

***GUIDELINES FOR EXAMINATION IN THE
OFFICE FOR HARMONIZATION IN THE
INTERNAL MARKET (TRADE MARKS AND
DESIGNS) ON COMMUNITY TRADE MARKS***

PART B

EXAMINATION

SECTION 4

ABSOLUTE GROUNDS FOR REFUSAL

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2.6 Public policy or morality, Article 7(1)(f) CTMR

Article 7(1)(f) CTMR excludes from registration trade marks that are contrary to public policy or to accepted principles of morality. The rationale of Article 7(1)(f) CTMR 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) CTMR (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 CTM applied for is not the determining factor for the application of Article 7(1)(f) CTMR 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.

2.6.1 ‘Public policy’

2.6.1.1 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.

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 CTM 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. 175/1998](#)) 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 CTM applied for which uses such symbols or names will be rejected as being against public policy.
3. Bearing in mind that the notion of ‘public policy’ also covers specific EU legislation in force in a given field, and insofar as there is both an EU Regulation and an International Convention that is binding on the European Union preventing the granting of exclusive rights in the name of a plant variety registered in the European Union, it follows that it is contrary to European public policy to grant exclusive trade mark rights in the name of a plant variety registered in the European Union, which is, therefore, considered to be descriptive by law.

2.6.1.2 Plant Variety Denominations

Plant variety names describe cultivated varieties or subspecies of live plants or agricultural seeds. 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. 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 give a suitable variety denomination that shall 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 the termination of the breeder’s right (Article 17 CPVRR).

Since 2005, the European Union is 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, the variety shall be designated by a denomination which will be its generic designation. Furthermore, each Contracting Party shall ensure that no rights in the designation registered as the denomination of the variety shall hamper the free use of the denomination in connection with the variety, even after the termination of the breeder’s right.

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

The use of variety denominations allows the interested person to know the variety it is using or purchasing and possibly the breeder and the origin of the 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, avoiding potential misleading of the public and counterfeiting. It is therefore a matter of public interest and public safety to use the adequate variety denomination in respect of a variety.

According to Art. 18(2) CPVRR, a third party may hamper the free use of a variety denomination only if the rights in respect of a designation that is identical with the variety denomination were granted before that variety denomination was designated pursuant to Article 63 CPVRR.

A contrario, Art. 18(2) CPVRR implies that no exclusive rights should be granted in respect of a designation that is identical with the variety denomination, after such variety denomination has been designated pursuant to Art. 63 CPVRR.

OHIM therefore considers that registration of a CTM that would hamper the free use of a variety denomination after the grant of a CPVR to the corresponding variety is contrary to public policy.

As a consequence, CTM applications consisting of or containing signs which, if registered, would lead to an undue monopolisation of a variety denomination designating a variety protected by a CPVR or a variety that is no longer protected by a CPVR, shall be objected to on the grounds of being contrary to public policy under Article 7(1)(f) CTMR, in relation to Article 18 (2) CPVRR, which provides for the free use by third parties of the denomination of a plant variety in connection with the variety itself (i.e. descriptive use).

The Community Plant Variety Office (CPVO), based in Angers (France), is the European Union's agency responsible for implementing 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 was terminated can be searched, based on their variety denomination and/or other search criteria, through the CPVO Variety Finder¹, available in the Office's intranet, which should be consulted by examiners as a reference tool whenever the type of goods and/or services covered by the CTM application so dictate. In particular, whenever the specification of a CTM application refers to *live plants, agricultural seeds, fresh fruits, fresh vegetables* or equivalent wordings, the examiner must verify that the term or terms making up the trade mark do not coincide with a registered variety denomination or with the denomination of a variety for which protection has been surrendered, terminated or has expired. The examiner will check the CPVO database in order to ascertain whether the term or terms making up the CTM application coincide with a variety denomination already entered in the abovementioned CPVO register. The search should be confined to variety denominations registered for the European Union.

If the check shows that the CTM applied for consists of or contains an identical reproduction of the variety denomination (be it in a word or in a figurative mark), the examiner must raise an objection under Article 7(1)(f) CTMR in respect of the relevant plant, seeds and fruits, as well as the dried, preserved and frozen fruits, since registration of a CTM consisting of a variety denomination entered in the abovementioned EU register is contrary to public policy. If, for example, a CTM applied

¹ <http://www.cpvo.europa.eu/main/en/home/databases/cpvo-variety-finder>

for 'flowers' contains a VD for a kind of rose, the list of goods will have to be limited in order to exclude 'roses'. Moreover, if more than one VD appear in a CTM applied for – say, a VD 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 VD, i.e., apples and strawberries.

Finally, where a plant variety denomination is used in the market but has not been registered or published in the CPVO, or in case of national VD, Articles 7(1)(c) and 7(1)(d) might be applicable (see sections 2.3 and 2.4).

2.6.2 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 Community 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 applied-for goods and services 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) CTMR 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 Board 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) CTMR 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 buen ye! Hijoputa’, para. 21).



The concept of morality in Article 7(1)(f) CTMR is not concerned with bad taste or the protection of individuals’ feelings. In order to fall foul of Article 7(1)(f) CTMR, 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 CTM 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) CTMR 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 CTMAs (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)
	General consumer	Morality – ‘fucking’ is an offensive and vulgar word in English.	R 0168/2011-1

Sign	Relevant Consumer	Public policy / morality	Case No
	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). 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 CTMAs

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 CTM 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).	CTM 3 798 469 CTM 4 781 662 CTM 5 028 477

2.7 Deceptiveness: Article 7(1)(g) CTMR

2.7.1 Examination of the deceptive character

Article 7(1)(g) CTMR 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, shall 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) CTMR, the circumstances for refusing registration referred to in Article 7(1)(g) CTMR presuppose the **existence of actual deceit or a sufficiently serious risk that the consumer will be deceived** (see 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 which were found to be deceptive with regard to all or part of the claimed goods².

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

² 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) CTMR (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 in respect of 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 in respect of the specific goods in respect of 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 in respect of 'KODAK VODKA' filed for *alcoholic beverages*, since this broad category includes vodka, in respect of 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) CTMR 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) CTMR 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).

2.7.2 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) CTMR, 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 CAFÉ LATINO**' covering *coffee, 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) CTMR 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) CTMR would also be justified in respect of chocolate, tea and cocoa (assuming that those products do not contain coffee). 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 'CAFÉ LATINO', since the general category *coffee* may include also coffee originating from Latin America. Hence no Article 7(1)(g) CTMR 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 'CAFÉ 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.

2.7.3 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) CTMR. 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.

2.7.4 Trade marks making reference to an ‘official’ approval, status or recognition

It should be noted that, under the Office practice, trade marks which 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</p> <p>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) 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>
 <p>for, among other things, <i>teaching of ski</i> 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>

2.7.5 Relation with other CTMR provisions

The above explanations aim to define the scope of application of Article 7(1)(g) CTMR. 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) CTMR

Under the current practice of the Office, if, following a descriptiveness and/or lack of distinctiveness objection, the CTM 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) CTMR. The following example illustrates such a scenario:

The trade mark '**ARCADIA**' was originally applied in respect of *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) CTMR

This provision excludes from registration those CTMs 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 CTM applicant and the international organisation whose flag or symbol appears in the CTM.

Articles 7(1)(j) and (k) CTMR (protected geographical indications)

These provisions exclude trade marks for wines or spirits, on the one hand, and other agricultural foodstuffs on the other, which contain or consist of protected geographical indications (PGIs) or protected geographical denominations (PDOs) where the list of the respective goods does not specify that they have the purported geographical origin. Under the directly applicable rules of the corresponding specific EU Regulations underlying those provisions, the Office must object to CTM applications where the protected geographic 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 17(4) CTMR (transfer)

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

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

Whereas in examining a trade mark under Article 7(1)(g) CTMR 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) CTMR the way the sign is used is decisive, given that according to this provision a registered CTM 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.

2.8 Protection of flags and other symbols – Articles 7(1)(h) and (i) CTMR

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) 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) CTMR 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 (see 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).

2.8.1. Protection of armorial bearings, flags, other state emblems, official signs and hallmarks indicating control and warranty under Article 7(1)(h) CTMR – Article 6^{ter}(1)(a) and (2) PC

In accordance with Article 6^{ter}(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 of the Paris Convention.

Therefore, to fall foul of Article 7(1)(h) CTMR, 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.



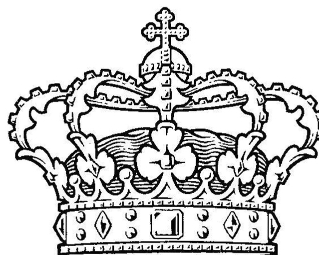
Bulgarian armorial bearing – 6ter database No BG2

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 federative 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.

Spanish official 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 and 72).

It follows that a trade mark that does not exactly reproduce a state emblem can nevertheless be covered by Article 6*ter*(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 and 51).

Furthermore, for Article 6*ter*(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 6*ter*(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 a Community trade mark (see also judgment of 21/04/2004, T-127/02, 'ECA', paras 40 to 41).

2.8.1.1 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 CTMA
	
Swiss flag	CTMA 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 CTMA
	
Canadian flag	CTMA 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.

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

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

The distinction between the cases examined in CTMA No 8 426 876 (objected to) and CTMA 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 CTMA No 6 015 473 are longer and thinner than in the flag) and a change of colour, since the cross in CTMA 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) CTMR must be refused for all goods and services applied for.

2.8.1.2. 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

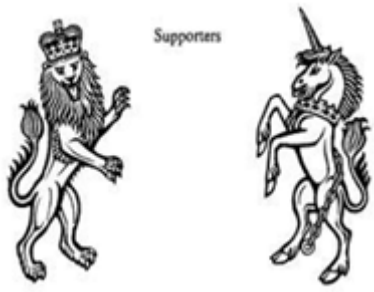



the ‘Article 6ter Structured Search’ tool made available by WIPO at <http://www.wipo.int/ipdl/en/6ter/>.

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

The General Court noted that the supporters contained in CTMA 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).

On the other hand, it was considered that the following mark (CTM No 6 832 571)





did not contain a heraldic imitation of the abovementioned British emblem. Indeed, as seen above, lions and unicorns are commonly used in this kind of symbol.

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 CTMA:

Protected emblem	Refused CTMA ^t
	
<p>Emblem of the Justice Department of the USA; 6^{ter} Number: US40</p>	<p>CTMA 4 820 213</p>

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

Protected emblem	Accepted CTMA
	
6ter number: AT10	CTMA 8 298 077

CTMA 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 CTMA.

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) CTMR must be refused for all goods and services applied for.

2.8.1.3 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).

2.8.2. Protection of armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organisations under Article 7(1)(h) CTMR – 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), 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 (see judgment of 15/01/2013, Case T-413/11 'EUROPEAN DRIVESHFT 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 the Board's decision in Case 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:



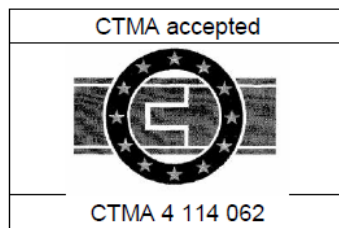
		
CTMA 2 305 399	CTMA 448 266	CTMA 6 449 524
		
CTMA 7 117 658	CTMA 1 106 442 (T-127/02)	CTM 4 081 014 (1640 C)
		
	CTMA 2 180 800 (T-413/11)	

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 CTMA 1 106 442 above).

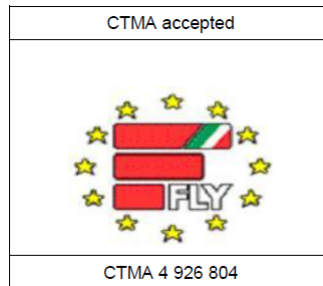
In contrast, the following example illustrates a case where the black-and-white reproduction of a circle of stars does not give the impression of being a black-and-white reproduction of the EU flag:



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. all three 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 GC judgment of 15/01/2013, Case 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 CTM 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 6*ter*(1)(a) PC, for which it is sufficient for the sign to consist of or contain the emblem or a heraldic imitation thereof, Article 6*ter*(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 (see judgment of 15/01/2013, Case 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 a CTMA 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 in respect of 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 E.N.C.A.P., 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 CTM 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. on a record data carrier), 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 in respect of which the public would, according to the examiner, see a connection between the mark and an organisation.

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

In accordance with Article 7(1)(i) CTMR, 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) CTMR 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) CTMR both have a similar scope of application and grant at least equivalent levels of protection.

This means that Article 7(1)(i) CTMR 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) CTMR than by Article 7(1)(h) CTMR. Following the same line of reasoning, Article 7(1)(i) CTMR 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) CTMR is conditional on a link between the mark and the symbol. Otherwise, trade marks to which Article 7(1)(i) CTMR applies, would obtain broader protection than under Article 7(1)(h) CTMR (see judgment of 10/07/2013, Case T-3/12 'MEMBER OF EURO EXPERTS').

Article 7(1)(i) 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 6ter 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 (see judgment of 10/07/2013, Case T-3/12, 'MEMBER OF EURO EXPERTS', para. 44). In particular, the Court specified that Article 7(1)(i) CTMR 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 *ibid.*, paras 45 and 46).

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

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:



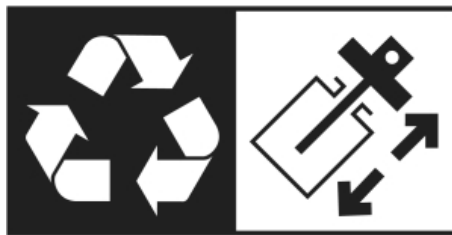
Apart from the symbols, their names are also protected (from left to right) as follows: 'Red Cross', 'Red Crescent' and 'Red Crystal'.

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 color or in different colors.'



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 CTMAs		
		
WO 964 979	CTMA 2 966 265	CTMA 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 CTM 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) CTMR.

Accepted CTMAs		
		
CTMA 8 986 069	CTMA 9 019 647	CTMA 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, Case 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 CTM 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.

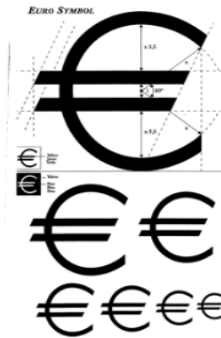
Furthermore, the examiner must also take into account the other elements of which the mark is composed. For it cannot be ruled out that all the other elements of the sign could lead to the conclusion that the public would not connect the sign with the authority concerned (see GC judgment of 10/07/2013, Case 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 a CTMA are likely to suggest a connection even more, since they could be perceived as implying EU approval (see GC judgment of 10/07/2013, Case T-3/12 ‘MEMBER OF EURO EXPERTS’, para. 113).

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



fell foul of Article 7(1)(i) CTMR 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 in respect of which the public would, according to the examiner, see a connection between the mark and the authority.

2.9 Article 7(1)(j) CTMR

2.9.1 Introduction

Article 7(1)(j) CTMR applies to CTMs that are in conflict with geographical indications for wines and spirits.

More specifically, it provides for the refusal of CTMs for wines that contain or consist of a geographical indication identifying wines or for spirits that contain or consist of a geographical indication identifying spirits in respect of wines or spirits not of such origin.

Article 7(1)(j) CTMR does not explicitly refer to the specific EU regulations on the protection of geographical indications for wines and spirits. In this respect, the Office follows a systematic approach and interprets Article 7(1)(j) CTMR in line with Article 7(1)(k) CTMR. That is to say, the Office applies Article 7(1)(j) CTMR in conjunction with the relevant provisions of the EU regulations on the protection of geographical indications for wines and spirits, namely Council Regulation (EU) No 1308/2013³ and Regulation (EC) No 110/2008 of the European Parliament and of the Council⁴ respectively.

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*.

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.

Protected designations of origin (PDOs) therefore have a closer link with the area. This distinction, however, does not affect scope of protection, which is the same for PDOs and PGIs (protected geographical indications). In other words, Article 7(1)(j) CTMR applies equally to all designations covered by Regulation (EU) No 1308/2013,

³ Council Regulation (EU) No 1308/2013 of 17 December 2013 establishing a common organisation of the markets in agricultural products.

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.

regardless of whether they are registered as PDOs or as PGIs. Regulation No 110/2008, however, covers only PGIs, not PDOs.

Protection is granted to PDOs/PGIs in order, inter alia, to protect the legitimate interests of consumers and producers.

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 or Article 15(1) of Regulation (EC) No 110/2008 (see, by analogy, judgment of 07/11/2000, C-312/98, 'Warsteiner Brauerei', paras 43 and 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.

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 which 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 shall 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.

Furthermore, 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'.

Article 103(2) of Regulation (EU) No 1308/2013 and Article 16 of Regulation (EC) No 110/2008 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.

Three cumulative conditions are necessary in order for Article 7(1)(j) CTMR to apply.

1. The PDO/PGI in question must be registered at EU level (see paragraph 2.9.2.1 below).
2. Use of the CTM that consists of or contains a PDO/PGI for wines or a PGI for spirits must constitute one of the situations provided for in Article 103(2) of Regulation (EU) No 1308/2013 or in Article 16 of Regulation (EC) No 110/2008 (see paragraph 2.9.2.2 below).
3. The CTM application must include goods that are identical or 'comparable' to the goods covered by the PDO/PGI (see paragraph 2.9.2.3 below).

For these three conditions, reference is made below to: (i) which PDOs/PGIs may give rise to an objection under Article 7(1)(j) CTMR; (ii) under what circumstances a CTM contains or consists of a PDO/PGI in such a way that it falls under Article 103(2) of Regulation (EU) No 1308/2013 or Article 16 of Regulation (EC) No 110/2008; (iii) the

goods of the CTM application affected by the protection granted to the PDO/PGI. Finally, reference is also made below to how goods can be restricted in order to waive an objection.

2.9.2 The application of Article 7(1)(j) CTMR

2.9.2.1 Relevant PDOs/PGIs

Article 7(1)(j) CTMR 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 and No 110/2008.

For third-country PDOs/PGIs that enjoy protection in the European Union through international agreements concluded between the European Union and third countries see paragraph 2.9.3.2 below.

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/>. 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/Notice.do?val=464638:cs&lang=en&list=531377:cs,500631:cs,500623:cs,500621:cs,464638:cs,&pos=5&page=1&nbl=5&pgs=10&hwords=>. 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.

Protection is granted solely to the name of a PDO/PGI and does not extend *ipso iure* to the names of sub-regions, sub-denominations, local administrative areas or localities in the area covered by that PDO/PGI. In this respect, 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.

On the other hand, 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 (see 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, examiners should not use those lists as a source of information about EU PDOs/PGIs but should refer to the corresponding databases 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'.

Article 7(1)(j) CTMR applies only in respect of PDOs/PGIs that were applied for before the CTM **and** are registered at the time of examining the CTM. The relevant dates for establishing the priority of a trade mark and of a PDO/PGI are the date of application of

the CTM (or the so-called Paris Convention priority, if claimed) and the date of application for protection of a PDO/PGI to the Commission respectively.

Therefore, **no objection will be raised** under Article 7(1)(j) CTMR when the PDO/PGI was applied for **after** the filing date (or priority date, if applicable) of the CTM 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 regulation contains the relevant information;

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 PDO/PGI was applied for **before** the filing date (or the priority date, if applicable) of the CTM application **but** had not yet been registered at the time of examining the CTM application. However, if the CTM applicant submits 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.

2.9.2.2 Situations covered by Article 103 of Regulation (EU) No 1308/2013 and Article 16 of Regulation (EC) No 110/2008

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

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

CTM consists solely of a whole PDO/PGI (‘direct use’)

This situation covers the ‘direct use’ of a PDO/PGI as a CTM, that is, the trade mark consists solely of the name of the PDO/PGI.

Examples

PDO/PGI	Community trade mark
MADEIRA (PDO-PT-A0038)	MADEIRA (Collective CTM No 3 540 911)
MANZANILLA (PDO-ES-A1482)	MANZANILLA (Collective CTM No 1 723 345)

If the mark consists solely of the PDO/PGI, the CTM also falls under Article 7(1)(c) CTMR, 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)(j) and 7(1)(c) CTMR. There is an exception to this, pursuant to Article 66(2) CTMR, when the CTM is a collective trade mark and the regulations governing use thereof include the particulars foreseen in Article 67(2) (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) CTMR (see paragraph 2.9.2.3 below), such restriction is irrelevant for Article 7(1)(c) CTMR.

For example, an application for the word mark 'Bergerac' for *wines* will simultaneously be objected to under both Article 7(1)(j) and Article 7(1)(c) CTMR: 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) CTMR will be waived but the trade mark is still descriptive and continues to be objectionable under Article 7(1)(c) CTMR, unless it has been applied for as a collective trade mark that complies with Article 67(2) CTMR.

CTM 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 a CTM through reproduction of the name of the PDO/PGI together with other elements.

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

PDO/PGI	Community trade mark
<p>BEAUJOLAIS (PDO-FR-A0934)</p>	<p>BEAUX JOURS BEAUJOLAIS (CTM No 1 503 259)</p>
<p>CHAMPAGNE (PDO-FR-A1359)</p>	<p>CHAMPAGNE VEUVE DEVANLAY (CTM No 11 593 381)</p>
<p>BEAUJOLAIS (PDO-FR-A0934)</p>	 <p>• <i>La Maison des Beaujolais</i> • (CTM No 1 561 646)</p>

Under Article 7(1)(j) CTMR 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) CTMR and still be objectionable (as in the cases above) under Article 7(1)(j) CTMR.

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 will be objectionable 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	Community trade mark
<p style="text-align: center;">OPORTO (PDO-PT-A1540)</p>	<div style="text-align: center;">  </div> <p style="text-align: center;">CTMs No 11 907 334 and No 2 281 970)</p>

CTM contains or consists of an imitation or evocation of a PDO/PGI

Neither the CTMR nor Regulations No 1308/2013 and No 110/2008 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’ (judgment of 04/03/1999, C-87/97, ‘Cambozola’, para. 25 and judgment of 26/02/2008, C-132/05, para. 44).

The above means that there may be evocation when the CTM reproduces **part of** a PDO/PGI, such as (one of its) geographically significant word element(s) (in the sense that it is not a generic element, like ‘cabernet’ and ‘ron’ in the PDO/PGI ‘Cabernet d’Anjou’ or ‘Ron de Granada’), or even part of a word, such as a characteristic root or ending (examples are given below).

Moreover, Article 103(2)(b) of Regulation (EU) No 1308/2013 and Article 16 of Regulation (EC) No 110/2008 protect PDOs/PGIs against misuse, imitation or evocation, ‘even if the true origin of the product is indicated or if the protected name is translated or accompanied by an expression such as “style”, “type”, “method”, “as produced in”, “imitation” ... or similar’, thus even if consumers are not misled.

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) CTMR, the Office will assess in an equally objective way the situations described below, regardless of the CTM 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 CTM incorporates the geographically significant part (in the sense that it is not the generic element) of the PDO/PGI;
- (b) the CTM contains an equivalent adjective/noun that indicates the same geographical origin;
- (c) the PDO/PGI is translated;
- (d) the CTM includes a 'de-localizer' expression in addition to the PDO/PGI or its evocation.

The CTM incorporates part of the PDO/PGI

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 CTM 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'.

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

Although the following examples concern foodstuffs, they equally serve to demonstrate 'imitation' and 'evocation' for wines and spirit drinks.

PDO/PGI	Trade Mark	Explanation
<p>CHIANTI CLASSICO (IT/PDO/0005/0108)</p>	 (CTM 9 567 851)	<p>The term 'chianti' evokes the PDO 'Chianti Classico'. (R 1474/2011-2, 'AZIENDA OLEARIA CHIANTI', paras 14-15)</p>
<p>GORGONZOLA (IT/PDO/0017/0010)</p>	<p>CAMBOZOLA</p>	<p>'... a protected name is indeed evoked where the term used to designate that product ends in the same two syllables and contains the same number of syllables, with the result that the phonetic and visual similarity between the two names is obvious' (C-87/97, para. 27)</p>

If a PDO/PGI contains or evokes the name of a product that is considered generic, protection does not extend to the generic element. For example, in the PGI 'Ron de Málaga', it is a well-known fact that the term 'ron' (rum in Spanish) is generic and therefore does not deserve protection. Accordingly, no objection will be raised to the mere fact that a CTM contains a generic term that is part of a PDO/PGI.

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 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 (see 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.

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

PDO/PGI	RIOJA (PDO-ES-A0117) SANTIAGO (Chilean PGI)
Community trade mark	RIOJA SANTIAGO
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 wines, the former ('RIOJA') being protected by the European Union and the latter ('SANTIAGO'), a geographical indication for a wine originating from Chile, being 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 'wine' originating from the territory of one of the two designations of origin since such a limitation automatically excludes wines 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 wine from the geographical area covered by either of the designations of origin, e.g. 'wines from the Rioja designation of origin and wines from the Santiago designation of origin', in Class 33, would be covered by the prohibition of Article 7(1)(j) CTMR insofar as the trade mark would inevitably – and confusingly – identify wines 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>

Provided that the CTM covers the relevant goods, an objection should be raised in respect of all the PDOs/PGIs concerned. However, the examiner will indicate that the objection cannot be overcome, because limiting the goods to those that comply with either one of or all of the PDOs/PGIs would necessarily trigger another objection under Article 7(1)(j) CTMR since such a limitation would inevitably and confusingly identify wines with a geographical origin other than that of the PDO/PGI in question.


Equivalent adjectives/nouns

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

PDO/PGI	Community trade mark (invented examples)	Explanation
IBIZA (PGI-ES-A0110)	IBICENCO	Noun in the PDO → Adjective in the CTM
AÇORES (PGI-PT-A1447)	AÇORIANO	Noun in the PDO → Adjective in the CTM
BORDEAUX (PDO-FR-A0821)	BORDELAIS	Noun in the PDO → Adjective in the CTM

Translated PDOs/PGIs

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

PDO/PGI	Community trade mark	Explanation
COGNAC	KONJAKKI (invented example)	A CTM that contains the term 'Konjakki' will be considered to evoke 'Cognac' in Finnish.
BOURGOGNE	 CTM 2417269	'Borgoña' is the Spanish translation of the French PDO 'Bourgogne'

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

Expressions used as 'de-localisers'

According to Article 103(2)(b) of Regulation (EU) No 1308/2013 and Article 16(b) of Regulation (EC) No 110/2008, 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 CTM is accompanied by these expressions does not militate against the application of Article 7(1)(j) CTMR. 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) CTMR. Notwithstanding this, the trade mark will be misleading under Article 7(1)(g) CTMR 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	Community trade mark (invented examples)	Explanation
RIOJA (PDO-ES-A0117)	RIOJA STYLE RED WINE	A CTM that contains an expression such as 'Rioja Style Red Wine' 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 wine.

Where the applicant has its legal seat is irrelevant for assessing Article 7(1)(j) CTMR. Article 103(1) of Regulation (EU) No 1308/2013 sets 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 CTM 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'.

Other misleading indications and practices

Article 103(2)(c) and (d) of Regulation (EU) No 1308/2013 and Article 16(c) and (d) of Regulation (EC) No 110/2008 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, a CTM 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).

The above must be interpreted in a restrictive way: it refers solely to CTMs 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.

PDO/PGI	Community trade mark (invented examples)	Explanation
<p style="text-align: center;">PORTO (PDO-PT-A1540)</p>	<p style="text-align: center;">CTM 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 wines other than those covered by the PDO 'Porto' would fall under Article 103(2)(c) and (d) of Regulation (EU) No 1308/2013.</p>

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

The reputation of PDOs/PGIs

According to Article 103(2)(a) of Regulation (EU) No 1308/2013 and Article 16(a) of Regulation (EC) No 110/2008, 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. 176).

However, 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.

Therefore, the Office considers that, in the context of examining absolute grounds for refusal, the PDO/PGI's protection is limited to identical or comparable products.

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

2.9.2.3 Relevant goods

Comparable products

Objections based on Article 7(1)(j) CTMR can be raised only in respect of specific goods of the CTM application, namely those that are identical or ‘comparable’ to ones covered by the PDO/PGI.

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.

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
Wine	All types of wines (including sparkling wine); grape must; wine vinegar; wine-based beverages (e.g. ‘sangría’)
Spirits	All types of spirits; spirit-based drinks

Restrictions of the list of goods

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

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

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/PGI 'X']*'. No other wording should be proposed or allowed. Restrictions such as '*[name of the product] with the [PDO/PGI 'X']*' or '*[name of the product] originating in [name of a place]*' are not acceptable.

PDO/PGI in the Community trade mark	Acceptable list of goods
Slovácká (PDO-CZ-A0890)	Wine complying with the specifications of the PDO 'Slovácká'

- The **category of products** that includes those covered by the PDO/PGI should be restricted to designate 'wines' that comply with the specifications of the PDO/PGI. 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.

PDO/PGI in the Community trade mark	Original specification (not acceptable)	Acceptable list of goods	Explanation
TOKAJI (PDO-HU-A1254)	Wines	Wine complying with the specifications of the PDO 'Tokaji'	The CTM can be accepted only for wine covered by the PDO

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

PDO/PGI in the Community trade mark	Original specification (not acceptable)	Acceptable list of goods	Explanation
MOSLAVINA (PDO-HR-A1653)	Alcoholic beverages (except beers)	Wine complying with the specifications of the PDO 'Moslavina'; alcoholic beverages other than wines	The CTM can be accepted only for wine covered by the PDO, and for alcoholic beverages other than wines.

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').

2.9.3 PDOs/PGIs not protected under Regulations (EC) No 1308/2013 and No 110/2008

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

The Court of Justice has set out (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 and spirits, for the following reasons.

The former protection at national level of geographical indications for wines and spirit drinks that now qualify for a PDO/PGI under Regulation (EU) No 1308/2013 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 and Articles 15(2), 20(1) of Regulation (EC) No 110/2008).

Geographical indications for wines that now qualify for a PDO/PGI under Regulation (EU) No 1308/2013 and in the past enjoyed protection by means of national legislation do not fall within the scope of Article 7(1)(j) CTMR. Accordingly, they do not constitute as such, and for that reason alone, a ground for refusal under Article 7(1)(j) CTMR, unless they have also been registered at EU level. Therefore, if for example a third party argues that a CTM 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 such 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) CTMR.

2.9.3.2 PDOs/PGIs from third countries

The following situations refer to PDOs/PGIs from third countries that are not simultaneously registered at EU level.

The geographical indication is protected only in the country of origin under national legislation.

Article 7(1)(j) CTMR 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).

Nevertheless, when the CTM contains or consists of one such protected geographical indication, it must also be assessed whether or not the CTM may be considered descriptive and/or deceptive under Article 7(1)(c) and (g) CTMR in accordance with the general rules set out in these Guidelines. For example, where a third party observes that a CTM 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) CTMR will not apply for the reasons set out above, but it must be examined whether or not the CTM will be perceived as a descriptive and/or deceptive sign by the relevant EU consumers.

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 'last 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, CTMs 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 Regulation (EU) No 1308/2013) 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 a CTM 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.

The geographical indication is protected under an international agreement signed only by Member States

Protection of geographical indications under agreements between two Member States is precluded under current EU regulation of PDOs/PGIs (see the doctrine in judgment of 08/09/2009, C-478/07, 'Bud', applied by the Office by analogy for PDOs/PGIs for wines and spirits). Such agreements are redundant and have no legal effect.

As regards 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), and 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, judgment of 14/10/1980, 812/79, para. 9).

2.10 Article 7(1)(k) CTMR

2.10.1 Introduction

Article 7(1)(k) CTMR applies to CTMs that are in conflict with protected designations of origin/protected geographical indications (PDOs/PGIs) for agricultural products and foodstuffs registered at EU level.

More specifically, it provides for the refusal of CTMs that contain or consist of a PDO/PGI for agricultural products and foodstuffs that has been registered under Regulation (EU) No 1151/2012⁵, provided that the situation corresponds to one covered in that regulation.

According to Regulation (EU) No 1151/2012, PDOs/PGIs cover products for which there is an intrinsic link between the product or foodstuff characteristics and its geographical origin.

More particularly:

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.

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 both PDOs and PGIs. In other words, Article 7(1)(k) CTMR applies indiscriminately to the designations covered by Regulation (EU) No 1151/2012, regardless of whether they are registered as PDOs or as PGIs.

Protection is granted to PDOs/PGIs with the aim of ensuring that they are used fairly and in order to prevent practices liable to mislead consumers (see Recital 29 of Regulation (EU) No 1151/2012).

In this respect, it must also be underlined that the concepts of PDO and PGI differ from 'simple indications of geographical provenance'. For the latter, there is no direct link

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.

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 5(2) of Regulation (EU) No 1151/2012 (judgment of 07/11/2000, C-312/98 'Haus Cramer', paras 43 and 44). For example, '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.

According to Article 14(1) of Regulation (EU) No 1151/2012,

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 shall 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 13(1) of Regulation (EU) No 1151/2012 sets 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.

Three cumulative conditions are necessary in order for Article 7(1)(k) CTMR to apply:

- The PDO/PGI in question must be registered at EU level under the procedure laid down in Regulation (EU) No 1151/2012 (see paragraph 2.10.2.1 below);
- Use of the CTM that consists of or contains a PDO/PGI for agricultural products and foodstuffs must constitute one of the situations provided for in Article 13(1) of Regulation (EU) No 1151/2012 (see paragraph 2.10.2.2 below);
- The CTM application must include goods that are identical or 'comparable' to the goods covered by the PDO/PGI (see paragraph 2.10.2.3 below).

For these three conditions, reference is made below to: (i) which PDOs/PGIs may give rise to an objection under Article 7(1)(k) CTMR; (ii) under what circumstances a CTM contains or consists of a PDO/PGI in such a way that it falls under Article 13(1) of Regulation (EU) No 1151/2012; (iii) the goods of the CTM application affected by the protection granted to the PDO/PGI. Finally, reference is also made below to how goods can be restricted in order to waive an objection.

2.10.2 The application of Article 7(1)(k) CTMR

2.10.2.1 Relevant PDOs/PGIs

Article 7(1)(k) CTMR applies where PDOs/PGIs (either from an EU Member State or from a third country) have been registered under the procedure laid down by Regulation (EU) No 1151/2012.

For third-country PDOs/PGIs that enjoy protection in the European Union through international agreements concluded between the European Union and third countries, see paragraph 2.10.3.2 below.

Relevant information about PDOs/PGIs registered under Regulation (EU) No 1151/2012 can be found in the database 'DOOR' maintained by the Commission, which can be accessed through the internet 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 sub-regions, sub-denominations, local administrative areas or localities in the area covered by that PDO/PGI. In this respect, 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.

On the other hand, 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 (see 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, examiners should not use those lists as a source of information about EU PDOs/PGIs but should refer to 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'.

Article 7(1)(k) CTMR applies only in respect of PDOs/PGIs that were applied for before the CTM **and** are registered at the time of examining the CTM. The relevant dates for establishing the priority of a trade mark and of a PDO/PGI are the date of application of the CTM (or the so-called Paris Convention priority, if claimed) and the date of application for protection of a PDO/PGI to the Commission respectively.

Therefore, no objection will be raised under Article 7(1)(k) CTMR when the PDO/PGI was applied for **after** the filing date (or the priority date, if applicable) of the CTM application. Details of the date of application for the PDO/PGI are available in the 'DOOR' database.

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 PDO/PGI was applied for **before** the filing date (or the priority date, if applicable) of the CTM application **but** had not yet been registered at the time of examining the CTM application. However, if the CTM applicant submits 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

2.10.2.2 Situations covered by Article 13(1) of Regulation (EU) No 1151/2012

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

1. the CTM consists solely of a whole PDO/PGI ('direct use');
2. the CTM contains a whole PDO/PGI in addition to other word or figurative elements ('direct or indirect use');
3. the CTM contains or consists of an imitation or evocation of a PDO/PGI;

- 4. other misleading indications and practices;
 - 5. the reputation of PDOs/PGIs
- CTM consists solely of a whole PDO/PGI ('direct use')

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

Examples

PDO/PGI	Community trade mark
DRESDNER CHRISTSTOLLEN (DE/PGI/005/0704)	DRESDNER CHRISTSTOLLEN (Collective CTM No 262 949)
PROSCIUTTO DI PARMA (IT/PDO/0117/0067)	PROSCIUTTO DI PARMA (Collective CTM No 1 116 458)

If the mark consists solely of the PDO/PGI, the CTM also falls under Article 7(1)(c) CTMR, 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)(k) and 7(1)(c) CTMR. There is an exception to this, pursuant to Article 66(2) CTMR, when the CTM is a collective trade mark and the regulations governing use thereof include the particulars foreseen in Article 67(2) (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).

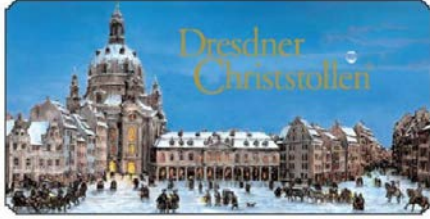


While restricting the relevant goods (to comply with the specifications of the PDO/PGI) is usually a means of waiving the objection under Article 7(1)(k) CTMR (see paragraph 2.10.2.3 below), such restriction is irrelevant for Article 7(1)(c) CTMR.

For example, a CTM consisting of the expression 'PROSCIUTTO DI PARMA' for *meat* will simultaneously be objected to under both Article 7(1)(k) and Article 7(1)(c) CTMR: it consists solely of the PDO 'Prosciutto di Parma', which enjoys protection for *meat products*, namely a specific type of ham, and is therefore descriptive. If the goods are subsequently limited to *ham complying with the specifications of the PDO 'Prosciutto di Parma'*, the objection under Article 7(1)(k) CTMR will be waived but the trade mark is still descriptive and continues to be objectionable under Article 7(1)(c) CTMR, unless it has been applied for as a collective trade mark that complies with Article 67(2) CTMR.

CTM 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 a CTM through reproduction of the name of the PDO/PGI together with other elements.

The following CTMs are considered to fall under Article 7(1)(k) CTMR since they contain the whole denomination of a PDO/PGI:

PDO/PGI	Community trade mark
<p>PROSCIUTTO DI PARMA (IT/PDO/0117/0067)</p>	<p>CONSORZIO DEL PROSCIUTTO DI PARMA (CTM No 6 380 141)</p>
<p>DRESDNER CHRISTSTOLLEN (DE/PGI/005/0704)</p>	 <p>(CTM No 5 966 668)</p>
<p>PARMIGIANO REGGIANO (IT/PDO/0117/0016)</p>	 <p>(CTM No 6 380 141)</p>
<p>WELSH BEEF (UK/PGI/0005/0057)</p>	 <p>(CTM No 10 513 729)</p>

Under Article 7(1)(k) CTMR 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) CTMR and still be objectionable (as in the cases above) under Article 7(1)(k) CTMR.

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 will be objectionable 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	Community trade mark
<p style="text-align: center;">WELSH LAMB (UK/PGI/0005/0081)</p>	 <p style="text-align: center;">(CTM No 11 927 472)</p>
<p style="text-align: center;">QUESO MANCHEGO (ES/PDO/0117/0087)</p>	 <p style="text-align: center;">(CTM No 5 582 267)</p>

CTM contains or consists of an imitation or evocation of a PDO/PGI

Neither the CTMR nor Regulation (EU) No 1151/2012 defines 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’ (judgment of 04/03/1999, C-87/97, ‘Cambozola’, para. 25 and judgment of 26/02/2008, C-132/05, para. 44).

The above means that there may be evocation when the CTM reproduces **part of a** PDO/PGI, such as (one of its) geographically significant word element(s) (in the sense that it is not a generic element), or even part of a word, such as a characteristic root or ending (examples are given below).

Moreover, Article 13(1)(b) of Regulation (EU) No 1151/2012 protects PDOs/PGIs against ‘any misuse, imitation or evocation, **even if the true origin of the products or services is indicated or if the protected name is translated or accompanied by an expression such as “style”, “type”, “method”, “as produced in”, “imitation” or similar**’ (emphasis added), thus even if consumers are not misled.

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)(k) CTMR, the Office will assess in an equally objective way the situations described below, regardless of the CTM 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 goods designated by the PDO/PGI are ‘evoked’ (called to mind).

In the light of the above, there is evocation or imitation of a PDO/PGI where:

- (a) the CTM incorporates the geographically significant part (in the sense that it is not the generic element) of the PDO/PGI;
- (b) the CTM contains an equivalent adjective/noun that indicates the same geographical origin;
- (c) the PDO/PGI is translated;
- (d) the CTM includes a ‘de-localizer’ expression in addition to the PDO/PGI or its evocation.


The CTM incorporates part of the PDO/PGI

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 CTM 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’.


As pointed out above, evocation is understood as encompassing not only when the CTM incorporates (one of) the geographically significant word(s) (as opposed to generic) element(s) of a PDO/PGI, but also when the CTM 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>(CTM No 9 567 851)</p>	<p>The term ‘chianti’ is an evocation of the PDO ‘Chianti Classico’ (R 1474/2011-2, ‘AZIENDA OLEARIA CHIANTI, paras 14-15)</p>

PDO/PGI	Trade Mark	Explanation
<p>GORGONZOLA (IT/PDO/0017/0010)</p>	<p>CAMBOZOLA</p>	<p>'... a protected name is indeed evoked where the term used to designate that product ends in the same two syllables and contains the same number of syllables, with the result that the phonetic and visual similarity between the two names is obvious'</p> <p>(C-87/97, para. 27)</p>
<p>NÜRNBERGER BRATWÜRSTE/NÜRNBERGER ROSTBRATWÜRSTE (DE/PGI/0005/0184)</p>	<p>NUERNBERGA (CTM No 9 691 577)</p>	<p>'due to the phonetic equivalence, NUERNBERGA is understood in the sense of the geographical indication Nürnberger'</p> <p>(R 1331/2011-4, 'NUERNBERGA', para. 12)</p>

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). For example, in the PGIs 'Maçã de Alcobaça' and 'Jambon d'Ardenne', it is a well-known fact that the terms 'maçã' (apple in Portuguese) and 'jambon' (ham in French) are generic and therefore they do not deserve protection. Accordingly, no objection will be raised to the mere fact that a CTM 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 (see judgment of 26/02/2008, C-132/05, para. 36). 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	Community trade mark
<p>(none, because 'camembert' is not a geographical indication, but a generic term)</p>	 <p>(CTM 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 terms 'maçã' and 'jambon' are generic for the Portuguese and French consumers, respectively, for it to be concluded that they are generic, regardless of whether or not these terms 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 (see 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.

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

PDO/PGI	Community trade mark	Explanation
Amarene Bruschette di Modena	 (CTM No 11 338 779)	The CTM contains the element 'MODENA' which evokes all PDOs/PGIs which include 'MODENA'
Aceto Balsamico di Modena		
Aceto balsamico tradizionale di Modena		
Cotechino Modena		
Zampone Modena		
Prosciutto di Modena		

Provided that the CTM covers the relevant goods, an objection should be raised in respect of all the PDOs/PGIs concerned. However, the examiner will indicate that the objection cannot be overcome, because limiting the goods to those that comply with either one or all PDOs/PGIs would necessarily trigger another objection under Article 7(1)(k) CTMR since such a limitation would inevitably and confusingly identify goods with a geographical origin other than that of the PDO/PGI in question.

Equivalent adjectives/nouns

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

PDO/PGI	Community trade mark (invented examples)	Explanation
JAGNIĘCINA PODHALAŃSKA (PL/PGI/0005/00837)	JAGNIĘCINA Z PODHALA	Adjective in the PGI → Noun in the CTM
MEL DO ALENTEJO (PT/PDO/0017/0252)	MEL ALENTEJANA	Noun in the PDO → Adjective in the CTM
SCOTTISH WILD SALMON (GB/PGI/0005/00863)	WILD SALMON FROM SCOTLAND	Adjective in the PGI → Noun in the CTM

Translated PDOs/PGIs

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

PDO/PGI	Community trade mark (invented example)	Explanation
PÂTES D'ALSACE (FR/PGI/0005/0324)	ALSATIAN PASTA	A CTM 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)(k) and 7(1)(c) CTMR rather than solely under Article 7(1)(c) CTMR.

Expressions used as ‘de-localisers’

According to Article 13(1)(b) of Regulation (EU) No 1151/2012, PDOs/PGIs are protected even ‘if the true origin of the products or services 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 CTM is accompanied by these expressions does not militate against the application of Article 7(1)(k) CTMR. 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)(k) CTMR. Notwithstanding this, the trade mark will be misleading under Article 7(1)(g) CTMR 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 7.

PDO/PGI	Community trade mark (invented examples)	Explanation
<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>A CTM 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’ cheese</p>

Where the applicant has its legal seat is irrelevant for assessing Article 7(1)(k) CTMR. Article 12(1) of Regulation (EU) No 1151/2012 sets 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 CTM application is irrelevant. For example, a company with legal domicile in Lithuania can own a factory located in Spain that elaborates products complying with the PGI ‘Chorizo de Cantimpalos’.

Other misleading indications and practices

Article 13(1)(c) and (d) of Regulation (EU) No 1151/2012 protects 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, a CTM 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 CTMs 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 which is described in the specifications of the PDO/PGI.

PDO/PGI	Community trade mark (invented examples)	Explanation
<p>MOULES DE BOUCHOT DE LA BAIE DU MONT-SAINT-MICHEL</p> <p>(FR/PDO/0005/0547)</p>	<p>A CTM 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>QUESO TETILLA</p> <p>(ES/PDO/0017/0088)</p>	<p>A CTM which depicts a cheese 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 objections by third parties.

The reputation of PDOs/PGIs

According to 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 in principle extends even to different products (see judgment of 12/06/2007, joined cases T-53/04 to T-56/04, T-58/04 and T-59/04, 'Budweiser', para. 176).

However, the scope of such protection must be read in line with the mandate contained in Article 14 of the same regulation, which limits the refusal of trade marks to products 'of the same type'.

Therefore, the Office considers that, in the context of examining absolute grounds for refusal, the PDO/PGI's protection is limited to identical or comparable products.

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

2.10.2.3 Relevant goods

Comparable products

Objections based on Article 7(1)(k) CTMR can be raised only in respect of specific goods of the CTM application, namely those that are identical or 'comparable' to ones covered by the PDO/PGI.

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
Specific meat and specific meat preparations	Any meat and any meat preparation (R 659/2012-5, p.14-17)
Milk	Cheese and other milk products
Fresh fruit	Preserved, frozen, dried and cooked fruits (jellies, jams, compotes 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’)
Fresh vegetables	Preserved, frozen, dried and cooked vegetables (jellies, jams 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’)

Restrictions of the list of goods

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 a product conforming to the corresponding specification’.

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

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/PGI ‘X’]*’. No other

wording should be proposed or allowed. Restrictions such as '[name of the product] with the [PDO/PGI 'X']' or '[name of the product] originating in [name of a place]' are not acceptable.

PDO/PGI in the CTM	Acceptable list of goods
<p>WELSH BEEF (UK/PGI/0005/0057)</p>	<p>Beef meat complying with the specifications of the PGI 'Welsh Beef'</p>

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'.

- 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.

PDO/PGI in the CTM	Original specification (which is not acceptable)	Acceptable list of goods	Explanation
<p>WELSH BEEF (UK/PGI/0005/0057)</p>	<p>Meat</p>	<p>Beef meat complying with the specifications of the PGI 'Welsh Beef'</p>	<p>'Meat' includes products (e.g. pork) which cannot comply with the specifications of a particular PDO/PGI that covers the specific product 'beef meat'</p>
<p>POMME DU LIMOUSIN (FR/PDO/0005/0442)</p>	<p>Fruits</p>	<p>Apples complying with the specifications of the PDO 'Pomme du Limousin'</p>	<p>The category 'fruits' includes products such as pear or peaches which cannot meet the specifications of a PDO that exclusively covers apples</p>

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

PDO/PGI in the CTM	Original specification (which is not acceptable)	Acceptable list of goods	Explanation
<p>POMME DU LIMOUSIN (FR/PDO/0005/0442)</p>	<p>Preserved, frozen, dried and cooked fruits</p>	<p>Preserved, frozen, dried and cooked apples complying with the specifications of the PDO 'Pomme du Limousin'</p>	<p>'Preserved, frozen, dried and cooked fruits' includes products made of other fruits which cannot meet the specifications of a PDO which exclusively covers apples. Also to note that the limitation should not be for 'apples'.</p>

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 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 CTM 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 CTM	Original specification (which is not acceptable)	Acceptable list of goods	Explanation
POMME DU LIMOUSIN (FR/PDO/0005/0442)	Jams and compotes	Jams and compotes of apples complying with the specifications of the PDO ‘Pomme du Limousin’	The fruit is the main ingredient of jams and compotes
PROSCIUTTO DI PARMA (IT/PDO/0117/0067)	Pizzas	Pizzas with ham complying with the specifications of the PDO ‘Prosciutto di Parma’	This topping is the main ingredient of a pizza 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 CTM	Original specification	Acceptable list of goods	Explanation
ACEITE DE LA ALCARRIA (ES/PDO/0005/0562)	Pastry	Pastry	The goods do not need to be restricted by the mere fact that oil is used in their preparation. ‘Oil’ is a secondary ingredient which is not commercially relevant

2.10.3 PDOs/PDIs not protected under Regulation (EU) No 1151/2012

2.10.3.1 PDOs/PDIs protected at national level in an EU Member State

The Court of Justice has set out (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’.

Article 9 of Regulation (EU) No 1151/2012 states that

a Member State may, on a transitional basis only, grant protection to a name under that Regulation at national level, with effect from the date on which an application is lodged with the Commission. Such national protection shall cease on the date on which either a decision on registration under that Regulation is taken or the application is withdrawn’. Those measures taken by Member States ‘shall produce effects at national level only, and they shall have no effect on intra-Union or international trade.

This provision is in line with Recital 24 of the same regulation, which declares that

to qualify for protection in the territories of Member States, designations of origin and geographical indications should be registered only at Union level. With effect from the date of application for such registration at Union level, Member States should be able to grant transitional protection at national level without affecting intra-Union or international trade.

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).

As a consequence of this, the former protection at national level of geographical indications for agricultural products and foodstuffs was discontinued once those geographical indications were registered at EU level.

Geographical indications for these kinds of products that in the past enjoyed protection by means of national legislation do not fall within the scope of Article 7(1)(k) CTMR. Accordingly, they do not constitute, as such and for that reason alone, a ground for refusal under Article 7(1)(k) CTMR, unless they have also been registered at EU level. Therefore, if for example a third party argues that a CTM contains or consists of a geographical indication for agricultural products and foodstuffs that was registered in the past at national level in an EU Member State, the examiner will check whether such 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)(k) CTMR.

2.10.3.2 PDOs/PDIs from third countries

The following situations refer to those PDOs/PGIs from third countries that are not simultaneously registered at EU level.

The geographical indication is protected only in the country of origin under national legislation

Article 7(1)(k) CTMR 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).

Nevertheless, when the CTM contains or consists of one such protected geographical indications, it must also be assessed whether or not the CTM may be considered descriptive and/or deceptive under Article 7(1)(c) and (g) CTMR in accordance with the general rules set out in these Guidelines. For example, where a third party observes that a CTM consists of the expression 'Tea Murakami' (invented example) which is a

PGI in accordance with the national legislation of country X, Article 7(1)(k) CTMR will not apply for the reasons set out above, but it must be examined whether or not the CTM will be perceived as a descriptive and/or deceptive sign by the relevant EU consumers.

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 (in particular in the field of wines and spirits) usually contained only general provisions, the 'last generation' of free trade agreements refer to the relationship between trade marks and PGIs in similar terms to those of Articles 13 and 14 of Regulation (EU) No 1151/2012 (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, CTMs 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 Regulation (EU) No 1151/2012) 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 a CTM 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.

The geographical indication is protected under an international agreement signed only by Member States

Protection of geographical indications under agreements between two Member States is precluded under current EU regulation of the PDOs/PGIs for agricultural products and foodstuffs (judgment of 08/09/2009, C-478/07, 'Bud'). Such agreements are redundant and have no legal effect.

As regards 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), and 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, judgment of 14/10/1980, 812/79, para. 9).

2.11 Community collective marks

2.11.1 Character of collective marks

A Community collective mark (CCTM) is a specific type of CTM which, pursuant to Article 66(1) CTMR, '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 Community collective mark is aimed at distinguishing the goods and services of the members of the association which owns the mark from those of other companies which do not belong to that association. Therefore, the Community 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.

A CCTM 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 CTM or, if the conditions described in this chapter are met, as a collective CTM. Differences between individual and collective marks do not depend on the signs per se, rather they depend 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 which 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 a CCTM, 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 CTMR provisions apply to CCTMs, unless Articles 67-74 CTMR provide otherwise. CCTMs are thus subject, on the one hand, to the general CTM regime and, on the other hand, to some exceptions and particularities.

It follows, firstly, that a CCTM 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 CCTM falls under one of the grounds for refusal of Article 7 CTMR will also be examined.

Secondly, the examination of a CCTM 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 a CCTM. (For further details of the examination of formalities of CCTMs, including the regulations of use of the mark, see the Guidelines, Part B, Examination, Section 2, Examination of Formalities, paragraph 8.2 Collective marks).

The substantive exceptions and particularities which apply to a CCTM are described below.

2.11.2 Ownership

Ownership of CCTMs 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 owners 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 a CCTM. 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 CCTMs. In these cases, the requirement concerning the conditions for membership under Article 67(2) CTMR 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 a CCTM is a legal person governed by public law which 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.

2.11.3 Particularities as regards absolute grounds for refusal

The absolute grounds for refusal listed in Article 7(1) CTMR apply to CCTMs. 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) CTMR, it will be refused (see decision of 18/07/2008, R 229/2006-4, para. 7).

However, there are some exceptions and particularities which must also be taken into account when examining the absolute grounds for refusal for CCTMs. In addition to the grounds for refusal of a CTM application contained in Article 7(1) CTMR, 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 object of observations filed by third parties.

2.11.3.1 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 which exclusively describes the geographical origin of the goods or services (and which must be refused if it is applied for as an individual CTM) can be accepted if (i) it is validly applied for as a CCTM 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 a CCTM which is descriptive must authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which 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) CTMR 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 a CCTM (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 Community collective marks) and the regulations governing use of the mark contain the authorisation foreseen in Article 67(2) CTMR, it will be accepted under Article 7(1)(c) CTMR.

This exception exclusively applies to those signs which are descriptive of the geographical origin of the goods and services. If the CCTM 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) CTMR.

For example, if the word mark 'Do-it-yourself' is applied for as a CCTM 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) CTMR despite having been applied for as a CCTM (see decision of 08/07/2010, R 934/2010-1, para. 35).

2.11.3.2 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 which is available for use only by members of an association which 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.

2.11.3.3 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 CCTM application must be refused.

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

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

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

2.12 Acquired distinctiveness

2.12.1 Introduction

In accordance with Article 7(3) CTMR, a trade mark may still be registered despite the fact that it does not comply with Article 7(1)(b), (c) or (d) CTMR, provided that 'the mark has become distinctive in relation to the goods and services for which registration is requested in consequence of the use which has been made of it'.

Article 7(3) CTMR constitutes an exception to the rule laid down in Articles 7(1)(b), (c) or (d) CTMR, whereby registration must be refused for trade marks which are per se devoid of any distinctive character, for descriptive marks, and for marks which consist exclusively of indications which have become customary in the current language or in the bona fide and established practices of the trade.

Distinctive character acquired through use means that although the sign *ab initio* lacks inherent distinctiveness with regard to the goods and services claimed, owing to the use made of it on the market, the relevant public has come to see it as identifying the goods and services claimed in the CTM application as originating from a particular undertaking. Thus, the sign has become capable of distinguishing goods and services from those of other undertakings because they are perceived as originating from a particular undertaking. In this way, a sign originally unable to be registered under Article 7(1)(b), (c) or (d) CTMR can acquire a new significance and its connotation, no longer purely descriptive or non-distinctive, permits it to overcome those absolute grounds for refusal of registration as a trade mark that would have otherwise applied.

2.12.2 Request

The Office will only examine the acquired distinctive character following a request from the CTM applicant, which may be filed at any time during the examination proceedings.

2.12.3 The point in time the evidence must relate to

The evidence must prove that distinctiveness through use was acquired prior to the CTMA's filing date. In the case of an IR, the relevant date is the date of registration by the International Bureau. Where priority is claimed, the relevant date is the priority date. Hereafter, all these dates are referred to as the 'filing date'.

2.12.3.1 Examination proceedings

Since a trade mark enjoys protection as of its filing date, and since the filing date of the application for registration determines the priority of one mark over another, a trade mark must be registrable on that date. Consequently, the applicant must prove that distinctive character has been acquired through use of the trade mark prior to the date of application for registration (judgment of 11/06/2009, C-0542/07P, 'Pure Digital', paras 49 and 51; and judgment of 07/09/2006, C-0108/05, 'Europolis', para. 22). Evidence of use made of the trade mark after this date should not be automatically disregarded, to the extent that it may provide indicative information regarding the situation prior to the date of application (judgment of 28/10/2009, T-137/08, 'Green/Yellow', para. 49).

2.12.3.2 Cancellation Proceedings

In Cancellation Proceedings, a trade mark which was registered in breach of the provisions of Article 7(1)(b), (c) or (d) CTMR may nevertheless no longer be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character for the goods or services for which it is registered (Article 52(2) CTMR).

The precise purpose of this norm is to maintain the registration of those marks which, due to the use which has been made of them, have in the meantime – that is to say, after their registration – acquired distinctive character for the goods or services for which they were registered, in spite of the fact that, when it took place, such registration was contrary to Article 7 CTMR (judgment of 14/12/2011, T-237/10, 'Louis Vuitton', para. 86 and judgment of 15/10/2008, T-405/05, 'Manpower' para. 127).

2.12.4 Consumer

Distinctive character, including that acquired through use, of a sign must be assessed in relation to the presumed perception of the average consumer for the category of goods or services in question. These consumers are deemed to be reasonably well-informed, and reasonably observant and circumspect. The definition of the relevant public is linked to an examination of the intended purchasers of the goods or services concerned, since it is in relation to those purchasers that the mark must perform its essential function. Consequently, such a definition must be arrived at by reference to the essential function of a trade mark, namely to guarantee the identity of the origin of the goods or services covered by the mark to consumers or end-users by enabling them, without any possibility of confusion, to distinguish the goods or services from others which have another origin (judgment of 29/09/2010, T-378/07, 'RED/BLACK/GREY (Surface of a tractor)', paras 33, 38).

The relevant consumer includes, therefore, not only persons who have actually purchased the goods and services but also any potentially interested person, in the strict sense of prospective purchasers (judgment of 29/09/2010, T-378/07, 'RED/BLACK/GREY (Surface of a tractor)', paras 41 et seq.).

Prospective purchasers are defined by the precise product or service for which registration is sought. If the claimed goods or services are broad (for example, bags or watches), it is irrelevant that the actual products offered under the sign are extremely expensive luxury items – the public will include all the prospective purchasers for the goods claimed in the CTMA, including non-luxury and cheaper items if the claim is for the broad category.

2.12.5 Goods and Services

Since one of the main functions of a trade mark is to guarantee the origin of goods and services, acquired distinctiveness must be assessed in respect of the goods and services at issue. Consequently, the applicant's evidence must prove a link between the sign and the goods and services for which the sign is applied for, establishing that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark (judgment of 04/05/1999, C-0108/97 & C-0109/97, 'Chiemsee', para. 52; and judgment of 19/05/2009, T-0211/06, 'Cybercrédit et al.', para. 51).

2.12.6 Territorial Aspects

Pursuant to Article 1 CTMR, a Community trade mark has a unitary character and has equal effect throughout the European Union. Article 7(2) CTMR provides that a trade mark must be refused registration if an absolute ground exists only in part of the European Union.

As a logical consequence thereto, acquired distinctiveness must be established throughout the territory in which the trade mark did not, *ab initio*, have such character (judgment of 22/06/2006, C-0025/05P, 'Sweet wrapper', paras 83, 86; and judgment of 29/09/2010, T-0378/07, 'RED/BLACK/GREY (Surface of a tractor)', para. 30).

This is because the unitary character of the Community trade mark requires a sign to possess distinctive character, inherent or acquired through use, throughout the

European Union (judgment of 17/05/2011, T-7/10, ‘υγεία’, para. 40). It would be paradoxical to accept, on the one hand, pursuant to Article 3(1)(b) TMD that a Member State has to refuse to register as a national mark a sign that is devoid of any distinctive character in its territory and, on the other, that that same Member State has to respect a Community trade mark relating to that sign for the sole reason that it has acquired distinctive character in the territory of another Member State (judgment of 14/12/2011, T-237/10, ‘Louis Vuitton’, para. 100).

2.12.6.1 Special provisions with respect to the accession of new Member States

In accordance with the provisions of the EU Accession Treaties, a CTM applied for before the date of accession of a given Member State may only be rejected for reasons which already existed before the date of accession. Hence, in the Office’s examination proceedings, acquired distinctiveness must be demonstrated only with respect to Member States of the EU at the time of the CTM application, and not those which have joined the EU subsequently.

2.12.6.2 3D marks, colours per se and figurative trade marks

If the objection exists throughout the European Union, as is normally the case for 3D marks, colours per se and figurative trade marks consisting exclusively of the depiction of the goods in question, acquired distinctiveness must be proven throughout the entire European Union. For the possibility of extrapolating the evidence, see paragraph 2.12.8.7 below.

2.12.6.3 Language area

Where the CTM applied for is rejected with respect to its meaning in a specific language, acquired distinctiveness through use must be shown at least with respect to the Member States in which that language is an official language.

Particular care should be taken when a language is an official language in more than one EU Member State. In such cases, when dealing with an absolute grounds objection based on the meaning of wording in a certain language, acquired distinctiveness through use must be proven for each of the Member States where that language is official (as well as any other Member States or markets where it will be understood).

(a) Examples of languages being official languages in more than one EU Member State include:

- German

German is an official language in Germany and Austria as well as in Luxembourg and Belgium. Any claim that acquired distinctiveness through use enables the applied-for sign to overcome an absolute grounds objection based on the meaning of German language wording must automatically be examined for all these countries.

- Greek

Greek is an official language not only in Greece but also in Cyprus. Any claim that acquired distinctiveness through use enables the applied-for sign to overcome an absolute grounds objection based on the meaning of Greek language wording must automatically be examined for both these countries.

- English

English is an official language in the United Kingdom, in Ireland and in Malta. Any claim that acquired distinctiveness through use enables the applied-for sign to overcome an absolute grounds objection based on the meaning of English language wording must automatically be examined for all these countries.

- French

French is an official language not only in France but also in Belgium and Luxembourg. Any claim that acquired distinctiveness through use enables the applied-for sign to overcome an absolute grounds objection based on the meaning of French language wording must automatically be examined for all these countries.

- Dutch

Dutch is an official language not only in the Netherlands but also in Belgium. Any claim that acquired distinctiveness through use enables the applied-for sign to overcome an absolute grounds objection based on the meaning of Dutch language wording must automatically be examined for both these countries.

- Swedish

Swedish is an official language not only in Sweden but also in Finland. Any claim that acquired distinctiveness through use enables the applied-for sign to overcome an absolute grounds objection based on the meaning of Swedish language wording must automatically be examined for both of these countries.

(b) Understanding of a Member State language in Member States where it is not official

In addition to the Member States where the language of a sign's wording is an official EU language, it must also be considered whether a given official EU language is understood in other Member States where it is not official. This may be because, depending on the goods and services claimed in the CTMA, the relevant public in that Member State have an elementary understanding of the language in question, or because the relevant public consists of specialists for whom certain technical terms in another EU Member State's official language are understood. If so, then acquired distinctiveness must be proven for the relevant public in these other EU Member States, and not only the Member States where the language is official.

By way of example, the GC has held that a very large proportion of European consumers and professionals have an elementary knowledge of English (judgment of 26/09/2012, T-301/09, 'Citigate', para. 41). Accordingly, depending on the relevant consumer of the goods and services in question and whether the sign consists of an elementary English word or not, acquired distinctiveness may also have to be assessed with respect to further Member States.

Moving from the general public to a more specialist public for goods and services, the GC has held that certain English terms in the medical field (judgment of 29/03/2012, T-242/11, '3D eXam', para. 26), in technical fields (judgment of 09/03/2012, T-172/10, 'Base-seal', para. 54) and in financial matters (judgment of 26/09/2012, T-301/09, 'Citigate', para. 41) will be understood by the relevant professionals throughout the European Union as English is the commonly used professional language in these areas.

On the other hand, since the understanding of languages is not strictly limited by geographical borders, it may well be that, for historical, cultural or cross-border market reasons, certain (usually elementary) vocabulary of a given language may spread and could be widely understood by the general public in other Member States, particularly those with contiguous land borders. By way of example, German and French are commonly used in the Italian regions of Trentino-Alto Adige and Valle d'Aosta, respectively.

2.12.7 What has to be Proved

The Court of Justice has provided guidance on the conditions which should result in a finding that a trade mark has acquired a distinctive character through use: 'If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied.' (Judgment of 04/05/1999, C-0108/97 & C-0109/97, 'Chiemsee', para. 45 et seq.).

Accordingly, the evidence must demonstrate that a significant proportion of the relevant public for the claimed goods and services in the relevant territory see the trade mark as identifying the relevant goods or services of a specific undertaking, in other words, that the use made of the mark has created a link in the mind of the relevant public with a specific company's goods or services, regardless of the fact that the wording at issue would lack the distinctiveness to make this link had such use not taken place.

With regards to the extent of market penetration and relevant public recognition a trade mark must achieve to hold that it has acquired distinctiveness through use, in that it has come to identify the goods and services of one undertaking as opposed to those of others for the relevant public, case-law does not prescribe fixed percentages of market recognition for the relevant public. Rather than using a fixed percentage of the relevant public in a given market, the evidence should rather show that a significant proportion of the public perceive the mark as identifying specific goods or services.

Finally, the evidence must relate to each of the goods and services claimed in the CTM application. After an initial absolute grounds objection under Article 7(1)(b), (c) or (d) CTMR, only the goods and services claimed in the application for which acquired distinctiveness through use has been proven will be registerable.

2.12.8 The evidence and its assessment

In establishing acquired distinctiveness, evidence of the following items may be taken into consideration: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant public who, because of the mark, identify goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (judgment of 04/05/1999, C-108/97 & C-0109/97, 'Chiemsee', para. 31; and judgment of 29/09/2010, T-378/07, 'RED/BLACK/GREY (Surface of a tractor)', para. 32).

The Office is not bound to examine facts showing that the mark claimed has become distinctive through use within the meaning of Article 7(3) unless the applicant has pleaded them (judgment of 12/12/2002, T-247/01, 'Ecopy', para. 47).

2.12.8.1 The kind of evidence that may be submitted

Examples of evidence which can serve to indicate some or all of the above factors which may show acquired distinctiveness include items such as sales brochures, catalogues, price lists, invoices, annual reports, turnover figures, advertising investment figures and reports, advertisements (press cuttings, billboard posters, TV adverts) together with evidence as to their intensity and reach, as well as customer and / or market surveys.

Applicants should take great care to make sure that the evidence shows not only use of the mark applied-for but also that it is sufficient to identify the dates of such use and the specific geographical territory of use within the EU. Undated evidence will normally be insufficient to show that distinctiveness had been acquired before the filing date, and evidence of use outside the EU cannot show the required market recognition of the relevant public within the EU. Further, if evidence mixes materials concerning EU and non-EU territories, and does not permit the Office to identify the specific extent of EU-only use, it will be similarly devoid of probative value for the relevant EU public.

Article 78 CTMR contains a non-exhaustive list of means of giving or obtaining evidence in proceedings before the Office, which may serve as guidance to applicants.

2.12.8.2 Assessment of evidence as a whole

Since the Office must assess the evidence as a whole (R 0159/2005-4, 'Metavit/MEXAVIT C *et al*', para. 37). It is not necessary that any one item of evidence alone is capable of proving the matter at issue. Such proof can result from an overall assessment of all items of evidence submitted (judgment of 07/06/2005, T-303/03, 'Salvita', para. 42; and decision of 08/03/2006, R 0358/2004-4, 'MediQi/MEDICE', para. 34). In order to assess the evidential value of a document, regard should be given to its credibility. It is also necessary to take into account the origin of the document, the circumstances in which it came into being, the person to whom it was addressed and whether the document appears sound and reliable (judgment of 07/06/2005, T-303/03, 'Salvita', para. 42; and judgment of 16/12/2008, T-86/07, 'DEITECH' [Fig. Mark], paras 46 *et seq.*).

2.12.8.3 Market share

The market share held by the trade mark may be relevant for assessing whether that mark has acquired distinctive character through use, to the extent that such market penetration might enable the Office to infer that the relevant public would recognise the mark as identifying the goods or services of a specific undertaking, and thus distinguishing those goods or services from those of other undertakings.

The amount of publicity on the relevant market for the goods or services claimed (as represented by advertising investment in promoting a mark) may also be relevant for assessing whether the mark has acquired distinctive character through use (judgment of 22/06/2006, C-0025/05P, 'Sweet wrapper', paras 76 et seq.). However, many attempts to prove distinctiveness acquired through use fail because the applicant's evidence is not sufficient to prove a link between the market share and advertising, on the one hand, and the consumer perception on the other.

2.12.8.4 Opinion polls and surveys

Opinion polls concerning the level of recognition of the trade mark by the relevant public on the market in question can, if conducted properly, constitute one of the most direct kinds of evidence, since they can show the actual perception of the relevant public. However, it is not an easy matter to correctly formulate and implement an opinion poll so that it can be seen to be truly neutral and representative. Leading questions, unrepresentative samples of the public, and undue editing of responses should be avoided, as these can undermine the probative value of such surveys.

The GC has found that in principle it is not inconceivable that a survey compiled some time before or after the filing date could contain useful indications, although it is clear that its evidential value is likely to vary depending on whether the period covered is close to or distant from the filing date or priority date of the trade mark application at issue. Furthermore, its evidential value depends on the survey method used (judgment of 12/07/2006, T-277/04, 'Vitacoat', paras 38-39).

Accordingly, any opinion poll evidence must be assessed carefully. It is important that the questions asked are relevant and not leading. The criteria for the selection of the interviewed public must be assessed carefully. The sample must be indicative of the entire relevant public and, accordingly, must be selected randomly.

Evidence from independent trade associations, consumer organisations and competitors should also be given weight. Evidence from suppliers or distributors should, generally, be given less weight, since it is less likely that their evidence will be from a third-party independent perspective. In this regard, the degree of independence of the latter will influence the weight to be given to the evidence by the Office (judgment of 28/10/2009 T-137/08, 'Green/Yellow').

2.12.8.5 Turnover and advertising

Information concerning turnover is one of the most readily available forms of evidence to companies. The same holds true with respect to advertising expenses.

These figures can have a significant impact on the assessment of the evidence, but in the great majority of cases are not sufficient alone to prove the issue of acquired

distinctiveness of a trade mark through use. This is because turnover/advertising costs alone, without additional corroborative details, are frequently too general to allow specific conclusions to be drawn about the use of one particular trade mark: it must be possible to identify with precision the turnover/advertising figures and evidence relating to the mark applied for, and also the relevant goods and services must be identifiable.

Goods and services are often marketed under several trade marks, which renders it difficult to see what the relevant customer perception is of the applied-for mark alone, and turnover/advertising can often include sales or promotion of other trade marks, or of significantly different forms of the trade mark at issue (for example, figurative trade marks rather than word marks, or differing word elements in a figurative mark), or are too general to allow identification of the specific markets under consideration. Consequently, broadly consolidated turnover or advertising figures may not be sufficient to prove whether the relevant public perceives the trade mark at issue as a badge of origin or not.

Where figures for turnover or advertising are supplied, these should relate not only to the trade mark for which registration is sought, but also specifically to the goods or services covered by that mark. It is desirable that the turnover figures be segregated on an annual and market-by-market basis. The specific period(s) of use (including details as to when the use commenced) should be shown by the evidence, so that the Office is able to satisfy itself that the evidence proves that the trade mark acquired distinctiveness before the filing date.

2.12.8.6 Indirect evidence of use

The evidence may consist of or include Member State registrations obtained on the basis of acquired distinctiveness.

The date to which the evidence filed at national level refers will usually be different from the filing date of the CTM application. These registrations may be taken into account, although they are not binding, when the examiner is able to assess the evidence which was submitted before the national IP office.

2.12.8.7 Extrapolation

Another important issue in the evaluation of evidence is whether the Office can extrapolate from selective evidence to draw broader conclusions. This concerns the extent to which evidence showing distinctiveness acquired through use in certain Member States can be used to make inferences with regard to the market situation in other Member States not covered by the evidence.

Extrapolating in this way to make broader inferences is of particular relevance to an enlarged European Union comprising many Member States, since it is very unlikely that a party will be able to provide evidence with respect to the whole European Union, but will rather tend to concentrate on some areas.

Extrapolation is possible where the market is homogenous and if at least some evidence is submitted. The market conditions and the consumer habits have to be comparable. Consequently, it is particularly important that the applicant submits data concerning the size of the market, its own market share, and if possible that of its main competitors, as well as its marketing expenses. Only if all data is comparable, may the

Office extrapolate the results from one territory to another. For example, if the CTM is used in the entire relevant territory but the evidence only refers to a part of it, inference is possible if the circumstances are comparable. However, if the CTM is only used in part of the relevant territory (and the evidence refers to this), it will usually be difficult to extrapolate those facts to other parts of the territory.

2.12.8.8 Manner of use

The evidence should show examples of how the trade mark is used (brochures, packaging, samples of the goods, etc.). Use of a substantially different mark should not be given any weight.

It is sometimes the case that the use shown is of a sign which, while similar to the mark applied for, is in itself distinctive. In such cases the evidence should be disregarded. Acquired distinctiveness must be shown with respect to the sign applied for. However, in accordance with Article 15(1)(a) CTMR, minor amendments to the sign which do not change the distinctive character of the sign may be allowed (decision of 15/01/2010, R 0735/2009-2, 'PLAYNOW'; and decision of 09/02/2010, R 1291/2009-2, 'EUROFLORIST').

It is possible to prove acquired distinctiveness of a sign which has been used together with other trade marks (judgment of 28/10/2009, T-137/08, 'Green/Yellow', para. 27), provided that the relevant consumer attributes to the sign in question the identification function (judgment of 07/07/2005, C-353/03, 'Have a break'; judgment of 30/09/2009 T-75/08, '!' [Fig. Mark], para. 43; and judgment of 28/10/2009, T-137/08, 'Green/Yellow', para. 46).

2.12.8.9 Length of use

The evidence should indicate when use commenced and should also show that the use was continuous or indicate reasons if there are gaps in the period of use.

2.12.8.10 Post-filing date evidence

The evidence must show that prior to the filing date, the trade mark had acquired distinctive character through use.

However, evidence cannot be rejected merely because it postdates the filing date, since it may provide indications as to the situation before the filing date. Accordingly, such evidence must be assessed and due weight given to it.

As an example, a trade mark which enjoys a particularly relevant recognition on the market or a substantially relevant market share a few months after the filing date may have acquired distinctiveness also on the filing date.

2.12.9 Consequences of Acquired Distinctiveness

A trade mark registered in accordance with Article 7(3) CTMR enjoys the same protection as any other trade mark which was found inherently registrable upon examination.

If the CTM application is accepted based on Article 7(3) CTMR, this information is published in the CTM Bulletin, using the INID code 521.