TM & GIs: pros and cons
General Concepts

Geographical Indication (GI):

- Is the name of a product where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin. It is a type of intellectual property right that can apply in the EU to different types of products.
- GIs are typically used for agricultural products, foodstuffs, wine and spirits. In some countries handicrafts and industrial products can also be protected as GIs.
- GI protection may be requested by a group of producers of the product identified by the geographical indication. The producers may be organized as an entity, such as a cooperative or association, which represents them and ensures that the product fulfils certain requirements which they have agreed upon or adhered to. In some jurisdictions, protection may also be requested by a national competent authority (for example, a local government authority).
- A sign must qualify as a geographical indication under the applicable law and not be subject to any obstacles to registering GI. Generally, an important requirement under the definition, is that the good identified by the GI needs to have a link to the geographical origin.
PDO

PDO:

Products’ qualities or characteristics are due to the geographical environment with its natural and human factors.

Raw materials and all stages of the production take place in the geographical area.
PGI:

The product possesses specific quality, characteristics or reputation attributable to its geographical origin.

One stage of the production process must take place in the region.
General Concepts

Trade mark (EUTM)

Trade marks are signs used in trade to identify products and/or services. In particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

1. Distinguishing the goods and/or services of one undertaking from those of other undertakings, and
2. Being capable of being represented in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.
Single letters and digits

Figurative arrangement – particular shape, style or colour
POSITION MARKS
Pros and cons of TMs that are also GIs

GIs identify a good as originating **from a particular place**.

By contrast, a trade mark identifies a good or service as originating **from a particular company**.

A trade mark often consists of a fanciful or arbitrary sign.

In contrast, the name used as a GI is usually predetermined by the name of a geographical area.

Finally, a trade mark can be assigned or licensed to anyone, anywhere in the world, because it is linked to a specific company and not to a particular place.

In contrast, a GI may be used by any persons in the area of origin, who produces the good according to specified standards, but because of its link with the place of origin, a GI cannot be assigned or licensed to someone outside that place or not belonging to the group of authorized producers.
Pros and cons of TMs that are also GIs

Pros:

• TM registration provides easy and immediate protection if no national GI registrations system is in place.
• TM protection can also serve the purpose of preventing producers from other geographical areas to seek protection over a GI product.
• Prevent that a GI may become at some point a generic term.
• A prior GI prevents the registration of a TM

Cons:

• Diversification of products packaging to address different market channels do not allow for a diversification of trade marks if the TM is also the GI.
• TM protection may be refused due to the descriptiveness of the sign.
• Enforcement and opposition may become difficult for the descriptive part of a sign
Some examples of GIs and Trademarks

- **EUTM 12 296 191**
  - cl. 24,25,28

- **EUTM 2 015 246**
  - cl. 29,30,31

- **EUTM 5 739 222**
  - cl. 29

- **POIVRE DE KAMPOT**
  - EUTM 8 497 406
    - Collective Mark
    - cl. 30,35
DARJEELING
EUTM 387 522
cl. 30

EUTM 15 031 362
cl. 33

EUTM 1 753 284
cl. 29

EUTM 226 118
cl. 33
EUTM 1 210 046
cl. 16, 29, 42

EUTM 006103899
Cl. 29

EUTM 1 514 124
cl. 29, 35

EUTM 8 992 901
Collective mark
cl. 29, 35, 42

ACEITES DE JAEN

EUTM 12 212 321
cl. 16, 30, 35
Some examples: TM and GIs

- Trade Mark, as well as the label as a whole or the packaging/container of the product
- Design, as well as the label as a whole or the packaging/container of the product (bottle)
- Protected GI for spirits
Protected GI for cheese

Trade Mark, as well as the label as a whole or the packaging/container of the product

Design, as well as the label as a whole or the packaging/container of the product
Trade Mark, as well as the packaging/container of the product

Protected GI for wine

Design, as well as the packaging/container of the product (bottle)
Trade Mark, as well as the label as a whole or the packaging/container of the product

Protected GI for ham

Design, as well as the label as a whole or the packaging/container of the product
Some examples: TMs and geographical origin

**Indian Trade Mark**

**Indian protected GI for agricultural product**
Registered Trade Mark (Mongolian Cashmere is disclaimed) (for various items to be produced in cashmere)

Indication of a geographical place
Registered Trade Mark, as well as the label as a whole or the packaging/container of the product (for beer)

Design, as well as the label as a whole or the packaging/container of the product (bottle)

Indication of a geographical place (Lapland, a region in Finland)
Refused Trade Mark
(application was for pastry and confectionary)

Indication of a geographical place
(Vienna has a reputation for pastry and confectionary)
Refused Trade Mark (applied for clothing)

NEW YORK CASUAL

Indication of a geographical place (New York has a reputation for fashion and fashion weeks)
Expert’s name: Natalie Pasinato
Expert’s title: IP Expert

European Union Intellectual Property Office (EUIPO)

Thank You

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