

POSITION PAPER

USE GIs AS INGREDIENTS, DO NOT TRADE MARK THEM

I. INTRODUCTION

In the modern world, cuisines are not only defined by cooking techniques and the mastery of the chefs, but they are also very much dependent on the quality and the origin of the ingredients used. Consumption of foodstuffs, wines and spirits has become a cultural experience. In the past, it was difficult, or next to impossible, to recreate such an experience far from the territory where the products and ingredients needed were traditionally produced or, otherwise, the experience was accessible only to the upper classes. Today, instead, most of the food, wines, ingredients that any advanced chef or demanding consumer could think of are easily available, anywhere in the world. If you wish to buy the "real thing" though, you should be ready to pay a higher price than that of the generic equivalent good and, of course, you need to have all guarantees that what you buy is, actually, the real thing! Geographical Indications fulfil exactly that purpose.

Most of the EU and non-EU countries are packed with traditional food and drink diversity, that are the result of unique processing techniques, ancient production standards and know-how that, combined with the link to a precise geographical origin, have created products with a strong, recognisable personality, and unique characteristics. The names of these products are often protected through the EU quality schemes as Geographical Indications (Protected Designations of Origin -PDOs- and Protected Geographical Indications -PGIs-).

While virtually any foodstuff or drink product protected by a GI can be used (and such use can be claimed, following certain rules) in a recipe or in a further processed product (e.g. *risotto all'Amarone della Valpolicella*, or the *Rose Biscuit de Reims* using a rosé Champagne), there are some GIs which, by their nature, are used mainly or even only as ingredients to produce other products. The Italian PGI *Limone di Sorrento* or the Spanish PDO *Chufa de Valencia* are good examples, the first being used as a key ingredient in a broad variety of recipes, while the second identifies the tiger nuts appreciated for their healthy and digestive properties and especially used to prepare the famous *horchata* drink.

Furthermore, there are GIs that have gained such a tremendous reputation that they reached a point where the use (or abuse) of their name in any context, or in respect of any type of goods, makes a difference, also where such GIs are used and claimed as an ingredient. In the past few years, for instance, we have witnessed the fast, tremendous and global growth of the *Prosecco* PDO to a point where today the name *Prosecco* (exactly as it happens with famous trade marks) has a value that goes well beyond the wine sector, a value that can be easily transferred to non-wine products using *Prosecco* as an ingredient. In the market, we have seen snacks of various sorts, even candies aromatised with *Prosecco*.

With the aim of providing legal certainty on this specific matter, yet in 2010, the European Commission issued the «Guidelines on the labelling of foodstuffs using protected designations of origin (PDOs) or protected geographical indications (PGIs) as ingredients»¹.

Subsequently to those guidelines, the EU legislator has clearly extended the scope of protection of PDOs and PGIs, in all three existing quality schemes (for wines and other

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¹ OJEU of 16.12.2010 - 2010/C 341/03.

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grapevine products, for spirit drinks and for other agricultural products and foodstuffs), also to situations where they are used as an ingredient.

While the operators marketing this kind of products will surely desire to make commercial use of the GI name (and, in most cases, register a trade mark containing the name), most GI holders are expected to be very minded about the reputation gained by the name and so enforcing the protection granted by the EU Regulations against any use that is not made with their express authorisation. Some cases have already been brought to the courts, such as the *Comité Interprofessionnel du Vin de Champagne vs Aldi* case, with a ruling of the CJEU issued on 20 December 2017 in Case C-393/16, as the most relevant one (better known as the '*Champagner Sorbet*' case). Likewise, the EUIPO has decided on the **registration of many trade marks that incorporate the name of a GI and cover goods that may contain the GI product as an ingredient**, and so building its own practice in that regard.

While the general protection of GIs has reached a very high level, at least across the EU, thanks to many generous judgments of the CJEU, granting protection in situations where the EU national courts had denied it, we believe that some more study and consideration should be given to the issue of the use of GIs as ingredients. More specifically, this paper addresses the problem of **registration** of these trade marks, for which, despite all the complex questions and situations that could arise from the use of the GI in the market, a simple answer can be given, in ECTA's opinion.

II. EXECUTIVE SUMMARY

The protection of Geographical Indications (GIs) through the EU quality schemes has allowed products with unique characteristics to gain recognition and protect their names.

Products benefitting from GIs can be used as ingredients for further processed foodstuffs. In fact, certain GI products are used mainly or even only as ingredients in a variety of food preparations, contributing to the added value of the final products.

To regulate the use of the GI name in such cases, the European Commission issued *ad hoc* Guidelines that distinguished between the use with information purposes (inclusion in the list of ingredients) and the use of commercial nature (in the labelling, in the presentation, in or close to the trade name of the foodstuff, etc.). The CJEU has also issued a preliminary ruling on this matter (the '*Champagner Sorbet*' case), concluding that the use of the GI name as part of the trade name of the resulting foodstuff could still constitute an unfair exploitation of the GI's reputation, even when the ingredient used complied with the GI specifications, but that ingredient did not confer on the foodstuff one of its essential characteristics.

However, can the operators marketing these foodstuffs register trade marks that contain the GI name? That is the question this paper tries to answer.

The EUIPO is granting registration of those trade marks as long as a restriction to the compliance of the ingredient with the GI specifications is included in the designation of goods.

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In ECTA's view, however, those trade marks should be refused since there is no proper justification to incorporate the GI name into a third party's exclusive right and there is no apparent legal basis that supports their registration.

III. COMMENTS

III.A. Legal framework

In the EUTMR, both an absolute and a relative ground for refusal, prevent from the registration of trade marks in conflict with prior GIs. Both grounds refer to the law governing the earlier GI for the purposes of applying its scope of protection.

According to **Article 7(1)(j)**, 'trade marks which are **excluded from registration**, pursuant to Union legislation or national law or to international agreements to which the Union or the Member State concerned is party, providing for protection of designations of origin and geographical indications' shall not be registered.

According to **Article 8(6)**, 'Upon opposition by any person authorised under the relevant law to exercise the rights arising from a designation of origin or a geographical indication, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Union legislation or national law providing for the protection of designations of origin or geographical indications:

- (i) an application for a designation of origin or a geographical indication had already been submitted, in accordance with Union legislation or national law, prior to the date of application for registration of the EU trade mark or the date of the priority claimed for the application, subject to its subsequent registration;
- (ii) that designation of origin or geographical indication **confers the right to prohibit the use of a subsequent trade mark.**

In the case of GIs registered under the EU *sui generis* system, the right to prohibit the use (as referred to by the relative ground for refusal of Article 8(6) EUTMR) is governed by Article 103(2) of Regulation EU No 1308/2013 (for the scheme of wines and other grapevine products), Article 21(2) of Regulation EU 2019/787 (for spirit drinks) and Article 13(1) of Regulation EU No. 1151/2012 (for other agricultural products and foodstuffs). As explained above, in all three schemes (regardless of the slightly different drafting) protection is afforded also to cases in which they are used as ingredients:

'Registered names shall be protected against:

- (a) any direct or indirect commercial use of a registered name in respect of products not covered by the registration where those products are comparable to the products registered under that name or where using the name exploits, weakens or dilutes the reputation of the protected name, **including when those products are used as an ingredient;**

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(b) any misuse, imitation or evocation, even if the true origin of the products or services is indicated or if the protected name is translated or accompanied by an expression such as 'style', 'type', 'method', 'as produced in', 'imitation' or similar, **including when those products are used as an ingredient.**'

Whereas the situations in which a later trade mark is excluded from registration (as referred to by the absolute ground for refusal of Article 7(1)(j) EUTMR) are defined by Article 102 of Regulation EU No 1308/2013, Article 36 of Regulation EU 2019/787 and Article 14 of Regulation EU No. 1151/2012 provide:

'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 [its scope of protection as defined in the corresponding Article] 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.

Trade marks registered in breach of the first subparagraph shall be invalidated.'

III.B. The practice of the EUIPO

According to the Office's Guidelines², where a trade mark application is in conflict with a GI and covers products that are **identical to those covered by the GI**, the examiner shall raise an objection to registration under Article 7(1)(j) EUTMR. However, that objection '*may be waived if the relevant goods are restricted to comply with the specifications of the GI in question.*'

Several examples are given in that regard, e.g. a trade mark incorporating the name 'Welsh beef' would not be acceptable for 'meat' in class 29, but it would be acceptable for 'Welsh Beef (GI) beef meat'.

For trade mark applications designating **services**, the Office will also raise an objection '*when identical goods constitute the specific object of services such as retail, wholesale, import/export, provision of drink and food, production of [the product covered by the GI] for others*'. In these cases, likewise, the objection may be waived if the good that constitutes the specific object of the services is restricted to that one that complies with the specifications of the referred GI.³

The Guidelines themselves explain that this approach is based on '*Article 103(1) of Regulation (EU) No 1308/2013 [according to which] GIs may be used by any operator marketing a wine or aromatised wine conforming to the corresponding specification*', as well as '*Article 12(1) of Regulation (EU) No 1151/2012, [according to which] protected designations of origin and protected geographical indications may be used by any operator marketing [an agricultural or foodstuff] product conforming to the corresponding*

² Part B Examination, Section 4 Absolute grounds for refusal, Chapter 10 Trade Marks in Conflict with Geographical indications, 5 Relevant Goods under EU Regulations, 5.3 Restriction of the list of goods.

³ See same section of the Guidelines, point 5.1 Identical products *in fine*.

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specification'. Even if the Guidelines omit it, also Article 21(1) of Regulation EU 2019/787 contains the same kind of provision for spirit drinks.

The Office has proved to be consistent with the implementation of this practice, raising *ex officio* objections whenever a GI is identified in the sign applied for and the designated good is identical to that one covered by the GI. If the limitation of goods proposed by the examiner is accepted, the trade mark will be registered (e.g. EUTM n° 13062187 'tartuFeta by Kourellas S.A.' for 'Cheese produced in accordance with the requirements of the PDO 'FETA' in class 29, EUTM n° 13895578 'Parma Noble Food Selezione Italiana' for 'Cheese in conformity with the guidelines of the PDO Parmigiano Reggiano' in class 29 or EUTM n° 18028079 'CÁLEM EST PORTO 1859' for 'Port complying with the specifications of the PDO Porto' in class 33), otherwise, registration will be refused.

This practice seems to be confirmed by the Boards of Appeal: e.g. the Consejo Regulador del Cava opposed and, subsequently, filed an appeal against the registration of the EUTM n° 18154383 'CHENINE Brut PREMIUM CAVA' for 'Wines complying with the specifications of the protected designation of origin Cava', based, among other grounds, on the conflict with the PDO 'Cava'. In par. 61 *et seq.* of the Decision of 22/4/2022 in case R 981/2021-1, the First Board of Appeal denies the existence of any conflict with the PDO given that the wine in class 33 was properly restricted to 'Cava' (PDO) wine.

As for the purposes of the present paper, the Guidelines follow exactly the same approach when it comes to trade mark applications covering **goods that may contain the GI product as an ingredient**: *'Products used as ingredients: if the goods covered by the GI can be used as a commercially relevant ingredient (in the sense that it may determine the choice of the main product) of any of the goods included in the EUTM application, a restriction will be requested. This is because Article 13(1)(a) and (b) of Regulation (EU) No 1151/2012 expressly extend the scope of protection of a GI registered for a given product 'when those products are used as an ingredient'*.

Again, several examples of the practice are provided:

GI in the EUTM	Original specification (which is not acceptable)	Acceptable list of goods	Explanation
POMME LIMOUSIN DU (PDO-FR-0442) for apples	Jams and compotes	Jams and compotes of 'Pomme du Limousin' (GI) apples	The fruit is the main ingredient of jams and compotes.
PROSCIUTTO PARMA DI (PDO-IT-0067) for ham	Pizzas	Pizzas with 'Prosciutto di Parma' (GI) ham	This topping is the main ingredient of a pizza and the one that determines the consumer's choice.

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GI in the EUTM	Original specification (which is not acceptable)	Acceptable list of goods	Explanation
RIOJA (PDO-ES-A0117) for <i>wine</i>	<i>Wine vinegar</i>	<i>Wine vinegar made from 'Rioja' (GI) wine</i>	The EUTM can be accepted for <i>wine vinegar</i> complying with the specifications of the PDO. Wine is an ingredient of <i>vinegar</i> (wine vinegar is made of wine).

The Guidelines further explain that ‘A restriction is not necessary if the goods covered by the GI are used as a secondary, not commercially relevant, ingredient of the claimed goods’.

In ECTA’s opinion, the approach based on the relevance of the ingredient, and whether it may determine or not the choice of the final product, seems a valid criterion to decide whether the applied trade mark may conflict with an earlier GI; notwithstanding the difficulties of carrying out that evaluation. However (and although we understand that the ratio behind this practice based on the restriction of goods is to respect the protection of GIs), in our view, the answer given to these cases should be a different one: whenever the trade mark filed by a third party is deemed to be in conflict with a GI, registration should be refused, with no possible restriction of goods as regards the ingredients capable of justifying its registration. The reasons are explained hereunder.

III.C. Analysis

Our proposal to change the practice of the EUIPO as regards ‘ingredients’ is based on the scope of protection granted to GIs in the specific EU Regulations, on the content of the European Commission’s «Guidelines on the labelling of foodstuffs using protected designations of origin (PDOs) or protected geographical indications (PGIs) as ingredients» and on the case law of the EU courts. Furthermore, we will also refer to the content of the Proposal of the European Commission for a new Regulation on GIs for wine, spirit drinks and agricultural products, which seems to give more reasons to amend the current practice of the EUIPO in this regard.

- **The scope of protection of GIs in the specific EU Regulations**

First, as explained above (see III.A. Legal framework), the scope of protection of GIs extends to situations in which the concerned products are used as an ingredient.

Secondly, whereas Article 12(1) of Regulation (EU) No. 1151/2012, Article 103(1) of Regulation (EU) No. 1308/2013 and Article 21(1) of Regulation (EU) 2019/787 do indeed grant the right to use the relevant GI to ‘any operator marketing a product conforming to the corresponding specification’ (and this could justify the practice of the EUIPO regarding

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‘identical products’, as explained above), **such a right is not granted to operators marketing a product one of whose ingredients complies with the specification of the corresponding GI.** Much less is granted a hypothetical right to register a sign that includes the GI name as a trade mark.

On the contrary, the use of the GI in the labelling of foodstuffs using protected GIs as ingredients is subject to restrictive requirements, according to the *ad hoc* Guidelines of the European Commission.

- **The «Guidelines on the labelling of foodstuffs using protected designations of origin (PDOs) or protected geographical indications (PGIs) as ingredients»**

These Guidelines distinguish between what can be defined as use with mere information purposes (list of ingredients) and more commercial use (labelling, presentation).

According to them, where the marketed product contains the GI ingredient, the GI name ‘*may legitimately be included in the list of ingredients of a foodstuff*, without further requirements.

However, for the GI name to ‘*be mentioned in or close to the trade name of a foodstuff (...), as well as in the labelling, presentation and advertising relating to that foodstuff*, additional requirements must be satisfied:

- ‘*The foodstuff in question should not contain any other ‘comparable ingredient’.*
- ‘*This ingredient should also be used in sufficient quantities to confer an essential characteristic on the foodstuff concerned.*

If those conditions are not met, any use of the GI name that goes beyond its mere appearance in the list of ingredients could ‘*result in the undue exploitation of the reputation of the PDO or PGI and result in consumers being misled*’, in the European Commission’s view.

Finally, the possibility of registering a trade mark containing the GI name on the mere basis that the operator’s products contain the GI ingredient is not even considered by the European Commission’s Guidelines.

Hence, the restriction of goods that the EUIPO is requesting for the purposes of granting registration of trade marks that include a GI name would only **grant the right to mention the GI in the list of ingredients of a foodstuff, but not to make commercial use of it**, if the European Commission’s Guidelines were applied. In other words, the EUIPO is granting registration to trade marks the use of which will, in most of the cases, conflict with the GI protection. This may result in an inefficient administration of the system of trade mark registration and cause unnecessary confusion and frustration for trade marks owners.

- **The case-law of the EU courts**

In line with the Guidelines of the European Commission, in the ‘*Champagner Sorbet*’ case the CJEU concluded that the protection against exploitation of the reputation of the GI, as provided for by the specific EU Regulations, ‘*covers a situation where a PDO, such as ‘Champagne’, is used as part of the name under which a foodstuff is sold, such as ‘Champagner Sorbet’, and where that foodstuff does not correspond to the product*

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*specifications for that PDO but contains an ingredient which does correspond to those specifications' (§ 46). More specifically, the CJEU found that 'the use of a PDO as part of the name under which is sold a foodstuff that does not correspond to the product specifications for that PDO but contains an ingredient which does correspond to those specifications is **intended to take unfair advantage of the reputation of the PDO if that ingredient does not confer on that foodstuff one of its essential characteristics'** (§ 50).*

Therefore, the mere fact that the ingredient used complies with the GI specifications does not grant the right to incorporate the GI name into the name under which the foodstuff is sold, let aside register it as a trade mark.

The CJEU added that:

52. Where the name of the foodstuff indicates, as in the main proceedings, that it contains an ingredient protected by a PDO, which is intended to convey the taste of the foodstuff, the taste imparted by that ingredient must constitute the essential characteristic of that foodstuff. If the taste of the foodstuff is more attributable to other ingredients it contains, the use of such a name will take unfair advantage of the reputation of the PDO concerned. Thus, in order to determine whether the champagne contained in the product at issue in the main proceedings confers on it one of its essential characteristics, the national court must ascertain, in the light of the evidence before it, whether the taste of the product is attributable primarily to the presence of champagne in the composition of the product.

53. In the light of the above considerations, the answer to the second question is that Article 118m(2)(a)(ii) of Regulation No 1234/2007 and Article 103(2)(a)(ii) of Regulation No 1308/2013 are to be interpreted as meaning that the use of a PDO as part of the name under which is sold a foodstuff that does not correspond to the product specifications for that PDO but contains an ingredient that does correspond to those specifications, such as 'Champagner Sorbet', constitutes exploitation of the reputation of a PDO, within the meaning of those provisions, if that foodstuff does not have, as one of its essential characteristics, a taste attributable primarily to the presence of that ingredient in the composition of the foodstuff.'

Consequently, by complying with the only condition that the EUIPO is requesting for the registration of trade marks that make use of the GI name (i.e. mere incorporation of the GI product as an ingredient), that use could still (and will in most of the cases, if we take into account the difficulty to meet the additional requirement: that ingredient must confer to the final product one of its essential characteristics) constitute an exploitation of the reputation of the GI.

Moreover, dealing with an invalidity action against a trade mark that incorporated the EU



official symbol for PGIs , the GC made clear that the right to use that symbol (due to the compliance with the specifications of a given PGI) does not entitle the operator to use it as a trade mark. Judgement of 1 December 2021, in Case T-700/20, *Gabriele Schmid v. EUIPO*:

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*'45. In that context, it should be added, for the sake of completeness, that, contrary to what the applicant claims, the fact, assuming it to be established, that, on the date of filing of the application for registration, the goods designated by the contested mark met the conditions set out in Regulation No 1151/2012 in order to benefit from protection under protected geographical indications, has no bearing on that examination. First, such a fact means only that, in accordance with Article 12 of Regulation No 1151/2012, **the operator marketing those goods may use the geographical indication at issue, which does not, however, entitle him or her to use such an indication as a trade mark.** Secondly, the goods in question may cease to meet those conditions in the future. Even in that case, the trade mark concerned would continue to include the PGI symbol and would, as the case may be, be more likely to mislead the public as to the origin or properties of the goods which it designates.'*

This finding could call into question the whole practice of the EUIPO as regards restriction of goods (even for trade marks that cover the good complying with the GI specifications).

- **The Proposal of the European Commission for a new Regulation on GIs for wine, spirit drinks and agricultural products**

On 31 March 2022, the European Commission adopted a Proposal for a regulation on GIs for wine, spirit drinks and agricultural products, and other quality schemes for agricultural products, which will replace the EU Regulations now in force.

The content of the Proposal (still under discussion) contains a more detailed regulation on the use of GIs as ingredients. According to its Recital 20:

'In light of commercial practices and Union jurisprudence clarity is required on the use of a geographical indication in the sale name of a processed product of which the product designated by the geographical indication is an ingredient. It should be ensured that such use is made in accordance with fair commercial practices and **does not weaken, dilute or is not detrimental to the reputation of the product bearing the geographical indication. A consent of a large majority of the producers of geographical indications concerned should be required to allow such a use.**'

Article 27 defines the scope of protection of registered GIs. In contrast to the content of the specific Articles of the Regulations currently in force, Article 27 of the Proposal (according to the text as proposed by the Commission) does not specifically refer to the situations in which 'those products are used as an ingredient'⁴. However, we understand that protection against that practice would still be provided under the general clause of paragraph 1, letter (a) ('where use of a name exploits, weakens, dilutes, or is detrimental to the reputation of, the protected name'), especially if we take into account the content of the above referred Recital 20.

⁴ It is important to note, however, that on 3 April 2023 the Swedish Presidency of the Council issued its suggestions on the Commission's Proposal, and on 3 May 2023 the European Parliament issued its Report on the Commission's Proposal, and both proposed to include again the specific reference to situations in which 'those products are used as an ingredient' within the scope of protection of GIs.

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In fact, this situation concerning the use as an ingredient is governed in a more specific manner in the subsequent Article 28 of the Proposal:

‘1. Article 27 is without prejudice to the use of a geographical indication by operators in conformity with Article 36⁵ to indicate that a processed product contains, as an ingredient, a product designated by that geographical indication provided that such use is made in accordance with honest commercial practices and does not weaken, dilute or is not detrimental to the reputation of the geographical indication.

2. The geographical indication designating a product ingredient shall not be used in the food name of the related processed product, except in cases of an agreement with a producer group representing two thirds of the producers.^{6 7}

It appears that the Proposal for a new Regulation further develops the approach that was established by the previous Guidelines of the European Commission in this regard, distinguishing between:

- Use of the GI name with mere informative purposes: ‘to indicate that a processed product contains, as an ingredient, a product designated by that geographical indication provided that such use is made in accordance with honest commercial practices’. Such use, of course, **does not cover the inclusion of the GI name into the product’s trade mark**, nor the use in the food name of the product.

⁵ ‘A registered geographical indication may be used by any operator marketing a product conforming to the corresponding product specification or single document or an equivalent to the latter.’

⁶ In the revised version issued by the Swedish Presidency of the Council on 3 April 2023, the right to mention the GI is not dependant on the authorisation by a group representing the majority of the producers, but on the following technical requirements:

‘a) the processed product does not contain any other product comparable to the product ingredient designated by the geographical indication included in its name;

b) the concerned product ingredient is used in sufficient quantities to confer an essential characteristic on the processed product concerned; and

c) the percentage of the concerned product ingredient in the processed product is indicated in the label.’

⁷ Furthermore, in the amended version proposed by the European Parliament on 3 May 2023, it is clearer that the only possible use of the GI name, without the express authorization of a group representing the majority of the producers, is the mere inclusion in the list of ingredients:

‘(1) The name of a geographical indication used by operators in conformity with Article 36 to indicate that as an ingredient in a processed product may be referred to in the list of ingredients, provided that such use complies with Article 27, that it is made in accordance with honest commercial practices and does not weaken, dilute or is not detrimental to the reputation of the geographical indication, and that it complies with the applicable provisions of Regulation (EU) 2019/787 in respect of spirit drinks.

(2) The geographical indication designating a product ingredient shall not be used in the food name, labelling except the list of ingredients, packaging device or advertising of the related processed product, except in cases of the existence of an agreement in writing including control provisions concluded with the recognised producer group, or, where such a group does not exist, the producer group representing a majority of producers, which may establish minimum conditions for the fair usage of the name.

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- Use of the GI name with more than mere informative purposes (e.g. commercial purposes): for which the authorisation of the large majority of the GI producers will be required.

IV. FINAL REMARKS

In light of all the foregoing, ECTA understands that trade marks applied for by third parties, which refer to a GI name (either by making a direct use, or evoking, or imitating, etc. that name) and cover goods that may contain the GI product as a commercially relevant ingredient, should simply not be registered.

Instead of proposing a restriction of the designated goods -[foodstuff] containing GI [ingredient]-, we propose that the examiners of the EUIPO simply refuse *ex officio* the registration of these applications, since there is no possible restriction of goods that guarantees a fair use of the GI and justifies the inclusion of the protected name in a registered trade mark.

This should be even clearer whenever a group of producers of a GI or the entity managing the GI file an opposition against these trade marks, as it would be proof that, for the legitimate users, that kind of use would be detrimental to the GI.

As we have seen, far from granting a right to make commercial use of the GI when used as an ingredient, the applicable regulation imposes very restrictive requirements for any use that goes beyond the mere informative purposes (inclusion in the list of ingredients). The *ad hoc* Guidelines of the European Commission, the case-law and even the Proposal for a new Regulation have only considered the use of the GI name in the food name of the final product, in its labelling or presentation; they have never considered its inclusion in a trade mark registered on behalf of the operator marketing that final product.

Account must be taken of the fact that a trade mark, by definition, is a sign that distinguishes the goods of one undertaking from those of other undertakings⁸ and that the purpose of registering it is getting an exclusive right of use (which includes the right to exclude others from using). Therefore, trying to register a trade mark that contains, or somehow refers to, a GI name, in relation to products that do not comply with the GI specifications, but only contain the GI product as an ingredient, can only be seen as an attempt to unduly benefit from the reputation of the GI; exactly what the protection afforded to GIs tries to prevent.

⁸ Cf. Article 4 EUTMR.

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ECTA, which was formed in 1980, is an organisation concerned primarily with trade marks and designs. ECTA has approximately 1,500 members, coming from all the Member States of the EU, with associate Members from more than 50 other countries throughout the world.

ECTA brings together those practicing in the field of IP, in particular, trade marks, designs, geographical indications, copyright and related matters. These professionals are lawyers, trade mark and patent attorneys, in-house lawyers concerned with IP matters, and other specialists in these fields. ECTA does not have any direct or indirect links to, and is not funded by, any section of the tobacco industry.

The extensive work carried out by the Association, following the above guidelines, combined with the high degree of professionalism and recognised technical capabilities of its members, has established ECTA at the highest level and has allowed the Association to achieve the status of a recognised expert spokesman on all questions related to the protection and use of trade marks, designs and domain names in and throughout the European Union, and for example, in the following areas:

- Harmonization of the national laws of the EU member countries;
- European Union Trade Mark Regulation and Directive;
- Community Design Regulation and Directive;
- Organisation and practice of the EUIPO.

In addition to having close links with the European Commission and the European Union Intellectual Property Office (EUIPO), ECTA is recognised by WIPO as a non-Government Organisation (NGO).

ECTA does also take into consideration all questions arising from the new framework affecting trade marks, including the globalization of markets, the explosion of the Internet and the changes in the world economy.