GIs, certification marks and collective marks – are they serving different purposes and value propositions?

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OVERVIEW

**TMss**
- Individual
- Collective
- Certification

**GIs**
- Nature
- Means of protection
- Scope of protection

- Ex-officio examination of TM applications
- GIs as earlier rights
• Regulation (EU) No 1308/2013 - wines;
• Regulation (EU) 2019/787 - spirit drinks;
• Regulation (EU) No 1151/2012 - agricultural products and foodstuffs.

• GIs that enjoy protection in the EU through international agreements to which the EU is a party Article 7(j) EUTMR.
GEOGRAPHICAL INDICATIONS in EU

EU GI REGULATIONS

1 Geographical area

Identification of a product

2 Specific product

Product specification

Collective right

3rd party controls

3 Link between 1 and 2

GI
EU COLLECTIVE MARKS

1. An EU collective mark shall be an EU trade mark which is described as such when the mark is applied for and is capable of distinguishing the goods and services of the members of an association from those of other undertakings. Associations of manufacturers, producers, suppliers, or traders [...], as well as legal persons governed by public law, may apply for EU collective marks.

2. By way of derogation from Article 7(1)(c) EUTMR, signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute EU collective marks. An EU collective mark shall not entitle the proprietor to prohibit a third party from using in the course of trade such signs or indications, provided that he uses them in accordance with honest practices in industrial or commercial matters; in particular, such a mark shall not be invoked against a third party who is entitled to use a geographical name.
### EU CERTIFICATION MARKS

<table>
<thead>
<tr>
<th>Art 83-93 EUTMR</th>
<th>Description</th>
<th>Regulations of Use</th>
</tr>
</thead>
<tbody>
<tr>
<td>Art 2(3) EUTMIR</td>
<td>Ownership</td>
<td>Specific ground of refusal: Misleading</td>
</tr>
<tr>
<td>Art 17 EUTMIR</td>
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</tbody>
</table>

Art. 83 (1) EUTMR: An EU certification mark shall be described as such [...] and is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, with the exception of geographical origin, from goods and services not so certified. (2) Any natural or legal person may apply [...] provided that such person does not carry on a business involving the supply of goods or services of the kind certified.
### GEOGRAPHICAL INDICATIONS AND TRADE MARKS

<table>
<thead>
<tr>
<th></th>
<th>GIs</th>
<th>Individual TM</th>
<th>Collective marks</th>
<th>Certification marks</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Definition</strong></td>
<td>Name or indication which <em>identifies a product</em> with specific geographical origin</td>
<td>Distinguishing the goods or services of one undertaking from those of other undertakings</td>
<td>Distinguishing the goods or services of the members of an association from those of other undertakings</td>
<td>Distinguishing goods or services <em>certified by the proprietor</em> from those not so certified</td>
</tr>
<tr>
<td><strong>Essential function</strong></td>
<td>Geographical origin</td>
<td>Commercial origin</td>
<td>Collective commercial origin</td>
<td>Compliance with certification scheme</td>
</tr>
<tr>
<td><strong>Geographical terms</strong></td>
<td>YES</td>
<td>NO</td>
<td>YES</td>
<td>NO (EU)</td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
<td></td>
<td>YES (National)</td>
</tr>
<tr>
<td><strong>Right to use</strong></td>
<td>Any operator complying with specifications</td>
<td>Proprietor and licensees</td>
<td>Association members <em>Bona Fide Third Parties</em></td>
<td>Certified users <em>Bona Fide Third Parties</em> Not the Proprietor</td>
</tr>
</tbody>
</table>
THANK YOU

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