

Feedback form for comments on the draft Guidelines

User Association/National Office	MARQUES - The European Association of Trade Mark Owners
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Contributor (name & position)	MARQUES – Geographical Indications Team
Linguistic version the comments refer to	ENX DE <input type="checkbox"/> ES <input type="checkbox"/> FR <input type="checkbox"/> IT <input type="checkbox"/>
Part/Section/Chapter of the Guidelines the comment(s) refer to	PART B, EXAMINATION, SECTION 4, ABSOLUTE GROUNDS FOR REFUSAL, ARTICLES 7(1)(j) EUTMR
Page of the document	
Issue(s) you wish to comment on	2.10 Art 7(1)(j) EUTMR: Comments on the exhaustive nature of the EU system of protection
Suggestion for text	<p>The question of the exhaustive nature of the EU schemes of protection for GIs issue is taken for granted, while it appears to still be open to discussion – e.g. in Case T-659/14 Instituto dos Vinhos do Douro e do Porto, IP v OHIM – Bruichladdich Distillery (PORT CHARLOTTE), with respect to the possibility for national laws to supplement the EU legislation - where the General Court takes the view that the Regulation on the protection of geographical indications for wines is not exhaustive.</p> <p>Accordingly, MARQUES respectfully requests that the EUIPO further examine and clarify this delicate and controversial issue.</p>

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Page of the document	41
Issue(s) you wish to comment on	<p>2.10.2 Relevant PDOs/PGIs under EU Regulations</p> <p>Notwithstanding the above, and in view of the fact that the vast majority of applications for PDO/PGI usually mature into a registration, an objection shall be raised when the PDO/PGI was applied for before the filing date (or the priority date, if applicable) of the EUTM application even if it had not yet been registered at the time of examining the EUTM application.</p> <p>However, if the EUTM applicant indicates that the PDO/PGI in question has not yet been registered, the proceedings should be suspended until the outcome of the registration procedure of the PDO/PGI.</p> <p>Accordingly, MARQUES respectfully submits that in those cases, the proceedings should be suspended ex-officio by the EUIPO</p>

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Suggestion for text	
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Page of the document	50 and 51
Issue(s) you wish to comment on	2.10.3.5 The exploitation of the reputation of PDOs/PGIs
Suggestion for text	<p>This part should be adjusted to better clarify:</p> <ul style="list-style-type: none"> - That the AGs examination conducted by the Office shall cover the exploitation of the reputation of PDOs/PGIs for the categories of products and services to which an AG refusal on this ground may apply. - That an enhanced scope of protection of a PDO/PGI with reputation with respect to other products/services - to which an AG refusal on this ground cannot apply – <u>may</u> in case be invoked in the context of Article 8(4) EUTMR, subject to strict proof of reputation of the GI in the EU and proof that the use of the contested mark in relation to the contested goods and services would exploit the reputation of the GI.

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Page of the document	51
Issue(s) you wish to comment on	2.10.3.6. Limits to the scope of protection
Suggestion for text	MARQUES appreciates that the Office has clearly explained the limits of the scope of protection when a PDO/PGI contains or evokes the name of a product that is considered generic, and also when a PGI/PDO contains or evokes surnames or family names, when used in combination with other elements.

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Page of the document	53, 54
Issue(s) you wish to comment on	2.10.3.7 Trade marks in conflict with two or more PDOs/PGIs
Suggestion for text	There are some references to ACETO BALSAMICO DE MODENA and ACETO BALSAMICO TRADIZIONALE DE MODENA, which are incorrect as misspelt and should thus be changed to ACETO BALSAMICO DI MODENA and ACETO BALSAMICO TRADIZIONALE DI MODENA

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Page of the document	60 and 61
Issue(s) you wish to comment on	2.10.5.1 PDOs/PGIs protected at national level in an EU Member State
Suggestion for text	<p>The Court of Justice has stated that the EU system of protection for PDOs/PGIs for agricultural products and foodstuffs laid down in the EU Regulation is exhaustive in nature.</p> <p>Due to a divergence in text, the similar approach of the Office is problematic.</p> <p>Accordingly, the General Court takes a different approach with regard to wines – e.g. in see Case <T-659/14 Instituto dos Vinhos do Douro e do Porto, IP v OHIM – Bruichladdich Distillery (PORT CHARLOTTE).</p> <p>The EU system of protection with regard to wine, and spirits, does not necessarily override and replace national protection.</p> <p>Apart from the question of the exhaustive nature of the different EU regulations, the draft guidelines indicate that in lack of a database for national PDOs/PGIS operated by the Office or the European Union Commission, the Office will principally rely on observations by third parties.</p> <p>Though it is observed that in principle the requirement of a full examination on absolute grounds should be fulfilled, however, in the lack of repositories or databases for national PDOs/PGIS publicly accessible, the proposed practice that the Office shall principally rely on third-party observations seems more equitable.</p>

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Page of the document	63
Issue(s) you wish to comment on	2.10.5.2 c) The geographical indication is protected under an international agreement signed only by Member States
Suggestion for text	<p>As stated above (comments on paragraph 2.10.5.1), the EU system of protection with regard to wines and spirits, does not necessarily override and replace national protection.</p> <p>Therefore, international agreements signed only by Member States relating to wines or spirits should be taken into account in the Office’s absolute grounds examination.</p> <p>However, though it is observed that in principle the requirement of a full examination on absolute grounds should be fulfilled, in the lack of repositories or databases for those PDOs/PGIs publicly accessible, the proposed practice that the Office shall principally rely on third-party observations seems more equitable.</p>

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Page of the document	70
Issue(s) you wish to comment on	PDO ‘Mozzarella di Buffala Campana’
Suggestion for text	The correct name of the PDO is “Mozzarella di Bufala Campana”

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Issue(s) you wish to comment on	2.12.5 International Agreements
Suggestion for text	The draft guidelines indicate that in lack of a database for TSGs protected under international agreements, the Office will principally rely on observations by third parties. Again, though it is observed that in principle the requirement of a full examination on absolute grounds should be fulfilled, in the lack of repositories or databases for those TSGs publicly accessible, the proposed practice that the Office shall principally rely on third-party observations seems more equitable

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Page of the document	25
Issue(s) you wish to comment on	<p>If an opponent files an opposition based on a GI upon or after entry into force of the Amending Regulation, in which it indicates incorrectly Article 8(4) EUTMR as a ground for opposition, the Office will examine the opposition, to the extent that it is clearly based on a GI , as if the ground invoked has been Article 8(4a) EUTMR, as introduced by the Amending Regulation.</p> <p>In such a case, the notice of opposition must leave no doubt that the opponent’s intention was to invoke the ground for opposition protecting earlier GIs.</p> <p>This should be in line with the practice of the Office according to which even if an opponent has not expressly based its opposition on Article 8(4)(a) EUTMR, the contents of the notice and the wording of the explanation of grounds must be carefully analysed with a view to objectively establish that that was the opponent’s intention.</p>
Suggestion for text	For the sake of clarity, it would be worth adding a reference to Page 17 of Chapter 2.4.1.2 “Identification of the earlier marks/rights”, Guidelines, Part C, Opposition, Section 1, Procedural matters, which details the absolute indications for the identification of a GI as basis of an opposition.

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Page of the document	27
Issue(s) you wish to comment on	<p>A mere excerpt of the relevant online EU databases (DOOR, E-Bacchus or E-Spirit-Drinks) or in the case of spirit drinks, an excerpt of Annex III in the Spirit Drinks Regulation, is not sufficient, as such excerpt do not contain sufficient data to determine all the relevant particulars of the earlier right (e.g. entitlement of the opponent or goods protected by the GI).</p> <p>For example, the E-Bacchus and E-Spirit Drinks excerpts, or excerpts of Annex III of the Spirits Drinks Regulation merely indicate the country of origin of the GI, which is not sufficient to prove the opponent’s entitlement.</p>
Suggestion for text	<p>The differences and inconsistencies in the online EU databases on GIs reflect the current limits of the EU GI schemes, which inevitably lead to an undesirable degree of legal uncertainty.</p> <p>MARQUES would like to that this opportunity to reiterate its support to the adoption of a common EU regulation for all agri- and non-agri foods and also to kindly call for the EUIPO to promote a project for the creation of a harmonised unique database of all GIs (including GIs for non-agricultural products protected under national laws of EU Member States), featuring the main particulars of the protected GI.</p>

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Suggestion for text	<p>The question of the exhaustive nature of the EU schemes of protection for GIs issue is taken for granted, while it appears to still be open to discussion – e.g. in Case T-659/14 Instituto dos Vinhos do Douro e do Porto, IP v OHIM – Bruichladdich Distillery (PORT CHARLOTTE), with respect to the possibility for national laws to supplement the EU legislation - where the General Court takes the view that the Regulation on the protection of geographical indications for wines is not exhaustive.</p> <p>Accordingly, MARQUES respectfully requests that the EUIPO further examine and clarify this delicate and controversial issue.</p>

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Page of the document	29-30
Issue(s) you wish to comment on	<p>The addition in this chapter of a chart showing <i>(i)</i> the dates of accession to the EU of each Member States and <i>(ii)</i> the dates of entry into force of the uniform EU systems for protection of GIs, would facilitate users in verifying whether the exceptions set forth in this paragraph may apply or not.</p>
Suggestion for text	