0168/2011-1
	General consumer	Morality — 'HIJOPUTA' is an offensive and vulgar word in Spanish.	T-417/10
	General consumer	Public policy — the Hungarian criminal code bans certain 'symbols of despotism', including the hammer and sickle as well as the 5-pointed red star symbolising the former USSR. This law is not applicable by reason of its normative value but rather as evidence of the perception of the relevant public (paras 59-63).	T-232/10
PAKI	General consumer	Morality — 'PAKI' is a racist insult in English.	T-526/09
SCREW YOU	General consumer (for products other than sex products)	Morality — a substantial proportion of ordinary citizens in Britain and Ireland would find the words 'SCREW YOU' offensive and objectionable (para. 26).	R 0495/2005-G
FICKEN	General consumer	Morality — 'FICKEN' is an offensive and vulgar word in German (it means 'fuck').	T-52/13
ATATURK	Average consumer in the European general public of Turkish origin	Banal use of signs with a highly positive connotation can be offensive under Article 7(1)(f) EUTMR. ATATURK is a national symbol with a spiritual and political value for the European general public of Turkish origin.	R 2613/2011-2

Examples of accepted EUTM applications

Sign	Relevant Consumer	Public policy/morality	Case No
KURO	General consumer	The fact that a foreign term, name or abbreviation displays certain similarities with an offensive word (like kúró) is not in itself sufficient reason to refuse the EUTM applied for (para. 20). Hungarian vowels 'ò' and 'ù' are clearly different from 'o' and 'u' without accent. Furthermore, Hungarian words never end with 'o' without accent (paras 15-18).	R 482/2012-1
SCREW YOU	General consumer (for sex products)	A person entering a sex shop is unlikely to be offended by a trade mark containing crude, sexually charged language (para. 26).	R 495/2005-G
DE PUTA MADRE	General consumer	Although 'puta' means 'whore' in Spanish, the expression DE PUTA MADRE means 'very good' in Spanish (slang).	EUTM 3 798 469 EUTM 4 781 662 EUTM 5 028 477

2.8 Deceptiveness: Article 7(1)(g) EUTMR

2.8.1 Examination of the deceptive character

Article 7(1)(g) EUTMR provides that marks which are of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or services, must not be registered.

According to the case-law relating to Article 3(1)(g) of the First Trademark Directive (TMD), the wording of which is identical to that of Article 7(1)(g) EUTMR, the circumstances for refusing registration referred to in Article 7(1)(g) EUTMR presuppose the **existence of actual deceit or a sufficiently serious risk that the consumer will be deceived** (judgment of 30/05/2006, C-259/04, 'Elizabeth Emanuel', para. 47 and the case-law cited therein).

Pursuant to the above, the Office, as a matter of practice, makes the twin assumptions that:

1. There is no reason to assume that a trade mark is intentionally applied for to deceive customers. No deceptiveness objection should be raised if a non-deceptive usage of the mark is possible *vis-à-vis* the goods and services specified: i.e. an assumption is made that non-deceptive use of the sign will be made if possible,
2. The average consumer is reasonably attentive and should not be regarded as particularly vulnerable to deception. An objection will generally only be raised where the mark leads to a **clear** expectation which is **patently contradictory** to, for instance, the nature or quality or geographical origin of the goods.

An objection should be raised when the list of goods/services is worded in such a way that a non-deceptive use of the trade mark is impossible.

The following are two examples of marks that were found to be deceptive with regard to all or part of the claimed goods¹.

Mark and goods	Reasoning	Case
LACTOFREE for <i>lactose</i> in Class 5	The nature of the sign would immediately lead the relevant consumer to believe that the product in question, i.e. 'lactose', does not contain any lactose. It is clear that if the good being marketed under the sign 'LACTOFREE' is actually <i>lactose</i> itself, then the mark would be clearly misleading. NB: The mark is also objectionable under 7(1)(c)	R 892/2009-1

¹ These examples address only the issue of whether a deceptiveness objection should be raised or not. This paragraph does not deal with possible objections under other absolute grounds for refusal. Therefore, the possibility that a given trade mark might appear to be *prima facie* objectionable under Article 7(1)(b) and/or (c) EUTMR (or other provisions for that matter) is not contemplated here.

Mark and goods	Reasoning	Case
<p style="text-align: center;">TITAN (German word for 'titanium')</p> <p><i>for portable and relocatable buildings; modular portable building units for use in the construction of prefabricated relocatable buildings; prefabricated relocatable buildings constructed of modular portable building units, none of the aforesaid goods being made from or including titanium in Classes 6 and 19.</i></p>	<p>The applicant, during the appeal proceedings, in an attempt to overcome an objection of descriptiveness, offered to restrict the specifications in both classes by adding, at the end, the indication <i>none of the aforesaid goods being made from or including titanium</i>. The Board held that such a restriction, if accepted, would have had the effect of rendering the trade mark deceptive from the standpoint of the German-speaking public, as they would assume that the goods were made from titanium when in reality this is not the case.</p>	<p style="text-align: center;">R 789/2001-3</p>

An objection should be raised when the list of goods/services, worded in a detailed manner, contains goods/services for which a non-deceptive use is impossible.

In the (invented) case of a trade mark 'KODAK VODKA' for *vodka, rum, gin, whisky*, an objection should be raised for the specific goods for which a non-deceptive use of the trade mark is not possible, i.e. *rum, gin, whisky*. Such cases are substantially different from those (see here below) where broad wording/categories are used and where a non-deceptive use of the sign is possible. For example, no objection would be raised for 'KODAK VODKA' filed for *alcoholic beverages*, since this broad category includes vodka, for which the trade mark is not deceptive.

No objection should be raised when the list of goods/services is worded in such a broad way that a non-deceptive use is possible.

When **wide categories** in the list of goods/services are used, the question arises whether an objection should be raised in relation to an entire category due to the mark being deceptive in relation to only some goods/services falling within that category. The policy of the Office is not to object in these circumstances. The examiner should assume that the mark will be used in a non-deceptive manner. In other words they will not object on the basis of deceptiveness wherever they can pinpoint (in a category) a non-deceptive use.

Therefore, the rule is that **Article 7(1)(g) EUTMR does not apply if the specification consists of wide categories which include goods/services for which use of the trade mark would be non-deceptive**. For example, in the case of a trade mark 'ARCADIA' applied for *wines*, an objection under Article 7(1)(g) EUTMR would not be appropriate, since the broad category *wines* also covers *wines* originating from Arcadia (and since Arcadia — which identifies a *wine*-producing region in Greece — is not a protected geographical indication at Community level, there is no obligation on the part of the applicant to restrict the specification only to *wines* originating from Arcadia).

2.8.2 Market reality and consumers' habits and perceptions

When assessing if a given trade mark is deceptive or not, **account should be taken of market reality and consumers' habits and perceptions**.

In order to evaluate the deceptiveness of a trade mark under Article 7(1)(g) EUTMR, account must be taken of the **reality of the market** (i.e. the way the goods and services are normally distributed/held out for sale/purchased/rendered, etc.) as well as of the **consumption habits and perception of the relevant public**, which is normally composed of reasonably well-informed, observant and circumspect persons.

For example, in the (invented) trade mark '**ELDORADO CAFÈ LATINO**' covering *coffee, preparations for use as substitutes for coffee, artificial coffee, chicory, chicory flavourings; chocolate, preparations for use as substitutes for chocolate; tea, cocoa; sugar, rice, tapioca, sago; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice* in Class 30, the examination should lead to the following conclusions.

- An objection under Article 7(1)(g) EUTMR would be justified in relation to preparations for use as substitutes for coffee, artificial coffee, chicory, chicory flavourings because use of the mark on these goods would be necessarily deceptive. One would assume one was purchasing coffee and this would not in fact be the case.
- An objection under Article 7(1)(g) EUTMR would also be justified for tea. Given that such goods may be sold in packaging quite similar to those used for coffee, and are often bought rather hastily, it is likely that many consumers will not indulge in analysing the wording on the packaging, but will choose these goods from the shelf in the (erroneous) belief that they are *coffee*.
- However, as far as coffee is concerned, there is no 'clear contradiction' between the claim for *coffee* and the wording 'CAFÈ LATINO', since the general category *coffee* may include also coffee originating from Latin America. Hence no Article 7(1)(g) EUTMR objection arises for the category of *coffee* itself. The same logic applies in relation to goods which could be flavoured with coffee (such as *chocolate, ices* and *pastry and confectionery*) — an assumption of non-deceptive use should be made, and no contradiction between the said wording and the goods necessarily arises.
- Finally, for the remainder of the goods are concerned, i.e. honey, bread, vinegar etc., the presence of the wording 'CAFÈ LATINO' will not give rise to any expectations at all. In relation to such goods, this wording will be seen as clearly non-descriptive and hence there is no potential for actual deception. In the 'real' market, coffee is not displayed on the same shelves or shop sections as bread, honey or vinegar. Furthermore, the goods in question have a different appearance and taste and are normally distributed in different packaging.

2.8.3 Trade marks with geographical connotations relating to the location of the applicant or the place of origin of the goods/services

When it comes to trade marks having certain 'geographical' connotations relating to the location of the applicant or the place of origin of the goods/services, the following should be noted.

As a general rule, the Office will not raise an objection on deceptiveness based upon the applicant's geographical location (address). Indeed, such a geographical location bears, in principle, no relation to the geographical origin of the goods and services, i.e. the actual place of production/offering of the goods and services covered by the mark.

As an example, a figurative mark containing the words **MADE IN USA** for *clothing* in Class 25 filed by a company having its seat in Sweden would not be open to an objection under Article 7(1)(g) EUTMR. In such cases, the Office assumes a non-deceptive use of the mark on the part of the proprietor.

Deceptiveness would nonetheless arise in the hypothetical event that a figurative mark containing the words **MADE IN USA**, filed by a company having its seat in the United States of America, were filed for a specifically limited list of goods: *clothing articles made in Vietnam* — although, in practice, such cases seem unlikely to arise.

In certain cases, the sign could evoke in the consumers' minds some impressions/expectations as to the geographical origin of the goods or of the designer thereof and which may not correspond to reality. For example, trade marks such as **ALESSANDRO PERETTI** or **GIUSEPPE LANARO** (invented examples) covering clothing or fashion goods in general may suggest to the relevant public that these goods are designed and produced by an Italian stylist, which may not be the case.


However, such a circumstance is not sufficient per se to render those marks misleading. Indeed, 'false impressions/expectations' caused by the trade mark are not tantamount to actual deceptiveness when the sign is merely evocative. In such cases there is no clear contrast between the impression/expectation a sign may evoke and the characteristics/qualities of the goods and services it covers.

2.8.4 Trade marks making reference to an 'official' approval, status or recognition

It should be noted that, under the Office's practice, trade marks that could evoke official approval, status or recognition without giving the firm impression that the goods/services issue from, or are endorsed by, a public body or statutory organisation, are acceptable.

The following are two examples where the marks concerned, although allusive or suggestive, were not found to be deceptive:

Mark and services	Reasoning	Case
<p>THE ECOMMERCE AUTHORITY for <i>business services, namely, providing rankings of and other information regarding electronic commerce vendors, goods and services via the Internet</i> in Class 35 and <i>providing research and advisory services and information in the area of electronic commerce</i> in Class 42.</p>	<p>The Board found that the trade mark was not deceptive, as it did not convey the firm impression that the services issue from a governmental or statutory organisation (the Board, however, confirmed the refusal under Article 7(1)(b) EUTMR on the grounds that the mark lacked distinctive character, as it would be perceived by the English-speaking public merely as a simple statement of self-promotion which claims something about the level of competence of the service providers).</p>	<p>R 803/2000-1</p>

Mark and services	Reasoning	Case
 <p>for, among other things, teaching of ski in Class 41.</p>	<p>The Board held that the French consumers would understand that the trade mark alludes to the fact that the services are supplied in France, by a French teaching centre, and relate to learning skiing 'in the French way'. It added that the French public had no reason to believe, simply because of the presence of a tricolour logo (not being a reproduction of the French flag), that the services are supplied by public authorities or even authorised by such authorities.</p>	<p>R 235/2009-1 confirmed by the General Court in T-41/10</p>

2.8.5 Relation with other EUTMR provisions

The above explanations aim to define the scope of application of Article 7(1)(g) EUTMR. Although addressed in their respective sections of the Guidelines, in the context of absolute grounds examination and of possible deceptiveness scenarios, the following provisions may be of particular relevance.

Article 7(1)(b) and (c) EUTMR

Under the current practice of the Office, if, following a descriptiveness and/or lack of distinctiveness objection, the EUTM applicant proposes a limitation in an attempt to overcome it, and provided the proposed limitation meets the prescribed requirements (unconditional request and suitably worded), the original list of goods and/or services will be limited accordingly. However, if the limitation in question (albeit overcoming the initial objection) has the effect of rendering the trade mark applied for deceptive, then the examiner will have to raise a deceptiveness objection under Article 7(1)(g) EUTMR. The following example illustrates such a scenario:

The trade mark '**ARCADIA**' was originally applied for *wines, spirits (beverages) and liqueurs* in Class 33. The examiner objected because the trade mark was descriptive of the geographical origin of *wines*, to the extent that Arcadia is a Greek region known for its *wine* production (however, it should be noted that Arcadia is not a protected geographical indication). The applicant offered to limit the specification of goods to exclude *wines* made in Greece or, if preferred, to include only *wines* produced in Italy. The examiner held that the proposed limitation would render the trade mark deceptive since it would convey false information as to the origin of the goods. On appeal, the Board confirmed the reasoning of the examiner (see decision of 27/03/2000, R 246/1999-1 – '**ARCADIA**', para. 14).

Article 7(1)(h) EUTMR

This provision excludes from registration those EUTMs which consist of/contain flags and other symbols of States, on the one hand, and flags and other symbols of international intergovernmental organisations on the other, which are protected according to Article 6ter of the Paris Convention and the inclusion of which in the trade mark has not been expressly authorised by the competent authorities. When it comes to the flags and other symbols of international intergovernmental organisations, the problem arises when the public might erroneously believe that, in view of the goods/services concerned, there is a connection between the EUTM applicant and the international organisation whose flag or symbol appears in the EUTM.

Article 7(1)(j) EUTMR (protected geographical indications)

This provision excludes trade marks in conflict with protected geographical indications (PGIs) or protected geographical denominations (PDOs) protected under EU law, national law or international agreements to which the EU or the Member State concerned is party, where the list of the respective goods does not specify that they have the purported geographical origin. The Office must object to EUTM applications where the protected geographical indication is misused or which convey any other false or misleading indication as to the provenance, origin, nature or essential qualities of the products concerned.

Article 7(1)(k) and (l) EUTMR (traditional terms for *wines* and traditional specialities guaranteed)

Article 7(1)(k) and (l) EUTMR exclude from registration trade marks that are in conflict with traditional terms for *wine* (TTW) and traditional specialities guaranteed (TSG), respectively, protected by either EU legislation or international agreements to which the EU is party. The Office must object to EUTM applications where the TTW or the TSG is misused or which convey any other misleading indications, such as the products qualifying for the protected TTW or TSG.

Article 17(4) EUTMR (transfer)

Under this provision, where it is clear from the transfer documents that, because of the transfer, the EUTM is likely to mislead the public concerning the nature, quality or geographical origin of the goods or services for which it is registered, the Office will not register the transfer unless the successor agrees to limit (the) registration of the EUTM to goods or services for which it is not likely to mislead (see also Part E, Section 3, Chapter 1, paragraph 3.6).

Article 51(1)(c) EUTMR (grounds for revocation)

Whereas in examining a trade mark under Article 7(1)(g) EUTMR an examiner must confine the assessment to the meaning conveyed by the sign vis-à-vis the goods/services concerned (meaning that the way the sign is actually used is of no relevance), under Article 51(1)(c) EUTMR the way the sign is used is decisive, given that according to this provision a registered EUTM may be declared revoked if, in consequence of the use made of the sign by its proprietor or with their consent, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of the goods/services concerned.

2.9 Protection of flags and other symbols — Article 7(1)(h) and (i) EUTMR

The objective of Article 6^{ter} Paris Convention (PC) is to exclude the registration and use of trade marks that are identical or in some way similar to state emblems or the emblems, abbreviations and names of international intergovernmental organisations.

‘The reasons for this are that such registration or use would violate the right of the State to control the use of symbols of its sovereignty and furthermore might mislead the public with respect to the origin of goods to which such marks would be applied.’ (G.H.C. Bodenhausen, Guide to the application of the Paris Convention for the Protection of Industrial Property as revised in Stockholm in 1967, page 96.). Origin in

this regard must be understood as coming from or endorsed by the relevant administration, not as being produced in the territory of that state or, in the case of the EU, in the EU.

Article 7(1)(h) EUTMR therefore refers to the following symbols:

- Armorial bearings, flags, other emblems, official signs and hallmarks that belong to states and have been communicated to WIPO, although, in the case of flags, such communication is not mandatory.
- Armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organisations that have been communicated to WIPO, with the exception of those already the subject of international agreements for ensuring their protection (see, for example, the Geneva Convention for the Amelioration of the Condition of the Wounded and Sick in Armed Forces of 12/08/1949, Article 44 of which protects the emblems of the Red Cross on a white ground, the words 'Red Cross' or 'Geneva Cross', and analogous emblems).

The Court of Justice has made clear that these provisions can be applied regardless of whether the application concerns goods or services, and that the scopes of application of Article 7(1)(h) and 7(1)(i) EUTMR are analogous. Both articles should therefore be assumed to grant at least an equivalent level of protection, since they pursue the same objective, that is, to prohibit the use of specific emblems of public interest without the consent of the competent authorities (judgment of 16/07/2009 in Joined Cases C-202/08 P and C-208/08 P, 'RW feuille d'érable', paras 78, 79 and 80).

2.9.1 Protection of armorial bearings, flags, other state emblems, official signs and hallmarks indicating control and warranty under Article 7(1)(h) EUTMR — Article 6ter(1)(a) and (2) PC

In accordance with Article 6ter(1)(a) PC, the registration, either as a trade mark or as an element thereof, of armorial bearings, flags, and other state emblems of the countries of the Union (i.e. the countries to which the PC applies), or of official signs and hallmarks adopted by states as an indication of control and warranty, as well as any imitation from a heraldic point of view will be refused if no authorisation has been granted by the competent authority.

The members of the World Trade Organization (WTO) enjoy the same protection pursuant to Article 2(1) TRIPs, according to which members of the WTO must comply with Articles 1 to 12 and 19 PC.

Therefore, to fall foul of Article 7(1)(h) EUTMR, a trade mark:

- must consist solely of an identical reproduction or a 'heraldic imitation' of the abovementioned symbols;
- must contain an identical reproduction or a 'heraldic imitation' of the abovementioned symbols.

Furthermore, the competent authority must not have given its authorisation.

Armorial bearings consist of a design or image depicted on a shield. See the following example.



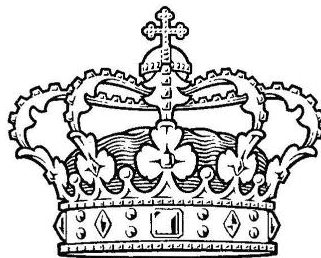
Bulgarian armorial bearing – 6ter database No BG2

State flags usually consist of a distinctive rectangular design that is used as the symbol of a nation. See the following example.



Croatian flag

The expression 'other State emblems' is rather vague. It usually indicates any emblems constituting the symbol of the sovereignty of a state, including the escutcheons of reigning houses as well as emblems of states included in a federal state that is party to the Paris Convention. See the following example.



Danish state emblem — 6ter database No DK3

The purpose of official signs and hallmarks indicating control and warranty is to certify that a state or an organisation duly appointed by a state for that purpose has checked that certain goods meet specific standards or are of a given level of quality. There are official signs and hallmarks indicating control and warranty in several states for *precious metals* or products such as *butter, cheese, meat, electrical equipment, etc.* Official signs and hallmarks may also apply to services, for instance those relating to *education, tourism, etc.* See the following examples.



Official Spanish sign for export promotion No ES1



UK hallmark for platinum articles No GB 40

It must be noted that Article 6ter PC does not protect the abovementioned symbols against all imitations, only 'heraldic imitations'. The notion of 'heraldic imitation' must be construed in the sense that '... the prohibition of the imitation of an emblem applies only to imitations of it from a heraldic perspective, that is to say, those which contain heraldic connotations which distinguish the emblem from other signs. Thus, the protection against any imitation from a heraldic point of view refers not to the image as such, but to its heraldic expression. It is therefore necessary, in order to determine whether the trade mark contains an imitation from a heraldic point of view, to consider the heraldic description of the emblem at issue' (see CJEU judgment of 16/07/2009 in Joined Cases C-202/08 P and C-208/08 P, para. 48).

Consequently, when making a comparison 'from a heraldic point of view' within the meaning of Article 6ter PC, account must be taken of the heraldic description of the emblem concerned and not any geometric description of the same emblem, which is by nature much more detailed. Indeed, if the geometric description of the emblem were taken into account, this '... would lead to the emblem being refused protection under Article 6ter(1)(a) of the Paris Convention in the event of any slight discrepancy between the two descriptions. Secondly, the case of graphic conformity with the emblem used by the trade mark is already covered by the first part of that provision, so that the expression "any imitation from a heraldic point of view" must be different in its scope' (see *ibidem*, para. 49).

For example, an examiner should take into account the heraldic description of the



European emblem — 'on an azure field a circle of twelve golden mullets, their points not touching' — and not its geometrical description: 'the emblem is in the form of a blue rectangular flag of which the fly is one and a half times the length of the hoist. Twelve gold stars situated at equal intervals form an invisible circle whose centre is the point of intersection of the diagonals of the rectangle. The radius of the circle is equal to one third of the height of the hoist. Each of the stars has five points

which are situated on the circumference of an invisible circle whose radius is equal to one eighteenth of the height of the hoist. All the stars are upright — that is to say, with the one point vertical and two points in a straight line at right angles to the mast. The circle is arranged so that the stars appear in the position of the hours on the face of a clock. Their number is invariable.’

Furthermore, armorial bearings and other heraldic emblems are drawn on the basis of a relatively simple description of the layout and background colour that also lists the different elements (such as a lion, an eagle, a flower, etc.) constituting the emblem and gives information on their colour and position within the emblem. However, a heraldic description does not give details of the design of the emblem and the specific elements that constitute it, with the result that a number of artistic interpretations of one and the same emblem on the basis of the same heraldic description are possible. Although there may be differences in detail between each of those interpretations, the fact remains that they will all be imitations ‘from a heraldic point of view’ of the emblem concerned (T-215/06, 28/02/2008, paras 71-72).

It follows that a trade mark that does not exactly reproduce a state emblem can nevertheless be covered by Article 6ter(1)(a) PC where it is perceived by the relevant public as imitating such an emblem. So far as the expression ‘imitation from a heraldic point of view’ in that provision is concerned, a difference detected by a specialist in heraldic art between the trade mark applied for and the State emblem will not necessarily be perceived by the average consumer who, in spite of differences at the level of certain heraldic details, can see in the trade mark an imitation of the emblem in question (see CJEU judgment of 16/07/2009 in Joined Cases C-202/08 P and C-208/08 P, paras 50-51).

Furthermore, for Article 6ter(1)(a) PC to apply, it is not necessary to examine the overall impression produced by the mark by taking into account also its other elements (words, devices, etc.).

Indeed, Article 6ter(1)(a) PC applies not only to trade marks but also to elements of marks that include or imitate state emblems. It is sufficient, therefore, for a single element of the trade mark applied for to represent such an emblem or an imitation thereof for that mark to be refused registration as an European Union trade mark (see also judgment of 21/04/2004, T-127/02, ‘ECA’, paras 40-41).

2.9.1.1 Examination of marks consisting of or containing a state flag

There are three steps to examining marks that consist of or contain a state flag:

- 1 Find an official reproduction of the protected flag.
- 2 Compare the flag with the mark applied for. Does the mark applied for consist solely of or contain an identical reproduction of the flag (b)? Or does the mark consist solely of or contain a heraldic imitation of that flag (b)?
- 3 Check whether there is any evidence on file to show that registration of the flag has been authorised by the competent authority.

- 1 Find the protected flag

As seen above, states are not obliged to include flags in the list of emblems to be communicated to WIPO. This is because flags are supposed to be well known.

Nevertheless, some flags have been included in the list, which is accessible via the 'Article 6ter Structured Search' tool made available by WIPO. Otherwise, examiners should refer to the official websites of the relevant governments, and to encyclopaedias and/or dictionaries for an accurate reproduction of the state flag.

2 Compare the flag with the mark applied for



- (a) Does the mark applied for consist solely of or contain an identical reproduction of a flag? If so, proceed to the next step.
- (b) Does the mark consist solely of or contain a heraldic imitation of a flag?

In the case of flags, the mark must be compared with the heraldic description of the flag at issue. For example, in Case T-41/10 of 05/05/2011 (ESF Ecole du ski français), the French flag was described as a rectangular or square flag made up of three equal vertical bands of the colours blue, white and red.



The examiner will use the heraldic description, which gives details of the layout and background colour, lists the different elements (such as a lion, an eagle, a flower, etc.) that constitute the flag and specifies the colour, position and proportions of the latter to reach a conclusion on heraldic imitation.

As a rule, the flag and the mark (or the part of the mark in which the flag is reproduced) must be quite similar in order for a heraldic imitation to be found.

See the following example where a 'heraldic imitation' of a flag was found:


Flag	Refused EUTM application
	
Swiss flag	EUTM application 8 426 876

The use of a flag in black and white may still be considered a heraldic imitation when the flag consists of or contains unique heraldic features. For example, the black-and-white representation of the Canadian flag in the following example is considered to be a heraldic imitation.

Flag	Refused EUTM application
	
Canadian flag	EUTM application 2 793 495


On the other hand, for flags consisting only of stripes of three colours (whether vertical or horizontal) a black-and-white reproduction will not be considered a heraldic imitation because flags of that kind are quite common.

As seen above, the presence of other elements in the marks is irrelevant; this is confirmed by the Board of Appeal's refusal of EUTM application 10 502 714.

Flag	Sign
<p>The flags of, for example, Belgium, the Czech Republic, France, Italy, Latvia, Austria, Finland and Sweden.</p>	 <p>EUTM application 10 502 714, R 1291/2012-2</p>
<p>'... the flags ... are all represented in the mark and will be immediately recognized as such by the public coming from those parts of the EU, as well as many others across the relevant territory. ... they do not merge into each other in a way which dissipates their individual characteristics. It must also be noted that the flags appearing at the bottom of the mark ... are not upside down, but are presented exactly as they would be normally.'</p> <p>As noted by the Court in the judgment of 16 July 2009, C-202/08 P and C-208/08 P, 'RW feuille d'érable' at para. 59, Article 6ter(1)(a) of the Paris Convention applies not only to trade marks but also to elements of marks which include or imitate State emblems. It is sufficient, therefore, for a single element of the trade mark applied for to represent such an emblem or an imitation thereof for that mark to be refused registration as a Community trade mark ... Therefore the applicant's arguments that although the mark contains various national flags, this is only a small part of the mark which is overwhelmed by the presence of the additional elements and that these elements are more dominant and distinctive, fail.' (paras 18-19)</p>	

If an element is a different shape from a flag (e.g. circular), it is not considered to be a heraldic imitation. Other different shapes that are not heraldic imitations are shown in the following examples:

Flag	Accepted EUTM application
	
	<p>EUTM application 5 851 721</p>
	
<p>Italian flag</p>	<p>EUTM application 5 514 062</p>
	
<p>Swiss flag</p>	<p>EUTM application 6 015 473</p>
	
<p>Finnish flag</p>	<p>EUTM application 7 087 281</p>
Flag	Accepted EUTM application
	
<p>Swedish flag</p>	<p>EUTM application 8 600 132</p>

	
<p>Danish flag</p>	<p>EUTM application 8 600 173</p>
	
<p>French flag</p>	<p>CTM 4 624 987, T-41/10</p>

The distinction between the cases examined in EUTM application No 8 426 876 (objected to) and EUTM application No 6 015 473 (not objected to) should be noted. In the latter, it was decided not to object because of the number of changes: a change in the shape (from a square to a circle), a change in proportions (the white lines of the cross in EUTM application No 6 015 473 are longer and thinner than in the flag) and a change of colour, since the cross in EUTM application No 6 015 473 has a shadow.

3 Check whether registration has been authorised

Once the examiner has found that the mark consists of or contains a flag or a heraldic imitation thereof, he/she must check whether there is any evidence on file to show that the registration has been authorised by the competent authority.

Where there is no such evidence, the examiner will object to the registration of the mark applied for. The objection will reproduce the official flag in colour and indicate the source of the reproduction.

Such an objection can only be waived if the applicant produces evidence that the competent authority of the state concerned has authorised registration of the mark.

Extent of the refusal: In the case of state flags, trade marks that fall foul of Article 7(1)(h) EUTMR must be refused for all goods and services applied for.

2.9.1.2 Examination of marks consisting of or containing armorial bearings and other state emblems

The same steps mentioned in relation to state flags are followed also when examining marks that consist of or contain armorial bearings or other state emblems.

Nevertheless, to be protected, armorial bearings and other state symbols must be contained in 'the list of armorial bearings and state emblems'. This list is accessible via

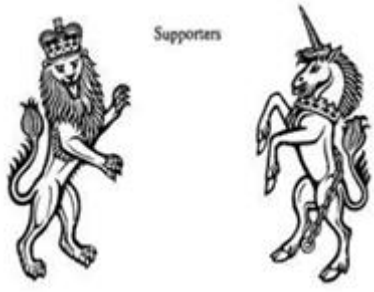



the ‘Article 6ter Structured Search’ tool made available by WIPO at <http://www.wipo.int/ipdl/en/6ter/>.

The WIPO Article 6ter database gives details of written elements and contains references to the categories of the Vienna Classification code. Therefore, the best way to search is by using that code.

In these cases, the protected symbol, which very often consists of or contains recurring devices such as crowns, unicorns, eagles, lions, etc., and the mark (or the part of the mark in which the symbol is reproduced) must be closely similar.

For background on this and heraldic descriptions, please see the explanation in paragraph 2.8.1.1 ‘Examination of marks consisting of or containing a state flag’ above.



Here are two examples where a ‘heraldic imitation’ of a state symbol was found:

Protected emblem	Refused EUTM application
 <p style="text-align: center;">Supporters</p>	
<p style="text-align: center;">British emblem: 6ter Number: GB4</p>	<p style="text-align: center;">EUTM application 5 627 245, T-397/09</p>
	
<p style="text-align: center;">Canadian emblem: 6ter Number: CA2</p>	<p style="text-align: center;">EUTM application 2 785 368 (CJEU C-202/08)</p>

The General Court noted that the supporters contained in EUTM application No 5 627 245 were almost identical to those in the emblem protected under sign GB4. The only difference lay in the crowns in both signs. However, the GC ruled that any difference between the mark and the state emblem detected by an expert in heraldry would not necessarily be perceived by the average consumer who, despite some differences in heraldic details, can see in the mark an imitation of the emblem. Therefore, the GC concluded that the Board was right to find that the mark applied for contained an imitation from a heraldic perspective of emblem GB4, protected under Article 6ter of the Paris Convention (Case T-397/09, paras 24-25).

In the example reproduced below a ‘heraldic imitation’ of state emblems was found by the examiner. However, the decision was annulled by the Board which considered that the sign applied for is not identical to the national emblem of Ireland. It does not contain

an imitation of the national emblems of Ireland either and it does not reproduce characteristic heraldic features of these emblems (R 0139/2014-5, para. 16):



State emblem	EUTM application
	
Irish state emblems: 6ter Numbers: IE 11 — IE 14	EUTM application 11 945 797

It should also be noted that black-and-white reproductions of armorial bearings and other state emblems may still be considered heraldic imitations when the protected symbol consists of or contains unique heraldic features (see the example of the Canadian emblem).



Furthermore, the presence of other elements in the rejected marks is irrelevant.

There is even a heraldic imitation when the protected symbol is only partially reproduced as long as what is partially reproduced represents the significant element(s) of the protected symbol and (a) unique heraldic feature(s).

The following is an example of a partial heraldic imitation because the significant element of the protected symbol, the eagle with the arrows over the emblem, is a unique heraldic device and its heraldic characteristics are imitated in the EUTM application:

Protected emblem	Refused EUTM applications
	
Emblem of the Justice Department of the USA; 6ter Number: US40	EUTM application 4 820 213

In the following example there is no heraldic imitation of a state emblem:

Protected emblem	Accepted EUTM application
	
6ter number: AT10	EUTM application 8 298 077

EUTM application No 8 298 077 is not a heraldic imitation of the Austrian symbol because its shape is different and the lines inside the white cross in the Austrian symbol are not present in the EUTM application.

Once the examiner has found that a mark reproduces a symbol (or is a heraldic imitation thereof), they must check whether there is any evidence on file to show that registration has been authorised by the competent authority.

Where there is no such evidence, the examiner will object to the registration of the mark applied for. The objection will reproduce the protected symbol, quoting its 6ter number.

Such an objection can only be waived if the applicant produces evidence that the competent authority of the state concerned has authorised registration of the mark.

Extent of the refusal: In the case of state symbols, trade marks that fall foul of Article 7(1)(h) EUTMR must be refused for all goods and services applied for.

2.9.1.3 Examination of marks consisting of or containing official signs and hallmarks indicating control and warranty

The steps to be followed by the examiner are the same as for the state flags, protected armorial bearings and other state emblems mentioned above.

However, the extent of the refusal is limited. Trade marks that consist of or contain an identical reproduction/heraldic imitation of official signs and hallmarks indicating control and warranty will be refused only for goods that are identical or similar to those to which said symbols apply (Article 6ter(2) PC).

2.9.2 Protection of armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organisations under Article 7(1)(h) EUTMR — Article 6ter(1)(b) and (c) PC

In accordance with Article 6ter(1)(b) and (c) PC, the registration, either as a trade mark or as an element thereof, of armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organisations (of which one or more countries

of the Paris Union is/are member(s)) or any imitation from a heraldic point of view will be refused if no authorisation has been granted by the competent authority.

The members of the WTO enjoy the same protection pursuant to Article 2(1) TRIPs, according to which members of the WTO must comply with Articles 1 to 12 and 19 of the Paris Convention.

Furthermore, the trade mark should be of such a nature as to suggest to the public that there is a connection between the organisation concerned and the armorial bearings, flags, emblems, abbreviations or names, or to mislead the public as to the existence of a connection between the owner and the organisation.

International intergovernmental organisations (IGOs) include bodies such as the United Nations, the Universal Postal Union, the World Tourism Organization, WIPO, etc.

In this respect, the European Union must be considered neither as an international organisation in the usual sense nor as an association of states, but rather as a 'supranational organisation', i.e. an autonomous entity with its own sovereign rights and a legal order independent of the Member States, to which both the Member States themselves and their nationals are subject within the EU's areas of competence.

On the one hand, the Treaties have led to the creation of an independent Union to which the Member States have ceded some of their sovereign powers. The tasks allotted to the EU are very different from those of other international organisations. While the latter mainly have clearly defined tasks of a technical nature, the EU has areas of responsibility that together constitute essential attributes of statehood.




On the other hand, the EU institutions too only have powers in certain areas to pursue the objectives specified in the Treaties. They are not free to choose their objectives in the same way as a sovereign state. Moreover, the EU has neither the comprehensive jurisdiction enjoyed by sovereign states nor the powers to establish new areas of responsibility ('jurisdiction over jurisdiction').

Notwithstanding the particular legal nature of the EU, and for the sole purpose of the application of Article 7(1)(h) EUTMR, the European Union is likened to an international organisation. In practice, account will be taken of the fact that the EU's field of activity is so broad (judgment of 15/01/2013, T-413/11, 'EUROPEAN DRIVESHIFT SERVICES', para. 69) that the examiner is very likely to find a link between the goods and services in question and the EU's activities.



The most relevant EU flags and symbols, protected by the Council of Europe, are shown here:

	
6ter number: QO188	6ter number: QO189

The following have been protected for the Commission:

		
6ter number: QO245	6ter number: QO246	6ter number: QO247

The following have been protected for the European Central Bank:

	
6ter number: QO852	6ter number: QO867

There are four steps to examining marks that contain the armorial bearing, flag or other symbols of an international intergovernmental organisation.

- 1 Find an official reproduction of the protected symbol (which may be an abbreviation or name).
- 2 Compare the symbol with the mark applied for.
- 3 Check whether the mark applied for suggests to the relevant public that there is a connection between the owner and the international organisation or misleads the public as to the existence of such a connection.
- 4 Check whether there is any evidence on file to show that registration has been authorised by the competent authority.

- 1 Find the protected symbol (or abbreviation or name)

To be protected, the symbols of international intergovernmental organisations must be incorporated in the relevant list. Unlike the situation with state flags, this requirement also applies to international organisations' flags.

The relevant database is accessible via the 'Article 6ter Structured Search' tool provided by WIPO. In this case too, the best way to search is by using the Vienna Classification code.

2 Compare the symbol with the mark applied for








Does the mark applied for consist solely of or contain an identical reproduction of the protected symbol of an international intergovernmental organisation Or does the mark applied for consist of or contain a heraldic imitation thereof?

- (a) Does the mark applied for consist solely of or contain an identical reproduction of the protected symbol? If so, proceed to the next step.
- (b) Does the mark applied for consist solely of or contain a heraldic imitation thereof?

The test is the same as that for state flags and symbols, that is, the protected symbol and the mark (or the part of the mark in which the protected symbol is reproduced) must be closely similar. The same applies to abbreviations and names of international intergovernmental organisations (see decision R 1414/2007-1 – ‘ESA’).

The following marks were rejected because they were considered to contain ‘heraldic imitations’ of the European Union flag protected under QO188:



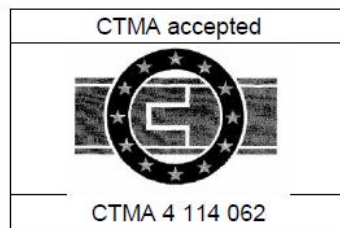
		
EUTM application 2 305 399	EUTM application 448 266	EUTM application 6 449 524
		
EUTM application 7 117 658	EUTM application 1 106 442 (T-127/02)	EUTM 4 081 014 (1640 C)
		
	EUTM application 2 180 800 (T-413/11)	

For heraldic imitations of the European Union flag (QO188 above), it is considered relevant that (a) there are 12 five-pointed stars, (b) the stars are in a circle and are not touching each other, and (c) the stars contrast with a darker background.

In particular, it must be taken into account that the 'device in the form of twelve stars arranged in a circle is the most important element of the European Union emblem ('the emblem') because it conveys strong messages: (a) the circle of gold stars symbolises solidarity and harmony between the peoples of Europe and (b) the number twelve evokes perfection, completeness and unity. The other element of the emblem is a background suitably coloured to highlight the device' (see BoA decision in case R 1401/2011-1, para. 21).

It follows from the above that the representation of the EU flag in black and white may still be considered a heraldic imitation when the stars contrast with a dark background in such a way as to give the impression of being a black-and-white reproduction of the EU flag (see EUTM application 1 106 442 above).

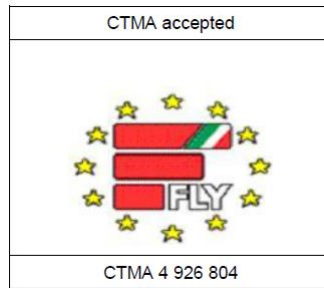
In contrast, the following example illustrates a case where the black-and-white reproduction of a circle of stars does not give the impression of being a black-and-white reproduction of the EU flag:



The following three cases are not considered to be heraldic imitations of the European Union flag because they do not reproduce twelve stars in a circle (i.e. both marks were accepted):



The following is not a heraldic imitation because, although the stars are yellow, there is no blue (or dark-coloured) background:



- 3 Check whether the mark applied for suggests to the relevant public that there is a connection between the owner and the international organisation or misleads the public as to the existence of such a connection.

A connection is suggested not only where the public would believe that the goods or services originate with the organisation in question, but also where the public could believe that the goods or services have the approval or warranty of, or are otherwise linked to, that organisation (see judgment of 15/01/2013, T-413/11, 'EUROPEAN DRIVESHAFT SERVICES', para. 61).

In order to assess the circumstances properly, the examiner must take into account the following:

- the goods and/or services covered by the EUTM application;
- the relevant public;
- the overall impression conveyed by the mark.


With regard to the European Union flag, the examiner must evaluate whether there is any overlap between the claimed goods and/or services and the European Union's activities, bearing in mind that the European Union is active in numerous sectors and regulates goods and services in all fields of industry and commerce, as is clear from the wide variety of Directives that it has adopted. Likewise, the examiner must take into account that even average consumers could be aware of such activities, which means, in practice, that the examiner is very likely to find a link in most cases.


Finally, in contrast to Article 6ter(1)(a) PC, for which it is sufficient for the sign to consist of or contain the emblem or a heraldic imitation thereof, Article 6ter(1)(c) PC requires an overall assessment.

It follows that, unlike for state emblems and flags, the examiner must take into account also the other elements of which the mark is composed. For it cannot be ruled out that all the other elements of the sign could lead to the conclusion that the public would not connect the sign with an international intergovernmental organisation (judgment of 15/01/2013, T-413/11, 'EUROPEAN DRIVESHAFT SERVICES', para. 59).

Still with regard to the EU flag, it must be noted that, as a rule, word elements such as 'EURO'/'EUROPEAN' in an EUTM application are likely to suggest a connection even more, since they could be perceived as implying an official EU agency's approval, quality control or warranty services for the claimed goods and services.

Here are two examples of where a connection with the EU was found:

	
G&S	<p>Class 16: <i>Periodical and other publications</i> Class 42: <i>Preparation of reports or studies relating to cars, motorcycles and bicycles</i></p>
Reasoning	<p>The mark was refused for all the goods and services for the following reasons: (26) Consumers in this market are aware of how important it is for companies that provide surveys and reports on expensive and potentially dangerous goods like vehicles to be credible. Consumers may also be aware that the European Union itself is involved in such activities through its association with Euro NCAP, which provides motoring consumers with independent assessments of the safety and performance of cars sold on the European market. Given these facts, and the fact that the proprietor's mark contains a recognisable heraldic element of the European emblem, it is likely that the public would assume that the inclusion of the twelve gold stars of the EU emblem in the EUTM pointed to a connection between the proprietor and the EU.</p>

	
G&S	<p>Class 9: <i>Computer hardware, computer software, recorded data carriers.</i> Class 41: <i>Arranging and conducting of colloquiums, seminars, symposiums, congresses and conferences; providing of tuition, instruction, training; consultancy on training and further training.</i> Class 42: <i>Creating, updating and maintenance of computer programs; computer program design; consultancy in the field of computers; rental of computer hardware and computer software; leasing access time to a computer database.</i></p>
Reasoning	<p>The mark was refused for all the goods and services for the following reasons: The Board of Appeal found that, contrary to what the applicant claimed, there was some overlap between the goods and services offered by the applicant and the activities of the Council of Europe and the European Union. The Board of Appeal referred, inter alia, to the Official Journal of the European Union, which is available on CD-ROM (i.e. compact disc with a read-only memory), to seminars, training programmes and conferences offered by the Council of Europe and the European Union in a variety of areas, and to a large number of databases made available to the public by those institutions, in particular EUR-Lex. Given the wide variety of services and goods that may be offered by the Council of Europe and the European Union, it cannot be ruled out, for the kind of goods and services for which registration was sought, that the relevant public might believe that there is a connection between the applicant and those institutions. Accordingly, the Board of Appeal was right to find that registration of the mark sought was likely to give the public the impression that there was a connection between the mark sought and the institutions in question.</p>

4 Check whether registration has been authorised

Where there is no evidence that registration of the mark applied for has been authorised, the examiner will object to its registration. The objection must reproduce the protected symbol, quoting its *6ter* number.

The examiner must also indicate the refused goods and services clearly and give reasons why the mark suggests to the public a connection with the organisation concerned.

Such an objection can only be waived if the applicant provides evidence that the competent authority has authorised registration of the mark.

Extent of the refusal: In the case of flags and symbols of international intergovernmental organisations, the refusal must specify the goods and/or services affected, that is, those for which the public would, according to the examiner, see a connection between the mark and an organisation.

2.9.3 Protection of badges, emblems or escutcheons other than those covered by Article 6*ter* of the Paris Convention under Article 7(1)(i) EUTMR

In accordance with Article 7(1)(i) EUTMR, trade marks will not be registered if they include badges, emblems or escutcheons other than those that are covered by Article 6*ter* of the Paris Convention and are of particular public interest, unless the competent authority has consented to their registration.

As seen above, Article 7(1)(i) EUTMR refers to all other badges, emblems or escutcheons that have not been communicated in accordance with Article 6*ter*(3)(a) PC regardless of whether they are the emblems of a state or international intergovernmental organisation within the meaning of Article 6*ter*(1)(a) or (b) PC or of public bodies or administrations other than those covered by Article 6*ter* PC, such as provinces or municipalities.

Furthermore, according to the case-law, Article 7(1)(i) and Article 7(1)(h) EUTMR both have a similar scope of application and grant at least equivalent levels of protection.

This means that Article 7(1)(i) EUTMR applies not only where the abovementioned symbols are reproduced identically as a trade mark or a part thereof, but also where the mark consists of or contains a heraldic imitation of those symbols. Any other interpretation of this provision would result in less protection being provided by Article 7(1)(i) EUTMR than by Article 7(1)(h) EUTMR. Following the same line of reasoning, Article 7(1)(i) EUTMR applies where the mark is liable to mislead the public as to the existence of a connection between the owner of the trade mark and the body to which the abovementioned symbols refer. In other words, the protection afforded by Article 7(1)(i) EUTMR is conditional on a link between the mark and the symbol. Otherwise, trade marks to which Article 7(1)(i) EUTMR applies, would obtain broader protection than under Article 7(1)(h) EUTMR (judgment of 10/07/2013, Case T-3/12 'MEMBER OF EURO EXPERTS').

Article 7(1)(i) EUTMR does not define symbols of 'particular public interest'. However, it is reasonable to assume that the nature of these could vary and could include, for example, religious symbols, political symbols or symbols of public bodies or

administrations other than those covered by Article 6^{ter} PC, such as provinces or municipalities. In any case, the ‘particular public interest’ involved must be reflected in a public document, for example a national or international legal instrument, regulation or other normative act.

The General Court stated that a ‘particular public interest’ existed when the emblem had a particular link with one of the activities carried out by an international intergovernmental organisation (judgment of 10/07/2013, T-3/12, ‘MEMBER OF EURO EXPERTS’, para. 44). In particular, the Court specified that Article 7(1)(i) EUTMR applied also when the emblem merely evoked one of the fields of activity of the European Union, and even if that activity concerned only some of the EU states (see *ibidem*, paras 45-46).

This confirms that the protection afforded by Article 7(1)(i) EUTMR applies also to symbols that are of particular public interest in only a single Member State or part thereof (Article 7(2) EUTMR).

There are four steps to examining marks that contain badges, emblems and escutcheons of particular public interest.

- 1 Find the symbol of particular public interest.
- 2 Compare the symbol with the mark applied for.
- 3 Check whether the mark applied for suggests to the relevant public that there is a connection between the owner and the authority to which the symbol refers or misleads the public as to the existence of such a connection.
- 4 Check whether there is any evidence on file to show that registration has been authorised by the appropriate authority.

- 1 Find the symbol of particular public interest.

At present, there is no list or database allowing examiners to identify which symbols are of particular public interest, especially in a Member State or part thereof. Therefore, third party observations are likely to remain the source of many objections to such symbols.

One example of a symbol of particular public interest is the Red Cross, which is protected by the Convention for the Amelioration of the Condition of the Wounded and Sick in Armed Forces in the Field, signed in Geneva (<http://www.icrc.org/> and <http://www.icrc.org/Web/Eng/siteeng0.nsf/htmlall/genevaconventions>).

The following symbols are protected under the Geneva Convention:



Apart from the symbols, their names are also protected (from left to right) as follows:

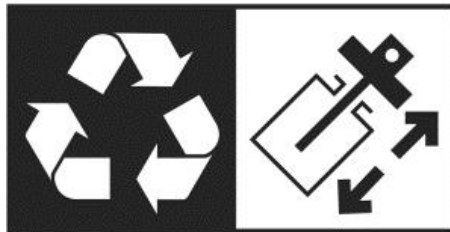
‘Red Cross’, ‘Red Crescent’ and ‘Red Crystal’.

Another example of a symbol of particular public interest is the Olympic symbol as defined in the Nairobi Treaty on the Protection of the Olympic Symbol. According to the definition in the Nairobi Treaty, 'the Olympic symbol consists of five interlaced rings: blue, yellow, black, green and red, arranged in that order from left to right. It consists of the Olympic rings alone, whether delineated in a single colour or in different colours.'



The following symbol was considered not to be a symbol of particular public interest:

RESPONSIBLE RECYCLING PACKAGING



SEPARATE GLASS FROM PLASTIC

The recycling symbol (on the left) was not considered to be protected under this provision because it is a commercial symbol.

2 Compare the symbol with the mark applied for.

Does the mark applied for consist solely of or contain an identical reproduction of the symbol of particular public interest? Or does the mark applied for consist of or contain a heraldic imitation thereof?




- (a) Does the mark applied for consist solely of or contain an identical reproduction of the symbol? If so, proceed to the next step.
- (b) Does the mark applied for consist solely of or contain a heraldic imitation of the symbol?

The test is the same as the one for flags and symbols of international intergovernmental organisations, that is, the symbol and the mark (or the part of the mark in which the symbol is reproduced) must be quite similar.

The following are examples of marks that were rejected because they contained the Red Cross symbol or a heraldic imitation thereof.

Refused EUTM application s		
		
WO 964 979	EUTM application 2 966 265	EUTM application 5 988 985




On the other hand, a number of well-known red crosses have traditionally been used and are still in use, the incorporation of which in a mark would not be considered a reproduction of the 'Red Cross'. Examples of these famous crosses include the following:

		
Templar cross	St George's cross	Maltese cross

The following EUTM was accepted because it contained two reproductions of the Templar cross.



A mark which contains a cross in black and white (or shades of grey) is not objectionable. Nor is a cross in a colour other than red objectionable under Article 7(1)(i) EUTMR.

Accepted EUTM application s		
		
EUTM application 8 986 069	EUTM application 9 019 647	EUTM application 9 025 768

- 3 Check whether the mark applied for suggests to the relevant public that there is a connection between the owner and the authority to which the symbol refers or misleads the public as to the existence of such a connection.

A connection is suggested not only where the public would believe that the goods or services originate with the authority in question, but also where the public could believe that the goods or services have the approval or warranty of, or are otherwise linked to, that authority (see GC judgment of 10/07/2013, T-3/12, ‘MEMBER OF EURO EXPERTS’, para. 78).

In order to assess the circumstances properly, the examiner must, as above, take into account the following:

- the goods and/or services covered by the EUTM application;
- the relevant public;
- the overall impression conveyed by the mark.

The examiner must evaluate whether there is any overlap between the claimed goods and/or services and the activities of the authority at issue and whether the relevant public could be aware of it.

In particular, with regard to the European Union, the examiner must take into account that the latter is active in numerous fields, as is clear from the wide variety of Directives that it has adopted.

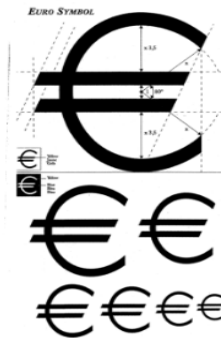
Furthermore, the examiner must also take into account the other elements of which the mark is composed. For it cannot be ruled out that all the other elements of the sign could lead to the conclusion that the public would not connect the sign with the authority concerned (see judgment of 10/07/2013, T-3/12, ‘MEMBER OF EURO EXPERTS’, para. 107).

Still with regard to the EU, it must be noted that, as a rule, word elements such as ‘EURO’/‘EUROPEAN’ in an EUTM application are likely to suggest a connection even more, since they could be perceived as implying EU approval (see judgment of 10/07/2013, T-3/12, ‘MEMBER OF EURO EXPERTS’, para. 113).

For example, the General Court (in Case T-3/12) confirmed that the following mark (C EUTM application TMA No 6 110 423, covering Classes 9, 16, 35, 36, 39, 41, 42, 44 and 45)



fell foul of Article 7(1)(i) EUTMR since it contained a (heraldic) imitation of the 'Euro' symbol.



4 Check whether registration has been authorised.

Is there any evidence on file that the appropriate authority has authorised registration?

Where there is no such evidence, the examiner will object to the registration of the mark applied for. The objection will reproduce the symbol and provide the applicant with all necessary details and, in particular, information on why the symbol is of 'particular public interest' (for example, if protected by an international instrument, a reference to that instrument; in the case of the Red Cross this is the Convention for the Amelioration of the Condition of the Wounded and Sick in Armed Forces in the Field, signed in Geneva (<http://www.icrc.org/> and <http://www.icrc.org/Web/Eng/siteeng0.nsf/htmlall/genevaconventions>)).

Such an objection can only be waived if the applicant submits evidence that the appropriate authority has consented to registration of the mark.

Extent of the refusal: In the case of symbols of particular public interest, the refusal must specify the goods and/or services affected, that is, those for which the public would, according to the examiner, see a connection between the mark and the authority.

2.10 Article 7(1)(j) EUTMR

Article 7(1)(j) EUTMR provides for the refusal of EUTMs that are excluded from registration pursuant to national or EU legislation or international agreements to which the EU or the Member State concerned is party, providing for protection of designations of origin and geographical indications.

As regards **EU legislation** protecting designations of origin and geographical indications, the following EU regulations are currently in place:

- Regulation (EU) No 1308/2013² on the protection of geographical indications for *wines*
- Regulation (EU) No 251/2014³ on the protection of geographical indications for *aromatised wines*
- Regulation (EC) No 110/2008⁴ on the protection of geographical indications for *spirit drinks*
- Regulation (EU) No 1151/2012⁵ on the protection of geographical indications for *agricultural products and foodstuffs*

As a consequence, Article 7(1)(j) EUTMR applies where protected designations of origin (PDOs) or protected geographical indications (PGIs) have been registered under the procedure laid down by these EU regulations. Importantly, PDOs/PGIs registered at EU level can originate from EU Member States, but also from third countries.

Article 7(1)(j) EUTMR also applies to EUTMs that are in conflict with third-country PGIs/PDOs that enjoy protection in the EU through **international agreements to which the EU is a party** (see paragraph 2.10.5 below).

As regards **national legislation** referred to in Article 7(1)(j) EUTMR, it is the Office interpretation that it exclusively relates to national legislation providing for the protection of PDOs/PGIs in those areas where there is not an uniform system of EU protection, namely those areas not covered by the abovementioned EU regulations. For the purposes of these Guidelines, they will be referred to as '**non-agricultural PDOs/PGIs**' (e.g. *handicrafts*).

As regards **international agreements concluded by Member States only**, and by analogy to the Office's interpretation of Article 7(1)(j) EUTMR as far as national law is concerned, the Office considers that the reference to an 'international agreement to which the Member State concerned is party' should be interpreted as international agreements (including the Lisbon Agreement) in those areas where no uniform EU protection is in place, namely *non-agricultural products* (see paragraph 2.10.5 below).

² Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013 establishing a common organisation of the markets in agricultural products.

³ Regulation (EU) No 251/2014 of the European Parliament and of the Council of 26 February 2014 on the definition, description, presentation, labelling and the protection of geographical indications of aromatised wine products and repealing Council Regulation (EEC) No 1601/91

⁴ Regulation (EC) No 110/2008 of the European Parliament and of the Council of 15 January 2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks and repealing Council Regulation (EEC) No 1576/89.

⁵ Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs. It replaced and repealed Regulation (EC) No 510/2006.

2.10.1 General remarks on EU Regulations

2.10.1.1 Definition of geographical indications under EU Regulations

As regards *spirit drinks*, according to Article 15(1) of Regulation (EC) No 110/2008, a 'geographical indication' is an indication that identifies a spirit drink as originating in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of that spirit drink is essentially attributable to its geographical origin.

As regards *wines*, according to Article 93 of Regulation (EU) No 1308/2013:

- (a) 'designation of origin' means the name of a region, a specific place or, in exceptional cases, a country used to describe a *wine* that complies with the following requirements:
- (i) its quality and characteristics are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors;
 - (ii) the grapes from which it is produced come exclusively from this geographical area;
 - (iii) its production takes place in this geographical area; and
 - (iv) it is obtained from vine varieties belonging to *Vitis vinifera*.
- (b) 'geographical indication' means an indication referring to a region, a specific place or, in exceptional cases, a country, used to describe a *wine* that complies with the following requirements:
- (i) it possesses a specific quality, reputation or other characteristics attributable to that geographical origin;
 - (ii) at least 85 % of the grapes used for its production come exclusively from this geographical area;
 - (iii) its production takes place in this geographical area; and
 - (iv) it is obtained from vine varieties belonging to *Vitis vinifera* or a cross between the *Vitis vinifera* species and other species of the genus *Vitis*.

As regards *aromatised wines*, according to Article 2 of Regulation (EU) No 251/2014, a 'geographical indication' means an indication that identifies an *aromatised wine* product as originating in a region, a specific place, or a country, where a given quality, reputation or other characteristics of that product is essentially attributable to its geographical origin.

Finally, as regards **agricultural products and foodstuffs**, pursuant to Article 5 of Regulation (EU) No 1151/2012, a 'designation of origin' is a name that identifies a product:

1. originating in a specific place, region or, in exceptional cases, a country;
2. whose quality or characteristics are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors; and
3. the production steps of which all take place in the defined geographical area.

A 'geographical indication' is a name that identifies a product:

1. originating in a specific place, region or country;

2. whose given quality, reputation or other characteristic is essentially attributable to its geographical origin; and
3. of which at least one of the production steps takes place in the defined geographical area.

The difference between PGIs and PDOs is that the latter have a **closer link** with the area. In the foodstuffs sector, PDO is the term used to describe foodstuffs that are produced, processed and prepared in a given geographical area using recognised know-how. A PGI indicates a link with the area in at least one of the stages of production, processing or preparation. PDOs therefore have a stronger link with the area.

This distinction, however, does not affect the scope of protection, which is the same for PDOs and PGIs. In other words, Article 7(1)(j) EUTMR applies equally to all designations covered by Regulation (EU) No 1308/2013 on *wines* and Regulation (EU) No 1151/2012 on *agricultural products and foodstuffs*, regardless of whether they are registered as PDOs or as PGIs. Regulation (EC) No 110/2008 on *spirits* and Regulation (EU) No 251/2014 on *aromatised wines*, however, cover only PGIs, not PDOs.

In this respect, it must also be underlined that the concepts of PDO and PGI differ from a **'simple indication of geographical provenance'**. For the latter, there is no direct link between a specific quality, reputation or other characteristic of the product and its specific geographical origin, with the result that it does not come within the scope of Article 93 of Regulation (EU) No 1308/2013, Article 2 of Regulation (EU) No 251/2014, Article 15(1) of Regulation (EC) No 110/2008 and Article 5(2) of Regulation (EU) No 1151/2012 (see, by analogy, judgment of 07/11/2000, C-312/98, 'Warsteiner Brauerei Haus Cramer', paras 43-44). For example, 'Rioja' is a PDO for *wines* since it designates a *wine* with particular characteristics that comply with the definition of a PDO. However, *wine* produced in 'Tabarca' (a 'simple geographical indication' designating a small island close to Alicante) cannot qualify for a PDO/PGI unless it meets specific requirements. Similarly, 'Queso Manchego' is a PDO for *cheese* since it designates a product with particular characteristics that comply with the definition of a PDO. However, 'Queso de Alicante' (a 'simple geographical indication') cannot qualify for a PDO/PGI since it does not enjoy such characteristics and requirements

Protection is granted to PDOs/PGIs in order, inter alia, to protect the **legitimate interests of consumers and producers**. In particular, the specific objectives of protecting designations of origin and geographical indications are to secure a fair return for farmers and producers for the qualities and characteristics of a given product, or of its mode of production, and to provide clear information on products with specific characteristics linked to geographical origin, thereby enabling consumers to make more informed purchasing choices (see recital 18 of Regulation (EU) No 1151/2012). Moreover, their protection aims at ensuring that they are used fairly and at preventing practices liable to mislead consumers (see recital 29 of Regulation (EU) No 1151/2012).

2.10.1.2 Relevant provisions governing conflicts with trade marks

As regards *wines*, according to Article 102(1) of Regulation (EU) No 1308/2013, the registration of a trade mark that contains or consists of a protected designation of origin or a geographical indication that does not comply with the product specification concerned or the use of which falls under Article 103(2), and that relates to a product

falling under one of the categories listed in Part II of Annex VII must be refused if the application for registration of the trade mark is submitted after the date of submission of the application for protection of the designation of origin or geographical indication to the Commission and the designation of origin or geographical indication is subsequently protected.

As regards *aromatised wines*, according to Article 19(1) of Regulation (EU) No 251/2014, the registration of a trade mark, the use of which falls under Article 20(2) and relates to an *aromatised wine* product must be refused if the application for registration of the trademark is submitted after the date of submission of the application for protection of the geographical indication to the Commission and the geographical indication is subsequently protected.

As regards *spirit drinks*, according to Article 23(1) of Regulation (EC) No 110/2008, 'the registration of a trade mark which contains or consists of a geographical indication registered in Annex III shall be refused or invalidated if its use would lead to any of the situations referred to in Article 16'.

Finally, according to Article 14(1) of Regulation (EU) No 1151/2012, *agricultural products and foodstuffs*, 'Where a designation of origin or a geographical indication is registered under this Regulation, the registration of a trade mark the use of which would contravene Article 13(1) and which relates to a product of the same type must be refused if the application for registration of the trade mark is submitted after the date of submission of the registration application in respect of the designation of origin or the geographical indication to the Commission'.

Article 103(2) of Regulation (EU) No 1308/2013, Article 20 of Regulation (EU) No 251/2014, Article 16 of Regulation (EC) No 110/2008 and Article 13(1) of Regulation (EU) No 1151/2012 set out the situations that infringe the rights deriving from a PDO/PGI: (i) direct or indirect commercial use of the PDO/PGI; (ii) misuse, imitation or evocation; (iii) other misleading practices.

In light of the above provisions, **three cumulative conditions** are necessary for Article 7(1)(j) EUTMR in combination with the EU Regulations to apply.

1. The PDO/PGI in question must be registered at EU level (see paragraph 2.10.2 below).
2. Use of the EUTM that consists of or contains a PDO/PGI for *wines* or *agricultural products and foodstuffs*, or a PGI for *spirits* must constitute one of the situations provided for in Article 103(2) of Regulation (EU) No 1308/2013, Article 20(2) of Regulation (EU) No 251/2014 or in Article 16 of Regulation (EC) No 110/2008 (see paragraph 2.10.3 below).
3. The EUTM application must include goods that are identical or 'comparable' to the goods covered by the PDO/PGI. Reference is also made below to how goods can be restricted in order to waive an objection (see paragraph 2.10.4 below).

2.10.2 Relevant PDOs/PGIs under EU Regulations

Article 7(1)(j) EUTMR in combination with the EU Regulations applies where PDOs/PGIs (either from an EU Member State or from a third country) have been **registered** under the procedure laid down by Regulations No 1308/2013, No 251/2014, No 110/2008 and No 1151/2012.

- Relevant information about PDOs/PGIs for *wines* can be found in the 'E-Bacchus' database maintained by the Commission, which can be accessed through the internet at <http://ec.europa.eu/agriculture/markets/wine/e-bacchus/>.
- Currently, there are only five PGI's for *aromatised wines*: Nürnberger Glühwein, Samoborski bermet, Thüringer Glühwein, Vermouth de Chambéry, Vermouth di Torino⁶. In the future, and pursuant to Article 21 of Regulation (EU) No 251/2014, the Commission will establish an electronic register of the PGIs protected under this Regulation. This register is not in place yet.
- PGI's for *spirit drinks* are listed in Annex III of Regulation No 110/2008 (Article 15(2) of Regulation No 110/2008), as amended, which can be accessed at <http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32012R0164&from=EN>. The Commission also maintains a database, 'E-Spirit-Drinks', accessible at <http://ec.europa.eu/agriculture/spirits/>. However, this is not an official register and is, therefore, only informative in character.
- Relevant information about PDOs/PGIs for *agricultural products and foodstuffs* **registered** under Regulation (EU) No 1151/2012 can be found in the database 'DOOR' maintained by the Commission, which can be accessed at <http://ec.europa.eu/agriculture/quality/door/list.html>.

Protection is granted solely to the name of a PDO/PGI as registered (see Article 13(1) of Regulation (EU) No 1151/2012) and does not extend *ipso iure* to the **names of subregions, subdenominations, local administrative areas or localities** in the area covered by that PDO/PGI. In this respect, and in particular as regards *wines*, a distinction must be made between the doctrine of the General Court in judgment of 11/05/2010, T-237/08, 'Cuvée Palomar' and the current legal framework. That judgment refers to a system of Member State competencies on the designation of geographical indications for *wines* that existed under previous Regulation (EC) No 1493/1999 but is no longer in force. According to Article 67 of Commission Regulation (EC) No 607/2009 (see also Article 120(1)(g) of Regulation (EU) No 1308/2013), the names of those small geographical areas are now considered merely optional particulars on labels.

2.10.2.1 Relevant point in time

Article 7(1)(j) EUTMR applies only for PDOs/PGIs that were **applied for** before the EUTM application **and** are **registered** at the time the EUTM application is examined. The relevant dates to establish the priority of a trade mark and a PDO/PGI are the date of application of the EUTM application (or the so-called Paris Convention priority, if claimed) and the date of application for protection of a PDO/PGI to the Commission respectively.

Notwithstanding the above, and in view of the fact that the vast majority of applications for PDO/PGI usually mature in a registration, **an objection will be raised** when the

⁶ See http://ec.europa.eu/agriculture/quality/documents-links/pdf/rqi-aromatised-wine-products_en.pdf.

PDO/PGI was applied for **before** the filing date (or the priority date, if applicable) of the EUTM application **but** had not yet been registered at the time of examining the EUTM application. However, if the EUTM applicant indicates that the PDO/PGI in question has not yet been registered, the proceedings will be suspended until the outcome of the registration procedure of the PDO/PGI.

Therefore, **no objection will be raised** under Article 7(1)(j) EUTMR when the PDO/PGI was applied for **after** the filing date (or priority date, if applicable) of the EUTM application.

- For *wines*, where there is no relevant date information in the ‘E-Bacchus’ extract, this means that the PDO/PGI in question was already in existence on 01/08/2009, the date on which the register was set up. For any PDOs/PGIs for *wines* added subsequently, the ‘E-Bacchus’ extract includes a reference to the publication in the Official Journal, which gives the relevant information.
- For *spirit drinks*, the initial publication of Annex III of Regulation (EC) No 110/2008 contained all PGIs for *spirit drinks* that existed on 20/02/2008, the date of entry into force of that regulation. For any PGIs for *spirit drinks* added subsequently, the corresponding amendment of the regulation contains the relevant information.
- Similarly, for *aromatised wines*, the initial publication of Annex II of Regulation (ECC) No 1601/91 contained all PGIs for *aromatised wines* that existed on 17/06/1991, the date of entry into force of that regulation. For any PGIs for *aromatised wines* added subsequently, the corresponding amendment of the regulation contains the relevant information. However, with the reform brought by Regulation (EU) No 251/2014, in force as of 27/03/2014, any future PGI should be included in an electronic register established by the Commission (see Article 21). This register is not in place yet.
- Details of the date of application for the PDO/PGI for *agricultural products and foodstuffs* are available in the ‘DOOR’ database.

2.10.3 Situations covered by the EU Regulations

Article 7(1)(j) EUTMR applies (provided that the other conditions also apply) in all of the following situations:

1. the EUTM application consists solely of a whole PDO/PGI (‘direct use’);
2. the EUTM application contains a whole PDO/PGI in addition to other word or figurative elements (‘direct or indirect use’);
3. the EUTM application contains or consists of an imitation or evocation of a PDO/PGI;
4. other misleading indications and practices;
5. the use of the EUTM application would exploit the reputation of PDOs/PGIs.

A number of limits to the scope of protection however are possible (see paragraph 2.10.3.6 below) and special rules apply to trade marks in conflict with more than one PGI/PDO (see paragraph 2.10.3.7 below).

2.10.3.1 EUTM consists solely of a whole PDO/PGI ('direct use')

This situation covers the 'direct use' of a PDO/PGI as an EUTM, that is, the trade mark consists **solely** of the name of the PDO/PGI.

Examples

PDO/PGI	European Union trade mark
MADEIRA (PDO-PT-A0038)	MADEIRA (Collective EUTM No 3 540 911)
MANZANILLA (PDO-ES-A1482)	MANZANILLA (Collective EUTM No 1 723 345)
DRESDNER CHRISTSTOLLEN (DE/PGI/005/0704)	DRESDNER CHRISTSTOLLEN (Collective EUTM No 262 949)
PROSCIUTTO DI PARMA (IT/PDO/0117/0067)	PROSCIUTTO DI PARMA (Collective EUTM No 1 116 458)

If the mark consists solely of the PDO/PGI, the EUTM also falls under **Article 7(1)(c)** EUTMR, since it is considered descriptive of the geographical origin of the goods in question. This means that the examiner's objection will **simultaneously** raise absolute grounds for refusal under both Article 7(1)(c) and (j) EUTMR.

There is an exception to the application of Article 7(1)(c) EUTMR, pursuant to Article 66(2) EUTMR, when the EUTM is a **collective trade mark** and the regulations governing use thereof include the particulars foreseen in Article 67(2) EUTMR (for the contrary situation, where the mark had been applied for as an individual mark, see decision of 07/03/2006, R 1073/2005-1 – 'TEQUILA', para. 15).


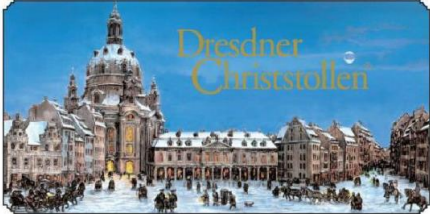

While **restricting the relevant goods** (to comply with the specifications of the PDO/PGI) is usually a means of waiving the objection under Article 7(1)(j) EUTMR (see paragraph 2.10.4 below), this restriction is irrelevant for Article 7(1)(c) EUTMR.



For example, an application for the word mark 'Bergerac' for *wines* will simultaneously be objected to under both Article 7(1)(c) and (j) EUTMR: it consists solely of the PDO 'Bergerac' and is therefore descriptive. If the goods are subsequently limited to *wines complying with the specifications of the PDO 'Bergerac'*, the objection under Article 7(1)(j) EUTMR will be waived but the trade mark is still descriptive and can be objected to under Article 7(1)(c) EUTMR, unless it is applied for as a collective trade mark that complies with Article 67(2) EUTMR.

2.10.3.2 EUTM contains a whole PDO/PGI in addition to other word or figurative elements ('direct or indirect use')

This situation also covers the '**direct use**' of a PDO/PGI in an EUTM through reproduction of the name of the PDO/PGI together with other elements.


The following EUTMs are considered to fall under Article 7(1)(j) EUTMR since they contain the whole denomination of a PDO/PGI.


PDO/PGI	European Union trade mark
<p>BEAUJOLAIS (PDO-FR-A0934)</p>	<p>BEAUX JOURS BEAUJOLAIS (EUTM No 1 503 259)</p>
<p>CHAMPAGNE (PDO-FR-A1359)</p>	<p>CHAMPAGNE VEUVE DEVANLAY (EUTM No 11 593 381)</p>
<p>BEAUJOLAIS (PDO-FR-A0934)</p>	 <p>(EUTM No 1 561 646)</p>
<p>PROSCIUTTO DI PARMA (IT/PDO/0117/0067)</p>	<p>CONSORZIO DEL PROSCIUTTO DI PARMA (EUTM No 6 380 141)</p>
<p>DRESDNER CHRISTSTOLLEN (DE/PGI/005/0704)</p>	 <p>(EUTM No 5 966 668)</p>
<p>PARMIGIANO REGGIANO (IT/PDO/0117/0016)</p>	 <p>(EUTM No 6 380 141)</p>

PDO/PGI	European Union trade mark
<p>WELSH BEEF (UK/PGI/0005/0057)</p>	 <p>(EUTM No 10 513 729)</p>
<p>WELSH LAMB (UK/PGI/0005/0081)</p>	 <p>(EUTM No 11 927 472)</p>

Under Article 7(1)(j) EUTMR, it is irrelevant whether or not the other word or figurative elements may give the trade mark distinctive character. The sign can be acceptable as a whole under Article 7(1)(b) and (c) EUTMR and can still be objected to (as in the cases above) under Article 7(1)(j) EUTMR.

There is '**indirect use**' of a PDO/PGI, for example, when the PDO/PGI appears in a complex trade mark (such as the representation of a label) in smaller characters as information about the origin or type of the product or as part of the producer's address. In such cases the trade mark can be objected to irrespective of the position or the size of the PDO/PGI within the trade mark as a whole, provided that it is visible.

PDO/PGI	European Union trade mark
<p>OPORTO (PDO-PT-A1540)</p>	 <p>EUTMs No 11 907 334 and No 2 281 970)</p>

<p>QUESO MANCHEGO (ES/PDO/0117/0087)</p>	 <p>(EUTM No 5 582 267)</p>
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There must be a logical separation of the PDO/PGI from the rest of the term for it to be identifiable and objectionable. A trade mark will not be objectionable when it contains the PDO/PGI as part of a word element which does not trigger in the mind of the consumer that of the product whose designation is protected. This is normally the case when the term has its own meaning.

Examples where an objection should not be raised: TORONTO, EXCAVADORA, IMPORT.

Examples where an objection was raised: R 2462/2013-2 – ‘TOROLOCO’ and R 1900/2013-5 – PARMATUTTO.

2.10.3.3 EUTM contains or consists of an imitation or evocation of a PDO/PGI

Neither the EUTMR nor the EU Regulations define the meaning of ‘imitation’ or ‘evocation’. To a large extent, they are closely related concepts.

According to the Court, ‘evocation’ covers ‘a situation where the term used to designate a product incorporates part of a protected designation, so that when the consumer is confronted with the name of the product, **the image triggered in his mind is that of the product whose designation is protected**’ (judgments of 04/03/1999, C-87/97, ‘Cambozola’, para. 25; 26/02/2008, C-132/05, para. 44).

According to the Advocate General (opinion of 17/12/1998, C-87/97, ‘Cambozola’, para. 33), ‘the term “evocation” is **objective**, so that it is not necessary to show that the owner of the mark intended to evoke the protected name’.

In this respect, and for the purposes of Article 7(1)(j) EUTMR, the Office will assess in an equally objective way the situations described below, under paragraphs (a) to (d), **regardless of the EUTM applicant’s actual intention**.

Furthermore, the Office considers the terms ‘imitation’ and ‘evocation’ as two corollaries of essentially the same concept. The mark ‘imitates’ (mimics, reproduces elements of, etc.), with the result that the product designated by the PDO/PGI is ‘evoked’ (called to mind).

In the light of the above, the Office finds that there is evocation or imitation of a PDO where:

- (a) the EUTM incorporates the geographically significant part (in the sense that it is not the generic element) of the PDO/PGI;

- (b) the EUTM contains an equivalent adjective/noun that indicates the same geographical origin;
- (c) the PDO/PGI is translated;
- (d) the EUTM includes a 'de-localiser' expression in addition to the PDO/PGI or its evocation.


a) The EUTM incorporates the geographically significant part of the PDO/PGI

As indicated above, according to the Court (judgment of 04/03/1999, C-87/97, 'Cambozola', and judgment of 26/02/2008, C-132/05, cited above), the EUTM must trigger in the consumer's mind the image of the product whose designation is protected.

The Court has also stated that 'it is possible ... for a protected designation to be evoked where there is no likelihood of confusion between the products concerned' (judgment of 04/03/1999, C-87/97, 'Cambozola', para. 26).

Importantly, evocation is **not assessed in the same way as likelihood of confusion** (see opinion of the Advocate General of 17/12/1998, C-87/97, 'Cambozola', para. 37). **A link must be made with the product whose designation is protected.** Therefore, whether or not there is evocation will not be analysed according to the principles laid down by the CJEU in judgment of 11/11/1997, C-251/95, 'Sabèl'.

Evocation is understood as encompassing not only when the EUTM **incorporates (one of) the geographically significant word(s)** (as opposed to generic) element(s) of a PDO/PGI, but also when the EUTM **reproduces other parts of that PDO/PGI**, such as a characteristic root or ending.

PDO/PGI	Trade Mark	Explanation
<p>CHIANTI CLASSICO (IT/PDO/0005/0108)</p>	 <p>(EUTM 9 567 851)</p>	<p>The term 'chianti' evokes the PDO 'Chianti Classico' protected for oils and fats. (R 1474/2011-2, 'AZIENDA OLEARIA CHIANTI', paras 14-15)</p>
<p>NÜRNBERGER BRATWÜRSTE/NÜRNBERGER ROSTBRATWÜRSTE (DE/PGI/0005/0184)</p>	<p>NUERNBERGA (EUTM No 9 691 577)</p>	<p>'due to the phonetic equivalence, NUERNBERGA is understood in the sense of the geographical indication Nürnberger' (R 1331/2011-4, 'NUERNBERGA', para. 12)</p>

b) Equivalent adjectives/nouns

The use of an equivalent adjective/noun to indicate the same origin constitutes an evocation of a PDO/PGI.

PDO/PGI	European Union trade mark (invented examples)	Explanation
IBIZA	IBICENCO	Noun in the PDO → Adjective in the EUTM

(PGI-ES-A0110)		
AÇORES (PGI-PT-A1447)	AÇORIANO	Noun in the PDO → Adjective in the EUTM
BORDEAUX (PDO-FR-A0821)	BORDELAIS	Noun in the PDO → Adjective in the EUTM
JAGNIĘCINA PODHALAŃSKA (PL/PGI/0005/00837)	JAGNIĘCINA Z PODHALA	Adjective in the PGI → Noun in the EUTM
MEL DO ALENTEJO (PT/PDO/0017/0252)	MEL ALENTEJANA	Noun in the PDO → Adjective in the EUTM
SCOTTISH WILD SALMON (GB/PGI/0005/00863)	WILD SALMON FROM SCOTLAND	Adjective in the PGI → Noun in the EUTM

c) Translated PDOs/PGIs

Likewise, there is evocation or imitation of the PDO/PGI when the EUTM contains or consists of a translation of the whole or part of a PDO/PGI in any of the EU languages.

PDO/PGI	European Union trade mark	Explanation
COGNAC	KONJAKKI (invented example)	An EUTM that contains the term 'Konjakkki' will be considered to evoke 'Cognac' in Finnish.
BOURGOGNE	 EUTM 2417269	'Borgoña' is the Spanish translation of the French PDO 'Bourgogne'
PÂTES D'ALSACE (FR/PGI/0005/0324)	ALSATIAN PASTA (invented)	An EUTM that contains the expression 'Alsation Pasta' will be considered to evoke the PGI 'Pâtes d'Alsace'

Trade marks consisting of these terms must be refused under both Article 7(1)(c) and(j) EUTMR rather than solely under Article 7(1)(c) EUTMR.

d) Expressions used as 'de-localisers'

According to Article 103(2)(b) of Regulation (EU) No 1308/2013, Article 20(2)(b) of Regulation (EU) No 251/2014, Article 16(b) of Regulation (EC) No 110/2008 and Article 13(1)(b) of Regulation (EU) No 1151/2012, PDOs/PGIs are protected 'even if the true origin of the product ... is indicated or if the protected name is ... accompanied by an expression such as "style", "type", "method", "as produced in", "imitation" ... or similar'.

Therefore, the fact that the PDO/PGI reproduced or evoked in the EUTM is accompanied by these expressions does not cancel out the application of Article 7(1)(j) EUTMR.

In other words, **even if the public is thereby informed about the actual origin of the product, an objection will still be raised** under Article 7(1)(j) EUTMR. Notwithstanding this, the trade mark will be **misleading** under Article 7(1)(g) EUTMR since there is a contradiction between the goods (restricted to the specific PDO/PGI) and the message conveyed by the mark (that the goods are not 'genuine' PDO/PGI products), which will thus necessarily lead to a further objection under that article.

PDO/PGI	European Union trade mark (invented examples)	Explanation
<p style="text-align: center;">RIOJA</p> <p style="text-align: center;">(PDO-ES-A0117)</p>	<p style="text-align: center;">RIOJA STYLE RED WINE</p>	<p>An EUTM that contains an expression such as 'Rioja Style Red <i>Wine</i>' will be considered to evoke the PDO 'Rioja' even if it conveys the idea that the product in question is not a 'genuine' PDO Rioja <i>wine</i>.</p>
<p style="text-align: center;">FETA</p> <p style="text-align: center;">(EL/PDO/0017/0427)</p>	<p style="text-align: center;">GREEK STYLE PLAIN FETA</p> <p style="text-align: center;">ARABIAN FETA</p>	<p>An EUTM that contains expressions such as 'Greek Style Plain Feta' or 'Arabian Feta', will be considered to evoke the PDO 'Feta', even if it conveys the idea that the product in question is not a 'genuine PDO Feta' <i>cheese</i></p>

Where the applicant has its legal seat is irrelevant for assessing Article 7(1)(j) EUTMR. Article 103(1) of Regulation (EU) No 1308/2013, Article 20(1) of Regulation (EU) No 251/2014 and Article 12(1) of Regulation (EU) No 1151/2012 set out that protected designations of origin and protected geographical indications may be used by any operator marketing a product that conforms to the corresponding specification. Hence, provided that the goods comply with the specification of the PDO/PGI in question (which is guaranteed by restricting the goods appropriately), the location of the applicant's legal seat as indicated in the EUTM application is irrelevant. For example, a company with legal domicile in Poland can own a vineyard located in Spain that produces *wine* complying with the product specification of the PDO 'Ribera del Duero'. Similarly, a company with its legal domicile in Lithuania can own a factory located in Spain that elaborates products complying with the PGI 'Chorizo de Cantimpalos'.

2.10.3.4 Other misleading indications and practices

Article 103(2)(c) and (d) of Regulation (EU) No 1308/2013, Article 20(2)(c) and (d) of Regulation (EU) No 251/2014, Article 16(c) and (d) of Regulation (EC) No 110/2008 and Article 13(1)(c) and (d) of Regulation (EU) No 1151/2012 protect the PDO/PGI against a number of false or misleading indications about the origin, nature or essential qualities of the product.

Although it very much depends on the particularities of each case, each of which must therefore be assessed individually, an EUTM may be considered misleading when, for example, it contains figurative elements that are typically associated with the geographical area in question (such as well-known historical monuments) or when it reproduces a particular shape of the product.

The above must be interpreted in a **restrictive way**: it refers solely to EUTMs that depict a well-known and singular image that is generally taken as a symbol of the particular place of origin of the products covered by the PDO/PGI or a singular shape of the product that is described in the specifications of the PDO/PGI.

PDO/PGI	European Union trade mark (invented examples)	Explanation
<p style="text-align: center;">PORTO (PDO-PT-A1540)</p>	<p style="text-align: center;">EUTM depicting the 'Dom Luís I Bridge' in the city of Porto</p>	<p>A picture of the Dom Luís I Bridge and its riverside is a well-known emblem of the city of Porto. Use of this image for <i>wines</i> other than those covered by the PDO 'Porto' would fall under Article 103(2)(c) and (d) of Regulation (EU) No 1308/2013.</p>
<p style="text-align: center;">MOULES DE BOUCHOT DE LA BAIE DU MONT-SAINT-MICHEL (FR/PDO/0005/0547)</p>	<p>An EUTM which contains an image of the Mont-Saint-Michel Abbey</p>	<p>A picture of the Mont-Saint-Michel Abbey is a well-known emblem of the city and island of Mont Saint Michel in Normandy. Use of this image for seafood other than that covered by the PDO 'Moules de Bouchot de la Baie du Mont-Saint-Michel' would fall under Article 13(1)(c) and (d) of Regulation (EU) No 1151/2012</p>
<p style="text-align: center;">QUESO TETILLA (ES/PDO/0017/0088)</p>	<p>An EUTM which depicts a <i>cheese</i> conical in shape</p>	<p>The singular shape of the product is described in the specifications of the PDO 'Queso Tetilla'</p>

Given the inherent difficulty in identifying evocative figurative elements, particularly in less obvious cases, the Office will in such cases rely principally on observations by third parties.

2.10.3.5 The exploitation of the reputation of PDOs/PGIs

According to Article 103(2)(a) of Regulation (EU) No 1308/2013, Article 20(2)(a) of Regulation (EU) No 251/2014, Article 16(a) of Regulation (EC) No 110/2008 and Article 13(1)(a) of Regulation (EU) No 1151/2012, registered names are protected against use that exploits the reputation of the protected name. This protection extends even to different products (see by analogy judgment of 12/06/2007, joined cases T-53/04 to T-56/04, T-58/04 and T-59/04, 'Budweiser', para. 175).

However, as regards *wines* the scope of such protection must be read in line with the mandate contained in Article 102 of Regulation (EU) No 1308/2013, which limits the refusal of trade marks to products listed in its Annex VII, Part II. As regards *aromatised wines*, Article 19 of Regulation (EU) No 251/2014 limits the refusal to trade marks relating to an *aromatised wine product*. For *agricultural products and foodstuffs*, Article 14 of Regulation (EU) No 1151/2012 limits the refusal of trade marks to products 'of the same type'.

For *spirit drinks*, Regulation (EC) No 110/2008 does not contain any specification but the Offices follows a systematic approach and considers that in the context of examining absolute grounds for refusal, the PDO/PGI's protection under all EU Regulations is limited to **identical or comparable products**. Other products and services are not objected to.

However, the extended scope of protection of a PDO/PGI with reputation can be invoked in the context of Article 8(4) EUTMR (see the Guidelines, Part C, Opposition, Section 4, Rights under Article 8(4) EUTMR).

2.10.3.6 Limits to the scope of protection


If a PDO/PGI contains or evokes the name of a product that is considered **generic**, protection does not extend to the generic element (see Article 13(1) of Regulation (EU) No 1151/2012, *in fine* and judgment of 12/09/2007, T-291/03, ‘Grana Biraghi’, paras 58 and 60).

In the PGI ‘Ron de Málaga’, it is a well-known fact that the term ‘ron’ (the Spanish word for rum) is generic and therefore does not deserve protection. Accordingly, no objection will be raised to the mere fact that an EUTM contains a generic term that is part of a PDO/PGI.

In the PGIs ‘Maçã de Alcobaça’ and ‘Jambon d’Ardenne’, it is a well-known fact that the terms ‘maçã’ (the Portuguese word for apple) and ‘jambon’ (the French word for ham) are generic and therefore they do not deserve protection. Accordingly, no objection will be raised to the mere fact that an EUTM contains those generic terms that are part of a PDO/PGI.

In particular, it must also be mentioned that the terms ‘camembert’ and ‘brie’ are generic (judgment of 26/02/2008, C-132/05, para. 36). See the PDOs Camembert de Normandie (FR/PDO/0017/0112), Brie de Meaux (FR/PDO/0017/0110) and Brie de Melun (FR/PDO/0017/0111).

Other examples are ‘cheddar’ or ‘gouda’ (see Regulation (EC) No 1107/96, footnotes to the PDOs ‘West Country Farmhouse Cheddar’ and ‘Noord-Hollandse Gouda’). Therefore, no objection was raised in the following case:

PDO/PGI	European Union trade mark
<p>(none, because ‘camembert’ is not a geographical indication, but a generic term)</p>	 <p>(EUTM No 7 389 158)</p>

Where the generic nature of an element in a PDO/PGI can be determined by standard dictionary definitions, the perspective of the public in the country of origin of the PDO/PGI is determinative. For instance, in the examples cited above, it suffices that the term ‘ron’ is generic for Spanish consumers and ‘maçã’ and ‘jambon’ for Portuguese and French consumers, for it to be concluded that it is generic, regardless of whether or not it can be understood by other parts of the public in the European Union.

By contrast, where no definition can be found in a standard, well-known dictionary, the generic nature of the term in question should be assessed following the criteria laid down by the Court (judgment of 26/02/2008, C-132/05 and judgment of 12/09/2007, T-291/03, ‘Grana Biraghi’), such as relevant national and EU legislation, how the term is perceived by the public, and circumstances relating to the marketing of the product in question.

In addition, if a PDO/PGI contains or evokes a term which is **commonly used in trade** (and it is not protected as a traditional term for *wine* or as a traditional speciality guaranteed) to designate the goods concerned, objections should not automatically be raised against trade marks containing/evoking that term (e.g. ‘Torre’, see judgment of 18/12/2008, T-287/06 ‘Torre Albéniz’, para. 58 and judgment of 11/07/2006, T-247/03 ‘Torre Muga’, para. 57). In particular, the Office will assess whether, by including the terms in the sign, the image triggered in the mind of the consumer is that of the product whose designation is protected.

PDO/PGI	CASTELLÓ (PGI) for wines
European Union trade mark	CASTELL DE LA BLEDA for wines
Comment	In the <i>wine</i> sector, the term ‘castello’ (without accent, castle in Italian) is frequently used. It is considered that the term ‘CASTELL’ does not constitute, strictly speaking, an evocation of the PGI in question. While it is admitted that the difference is only in one letter, terms such as ‘castillo/castello’, ‘torre’, etc. are commonly used in the presentation of <i>wines</i> . In view of this, it is doubtful that the relevant consumers would associate the EUTM in question with the <i>wines</i> protected under the PGI. It is rather more likely that they will first make an immediate association with a common term in the marketing of <i>wines</i> .

A PGI/PDO that coincides with **surnames or family names**, when used in combination with other elements, is unlikely remind the relevant consumer of the product protected under the relevant PDO/PGI. For instance, the term ‘Leon’ is included in the PDO ‘Tierra de León’ and the PGI ‘Castilla y León’, both for *wines*. However, in combination with a first name, it is more likely to be perceived as a family name rather than an indication of geographical origin (R 0227/2011-4 – MICHEL LEON but see on the contrary R 1944/2014-2 FRAY LEON, which was rejected).

The term ‘Lorenzo’ is included in the PDO ‘Castel San Lorenzo’ for *wines*. However, in combination with other elements, it is more likely to be perceived as a first name rather than an indication of geographical origin. See EUTM 14 095 228 Organic Casa Lorenzo (figurative).

2.10.3.7 Trade marks in conflict with two or more PDOs/PGIs

In some cases an EUTM application may constitute direct/indirect use or evocation of more than one PDO/PGI at the same time. This is likely to happen when the EUTM application contains an element (not being a generic one) that appears in more than one PDO/PGI.

In these cases, provided that the EUTM application covers the relevant goods, an objection should be raised for all the PDOs/PGIs concerned **to the extent that the objection cannot be overcome by limiting the goods.**

A number of scenarios can be identified:

- Use/evocation of two (or more) **different** PGIs/PDOs for **identical** products: the objection cannot be overcome by limiting the goods to those that comply with either one of or all of the PDOs/PGIs as this would necessarily trigger another objection under Article 7(1)(j) EUTMR, since such a limitation would inevitably and confusingly identify the goods with a geographical origin other than that of the PDO/PGI in question.

PDO/PGI	RIOJA (PDO-ES-A0117) SANTIAGO (Chilean PGI) For <i>wines</i>
European Union trade mark	RIOJA SANTIAGO for <i>wines</i>
Explanation	<p>The trade mark applied for consists of the terms 'RIOJA' and 'SANTIAGO', each of which coincides with a protected designation of origin for <i>wines</i>, the former ('RIOJA') being protected by the European Union and the latter ('SANTIAGO'), a geographical indication for a <i>wine</i> originating from Chile, protected under a bilateral agreement between the European Union and the Republic of Chile (...)</p> <p>It is not possible to accept any limitation that includes <i>wine</i> originating from the territory of one of the two designations of origin since such a limitation automatically excludes <i>wines</i> originating from the other designation of origin, which inevitably means that the trade mark applied for will lead to confusion. By the same token, a hypothetical limitation of the list of goods to <i>wine</i> from the geographical area covered by either of the designations of origin, e.g. '<i>wines</i> from the Rioja designation of origin and <i>wines</i> from the Santiago designation of origin', in Class 33, would be covered by the prohibition of Article 7(1)(j) EUTMR insofar as the trade mark would inevitably — and confusingly — identify <i>wines</i> with a geographical origin other than that of the respective designations of origin included under the trade mark. Preventing such an eventuality is the principal purpose of that article.</p> <p>(R 0053/2010-2, 'RIOJA SANTIAGO')</p>

PDO/PGI	PAUILLAC (PDO-FR-A0713) BORDEAUX (PDO-FR-A0821) For <i>wines</i>
European Union trade mark	PAUILLAC BORDEAUX for <i>wines</i>
Explanation	<p>A limitation is not possible, as a limitation of one or another will be deceptive. The quality and characteristics of the PDO are not the same and the consumers would be misled as to the geographical origin of the product.</p> <p>The above, notwithstanding that Pauillac is geographically located within the Bordeaux region.</p>

- Use/evocation of two (or more) PGIs/PDOs sharing common term(s) for **identical** products: the objection can be waived if a limitation for one of the PGIs/PDOs is introduced.

PDO/PGI	ACETO BALSAMICO DI MODENA (PGI) ACETO BALSAMICO TRADIZIONALE DI MODENA (PDO) Both for <i>vinegar</i>
European Union trade mark	MARIOLA ACETO BALSAMICO DI MODENA (invented) for <i>vinegar</i>
Comment	The sign reproduces in its integrity the PGI 'aceto balsámico di Modena'.

	<p>A limitation should be introduced for <i>vinegars complying with the specifications of the PGI ACETO BALSAMICO DI MODENA</i>. The public will not be deceived as to the geographical origin of the products.</p> <p>However, a limitation for 'aceto balsamico tradizionale di Modena' should not be accepted as the sign expressly refers to the PGI and not to the PDO.</p>
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PGI	ACETO BALSAMICO DI MODENA (PGI) ACETO BALSAMICO TRADIZIONALE DI MODENA (PDO) Both for <i>vinegar</i>
European Union trade mark	MARIOLA MODENA (invented) for <i>vinegar</i>
Comment	<p>A limitation should be introduced either for the PGI ACETO BALSAMICO DI MODENA or for the PDO ACETO BALSAMICO TRADIZIONALE DI MODENA or for both.</p> <p>The public will not be deceived as to the geographical origin of the products.</p>

PDO/PGI	Alpes-de-Haute-Provence (PGI) Coteaux d'Aix-en-Provence (PDO) Coteaux Varois en Provence (PDO) Côtes de Provence (PDO) Les Baux de Provence (PDO) All for <i>wines</i>
European Union trade mark	CHATEAU LABEL PONT EN PROVENCE for <i>wines</i>
Comment	<p>A limitation should be introduced with respect to one or several of the PGIs/PDOs</p> <p>e.g. <i>wines complying with the specifications of the PGI Alpes-de-Haute-Provence; wines complying with the specifications of the PDO Coteaux d'Aix-en-Provence; wines complying with the specifications of the PDO Côtes de Provence.</i></p> <p>This EUTM application is different from the EUTM application Pauillac Bordeaux, where the EUTM application expressly refers to two PGIs/PDOs. In the present case the sign only refers to the common term in all the PGIs/PDOs, 'PROVENCE' so a fair use of any of the PGIs/PDOs including 'PROVENCE' is possible. This is without prejudice to the applicable legislation on labelling.</p>

- Use/evocation of two (or more) PGIs/PDOs sharing common term(s) for different products: an objection can be waived for those goods where an appropriate limitation is introduced.

PDO/PGI	Sobrasada de Mallorca (PGI) (type of processed <i>meat</i> product) Ensaimada de Mallorca (PGI) (type of pastry)
European Union trade mark	MALLORCA SUN (invented) applied for in Class 29 <i>meat, eggs and milk</i> and Class 30 <i>bread, pastry</i> .
Comment	<p>A limitation can be introduced for both PGIs. The public will not be deceived as to the geographical origin of the products.</p> <p>Class 29: <i>meat complying with the specifications of the PGI sobrasada de Mallorca; eggs; milk.</i></p> <p>Class 30: <i>bread, pastry complying with the specifications of the PGI ensaimada de Mallorca.</i></p>

- Use/evocation of two (or more) PGIs/PDOs sharing common term(s) for comparable products: an objection can be waived if a limitation is properly introduced and the deceptive goods deleted from the list.

PDO/PGI	HIERBAS DE MALLORCA (PGI) — <i>for aniseed-flavoured spirit drinks</i> PALO DE MALLORCA (PGI) — <i>for liqueur</i>
European Union trade mark	SUNNY MALLORCA HIERBAS (invented) for <i>alcoholic beverages</i> in Class 33
Comment	The application can be accepted if a limitation is introduced for ‘ <i>aniseed-flavoured spirit drinks complying with the specification of the PGI “hierbas de Mallorca”</i> ’ and the other <i>spirits</i> (similar goods) are deleted.

PDO/PGI	Champagne (PDO) for <i>wine</i> Ratafia de Champagne (PGI) for <i>liqueur</i> Cognac de Champagne (PGI) for <i>wine spirit</i> Marc de Champagne (PGI) for <i>grape marc spirit</i>
European Union trade mark	AXM CHAMPAGNE for <i>alcoholic beverages</i> in Class 33
Comment	Wine and spirits are not considered comparable. The application can be accepted if a limitation is introduced for one or various PGIs/DPOs and the deceptive goods are deleted e.g. Class 33: <i>wines complying with the specifications of the PDO ‘Champagne’; liqueur complying with the specifications of the PGI ‘Ratafia de Champagne’; wines spirit complying with the specifications of the PGI ‘Cognac the Champagne’</i> If the EUTM application fully includes a different PGI/PDO with the term ‘Champagne’ (e.g. AXM RATAFIA DE CHAMPAGNE), it can be accepted if the goods are properly limited: e.g. Class 33: <i>liqueur complying with the specifications of the PGI Ratafia de Champagne.</i>
PDO/PGI	Prosciutto di Modena (PDO) Zampone di Modena (PGI) Cotechino di Modena (PGI)
European Union trade mark	AXM MODENA (invented) for <i>meat</i> in Class 29
Comment	The application can be accepted if a limitation is introduced for one or various PGIs/DPOs and the deceptive goods are deleted e.g. <i>ham complying with the specification of the PDO Prosciutto di Modena, zampone complying with the specification of the PGI zampone di Modena and cotechino complying with the specification of the PGI cotechino di Modena.</i> The rest of the <i>meat</i> products are deleted. The limitation <i>meat complying with the specifications of the PDO prosciutto di Modena</i> is not acceptable.

2.10.4 Relevant goods under EU Regulations

2.10.4.1 Comparable products

Objections based on Article 7(1)(j) EUTMR can be raised **only** for specific goods of the EUTM application, namely those that are identical or ‘comparable’ to ones covered by

the PDO/PGI. The Office does not raise objections against different goods or against services.

Specifically for *wines*, the different terms used in Articles 102(1) and 103(2) of Regulation (EU) No 1308/2013 ('product falling under one of the categories listed in Part II of Annex VII' and 'comparable products' respectively) are interpreted by the Office as synonyms referring to the same concept. For ease of reference, the categories listed in Part II of Annex VII can be grouped in: (i) *wine*; (ii) *sparkling wine*; (iii) *grape must*; (iv) *wine vinegar*.

For *aromatised wines*, Article 19(1) of Regulation (EU) No 251/2014 refers to products relating to 'an *aromatised wine* product'. According to Article 3(1) of the Regulation, *aromatised wine* products are obtained from the *wine* sector as referred to in Regulation (EU) No 1308/2013 that have been flavoured. They are classified into the following categories: *aromatised wines*; *aromatised wine-based drinks*; and *aromatised wine-product cocktails*.

For *spirit drinks*, Regulation (EC) No 110/2008 does not contain this specification.

For *agricultural products and foodstuffs*, the different terms used in Articles 13 and 14 of Regulation (EU) No 1151/2012 ('comparable products', and 'products of the same type' respectively) are interpreted by the Office as synonyms referring to the same concept.

The notion of **comparable goods** must be understood restrictively and it is independent of the analysis of similarity between goods in trade mark law. Accordingly, the criteria set out in judgment of 29/09/1998, C-39/97, 'Canon', should not necessarily be adhered to, although some of them may be useful. For example, given that a PDO/PGI serves to indicate the geographical origin and the particular qualities of a product, criteria such as the nature of the product or its composition are more relevant than, for instance, whether or not goods are complementary.

In particular, the CJEU (in judgment of 14/07/2011, joined cases C-4/10 and C-27/10, 'BNI Cognac', para. 54) has listed the following criteria for determining whether goods are comparable:

- whether or not they have common objective characteristics (such as method of elaboration, physical appearance of the product or use of the same raw materials);
- whether or not they are consumed, from the point of view of the relevant public, on largely identical occasions;
- whether or not they are distributed through the same channels and subject to similar marketing rules.

Although it is not possible in these Guidelines to list all the possible scenarios, the following are some examples of comparable products.

Products covered by the PDO/PGI	Comparable products
<i>Wine</i>	All types of <i>wines</i> (including <i>sparkling wine</i>); <i>grape must</i> ; <i>wine vinegar</i> ; <i>wine-based beverages</i> (e.g. <i>sangría</i>)
<i>Aromatised wines</i>	All types of <i>wines</i> ; <i>aromatised wines</i> (e.g. <i>vermouth</i>); <i>aromatised wine-based drinks</i> (e.g. <i>sangría</i>); and <i>aromatised wine-product cocktails</i> (e.g. <i>sparkling wine cocktail</i>).
<i>Spirits</i>	All types of <i>spirits</i> ; <i>spirit-based drinks</i>
<i>Specific meat and specific meat preparations</i>	Any <i>meat</i> and any <i>meat preparation</i> (R 659/2012-5, p.14-17)
<i>Cheese</i>	<i>Milk and other milk products</i>
<i>Fresh fruit</i>	<i>Preserved, frozen, dried and cooked fruits</i> (<i>jellies, jams, compotes</i> are not 'comparable products', but the fruit covered by the PDO/PGI can be a commercially relevant ingredient, see below under 'Products used as ingredients')
<i>Fresh vegetables</i>	<i>Preserved, frozen, dried and cooked vegetables</i> (<i>jellies, jams</i> are not 'comparable products', but the vegetable covered by the PDO/PGI can be a commercially relevant ingredient, see below under 'Products used as ingredients')

2.10.4.2 Restrictions of the list of goods

According to Article 103(1) of Regulation (EU) No 1308/2013 and Article 20(1) of Regulation (EU) No 251/2014, protected designations of origin and protected geographical indications may be used by any operator marketing a *wine* or *aromatised wine* conforming to the corresponding specification.

According to Article 12(1) of Regulation (EU) No 1151/2012, 'protected designations of origin and protected geographical indications may be used by any operator marketing an [*agricultural or foodstuff*] product conforming to the corresponding specification'.

Objections raised under Article 7(1)(j) EUTMR may be waived if the relevant goods are restricted to comply with the specifications of the PDO/PGI in question.

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Restriction of goods can be a complex task, which may depend to a large extent on a case-by-case examination.

- **Products of the same type** as those covered by the PDO/PGI must be restricted in order to meet the specifications of the PDO/PGI. The proper wording is '[name of the product] complying with the specifications of the [PDO 'X']/PGI 'X']'. No other wording should be proposed or allowed. Restrictions such as '[name of the product] with the [PDO 'X']/PGI 'X']' or '[name of the product] originating in [name of a place]' are not acceptable.

PDO/PGI in the European Union trade mark	Acceptable list of goods
Slovácká (PDO-CZ-A0890)	<i>Wine</i> complying with the specifications of the PDO 'Slovácká'
WELSH BEEF (UK/PGI/0005/0057)	<i>Beef meat</i> complying with the specifications of the PGI 'Welsh Beef'

The products covered by Regulation (EU) No 1151/2012 mostly refer to *foodstuffs and beverages* in Classes 29, 30, 31 and 32. However, there are a number of exceptions. For example:

- Class 3 *essential oils* (e.g. Bergamotto di Reggio Calabria)
 - Class 22 *wool* (e.g. Native Shetland Wool)
 - Class 31 *flowers and ornamental plants* (e.g. Flemish laurier) or *hay* (e.g. Foin de Crau).
- The **category of products** that includes those covered by the PDO/PGI should be restricted to designate *wines* and *aromatised wines* that comply with the specifications of the PDO/PGI. The category of products is found in the Extract from the E-Bacchus Register under "registered as". For *spirit drinks*, the restriction should designate the exact category of product (e.g. *whisky, rum, fruit spirit*, in accordance with Annex III of Regulation (EC) No 110/2008) that complies with the specifications of the PDO/PGI. For *agricultural products and foodstuffs*, the category of products that includes those covered by the PDO/PGI should be restricted to designate exactly the products covered by the PDO/PGI and that comply with its specifications. The category of products that includes those covered by the PDO/PGI in question can be consulted in the 'DOOR' database. The exact product covered can be found in the application document attached to the publication in the Official Journal, also accessible through 'DOOR'

PDO/PGI in the European Union trade mark	Original specification (not acceptable)	Acceptable list of goods	Explanation
TOKAJI (PDO-HU-A1254)	<i>Wines</i>	<i>Wine</i> complying with the specifications of the PDO 'Tokaji'	The EUTM can be accepted only for <i>wine</i> covered by the PDO
WELSH BEEF (UK/PGI/0005/0057)	<i>Meat</i>	<i>Beef meat</i> complying with the specifications of the PGI 'Welsh Beef'	' <i>Meat</i> ' includes products (e.g. pork) which cannot comply with the specifications of a particular PDO/PGI that covers the specific product <i>beef meat</i>
POMME DU LIMOUSIN (FR/PDO/0005/0442)	<i>Fruits</i>	Apples complying with the specifications of the PDO 'Pomme du Limousin'	The category <i>fruits</i> includes products such as <i>pearl</i> or <i>peaches</i> which cannot meet the specifications of a PDO that exclusively covers apples

- **Comparable products** are restricted to those products, within the category of comparable products, covered by the PDO/PGI.

PDO/PGI in the European Union trade mark	Original specification (not acceptable)	Acceptable list of goods	Explanation
MOSLAVINA (PDO-HR-A1653)	<i>Alcoholic beverages (except beers)</i>	<i>Wine complying with the specifications of the PDO 'Moslavina'; alcoholic beverages other than wines</i>	The EUTM can be accepted only for <i>wine</i> covered by the PDO, and for <i>alcoholic beverages other than wines, and wine-based beverages</i> .
POMME DU LIMOUSIN (FR/PDO/0005/0442)	<i>Preserved, frozen, dried and cooked fruits</i>	<i>Preserved, frozen, dried and cooked apples complying with the specifications of the PDO 'Pomme du Limousin'</i>	<i>Preserved, frozen, dried and cooked fruits</i> includes products made of other fruits which cannot meet the specifications of a PDO which exclusively covers <i>apples</i> . Also to note that the limitation should not be for <i>apples</i> .

There may be cases where the objection cannot be overcome by a limitation, for example when the goods applied for, although 'comparable', do not include the product covered by the PDO/PGI (e.g. where the PGI covers *whisky* and the goods applied for are *rum* or the PDO covers *cheese* and the goods applied for are *milk*).

- **Products used as ingredients:** if the goods covered by the PDO/PGI can be used as a commercially relevant ingredient (in the sense that it may determine the choice of the main product) of any of the goods included in the EUTM application, a restriction will be requested. This is because Article 13(1)(a) and (b) of Regulation (EU) No 1151/2012 expressly extend the scope of protection of a PDO/PGI registered for a given product 'when those products are used as an ingredient'.

PDO/PGI in the EUTM	Original specification (which is not acceptable)	Acceptable list of goods	Explanation
POMME DU LIMOUSIN (FR/PDO/0005/0442)	<i>Jams and compotes</i>	<i>Jams and compotes of apples complying with the specifications of the PDO 'Pomme du Limousin'</i>	The <i>fruit</i> is the main ingredient of <i>jams and compotes</i>
PROSCIUTTO DI PARMA (IT/PDO/0117/0067)	<i>Pizzas</i>	<i>Pizzas with ham complying with the specifications of the PDO 'Prosciutto di Parma'</i>	This topping is the main ingredient of a <i>pizza</i> and the one which determines the consumer's choice

A restriction is not necessary if the goods covered by the PDO/PGI are used as a secondary, not commercially relevant ingredient of the claimed goods.

PDO/PGI in the EUTM	Original specification	Acceptable list of goods	Explanation
<p>ACEITE DE LA ALCARRIA</p> <p>(ES/PDO/0005/0562)</p>	<p><i>Pastry</i></p>	<p><i>Pastry</i></p>	<p>The goods do not need to be restricted by the mere fact that <i>oil</i> is used in their preparation. <i>Oil</i> is a secondary ingredient which is not commercially relevant</p>

2.10.5 PDOs/PGIs not protected under EU Regulations

2.10.5.1 PDOs/PGIs protected at national level in an EU Member State

The Court of Justice has stated (judgment of 08/09/2009, C-478/07, 'Bud') that the EU system of protection for PDOs/PGIs for *agricultural products and foodstuffs* laid down in Regulation (EC) No 510/2006 [then in effect] is '**exhaustive in nature**'.

The Office applies an analogous approach for PDOs/PGIs for *wines, aromatised wines* and *spirit drinks* for the following reasons. The former protection at national level of geographical indications for *wines, aromatised wines* and *spirit drinks* that now qualify for a PDO/PGI under Regulation (EU) No 1308/2013, Regulation (EU) No 251/2014 and Regulation (EC) No 110/2008 respectively was **discontinued** once those geographical indications were registered at EU level (see Article 107 of Regulation (EU) No 1308/2013, Article 26 of Regulation (EU) No 251/2014, Articles 15(2) and 20(1) of Regulation (EC) No 110/2008 and Article 9 of Regulation (EU) No 1151/2012 read in conjunction with recital 24).

Moreover, reference must also be made to Council Regulation (EEC) No 2081/92 on the protection of geographical indications and designations of origin for *agricultural products and foodstuffs*. That regulation (which preceded and was repealed by Regulation (EC) No 510/2006) set out in Article 17(1) that Member States had to 'inform the Commission which of their legally protected names ... they wish[ed] to register' pursuant to that regulation. Paragraph 3 added that Member States could 'maintain national protection of the names communicated in accordance with paragraph 1 until such time as a decision on registration has been taken' (see in this respect judgment of 04/03/1999, C-87/97, 'Cambozola', para. 18).

In other words, the EU system of protection comprising the above EU Regulations **overrides and replaces** national protection of PDOs/PGIs for *agricultural products and foodstuffs, wines, aromatised wines* and *spirit drinks*.

In light of the foregoing:

- Geographical indications for *wines, spirits* and *agricultural products and foodstuffs* that now qualify for a PDO/PGI under EU Regulations and in the past enjoyed protection by means of national legislation do not fall within the scope of Article 7(1)(j) EUTMR. Accordingly, they do not constitute as such, and for that reason alone, a ground for refusal under Article 7(1)(j) EUTMR, unless they have **also been registered at EU level**. Therefore, if, for example, a third party argues that an EUTM contains or consists of a geographical indication for *wines* that was

registered in the past at national level in an EU Member State, the examiner will check whether the geographical indication is also registered at EU level as a PDO/PGI. If not, the third-party observations will be deemed not to raise serious doubts as regards Article 7(1)(j) EUTMR.

- For *aromatised wines*, pursuant to Article 26 of Regulation (EU) No 251/2014, a transitory period applies. Member States have until 28/03/2017 to submit all relevant information for the protection of national PGIs at EU level to the Commission. After that date, existing national PGIs that have not been notified to the Commission will lose protection. As a consequence, until 28/03/2017 both EU and national PGIs fall within the scope of Article 7(1)(j) EUTMR.

However, in those areas where no uniform EU system of protection is in place, PDOs/PGIs protected under national law fall within the scope of Article 7(1)(j) EUTMR. This is the case, in particular, for PDOs/PGIs for *non-agricultural products*.

Currently, neither the Commission nor the Office keeps a database listing the PDOs/PGIs protected under national law for *non-agricultural products*. Given the inherent difficulty in identifying such PDOs/PGIs, the Office will in these cases rely principally on observations by third parties.

2.10.5.2 PDOs/PGIs from third countries

The following situations refer to PDOs/PGIs from third countries that are not simultaneously registered at EU level. In the case the third country PDO/PGI is registered at EU level, paragraphs 2.10.3 and 2.10.4 of these Guidelines apply (e.g. Café de Colombia, Ron de Guatemala).

- a) The geographical indication is protected only in the third country of origin under its national legislation

Article 7(1)(j) EUTMR does not apply since the third-country geographical indication is not recognised and protected *expressis verbis* under EU legislation. In this respect, note that the provisions of the TRIPs Agreement are not such as to create rights upon which individuals may rely directly before the courts by virtue of EU law (judgment of 14/12/2000, joined cases C-300/98 and C-392/98, para. 44).

Example: 'Miel Blanc d'Oku' or 'Poivre de Penja' from Cameroon.

For third-country PDOs/PGIs protected in a Member State by virtue of an international agreement signed by that Member State (and not the EU), see paragraph 2.10.5.2 c) below.

Nevertheless, when the EUTM application contains or consists of one such protected geographical indication, it must also be assessed whether or not the EUTM may be considered descriptive and/or deceptive under Article 7(1)(c) and (g) EUTMR in accordance with the general rules set out in these Guidelines. For example, where a third party observes that an EUTM application consists of the term 'Murakami' (invented example), which is a PGI for *spirits* in accordance with the national legislation of country X, Article 7(1)(j) EUTMR will not apply for the reasons set out above, but it must be examined whether or not the EUTM will be perceived as a descriptive and/or deceptive sign by the relevant EU consumers.

- b) The geographical indication is protected under an agreement to which the European Union is a contracting party

The EU has signed a number of trade agreements with third countries that protect geographical indications. These instruments typically include a list of the geographical indications, as well as provisions on their conflicts with trade marks. The content and degree of precision may nevertheless vary from one agreement to another. Geographical indications from third countries are protected at EU level after the relevant agreement has entered into force.

In this respect, it is settled case-law that a provision of an agreement entered into by the EU with non-member countries must be regarded as being directly applicable when, in view of the wording, purpose and nature of the agreement, it may be concluded that the provision contains a **clear, precise and unconditional obligation that is not subject, in its implementation or effects, to the adoption of any subsequent measure** (judgment of 14/12/2000, joined cases C-300/98 and C-392/98, para. 42).

The scope of protection given to these PGIs by third countries is defined through the substantive provisions of the agreement concerned. While the oldest agreements usually contained only general provisions, the 'latest generation' of free trade agreements refer to the relationship between trade marks and PGIs in similar terms to Articles 102 and 103 of Regulation (EU) No 1308/2013 (see, for example, Articles 210 and 211 of the 'Trade Agreement between the European Union and its Member States, of the one part, and Colombia and Peru, of the other part', OJ L 354, 21/12/2012).

In the light of this, EUTMs that contain or consist of a third-country PDO/PGI that is protected by an agreement to which the EU is a contracting party (and is not simultaneously registered under the EU Regulations) are examined, on a case-by-case basis, in accordance with the specific substantive provisions of the agreement in question on the refusal of conflicting trade marks, taking into account the case-law cited above. The mere fact that a PDO/PGI from a third country is protected by those instruments **does not automatically** imply that an EUTM that contains or consists of the PDO/PGI must be refused: this will depend on the **content and scope** of the agreement's relevant provisions.

As regards the **relevant point in time** for the protection of such PDOs/PGIs, a case-by-case approach is necessary. PDOs/PGIs included in the initial agreement are normally protected as of the date when the agreement enters into force. However, the list of protected PDOs/PGIs can subsequently be updated in the so-called 'second generation agreements'. In these cases, the relevant priority date varies from agreement to agreement: in some cases the priority date can be the date of the third-country request to update the list and not the date when the Commission accepts the inclusion of the PDOs/PGIs.

The Office keeps a public database where information on third-country PDO/PGIs protected in the EU under international agreements is included. It is accessible here: https://oami.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/Geographical_indications/geographical_indications.xls

It should be noted that the trade agreements signed by the EU with third countries typically have annexed to them a list of the PDOs/PGIs registered at EU level that are also to be protected in the third countries in question (judgment of 11/05/2010,

T-237/08, ‘Cuvée Palomar’, paras 104-108 and decision of 19/06/2013, R 1546/2011-4 – ‘FONT DE LA FIGUERA’). However, the Office **does not use those lists** as a source of information about EU PDOs/PGIs, it uses the database cited above. Firstly, the lists of EU PDOs/PGIs to be protected abroad may vary from one agreement to another, depending on the particularities of the negotiations. Secondly, the annexes to the agreements are usually amended and updated through an ‘Exchange of Letters’.

Examples:

PDO/PGI	Country of origin	Products
Aguardiente chileno	Chile	<i>Spirit drinks</i>
Brandy/Brandewyn	South Africa	<i>Spirit drinks</i>
Breede River Valley	South Africa	<i>Wine</i>
Abricot du Valais	Switzerland	<i>Spirit drinks</i>

c) The geographical indication is protected under an international agreement signed only by Member States (i.e. the EU is not a party)

Article 7(1)(j) EUTMR applies to PDOs/PGIs protected by international agreements to which a Member State is a party. However, by analogy to the Office’s interpretation of Article 7(1)(j) EUTMR as far as national law is concerned, the Office considers that the reference to ‘international agreements to which the ... Member State concerned is party’ should be interpreted as international agreements in those areas where no uniform EU protection is in place, namely *non-agricultural products* (see paragraph 2.10.5.1 above).

In C-478/07, ‘BUD’, the Court discussed the exhaustive nature of EU law as regards PGIs originating from Member States. In the Office’s interpretation, this also applies to third-country PDOs/PGIs in the relevant product fields that enjoy protection in the territory of a Member State through an international agreement concluded between that Member State and a non-EU-country.

This interpretation also applies to international agreements signed exclusively by Member States with third countries (in particular, the Lisbon Agreement for the Protection of Appellations of Provenance and their International Registration). For the sole purpose of the examination of absolute grounds for refusal, the EU is not a contracting party to these agreements, and they do not impose any obligations on the EU (see, by analogy, the preliminary ruling of 14/10/1980, C-812/79, Attorney General v Juan C. Burgoa, para. 9). Therefore, Article 7(1)(j) EUTMR only applies to PDOs/PGIs for *non-agricultural products* protected under such agreements.

In light of the foregoing, for the purposes of Article 7(1)(j) EUTMR, international agreements concluded by Member States are not applicable except:

- To the extent that they cover PDOs/PGIs for *non-agricultural products*. Currently, neither the Commission nor the Office keeps a database listing the PDOs/PGIs for *non-agricultural products* protected under international agreements concluded by Member States.
- International agreements concluded with third countries by a Member State before its accession to the EU. This is because the obligations arising out of an international agreement entered into by a Member State before its accession to

the EU have to be respected. However, Member States are required to take all appropriate steps to eliminate the incompatibilities between an agreement concluded before a Member State's accession and the Treaty (see Article 307, Treaty Establishing the European Community, now Article 351 TFEU, as interpreted by the Court in its judgment of 18/11/2003, C-216/01 'BUD', paras. 168-172).

- International agreements concluded with a third country by a Member State after its accession to the EU, but before the entry into force of the uniform EU system of protection in the given product area.

Given the inherent difficulty in identifying such PDOs/PGIs, the Office will in these cases rely principally on observations by third parties.

2.10.5.3 Relationship with other EUTMR provisions

When the mark can be objected to under Article 7(1)(j) EUTMR, further examination may still be necessary under the remaining possible grounds for refusal, such as Article 7(1)(k) or 7(1)(l) EUTMR.

In other words, an EUTM application may be in conflict with both, a PDO/PGI in the *wine* sector and a protected traditional term for *wines* or with a PDO/PGI in the agricultural and foodstuffs sector and a protected traditional speciality guaranteed.

PDO/PGI	TTW/TSG	EUTM application (invented)
Jamón de Serón	Jamón serrano	ABC Jamón serrano de Serón for <i>ham</i>
Alicante	Fondillón	ABC Fondillón Alicante for <i>wine</i>

2.11 Article 7(1)(k) EUTMR

Regulation No 2015/2424 amending Regulation No 207/2009 on the Community trade mark introduced Article 7(1)(k) as a specific ground for objecting to trade marks in conflict with earlier traditional terms for *wine*.

Article 7(1)(k) EUTMR applies to EUTMs that are in conflict with traditional terms for *wine* (TTWs), protected by either EU legislation or international agreements to which the EU is party.

It is a ground for refusal of EUTMs, introduced for reasons of coherence, in order to offer an equivalent degree of protection to traditional terms for *wine* as to designations of origin and geographical indications for *wines*.

2.11.1 General remarks on EU Regulations

Protection of TTWs is provided for in Council Regulation No 1308/2013, and Commission Regulation No 607/2009, which lays down certain detailed rules for the implementation of the Council Regulation (implementing act).

2.11.1.1 Definition of traditional terms for *wine* under EU Regulations

As regards the definition of TTWs, recital 104 of Regulation No 1308/2013 indicates that ‘Certain terms are traditionally used in the Union to convey information to consumers about the particularities and the quality of *wines*, complementing the information conveyed by protected designations of origin and geographical indications. In order to ensure the working of the internal market and fair competition and to avoid consumers being misled, those traditional terms should be eligible for protection in the Union’.

Similarly, recital 12 of Commission Regulation No 607/2009 states that ‘The use, regulation and protection of certain terms (other than designations of origin and geographical indications) to describe *wine* sector products is a long-established practice in the Community. Such traditional terms evoke in the minds of consumers a production or ageing method or a quality, colour or type of place or a particular event linked to the history of the *wine*. So as to ensure fair competition and avoid misleading consumers, a common framework should be laid down regarding the definition, the recognition, protection and use of such traditional term’.

According to Article 112 of Regulation No 1308/2013, a traditional term is a term traditionally used in a Member State to designate:

- that the product has a protected designation of origin or a protected geographical indication under EU or national law
- or
- the production or ageing method or the quality, colour, type of place, or a particular event linked to the history of the product with a protected designation of origin or a protected geographical indication

It follows that **two different types** of traditional terms for *wines* are distinguished:

The first is used in place of a PDO (e.g. ‘appellation d’origine contrôlée (AOC)’, ‘denominación de origen protegida (DO)’, ‘denominazione di origine controllata (DOC)’, ‘Landwein’) or a PGI (‘Vin de Pays’, ‘Vino de la Tierra’, ‘Indicazione Geografica Tipica’, ‘Vinho Regional’, ‘Landwein’) under a Member State law.

The second type is a description of product characteristics used for production or ageing methods, quality, colour, type of place, or for a particular event linked to the history of the product with a PDO or PGI (e.g. ‘château’, ‘grand cru’, ‘añejo’, ‘clásico’, ‘crianza’, ‘riserva’, ‘fino’, ‘Federweisser’).

That said, TTWs convey information to consumers about the particularities and the quality of *wines*, in principle complementing the information conveyed by protected designations of origin and geographical indications, for example, ‘Gran Reserva de Fondillón’ for *wine* of overripe grapes of PDO Alicante, ‘Cru bourgeois’ for *wine* from PDO Médoc.

According to Article 40 of Commission Regulation 607/2009, traditional terms are listed and defined in the ‘E-Bacchus’ database, and must mention the following:

- (a) the language of protection;
- (b) the grapevine product category or categories concerned by the protection;
- (c) a reference to the national legislation of the Member State or third country in which the traditional term is defined and regulated, or to the rules applicable to

wine producers in the third country, including those originating from representative trade organisations, in the absence of national legislation in those third countries;

- d) a summary of the definition or conditions of use;
- (e) the name of the country or countries of origin;
- (f) the date of inclusion in the electronic database 'E-Bacchus'.

2.11.1.2 Relevant provisions governing conflicts with trade marks

As regards the scope of protection, Article 113(2) of Regulation No 1308/2013 and Article 40(2) of Commission Regulation No 607/2009 state that

Traditional terms shall be protected, only in the language and for the categories of grape vine products claimed in the application, against:

- (a) any misuse of the protected term, including where it is accompanied by an expression such as "style", "type", "method", "as produced in", "imitation", "flavour", "like" or similar;
- (b) any other false or misleading indication as to the nature, characteristics or essential qualities of the product, placed on the inner or outer packaging, advertising material or documents relating to it;
- (c) any other practice likely to mislead the consumer, in particular to give the impression that the *wine* qualifies for the protected traditional term.

A specific provision for the relationship of traditional terms for *wines* with trade marks (a provision analogous to Article 102 of Regulation No 1308/2013 governing PGI/PDOs) is found in Article 41 of Commission Regulation No 607/2009:

1. Where a traditional term is protected under this Regulation, the registration of a trademark, which corresponds to one of the situations referred to in Article 40, shall be refused if the application for registration of the trademark does not concern wines qualified to use such a traditional term and is submitted after the date of submission of the application for protection of the traditional term to the Commission and the traditional term is subsequently protected.

Trademarks registered in breach of the first subparagraph shall be declared invalid on application in accordance with the applicable procedures as specified by Directive 2008/95/EC of the European Parliament and of the Council or Council Regulation (EC) No 40/94.

2. A trademark, which corresponds to one of the situations referred to in Article 40 of this Regulation, and which has been applied for, registered or established by use, if that possibility is provided for by the legislation concerned, in the territory of the Community before 4 May 2002 or before the date of submission of the application for protection of the traditional term to the Commission, may continue to be used and renewed notwithstanding the protection of the traditional term.

In such cases the use of the traditional term shall be permitted alongside the relevant trademark.

In light of the above provisions, the following cumulative conditions must be fulfilled in order for Article 7(1)(k) EUTMR to apply:

1. The traditional term in question must be protected within the meaning of Article 112 of Regulation No 1308/2013 (see paragraph 2.10.2 above).
2. Use of the EUTM must constitute one of the situations provided for in Article 113(2) of Regulation (EU) No 1308/2013 (see paragraph 2.10.3 above).

2.11.2 Relevant TTWs under EU Regulations

Article 7(1)(k) EUTMR applies where a TTW (either from an EU Member State or from a third country) has been **registered** under the procedure laid down by Regulations No 1308/2013 and No 607/2009.

Relevant information about traditional terms for *wines* can be found in the 'E-Bacchus' database maintained by the Commission, which can be accessed using the internet at <http://ec.europa.eu/agriculture/markets/wine/e-bacchus/>.

2.11.2.1 Relevant point in time

Article 7(1)(k) EUTMR applies only for TTWs that were applied for before the EUTM application and are registered at the time of examining the EUTM application.

The relevant dates for establishing the priority of a trade mark and of a TTW are the date of application of the EUTM (or the so-called Paris Convention priority, if claimed) and the date of application for protection of a TTW to the Commission respectively.

[Where there is no relevant date information in the 'E-Bacchus' extract, this means that the TTW in question was already in existence on 01/08/2009, the date on which the register was set up. For any TTW added subsequently, the 'E-Bacchus' extract includes a reference to the publication in the Official Journal, which gives the relevant information.]

[By analogy with the current practice for PGI/PDOs, and in view of the fact that the vast majority of applications for TTWs usually mature in a registration, **an objection will be raised** when the TTW was applied before the filing date (or the priority date, if applicable) of the EUTM application **but** had not yet been registered at the time of examination of the EUTM application. However, if the EUTM applicant indicates that the TTW in question has not yet been registered, the proceedings will be suspended until the outcome of the registration procedure of the TTW.]

2.11.3 Situations covered by Article 113(2) of Regulation No 1308/2013

Traditional terms will be protected, **only in the language and for the categories of grape vine products claimed in the application**, against:

1. any misuse of the protected term, including where it is accompanied by an expression such as 'style', 'type', 'method', 'as produced in', 'imitation', 'flavour', 'like' or similar;

2. any other false or misleading indication as to the nature, characteristics or essential qualities of the product, placed on the inner or outer packaging, advertising material or documents relating to it;
3. any other practice likely to mislead the consumer, in particular to give the impression that the *wine* qualifies for the protected traditional term.

In view of the wording of Article 113(2) of Regulation No 1308/2013, the scope of protection of protected TTWs seems narrower than that of PDO/PGIs. Still, the Office considers that a systematic approach should be followed and analogies be drawn, to the extent possible, between the protection of PDO/PGI and TTWs. In particular:

PDO/PGI — Article 103(2)	TTW — Article 113(2)
The EUTM consists solely of a whole PDO/PGI ('direct use');	'Misuse' also covers direct use. The practice for the assessment of 'direct use' of a PDO/PGI should apply by analogy.
The EUTM contains a whole PDO/PGI in addition to other word or figurative elements ('direct or indirect use');	'Misuse' also covers indirect use. The practice for the assessment of 'indirect use' of a PDO/PGI should apply by analogy.
The EUTM contains or consists of an imitation or evocation of a PDO/PGI, including <ul style="list-style-type: none"> - the EUTM incorporates the geographically significant part (in the sense that it is not the generic element) of the PDO/PGI; - the EUTM contains an equivalent adjective/noun that indicates the same geographical origin; - the PDO/PGI is translated; - the EUTM includes a 'de-localiser' expression in addition to the PDO/PGI or its evocation. 	Only misuse is covered by Article 113(2) with the caveat that such misuse refers to a use in the language claimed in the application.
Other misleading indications and practices;	Any other false or misleading indication as to the nature, characteristics or essential qualities of the product, placed on the inner or outer packaging, advertising material or documents relating to it;
The reputation of PDOs/PGIs.	Not covered.

2.11.4 Relevant goods

Article 113(2) of Regulation No 1308/2013 and Article 40 (2) of Commission Regulation No 607/2009 refer to '**categories of grape vine products claimed in the TTW application**'. It is the Office interpretation that, unlike the case of PGI/PDOs, objections based on conflicts with TTWs cannot be raised for comparable goods. However, objections should be raised against any relevant product referred to in Article 92(1) of Regulation No 1308/2013 for the following reasons.

According to Article 92(1) of Regulation No 1308/2013 the rules on, inter alia, traditional terms should apply to the products referred to in points 1, 3 to 6, 8, 9, 11, 15 and 16 of Part II of Annex VIII. Such products are *wine*, *liqueur wine*, *sparkling wine*, *quality sparkling wine*, *quality aromatic sparkling wine*, *semi-sparkling wine*, *aerated semi-sparkling wine*, *partially fermented grape must*, *wine from raisined grapes*, *wine of overripe grapes*.

Since all these products are *wine*-based and in view of the fact that most of the EUTM applications applied for are *wines* without specifying the category of *wines*, objections should be raised against any relevant product referred to in Article 92(1) of Regulation

No 1308/2013. For instance, in cases of an EUTM application containing TTW Fondillon, applying for *wine* in Class 33, the objection should not only be raised against *wine of overripe grapes* that is protected by the TTW, but also for *wine* as such.

2.11.4.1 Restrictions of the list of goods

Objections raised due to conflicts with PDO/PGIs may be waived if the relevant goods are restricted to comply with the specifications of the PDO/PGI in question.

For TTWs, there are no such specifications but their registration in the 'E-Bacchus' database must, in accordance with Article 40 of Commission Regulation 607/2009, include a 'summary of definition/conditions of use'. Therefore objections should be waived if the relevant goods are restricted to comply with the definition/conditions of use of the TTW in question. The proper wording is '[name of the product] complying with the definition/conditions of use of the [TTW 'X']'. No other wording should be proposed or allowed. Restrictions such as '[name of the product] with the [TTW 'X']' are not acceptable.

2.11.5 International agreements

By analogy to PDO/PGIs where international agreements to which the EU is party can serve as a basis for raising an objection against a trade mark application, TTWs that may be protected under international agreements to which the EU is a party should be taken into account in the assessment of conflicts of a TTW with an EUTM application.

2.11.6 Relationship with other EUTMR provisions

When the mark can be objected to under Article 7(1)(k) EUTMR, further examination may still be necessary under the remaining possible grounds for refusal, such as Article 7(1)(j) EUTMR.

In other words, an EUTM application may be in conflict with both, a PDO/PGI in the *wine* sector and a TTW.

PDO/PGI	TTW	EUTM application (invented)
Alicante	Fondillón	ABC Fondillón Alicante

2.12 Article 7(1)(l) EUTMR

Regulation No 2015/2424 amending Regulation No 207/2009 on the Community trade mark introduced Article 7(1)(l) EUTMR as a specific ground for objecting to trade marks in conflict with traditional specialities guaranteed.

Article 7(1)(l) EUTMR applies to EUTMs that are in conflict with traditional specialities guaranteed (TSGs) protected by either EU legislation or international agreements to which the EU is party.

Just as in the case of TTWs, it is a ground for refusal of EUTMs, introduced for reasons of coherence, in order to offer an equivalent degree of protection to traditional specialities guaranteed to designations of origin and geographical indications.

2.12.1 General remarks on EU Regulations

2.12.1.1 Definition of traditional specialities guaranteed under EU Regulations

Protection of TSGs is provided for in Title III of Regulation (EU) No 1151/2012.

As regards the definition of TSGs, Article 17 of Regulation (EU) No 1151/2012 indicates that 'A scheme for traditional specialities guaranteed is established to safeguard traditional methods of production and recipes by helping producers of traditional product[s] in marketing and communicating the value-adding attributes of their traditional recipes and products to consumers'.

According to Article 18(1) of the regulation 'A name shall be eligible for registration as a traditional speciality guaranteed where it describes a specific product or foodstuff that:

- (a) results from a mode of production, processing or composition corresponding to traditional practice for that product or foodstuff; or
- (b) is produced from raw materials or ingredients that are those traditionally used'.

Hence, TSGs highlight the traditional characteristics of a product either in its production process or composition, for instance, 'Lambic, Gueuze-Lambic, Gueuze' for *Belgian acid beer during production of which spontaneous fermentation occurs*, 'Jamón Serrano' for *Spanish ham produced in accordance with a traditional method of salting, drying/maturing and ageing*.

Unlike PGI/PDOs, the TSG quality scheme does not certify that the protected food product has a link to a specific geographical area, for instance, TSG 'Mozzarella' for *Italian fresh pulled-curd cheese* and PDO 'Mozzarella di Bufala Campana' for *mozzarella cheese* originating from a particular geographical area.

To qualify for a TSG a product must, according to Article 18(2) of the regulation, be of specific character: '2. For a name to be registered as a traditional speciality guaranteed, it shall:

- (a) have been traditionally used to refer to the specific product; or
- (b) identify the traditional character or specific character of the product'.

In this context, it is referred to in Article 3 of Regulation (EU) No 1151/2012, which defines:

- i) 'specific character' as 'the characteristic production attributes which distinguish a product clearly from other similar products of the same category',
- ii) 'traditional' as 'proven usage on the domestic market for a period that allows transmission between generations; this period is to be at least 30 years'.

According to Article 23 of Regulation (EU) No 1151/2012, 'a name registered as a traditional speciality guaranteed may be used by any operator marketing a product that conforms to the corresponding specification'.

Article 24 of Regulation (EU) No 1151/2012 establishes the scope of protection of TSGs — 'registered names shall be protected against any misuse, imitation or evocation, or against any other practice liable to mislead the consumer'.

2.12.1.2 Relationship with trade marks

In contrast with PGI/PDOs, Regulation (EU) No 1151/2012 does not include a specific provision for the relationship of TSGs with trade marks (i.e. a provision analogous to Article 13). Article 24(1) only prohibits the use of the TSG in a number of situations but not the registration of a trade mark.

Article 7(1)(l) EUTMR however refers to ‘trade marks which are excluded from registration pursuant to Union legislation’.

The Office considers that a systematic approach should be followed and draws an analogy with Article 7(1)(j) EUTMR: the registration of an EUTM application should be refused or the registration of an EUTM invalidated if there is conflict with a TSG.

2.12.2 Relevant goods under EU Regulations

Article 7(1)(l) EUTMR applies where a TSG has been registered under the procedure laid down by Regulation (EU) No 1151/2012.

Relevant information about traditional specialities guaranteed can be found in the ‘DOOR’ database maintained by the Commission, which can be accessed online at <http://ec.europa.eu/agriculture/quality/door/list.html>.

2.12.2.1 Relevant point in time

Article 7(1)(l) EUTMR applies only for TSGs that were applied for before the EUTM application and are registered at the time of examining the EUTM application.

By analogy with the current practice for PGIs/PDOs, and in view of the fact that the vast majority of applications for TSG usually mature in a registration, an objection will be raised when the TSG was applied before the filing date (or the priority date, if applicable) of the EUTM application but had not yet been registered at the time of examining the EUTM application. However, if the EUTM applicant submits that the TSG in question has not yet been registered, the proceedings will be suspended until the outcome of the registration procedure of the TSG.

2.12.3 Situations covered by Article 24 of Regulation (EU) No 1151/2012

In view of the wording of Article 13 of Regulation (EU) No 1151/2012, the scope of protection of protected TSGs seems narrower than that of PDO/PGIs. However, the Office considers that a systematic approach should be followed and analogies drawn, to the extent possible, between the protection of PDO/PGI and TSGs, in particular:

PGI/PDO — Article 13	TSG — Article 24
The EUTM consists solely of a whole PDO/PGI ('direct use');	'Imitation, evocation or misuse' includes direct use.
The EUTM contains a whole PDO/PGI in addition to other word or figurative elements ('direct or indirect use');	'Imitation, evocation or misuse' includes direct or indirect use.
The EUTM contains or consists of an imitation or	The practice for the assessment of 'imitation or

<p>evocation of a PDO/PGI, including</p> <ul style="list-style-type: none"> the EUTM incorporates the geographically significant part (in the sense that it is not the generic element) of the PDO/PGI; the EUTM contains an equivalent adjective/noun that indicates the same geographical origin; the PDO/PGI is translated; the EUTM includes a 'de-localiser' expression in addition to the PDO/PGI or its evocation. 	evocation' of a PDO/PGI should apply by analogy
Other misleading indications and practices;	The practice for the assessment of 'misleading indications and practice' of a PDO/PGI should apply by analogy
The reputation of PDOs/PGIs.	Not covered

2.12.4 Relevant goods

Pursuant to Articles 13 and 14 of Regulation (EU) No 1151/2012, objections based on conflicts with PGI/PDO can be raised only for specific goods of the EUTM application, namely those that are identical or 'comparable' to ones covered by the PDO/PGI.

Article 19 of Regulation (EU) No 1151/2012 requires that a TSG must comprise a 'description of the product including its main physical, chemical, microbiological or organoleptic characteristics, showing the product's specific character'.

In light of the absence to any reference to 'comparable' goods in Article 24 of Regulation (EU) No 1151/2012, objections should be raised only to products covered by the TSG.

2.12.4.1 Restrictions of the list of goods

Objections raised due to conflicts with PDO/PGIs may be waived if the relevant goods are restricted to comply with the specifications of the PDO/PGI in question.

For TSGs, there are no such specifications but they must, in accordance with Article 20 of Regulation (EU) No 1151/2012, comprise a product specification. Therefore objections should be waived if the relevant goods are restricted to comply with the product specification of the TSG. The proper wording is '[name of the product] complying with the product specification of the [TSG 'X']'. No other wording should be proposed or allowed. Restrictions such as '[name of the product] with the [TSG 'X']' are not acceptable.

The TSG product specifications are published in the Official Journal and are accessible via the 'DOOR' database.

2.12.5 International agreements

By analogy to PDO/PGIs, where international agreements to which the EU is party can serve as a basis for raising an objection against a trade mark application, TSGs that may be protected under international agreements to which the EU is a party should be taken into account in the assessment of conflict of a TSG with an EUTM application.

Currently, the Office does not keep a record of TSGs protected under international agreements. Moreover, the ‘DOOR’ database does not include them either. Given the difficulty in identifying such TSGs, the Office will in these cases rely, in principle, on observations by third parties.

2.12.6 Relationship with other EUTMR provisions

When the mark can be objected to under Article 7(1)(l) EUTMR, further examination may still be necessary under the remaining possible grounds for refusal, such as Article 7(1)(j) EUTMR.

In other words, an EUTM application may be in conflict with both — a PDO/PGI in the agricultural and foodstuff sector and a protected traditional speciality guaranteed.

PDO/PGI	TSG	EUTM application (invented)
Jamón de Serón	Jamón serrano	ABC Jamón serrano de Serón

2.13 Article 7(1)(m) EUTMR

Regulation No 2015/2424 amending Regulation No 207/2009 on the Community trade mark introduced Article 7(1)(m) as a specific ground for objecting to trade marks in conflict with earlier plant variety denominations.

In particular, Article 7(1)(m) EUTMR provides for the refusal of EUTMs that consist of, or reproduce in their essential elements, an earlier plant variety denomination registered in accordance with Union legislation or national law or international agreements to which the Union or the Member State concerned is a party, providing for protection of plant variety rights, and which are in respect of plant varieties of the same or closely related species.

2.13.1 Legislative framework

As regards **Union legislation** protecting plant variety rights, Council Regulation (EC) No 2100/94 on Community plant variety rights (CPVRR) establishes a system of Community plant variety rights (CPVR) as the sole and exclusive form of Community industrial property rights for plant varieties.

Since 2005, the European Union has been party to the International Convention for the Protection of New Varieties of Plants (**UPOV Convention**), which has become an integral part of the Union’s legal order. Under Article 20(1) UPOV Convention, a variety ‘shall be designated by a denomination which will be its generic designation’. Furthermore, each Contracting Party must ensure that no rights in the designation registered as the denomination of the variety will hamper the **free use of the denomination** in connection with the variety, even after the expiration of the breeder’s right.

Therefore, both the CPVRR and the UPOV Convention impose the **obligation to use** the variety denominations in order to commercialise protected varieties or varieties whose protection has ended.

Moreover, pursuant to Article 7(1)(m) EUTMR, plant variety denominations registered following **national law** or **international agreements** to which Member States are a party must also be taken into account.

2.13.2 Definition of plant variety denomination

Plant variety denominations describe cultivated varieties or subspecies of live plants or agricultural seeds. A variety denomination must ensure clear and unambiguous identification of the variety and fulfil several criteria (Article 63 CPVRR). The applicant for a CPVR must indicate a suitable variety denomination, which will be used by anyone who markets such variety in the territory of a member of the International Union for the Protection of New Varieties of Plants (UPOV), even after termination of the breeder's right (Article 17 CPVRR).

Protection is granted to plant variety denominations in order, inter alia, to protect the **legitimate interest** of consumers and producers in knowing the variety they are using or purchasing, as well as possibly the breeder and origin of that variety. The obligation to use the variety denominations contributes to the regulation of the market and to the safety of transactions in the agricultural and food sector, thus preventing counterfeiting and any potential misleading of the public.

2.13.3 Situations covered by Article 7(1)(m) EUTMR

Article 7(1)(m) EUTMR applies if the following requirements are met:

- 1 there is a registered plant variety denomination (at EU or at national level, including in third countries that are party to UPOV);
- 2 the plant variety denomination was registered prior to the EUTM application;
- 3 the EUTM application consists of, or reproduces in its essential elements, the earlier plant variety denomination;
- 4 the EUTM application includes plant varieties of the same species as, or of species closely related to, those protected by the registered plant variety denomination.

2.13.3.1 Registered plant variety denominations

The Community Plant Variety Office (CPVO), based in Angers (France), is the European Union agency responsible for managing a system for the protection of plant variety rights.

The CPVO maintains a register of protected plant varieties. The protected varieties and the varieties whose CPVR has been terminated can be searched, based on their variety denomination and/or other search criteria, through the CPVO Variety Finder⁷, available on the Office's website. This reference tool can be consulted whenever the type of goods and/or services covered by the EUTM application so dictate (see paragraph 3.4 below).

⁷ <http://www.cpvo.europa.eu/main/en/home/databases/cpvo-variety-finder>.

In particular, whenever the specification of an EUTM application refers to *live plants, agricultural seeds, fresh fruits, fresh vegetables* or equivalent wording, the Office will verify in the CPVO Variety Finder whether the term(s) making up the essential elements of the trade mark coincide(s) with a registered variety denomination or with the denomination of a variety for which protection has expired or been surrendered or terminated.

The search should extend to variety denominations registered for the European Union, Member States and third countries on the basis of Union legislation, national law or international agreements to which the Union or the Member State concerned is a party.

A plant variety right is **surrendered** when, pursuant to Article 19(3) of Regulation (EC) No 2100/94, before expiry of the term of the right, the holder surrenders it by sending a written declaration to such effect to the CPVO, in which case the right lapses with effect from the day following the day on which the declaration is received by the CPVO.

Pursuant to Article 19(1) of Regulation (EC) No 2100/94, plant variety rights **expire** at the end of 25th calendar year, or 30th year, in the case of varieties of vine and tree species, following the year of grant.

Plant variety rights are **terminated** *ex tunc* when the Office declares the Community plant variety right null and void pursuant to Article 20 CPVRR and with effect *in futurum* if the Office cancels the Community plant variety right pursuant to Article 21 CPVRR.

2.13.3.2 Relevant point in time

Article 7(1)(m) EUTMR applies only in respect of plant variety denominations that were **registered** (or, as explained above, had expired or been surrendered or terminated) at the time when the EUTM application was examined. The relevant dates are the date of filing of the EUTM application (or the 'Paris Convention priority', if claimed) and the date of registration of the plant variety denomination.


2.13.3.3 The EUTM application consists of, or reproduces in its essential elements, the plant variety denomination

Pursuant to Article 7(1)(m) EUTMR, objections are to be raised only if the EUTM consists of, or reproduces in its essential elements, the plant variety denomination.

The following situations may therefore arise:

- a) The EUTM applied for **consists** of an earlier plant variety denomination, for example the word mark 'ANTONIO' for *fruits and vegetables*. Since 'ANTONIO' is an earlier plant variety denomination for *peppers*, the Office will object with regard to peppers. For 'closely related species', see paragraph 3.4 below.
- b) The EUTM **contains** an earlier plant variety denomination. Whether the application is objectionable or not will require a more detailed assessment. In particular, the Office will examine whether the plant variety denomination is one of the **essential elements** of the EUTM application.

Examples:

EU trade mark	Goods	Comment
<p>ANTONIO MARIN VEGETABLES</p>	<p>Fruits and vegetables</p>	<p>ANTONIO is a registered plant variety denomination for <i>peppers</i>. ANTONIO is an essential element of the trade mark. The Office will object with regard to peppers, including closely related species.</p>
	<p>Fruits and vegetables</p>	<p>ANTONIO is a registered plant variety denomination for <i>peppers</i>. ANTONIO is not considered to be an essential element of the trade mark. Therefore, the Office will not object.</p>

2.13.3.4 Plant varieties of the same or closely related species

A check is to be made whenever the specification of an EUTM application refers to *live plants, agricultural seeds, fresh fruits, fresh vegetables* or equivalent.

If the check shows that the word or figurative EUTM applied for consists of, or reproduces in its essential elements, an earlier plant variety denomination registered under Union law, national law or relevant international agreements, the examiner must raise an objection under Article 7(1)(m) EUTMR in respect of the relevant product. Taking as an example the scientific name of the product ‘oats’, *Avena sativa*, the term *Avena* describes the genus and in principle includes the closely related species *Avena abyssinica*, *Avena byzantine*, *Avena fatua*, *Avena nuda*, etc. Similarly, the scientific name of the most common pepper is *capsicum annuum*. The term *capsicum* describes the genus and in principle includes the closely related species [Capsicum baccatum](#), [Capsicum chinense](#), [Capsicum pubescens](#), etc.

RULE: The objection should refer to the genus of the scientific name of the plant variety denomination, which in principle covers closely related species.





EXCEPTION: There are cases where some species within the same genus are not closely related to the others, or where species from different genera are closely related. Exceptions will be examined by the Office upon request from the EUTM applicant and/or on the basis of third-party observations.

See also Annex of the [CPVO Guidelines on Article 63 CPVRR](#) on the meaning of ‘closely related species’.

Finally, when more than one plant variety denomination appear as an essential element in a trade mark application, for example a plant variety denomination for ‘apples’ and another one for ‘strawberries’, the list of goods will have to be limited in order to exclude the goods covered by each plant variety denomination, that is to say, apples and strawberries. This also applies where the two plant variety denominations are joined in the same term, for example MARINEGOLD, where both MARINE and

GOLD are protected; the list of goods will have to be limited in order to exclude the goods covered by each plant variety denomination.

Examples of objections and limitations:

European Union trade mark	Goods	Comment
EUTM application No 13 473 665 	Class 31	TROPICAL is protected at European level (QZ code) in the CPVO database for 'Solanum lycopersicum L.' (tomato), 'Chrysanthemum L.' (chrysanthemum) and 'Tulipa L.' (tulips). Registered with the following limitation in Class 31: '[t]he aforesaid goods not being or containing chrysanthemums, tulips or tomatoes, or materials for vegetative multiplication or reproduction of chrysanthemums, tulips or tomatoes'.
EUTM application  No 13 714 803	Wheat in Class 31	'Africa' is protected at European level (QZ code) for 'wheat'. The objection was overcome through a limitation ('not including wheat seeds').
EUTM application  No 13 784 021	Class 31	'Nike' is protected at European level (QZ code) for 'Avena sativa' and 'chrysanthemum'. The objection was overcome through a limitation.
EUTM application No 14 487 896 	Class 31	'Nature' is protected at European level (QZ code), for 'Diplotaxis tenuifolia' (a kind of rocket). However, due to the small size of the term 'nature' and to the integration into a longer phrase, the word 'nature' plays a secondary role and will not be perceived as a CPVO. The mark is accepted.

2.13.4 Relationship with other EUTMR provisions.

Where a plant variety denomination is used in the market but has not been registered or published in the CPVO or at national level, Article 7(1)(c) and (d) EUTMR might be applicable (see paragraphs 2.3 and 2.4).

2.14 European Union collective marks

2.14.1 Character of collective marks

A European Union collective mark (EU collective mark) is a specific type of EUTM which, pursuant to Article 66(1) EUTMR, 'is described as such when the mark is applied for and is capable of distinguishing the goods or services of the members of the association which is the proprietor of the mark from those of other undertakings'.

A European Union collective mark is aimed at distinguishing the goods and services of the members of the association that owns the mark from those of other companies that do not belong to that association. Therefore, the European Union collective mark qualifies the commercial origin of certain goods and services by informing the consumer that the producer of the goods or the service provider belongs to a certain association and that it has the right to use the mark.

An EU collective mark is typically used by companies, together with their own individual marks, to indicate that they are members of a certain association. For example, Spain's Association of Shoe Manufacturers may want to apply for the collective trade mark 'Asociación Española de Fabricantes de Calzado', which, while belonging to the association, is going to be used by all its members. A member of the association may want to use the collective mark in addition to its own individual mark, for example, 'Calzados Luis'.

Collective marks do not necessarily certify the quality of the goods, although this is sometimes the case. For example, regulations governing use frequently contain provisions to certify the quality of the goods and services of the members of the association and this is acceptable (see decision of 10/05/2012, R 1007/2011-2, para. 13).

It is up to the applicant to decide whether the trade mark fulfils the requirements of a collective mark or of an individual mark. This means that, in principle, the same sign could be applied for either as an individual EUTM or, if the conditions described in this chapter are met, as a collective EUTM. Differences between individual and collective marks do not depend on the signs per se, but rather on other characteristics such as the ownership or the conditions of use of the mark.

For example, an association can file an application for the word mark 'Tamaki' either as an individual mark or as a collective mark, depending on the use that is intended to be made of the mark (only by the association itself or also by the members thereof). If it is applied for as an EU collective mark, certain additional formalities must be met, such as the submission of regulations of use, etc.

After filing, changes of the kind of mark (from collective to individual or vice versa) are accepted only under certain circumstances (see the Guidelines, Part B, Examination, Section 2, Examination of Formalities, paragraph 8.2.5).

The EUTMR provisions apply to EU collective marks, unless Articles 67-74 EUTMR provide otherwise. EU collective marks are thus subject, on the one hand, to the general EUTM regime and, on the other hand, to some exceptions and particularities.

It follows, firstly, that an EU collective mark is subject to broadly the same examination procedure and conditions as individual marks. In general terms, the classification of

goods and services, examination of formalities and of absolute grounds for refusal is done according to the same procedure as that applied to individual trade marks.

For example, examiners will check the list of goods and services or the language requirements in the same way as they do with individual trade marks. Likewise, whether the EU collective mark falls under one of the grounds for refusal of Article 7 EUTMR will also be examined.

The regulations provided by the applicant governing the use of its EU collective mark **must cover its use for all the goods and services** included in the list of the EU collective mark application. For instance, the applicant may do so by reproducing the list of goods and services in the regulations of use or by referring to the list of goods and services of the EU collective mark application.

With respect to EU collective marks conflicting with PGIs/PDOs, traditional terms for wine or traditional specialities guaranteed, the regulations governing the use of a EU collective mark should accurately reflect **any limitation** introduced to overcome such conflicts. For example, the regulations of use of the EU collective mark 'XYZ Designation of Origin' for 'wines' should accurately reflect the fact that they refer to the use of the trade mark for *wines complying with the PDO 'XYZ'*.

Secondly, the examination of an EU collective mark will also consider the exceptions and particularities of this kind of mark. These exceptions and particularities refer both to the formal and substantive provisions. As regards formalities, the requirement of the regulations governing use of the mark is, for example, a specific characteristic of an EU collective mark. (For further details of the examination of formalities of EU collective marks, including the regulations of use of the mark, see the Guidelines, Part B, Examination, Section 2, Examination of Formalities, paragraph 8.2.)

The substantive exceptions and particularities which apply to an EU collective mark are described below.

2.14.2 Ownership

Ownership of EU collective marks is limited to (i) associations of manufacturers, producers, suppliers of services, or traders which, under the terms of the law governing them, have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue and be sued; and (ii) legal persons governed by public law.

The first type of owner typically comprises private associations with a common purpose or interest. They must have their own legal personality and capacity to act. Therefore, private companies such as *sociedades anónimas*, *Gesellschaften mit beschränkter Haftung*, etc., multiple applicants with separate legal personality or temporary unions of companies cannot be owners of an EU collective mark. As set out in the Guidelines, Part B, Examination, Section 2, Examination of Formalities, paragraph 8.2.1, 'collective does not mean that the mark belongs to several persons (co-applicants/co-owners) nor that it designates/covers more than one country'.

As regards the second type of owners, the concept 'legal persons governed by public law' must be interpreted broadly. This concept includes, on the one hand, associations, corporations and other entities governed by public law. This is, for example, the case of 'Consejos Reguladores' or 'Colegios Profesionales' under Spanish Law. On the other

hand, it also includes other legal persons governed by public law, for example, the European Union, States or municipalities, which do not necessarily have a corporative or an associative structure but which can nevertheless be owners of EU collective marks. In these cases, the requirement concerning the conditions for membership under Article 67(2) EUTMR is not applicable (see decision of 22/11/2011, R 828/2011-1, para. 18 and decision of 10/05/2012, R 1007/2011-2, paras 17-18). That is to say, when the applicant for an EU collective mark is a legal person governed by public law that does not necessarily have a corporative or an associative structure, such as the European Union, a State or a municipality, the regulations governing use of the mark need not contain details concerning membership.

2.14.3 Particularities as regards absolute grounds for refusal

The absolute grounds for refusal listed in Article 7(1) EUTMR apply to EU collective marks. This means that these marks will first be examined under those provisions to verify, for example, whether or not they are distinctive, deceptive or have become a customary sign. If, for instance, a mark is not inherently distinctive under Article 7(1)(b) EUTMR, it will be refused (see decision of 18/07/2008, R 229/2006-4, para. 7).

However, there are some exceptions and particularities that must also be taken into account when examining the absolute grounds for refusal for EU collective marks. In addition to the grounds for refusal of an EUTM application contained in Article 7(1) EUTMR, examiners also assess the following specific grounds:

- descriptive signs
- misleading character as to its nature
- regulations of use contrary to public policy and morality.

These specific grounds for refusals can also be the subject of observations filed by third parties.

2.14.3.1 Descriptive signs

Signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute Community collective marks (see judgment of 15/10/2003, T-295/01, para. 32 and judgment of 25/10/2005, T-379/03, para. 35).

As a result, a sign that exclusively describes the geographical origin of the goods or services (and that must be refused if it is applied for as an individual CTM) can be accepted if (i) it is validly applied for as an EU collective mark and (ii) it complies with the authorisation foreseen in Article 67(2) CTMR (see decision of 05/10/2006, R 280/2006-1, paras 16, 17).

According to this provision, the regulations governing use of an EU collective mark that is descriptive must authorise any person whose goods or services originate in the geographical area concerned to become a member of the association that is the proprietor of the mark.

For example, an application for the word mark 'Alicante', specifying *tourist services* should be refused under Article 7(1)(c) EUTMR if it is applied for as an individual CTM, given that it describes the geographical origin of the services. However, as an exception, if it is validly applied for as an EU collective mark (i.e. it is applied for by an

association or a legal person governed by public law and it complies with the other requirements of European Union collective marks) and the regulations governing use of the mark contain the authorisation foreseen in Article 67(2) EUTMR, it will be accepted under Article 7(1)(c) EUTMR.

This exception exclusively applies to those signs that are descriptive of the geographical origin of the goods and services. If the EU collective mark is descriptive of other characteristics of the goods or services, this exception does not apply and the application will be refused under Article 7(1)(c) EUTMR.

For example, if the word mark 'Do-it-yourself' is applied for as an EU collective mark for tools in Class 7, it will be considered descriptive of the intended purpose of the goods. Since the sign is descriptive of certain characteristics of the goods other than their geographical origin, it will be refused under Article 7(1)(c) EUTMR despite having been applied for as an EU collective mark (see decision of 08/07/2010, R 0934/2010-1, para. 35).

2.14.3.2 Misleading character as to its nature

The examiner must refuse the application if the public is liable to be misled as regards the character or the meaning of the mark, in particular if it is likely to be perceived as something other than a collective mark.

A collective mark that is available for use only by members of an association that owns the mark could be liable to mislead if it gives the impression that it is available for use by anyone who is able to meet certain objective standards.

2.14.3.3 Regulations of use contrary to public policy and morality

If the regulations governing use of the mark are contrary to public policy or to accepted principles of morality, the EU collective mark application must be refused.

This ground for refusal must be differentiated from that contained in Article 7(1)(f) EUTMR, which prohibits registration of those trade marks that are by themselves contrary to public policy or to accepted principles of morality.

The refusal foreseen in Article 68(1) EUTMR refers to situations where, regardless of the trade mark, the regulations governing use of the mark contain a provision that is contrary to public policy or to accepted principles of morality, for instance rules that discriminate on the grounds of sex, creed or race. For example, if the regulations contain a clause that prohibits women from using the mark, the EU collective mark application will be refused, even if the trade mark does not fall under Article 7(1)(f) EUTMR.

The examiner's objection can be waived if the regulations are amended in order to remove the conflicting provision. In the above example, the EU collective mark application will be accepted if the clause that prohibits women from using the mark is deleted from the regulations.